

United States District Court,
N.D. Illinois, Eastern Division.

W.R. GRACE & CO.-CONN,
Plaintiff.

v.

VISKASE CORPORATION,
Defendant.

July 26, 1991.

MEMORANDUM OPINION AND ORDER

CONLON, District Judge.

Plaintiff W.R. Grace & Co.-Conn. ("Grace") sues Viskase Corporation ("Viskase") for infringing Grace's patent No. 4,755,403 ("the patent" or "the Ferguson patent"). Viskase moves for summary judgment on the grounds that (1) Grace's patent is invalid and (2) Viskase's product does not infringe the patent.

BACKGROUND

The following is a brief sketch of the factual background concerning this litigation. For the sake of clarity, additional facts shall be discussed as they pertain to discrete legal issues.

I. The Ferguson Patent

The patent at issue in this litigation, the Ferguson patent, relates to a shrinkable plastic bag with a multilayer shrinkable plastic patch ("patch bag"). Viskase's Statement of Undisputed Material Facts as to Invalidity ("Viskase's Invalidity Facts") para. 1. The patch bag is used for packaging large pieces of fresh red meat with bones. *Id.* As the patch bag shrinks around the meat, the patch prevents bones from puncturing the bag. *Id.* The patch is comprised of an outer layer made of linear low density polyethylene ("LLDPE") and an inner layer made of an ethylene-vinyl acetate ("EVA") copolymer. *See* Ferguson patent (Grace's Invalidity Ex. 1 and Viskase's Invalidity Ex. A), col. 5, lines 15 to 26. The patch shrinks with the bag, thereby reducing the patch's tendency to delaminate from the bag. Viskase's Invalidity Facts para. 3.

II. Developing the Ferguson Patent

The problem of packaging fresh meat with sharp or pointy bones is not new. Before the patch bag was invented, packagers used a material called boneguard to cover the bones of a piece of meat in order to prevent the bone from puncturing the bag. Grace's Invalidity Ex. 25, p. 53; Grace's Invalidity Ex. 24, col. 1, lines 29-40. However, packagers were unhappy with boneguard because it was not an economically efficient material. Grace's Invalidity Ex. 25 at 56; Grace's Invalidity Ex. 24, col. 1, lines 40-54. In an attempt to improve upon the then-existing bonewrap material, Grace developed a patch bag in which the patch was made from valeron, a material that is not heat shrinkable. Grace's Invalidity Facts para. 46. On August 13,

1985, Grace obtained a patent for its valeron patch bag ("the Kuehne patent"). Id. However, the valeron patch bag was not commercially successful, because customers perceived valeron's stiffness as causing more leaks than boneguard. Id. para. 47.

Grace later developed the Ferguson patch bag described in the foregoing section. Grace's Ferguson patch bag has been a commercial success. Id. para. 53.

III. Viskase's E-Z Guard Patch Bag

In June 1984, Viskase obtained information that Grace had been testing the Ferguson patch bag. Id. para. 49. Viskase studied a sample of Grace's patch bag to determine its composition; Viskase noted that the Ferguson patch shrinks with the bag. Id. In December 1985, Viskase began experimenting to develop a puncture-resistant patch consisting of outer layers containing EVA and LLDPE and an inner layer made with EVA. Grace's Ex. 27. In January 1986, Viskase formulated a "Patch Bag Action Plan" with the objective of "develop [ing] [a] bone guard bag competitive to Cyrovac patch bag." FN1 Grace's Ex. 16. Viskase tested eight patch bags with various materials serving as adhesives. The test results demonstrated that only the Cyrovac patch combined with the Cyrovac bag provided excellent adhesion when submerged in water at temperatures of 90 and 95 degrees Centigrade. Grace's Infringement Facts para. 51.

Viskase now markets an "E-Z Guard Barrier Bag" for packaging fresh meat with bones. Id. para. 52. Viskase represents that its bag contains "an integral patch for extra puncture protection." Id. Viskase promotes the fact that the "Integral Patch Makes Puncture Protection E-Z and eliminates labor costs associated with applying other protective materials." Id. Viskase has manufactured two different types of E-Z Guard patch bags. The first type ("Viskase's old product"), used a patch whose inner layers were made of EVA. Viskase's Infringement Facts para. 15. Viskase stopped manufacturing its old product in November 1990. Id. The inner layers of the current Viskase patch ("Viskase's new patch") are made of ethylene methyl acrylate ("EMA"). Id. The inner layers on both the old and new patches are not self-welding. Instead, these layers are bonded together by an irradiation step. Id. para. para. 17, 18.

DISCUSSION

The Federal Circuit recognizes that "summary judgment is as appropriate in a patent case as in any other," so long as the usual requirements for summary judgment are satisfied. *Brenner v. United States*, 773 F.2d 306, 307 (7th Cir.1985). Summary judgment must be granted when the record shows that there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed.R.Civ.P. 56(c); *Marcial v. Coronet Ins. Co.*, 880 F.2d 954, 959 (7th Cir.1989). A party opposing a properly supported motion for summary judgment may not rest upon mere allegations or denials in the pleadings, but must set forth specific facts showing that there is a genuine issue for trial. Fed.R.Civ.P. 56(e); *Celotex Corp. v. Catrett*, 477 U.S. 317, 324 (1986); *Schroeder v. Lufthansa German Airlines*, 875 F.2d 613, 620 (7th Cir.1989). All reasonable inferences must be viewed in favor of the non-moving party. *Holland v. Jefferson Nat'l Life Ins. Co.*, 883 F.2d 1307, 1312 (7th Cir.1989).

Viskase advances two separate theories in support of summary judgment. First, Viskase contends that the Ferguson patent is invalid. Second, Viskase argues that its E-Z Guard patch bag does not infringe Grace's Ferguson patent.

I. Invalidity Based on Nonobviousness

Once issued, a patent is presumed to be valid, and the burden rests on the party attacking it to show invalidity. 35 U.S.C. s. 282; *Avia Group Int'l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1562 (Fed.Cir.1988). This presumption may be rebutted only by clear and convincing evidence. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050 (Fed.Cir.), *cert. denied*, 488 U.S. 825 (1988). Even if a challenger does introduce evidence disputing validity, the presumption of validity is neither eliminated nor undermined by the challenger's evidence. *Avia Group*, 853 F.2d at 1562. Thus, the challenger bears "the burden of going forward as well as the burden of proof of facts." *Id.*

Viskase contends that Grace's patent is invalid because the patent would have been obvious to one of ordinary skill in the art. Under 35 U.S.C. s. 103:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Obviousness under section 103 is a question of law involving four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) any secondary considerations of nonobviousness. *Uniroyal*, 837 F.2d at 1050. Secondary considerations include objective indicia of nonobviousness such as commercial success, long-felt but unsolved need, and failure of others. *Id.*, citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

A. *Prior Art*

In making a determination on obviousness, the court must not use hindsight gleaned from the invention itself, but must view the invention in light of the state of the art that existed at the time the invention was made. *Uniroyal*, 837 F.2d at 1050-51. As the Federal Circuit explained, "[s]omething in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination." *Id.*, citing *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462 (Fed.Cir.1984).

The Ferguson patch bag provides for a biaxially heat shrinkable protective multilayer patch in combination with a biaxially heat shrinkable bag.FN2 Ferguson's invention provides two attractive features: (1) the patch shrinks with the bag, thereby helping to insure that the patch stays on the bag; and (2) the patch is made of a strong enough material to prevent bone punctures when fresh meat is packaged in the patch bag. Viskase argues that these key features of the Ferguson patent were already taught by four prior inventions, described as follows.

Newsome U.S. Patent No. 4,457,960 ("the Newsome patent") and Engelsberger U.S. Patent No. 4,601,930 ("the Engelsberger patent") disclosed multilayer films made of outer layers of LLDPE and inner layers of EVA. *See Viskase's Invalidity Exs. D and E.* These films are desirable for packaging foods, because the combination of LLDPE and EVA layers made the film strong. Indeed, the Newsome patent stressed its invention's utility for shrink-packaging meats. Viskase's Invalidity Ex. E. Another patent designed for packaging meat, Kuehne U.S. Patent No. 4,534,984 ("the Kuehne patent"), discloses a layer of puncture-resistant film to be placed on one face of a flexible heat shrinkable bag. Viskase's Invalidity Ex. C. The Kuehne invention was specifically aimed at solving the problems associated with packaging fresh meat containing protruding bones. *Id.* The Kuehne patent recommends that the puncture-resistant film should be

made of valeron, a material that does not shrink with the bag. Id. col. 6, lines 55-60; Viskase's Invalidity Facts para. 13.

Finally, Schirmer U.S. Patent No. 4,448,792 ("the Schirmer patent") discloses a multilayer film for making heat shrinkable bags for pasteurizing or cooking food products in near boiling water. Viskase's Invalidity Ex. B. Specifically, the Schirmer patent states:

The instant invention is directed to a multilayer film from which packaging bags can be made which maintain seal integrity, are delamination *resistant*, and are *heat shrinkable* during pasteurizing or cooking of a contained food product at a sustained temperature near that of boiling water.

Id., col. 3, lines 52-57 (emphasis added). According to the Schirmer patent, the invention's delamination resistance is a product of irradiation treatment of the film and the film's shrink compatibility:

it has been discovered that irradiation according to conditions of the invention achieves the desired delamination resistance under pasteurization or cook-in conditions. Additionally, shrink compatibility among the layers of the multilayer film is another aspect in providing delamination resistance.

Id., col. 6 lines 13-19.

Viskase argues that in view of these four patents, anyone skilled in the art would find Ferguson's patch bag obvious. Viskase points out that the Ferguson patch is made of the same material as the Newsome and Engelsberger films. In addition, like the Kuehne patent's layer of reinforcing film, the Ferguson patch is applied to only a portion of the heat shrinkable bag. Furthermore, the Ferguson patch bag emphasizes the shrink compatibility of the patch with the bag to decrease the patch's tendency to delaminate from the bag. This shrink compatibility was emphasized in the Schirmer patent. Thus, Viskase contends that Ferguson merely combined all the useful aspects of the four prior inventions to produce the obvious result of a strong patch that shrinks with the bag to reduce delamination and leakage. For several reasons, the court does not agree.

First, although Ferguson's initial patent application was rejected, the United States Patent and Trademark Office ("the PTO") ultimately issued the Ferguson patent after considering the prior art, including the Newsome, Engelsberger and Kuehne patents. A review of the history of the patent's prosecution is instructive. Ferguson's original patent application claimed only the patch material and not the patch combined with the bag. Viskase's Infringement Facts para. 25. The PTO initially rejected Ferguson's patch, on the ground that the patch was obvious in light of Newsome and other prior patents. Id. para. 26. To overcome this objection, Grace added the claim limitation that:

said patch will, when adhered to said bag, shrink with the bag, thereby reducing the tendency of the patch to delaminate from the bag.

Id. Grace also argued that "the Examiner has overlooked the most important feature of the present invention-the patch tends not to delaminate from the bag." Id. para. 27. Grace further pointed out that:

The citations, Newsome, Brax, and Weinberg et al., are all silent with regard to a patch. Even Cooper ... is also silent with regard to a patch. Thus, no combination of these citations can lead to applicant's invention, absent the disclosure of the present application, *that a patch comprising particular amounts of LLDPE and*

EVA, and particular types of EVA in each layer, said patch being heat shrinkable, ... will achieve the unexpected result that the patch tends not to shrink from the bag, regardless of whether or not a barrier layer such as saran is included in the patch.

Grace's Invalidity Facts para. 27 (emphasis added). Grace, however, still did not claim the patch combined with the bag, and the examiner entered a final rejection of all claims in the original Ferguson patent application. Viskase Invalidity Facts para. 28.

Grace then filed a new patent application ("the divisional application"); this time, Grace claimed both the patch and the bag. Viskase's Invalidity Facts para. 30, 31. In support of its divisional application, Grace submitted an affidavit describing the claimed invention. The affidavit concluded by explaining the differences between the Ferguson patch bag and the prior art:

the structure of a biaxially heat shrinkable patch adhered to a biaxially heat shrinkable bag shrunk with the bag as the bag was shrunk and did not delaminate therefrom, as compared to the structure of a non-shrinkable patch adhered to a biaxially heat shrinkable bag which patch lifted, i.e. delaminated, from the bag as the bag was shrunk.

Viskase's Invalidity Ex. F at 23. Even so, the patent examiner rejected the divisional application. Viskase's Invalidity Facts para. 34. In response to the examiner's rejection, Grace stressed that none of the prior art mentioned by the PTO claimed a patch *and* a bag that were *both* biaxially heat shrinkable:

In summary, there is no positive teaching in any of the references taken either singly or together to employ a biaxially heat-shrinkable patch on a biaxially heat-shrinkable bag. Newsome does not relate at all to putting patches or protective panels on bags. Engelsberger and Lind et al relate to protective panels on bags, but are silent regarding biaxially heat-shrinkable materials. Kuehne relates to protective panels on biaxially heat-shrinkable bags, but his solution is to employ a cross-oriented patch [i.e. the valeron patch]. This is a teaching away from employing a biaxially heat-shrinkable patch as is taught by applicant.... The Examiner would have to employ applicant's own teaching to say do not use Kuehne's cross-oriented protective patch on a biaxially heat-shrinkable bag, but instead use a biaxially heat-shrinkable patch. This is an impermissible hindsight argument.

Id. at 61. As to other claims that the PTO had rejected, Grace stressed that "the Examiner has overlooked the most important feature of the present invention-the biaxially heat-shrinkable patch tends not to delaminate from the biaxially heat shrinkable bag." Id. at 62. This time, the PTO allowed the patent on the Ferguson patch bag. Id. at 65.

Viskase argues that the PTO never would have issued the Ferguson patent had it considered the Schirmer prior art.FN3 As stated previously, the Schirmer invention stressed the importance of making a bag with biaxially heat shrinkable multilayer film, because this type of film reduces delamination between the layers. Viskase contends that Schirmer's "shrink compatibility" teaching provides the missing link between the other prior art and Ferguson's patch bag. Grace repeatedly stressed the importance of matching a heat-shrinkable patch to a heat shrinkable bag. Thus, Viskase asserts that the examiner would have rejected the Ferguson patch bag as obvious in light of Schirmer. However, unlike the Ferguson bag, the Schirmer bag involved cook-in bags and did not contain a patch of any kind.FN4 Thus, the court is not convinced that one skilled in the art would find it obvious to apply Schirmer's shrink compatibility teachings to a patch bag for fresh meat.

The fact that some components of the Ferguson patch bag exist in prior art references does not automatically render Grace's patent invalid. "[I]t is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." *Uniroyal*, 837 F.2d at 1051, citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551 (Fed.Cir.1983), *cert. denied*, 469 U.S. 851 (1984). Viskase's argument in support of invalidity essentially amounts to an impermissible hindsight argument. Viskase has not met its burden of showing that the prior art renders the Ferguson patch bag obvious as a matter of law.

B. Secondary Considerations of Nonobviousness

Moreover, several secondary considerations indicate that the Ferguson patch bag was nonobvious at the time it was developed. The Federal Circuit has underscored the importance of considering objective evidence in making a determination of obviousness:

evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decisionmaker remains in doubt after reviewing the art.

Uniroyal, 837 F.2d at 1053, quoting *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed.Cir.1983). As set forth in the background section, the Ferguson patch bag enjoyed widespread commercial success. Indeed, the uncontested evidence indicates that the Ferguson patch bag provided a long-awaited solution to an industry-wide problem of packaging fresh meat with sharp or pointy bones. Moreover, as soon as Viskase learned of the Ferguson patch bag, Viskase embarked on a program to develop a patch bag that could compete with Grace's new bag. This effort included obtaining a sample of the Ferguson patch bag and testing it to determine its properties. While these actions do not automatically prove the Ferguson patent's validity, they are highly probative when combined with the other objective evidence of nonobviousness.

In sum, taking into consideration the prior art at the time Ferguson developed his patch bag and the other objective indicia of nonobviousness, the court concludes that invalidity has not been proved. Viskase has not presented clear and convincing evidence that one skilled in the art would find the Ferguson patch bag obvious. Accordingly, Viskase's motion for summary judgment on invalidity grounds is denied.

II. Infringement

Grace may recover for infringement by proving either literal infringement or infringement under the doctrine of equivalents. Viskase contends that as a matter of law, neither form of infringement is present in this case.

A. Literal Infringement

In order to determine whether Viskase's product literally infringes on Grace's Ferguson patent, the court engages in a two-step inquiry. First, the Ferguson patent's claims must be interpreted to determine their scope. *Hormone Research Foundation v. Genentech, Inc.*, 904 F.2d 1558, 1562 (Fed.Cir.1990), *cert. denied*, 111 S.Ct. 1434 (1991). Then, the court must determine whether Viskase's accused product falls within the scope of the properly construed claims. *Id.* "Literal infringement requires that every limitation of the patent claim must be found in the accused device." *Uniroyal*, 837 F.2d at 1054.

Claim interpretation is a question of law that may be resolved on summary judgment, unless "evidence pertaining to a claim's interpretation creates a factual dispute." *Becton Dickinson and Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 796 (Fed.Cir.1990). The broadest claim of the Ferguson patent, claim 1, reads:

A protective multi-layer patch in combination with a biaxially heat shrinkable bag, said patch comprising:

(I) an outer layer comprising a linear low density polyethylene [LLDPE];

(II) an inner layer comprising an ethylene-vinyl acetate copolymer [EVA];

(III) said patch being biaxially heat shrinkable, and being adhered to said bag;

(IV) wherein said patch will shrink with the bag, thereby reducing the tendency of the patch to delaminate from the bag.

Grace's Infringement Ex. 1, col. 5, lines 16-26. All the claims of the Ferguson patent require that the patch have an inner layer "comprising" EVA. Viskase's Infringement Facts para. 2. Viskase argues that its new E-Z Guard patch bag does not literally infringe the Ferguson patent because Viskase's new product does not have an EVA inner layer. Instead, Viskase's new product is made of an inner layer of EMA. EVA and EMA are two distinct chemical compounds with different formula structures. Viskase's Infringement Facts para. 16. Thus, Viskase's new product does not contain every limitation claimed in the Ferguson patent; as a matter of law, Viskase's new product does not literally infringe.

Viskase's old product, however, did contain an inner layer of EVA. For the purposes of this motion, Viskase concedes that its old product literally infringes. Nevertheless, Viskase argues that the EVA inner layers of its old product are substantially different from the Ferguson patch bag's EVA inner layers. Thus, Viskase contends that its old product did not infringe Grace's patch bag under the reverse doctrine of equivalents. Before addressing Viskase's reverse doctrine of equivalents theory, the court shall first consider whether Viskase's new product infringes under the doctrine of equivalents.

B. Infringement Under the Doctrine of Equivalents

Although Viskase's new product does not literally infringe the Ferguson patent, Grace asserts that the EMA inner layer of Viskase's new product infringes its Ferguson patent under the doctrine of equivalents. Even if the accused product does not literally infringe the patent, the doctrine of equivalents allows a patentee to recover for infringement if the accused product "performs substantially the same overall function or work, in substantially the same way, to obtain substantially the same overall result as the claimed invention." *Insta-Foam Products v. Universal Foam Systems*, 906 F.2d 698, 702 (Fed.Cir.1990).

The parties do not dispute that Viskase's new E-Z Guard bag obtains substantially the *same result* as the Ferguson patch bag; both products serve as packages for fresh red meat that have strong patches to prevent protruding bones from puncturing the bag. In addition, the undisputed evidence demonstrates that Viskase's patch bag performs substantially the *same function* or work as Grace's patch bag. Both products consist of a heat shrinkable bag with an integral patch that shrinks with the bag.FN5 Thus, the only issue before the court is whether Viskase's new patch bag functions in substantially the *same manner* as Grace's patch bag. Viskase points out that its EMA inner layer does not self-weld, whereas the EVA inner layers of the

Ferguson patch are self-welding. Because EMA does not self-weld, Viskase must use an irradiation process in order to force the inner layers of its patch to adhere to each other. Viskase asserts that the Ferguson patent specifically requires the inner layers of the patch to be self-welding. Thus, according to Viskase, the absence of self-welding in its inner layer means that Viskase's product does not perform in "substantially the same way" as Grace's product.

Viskase points out that in developing his patch bag, Ferguson abandoned any materials that did not self-adhere, because self-welding materials "worked better." Viskase's Infringement Ex. C at 127. In addition, the Ferguson patent's invention summary describes the invention as follows:

In one aspect, the subject invention is a method of making a multi-layer protective bag comprising *the steps of*: coextruding a multi-layer thermoplastic tube, the inner wall of said tube comprising [EVA] and the outer wall comprising ... [LLDPE] ...; applying a sufficient amount of powdered cornstarch or the like to the interior of the tubular extrudate so that upon collapsing, the tube will not self adhere; collapsing the tube; irradiating the collapsed tube to cross-link the materials thereof; opening, heating and stretching the tube to biaxially orient the tube material; *collapsing and flattening the oriented tube whereupon the tube adheres to itself....*

Ferguson patent, col. 1, line 60 to col. 2, line 9 (emphasis added). Viskase seizes on this language and argues that the Ferguson patent *requires* a self-welding inner layer. However, claim 1 (set forth in the previous section) does not expressly require the inner layers of the patch to self-weld. According to Grace, the critical aspect of the inner layer is its ability to adhere to the outer layers, not its ability to self-weld. Grace submits considerable evidence demonstrating that EMA and EVA are both used as adhesives to bond the outer LLDPE patch layers. *See* Grace's Infringement Facts para. 15, 16; Oberle Aff. para. 5-10, attached as Ex. 7 to Grace's Infringement Facts. In this respect, Grace asserts that EMA is the functional equivalent of EVA.

In sum, the parties offer conflicting evidence as to the importance of self-welding inner layers in the Ferguson patch. If self-welding is required, then Viskase has not infringed under the doctrine of equivalents. On the other hand, if self-welding is not imperative to the Ferguson invention, then Viskase may have infringed under the doctrine of equivalents. Because disputed issues of material fact underlie the determination of infringement under the doctrine of equivalents, summary judgment is inappropriate. The court cannot determine as a matter of law that Viskase's new product has not infringed under the doctrine of equivalents.

C. Reverse Doctrine of Equivalents

For the purposes of this motion, Viskase concedes that its old product, containing an inner layer of EVA, literally infringes the Ferguson patent. Nevertheless, Viskase asserts that as a matter of law, the reverse doctrine of equivalents allows Viskase to avoid infringement. This doctrine applies to literally infringing inventions that are so far changed in principle from the patented invention that the patented claim should be restricted. *Texas Instruments*, 846 F.2d at 1371. In order to invoke the reverse doctrine equivalents, (1) there must be apparent literal infringement of the words of the claim, and (2) the accused device must be sufficiently different from the patented invention that despite the apparent literal infringement, the patented claims are interpreted to negate infringement. *Id.*

Viskase contends that the lack of self-welding in its old product renders it so far removed from the Ferguson

patch bag that there can be no infringement. However, as explained in the foregoing discussion, the parties have presented conflicting evidence concerning the importance of self-welding inner layers in the Ferguson patch. This dispute creates a genuine issue of material fact that precludes summary judgment as to noninfringement under the reverse doctrine of equivalents.

CONCLUSION

Viskase's motion for summary judgment as to patent invalidity is denied. Viskase's motion for summary judgment as to non-infringement is denied.

FN1. Cyrovac is a subsidiary of Grace.

FN2. Viskase attacks the broadest claim of the Ferguson patent, claim 1. For the purposes of this motion, the court addresses the obviousness issue as to claim 1. As Viskase recognizes, if summary judgment as to claim 1 is inappropriate, then summary judgment as to the narrower claims in the patent would also be inappropriate.

FN3. Viskase and Grace agree that the Schirmer patent was not before the PTO during prosecution of the Ferguson patent. Grace is the assignee of the Schirmer patent and thus had knowledge of the Schirmer invention. Viskase's burden of proving invalidity by clear and convincing evidence is not reduced when prior art is presented to the court that was not considered by the PTO. *Uniroyal*, 837 F.2d at 1050. However, the Schirmer patent may serve as evidence for Viskase in meeting its burden of proof. *Id.*

FN4. Viskase attempts to convince the court that both Ferguson and the PTO acknowledge that the patch may be merely an additional layer on the multilayer bag. However, the history of Grace's patent prosecution indicates that Grace repeatedly stressed to the examiner the differences between its patch and the prior art's layers. Accordingly, Viskase has not introduced uncontradicted evidence on this point.

FN5. Viskase mistakenly argues that the function prong of the doctrine of equivalents is not met because the EMA inner layer of its new product does not self-weld, whereas the EVA inner layer of Grace's product is self-welding. However, under the doctrine of equivalents, the relevant inquiry is not whether EMA performs the same function as EVA, but whether Viskase's *product* performs the same function as Grace's *product*. *See Texas Instruments v. United States Int'l Trade Commission*, 846 F.2d 1369, 1371 (Fed.Cir.1988) ("[e]ach function in a claim is part of a combination, not a separate invention").

N.D.Ill.,1991.

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