

United States District Court,
E.D. Pennsylvania.

ENVIRON PRODUCTS, INC,
Plaintiff.

v.

TOTAL CONTAINMENT, INC,
Defendant.

Aug. 27, 1997.

John J. Marshall, Arthur H. Seidel, Seidel, Gonda, Lavorgna & Monaco, P.C., Joseph R. Del Master, Jr., Seidel, Gonda, Lavorgna and Monaco, P.C., Phila, PA, for Environ Products, Inc., Plaintiff.

Charles J. Bloom, Stevens & Lee, P.C., Wayne, PA, James J. Merek, Merek & Voorhees, for Total Containment, Inc., Defendant.

MEMORANDUM

GAWTHROP, J.

Before the court is Defendant Total Containment, Inc's Motion for Partial Summary Judgment, pursuant to Fed.R.Civ.P. 56, that Claims 33 to 47 of U.S. Patent No. 5,297,896 are invalid for failure to comply with 35 U.S.C. s. 305 because they impermissibly broaden the scope of the original patent grant. Plaintiff Environ Products, Inc. counters that the new claims are much narrower than the original. Upon the following reasoning, I shall deny Defendant's motion.

I. Background

Plaintiff Environ Products, Inc. and Defendant Total Containment, Inc. ("TCI") are competing manufacturers of secondary containment systems for underground piping systems. Both hold patents relating to secondary containment systems, and both have appeared before me in previous patent litigation.

The current action began when Environ filed a complaint alleging that TCI had infringed several patents, including U.S. Patent No. 5,297,896 ("the '896 patent"). Shortly before this suit was filed, however, TCI requested that the Patent and Trademark Office ("PTO") reexamine the '896 patent. The patent examiner confirmed the patentability of Claims 1-29 and 31, but rejected original Claims 30 and 32 in light of prior art submitted by TCI. In its response, Environ canceled original patent Claims 30 and 32, and added new Claims 33 to 47. The reexamination proceeding ended when the PTO issued reexamination certificate B1 5,297,896.

Original Claims 1 to 28 all require "an originating chamber," "a terminating chamber," and a "sealing device." Claim 29 does not have these elements, but instead claims:

A secondarily contained underground piping system for connecting the elements of the system including a dispensing pipe of an underground storage tank to an above ground dispensing unit, comprising:

a) at least one chamber installed around at least one of the elements of the system; and

b) a flexible piping connecting the elements consisting of an inner pipe member, an outer pipe member circumscribing the inner pipe member, a plurality of circumferentially spaced ribs extending radially from one of said pipe members having a surface confronting and snugly engaging the other pipe member and defining a *plurality of interstitial spaces* between the pipe members; and the confronting surfaces of said ribs having a predetermined configuration in a longitudinal direction to permit *migration of a fluid* in said interstitial spaces in all directions.

(emphasis added). Claim 31 repeats the first paragraph and subparagraph a) of Claim 29, then continues:

b) a flexible piping connecting the elements consisting of an inner pipe contained by an outer pipe is in radial communication with the outside surface of the inner pipe in such a manner that a *small interstitial space* between both walls is created to permit *fluid and gas migration* in both a radial and a longitudinal directions even under outside pressures created from underground burial conditions.

(emphasis added).

Canceled Claims 30 and 32 duplicated Claims 29 and 31 except in subparagraph b). Subparagraph b) of Claim 30 provided:

b) a flexible piping connecting the elements consisting of an inner and a outer pipe whereby the inside surface of the outer pipe has a plurality of internally facing longitudinal ribs in radial communication with the outside surface of the inner pipe in such a manner that a *small interstitial space* between both walls is created to permit *fluid and gas migration* from on [sic] end of the pipe section to the other.

Claim 32 stated:

b) a flexible piping connecting the elements consisting of an inner and a outer pipe is in radial communication with the outside surface of the inner pipe in such a manner that a *small interstitial space* between both walls is created to *permit fluid and gas migration* from one end of the pipe section to the other.

(emphasis added).

The claims added by Environ during the reexamination include 5 independent claims and 9 dependent claims. Independent Claims 33, 36, 39, 42 and 45 contain identical preambles, first, second, and fourth paragraphs, and similar third paragraphs:

A secondarily contained underground piping system for connecting the elements of the system including a dispensing pipe of an underground storage tank to an above ground dispensing unit, comprising:

at least one chamber installed around at least one of the elements of the system; and

flexible coaxial piping connecting the elements, said flexible coaxial piping consisting of an inner flexible primary pipe and a separate flexible damage protection and standoff pipe for secondary containment, each of said primary pipe and standoff pipe having an inner and an outer surface respectively, and

a multitude of separator legs extending radially inward from the inner surface of said standoff pipe and contacting the outer surface of the primary pipe, said separator legs creating an *interstitial space* for fluid ...
FN1

FN1. The claim language varies at this point. As discussed below, Claims 39 and 45 also have different claim language at the beginning of this paragraph.

said primary pipe comprising a plurality of layers including an inner barrier and an outer protection layer. (emphasis added). Claim 33's third paragraph provides "for fluid migration in all directions between the primary and standoff pipes," while Claim 36 claims "fluid migration in both radial and longitudinal directions between the primary and standoff pipes" In addition, the third paragraph of Claim 39 specifies that only "one of said primary pipe and standoff pipe having a multitude of separator legs ... said separator legs creating an interstitial space for fluid migration in all directions between the primary and the standoff pipes" Claim 45 similarly limits its third paragraph: "one of said primary pipe and standoff pipe having a multitude of separator legs ... said separator legs creating an interstitial space for fluid and gas migration through the coaxial pipe from one end to the other within the interstitial space" Claim 42's third paragraph provides "for fluid and gas migration through the coaxial pipe from one end to the other within the interstitial space." FN2

FN2. Because the arguments for the dependent claims' invalidity duplicates those for the independent claims' invalidity, I shall not discuss the dependent claims separately. I would note that Claims 34 and 35 depend from Claim 33, Claims 37 and 38 depend from Claim 36, Claims 40 and 41 depend from Claims 39, Claims 43 and 44 depend from Claim 42, and Claims 46 and 47 depend from Claim 45.

TCI argues that Claims 33 to 47 are impermissibly broader than the original claims. Thus, TCI has filed a Motion for Partial Summary Judgment, seeking a declaration that Claims 33 to 47 are invalid because they violate 35 U.S.C. s. 305. Environ counters that the new claims narrow, rather than broaden, the scope of the '896 patent.

II. *Standard of Review*

Summary judgment is proper "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c). Unless evidence in the record would permit a jury to return a verdict for the non-moving party, there are no issues for trial, and summary judgment becomes appropriate. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986). In considering a motion for summary judgment, a court does not resolve factual disputes or make credibility determinations, and must view facts and inferences in the light most favorable to the party opposing the motion. *Siegel Transfer, Inc. v. Carrier Express, Inc.*, 54 F.3d 1125, 1127 (3d Cir.1995). The party opposing the summary judgment motion must come forward with sufficient facts to show that there is a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548, 91

III. Discussion

TCI asserts that the claims added during the reexamination of the '896 patent are invalid because they violate 35 U.S.C. s. 305. *See Quantum Corp. v. Rodime PLC*, 65 F.3d 1577, 1584 (Fed.Cir.1995), *cert. denied*, 517 U.S. 1167, 116 S.Ct. 1567, 134 L.Ed.2d 666 (1996) (holding that a violation of s. 305 renders the claim invalid). Section 305 provides in relevant part: "No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter." Thus, the key issue is whether the new claims enlarge the scope of the original patent. If, in a new claim, a patentee omits a term or phrase appearing in an original claim, it does not follow automatically that the claim has been enlarged. *See Tillotson Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 (Fed.Cir.1987).FN3 Rather, "[a] claim is enlarged if it includes within its scope any subject matter that would not have infringed the original patent." *In re Freeman*, 30 F.3d 1459, 1464 (Fed.Cir.1994). Further, a "claim that is broader in any respect is considered to be broader than the original claims even though it may be narrower in other respects." *Id.* (quoting *Tillotson*, 831 F.2d at 1037 n. 2). Whether a new claim enlarges the scope of the original patent claims is a matter of claim construction. *Id.* Claim construction is itself a question of law. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 1393-95, 134 L.Ed.2d 577 (1996). However, resolution of that question may turn on underlying facts which, for example, may be illuminated by expert testimony. *Tillotson*, 831 F.2d at 1039.

FN3. *Tillotson* involves the standard for compliance with 35 U.S.C. s. 251, the provision on reissue. The compliance standard for s. 305 is identical. *In re Freeman*, 30 F.3d at 1464.

Claim interpretation begins with the claim's language, giving the words of the claim their ordinary meaning "unless it appears the inventor used them otherwise." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619-20 (Fed.Cir.1995). Courts also should look to the patent's specification and its prosecution history, if in evidence. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). Although extrinsic evidence may be used for the court's understanding of the claim, it may not be used to vary or contradict the terms of the claim. *Id.* at 981. *See also Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed.Cir.), *cert. denied*, 516 U.S. 987, 116 S.Ct. 515, 133 L.Ed.2d 424 (1995).

TCI first suggests that new Claims 33 to 47 are broader than original Claims 1 to 28 because they do not share those original claims' requirements of an originating chamber, a terminating chamber, and a sealing device. TCI then adds that they are also broader than Claim 29 because the added claims speak only of "an interstitial space" rather than a "*plurality of interstitial spaces*." Environ counters that the only comparison which should be made is between the new claims and Claim 32, the broadest original claim.

The heart of the enlargement test lies in the question: does the new claim "include[] within its scope any subject matter that would not have infringed the original patent"? *In re Freeman*, 30 F.3d at 1464. If the answer is yes, then the new claim is broader and, thus, invalid. In its motion, TCI essentially reframes the question to: does the new claim include within its scope any subject matter that would not have infringed *any claim within* the original patent? TCI's rephrasing is too restrictive. The test speaks in terms of "the original patent" as a whole, rather than of claims within the patent. Thus, while the subject matter of Claims 33 to 47 apparently would not infringe Claims 1 to 29,FN4 the question here is whether it would not infringe

the entire patent, including original Claims 30, 31 and 32.

FN4. TCI correctly notes that it is possible to design a device meeting the requirements of Claims 33 to 47 which would not infringe Claims 1 to 29. A hypothetical device with one chamber and the flexible coaxial piping required by Claims 33 to 47 would not infringe Claims 1 to 28 if it omitted "an originating chamber," "a terminating chamber" or "a sealing device." This same device would not infringe Claim 29 if it had one interstitial space rather than a "plurality of interstitial spaces."

TCI contends that the new claims would not infringe original Claims 30 to 32 because the former lack the latter claims' size restrictions. The original claims required a " *small* interstitial space," while the new Claims 33 to 47 speak simply of an "interstitial space." Environ responds that the adjective "small" was surplusage, an indefinite term which did not provide a meaningful limitation on the claim. Environ thus argues that its omission does not broaden the scope of the claim.

Environ makes a strong argument for the term's indefiniteness. The dictionary defines small, in relevant part, as "having little size ... as compared with other similar things," or as "little in a way that is objectively measurable." *Webster's Third New Int'l Dictionary, Unabridged* 2149 (1986). Under these definitions, this term has no definable scope without a frame of reference. Because neither the claim language itself nor the specifications provide a referential frame for the space's size, "small" lacks meaning here. *See also* In re Hotchkin, 42 C.C.P.A. 1013, 223 F.2d 490, 106 U.S.P.Q. 267, 270 (C.C.P.A.1955) ("the reference to a ' *small* slope' is not sufficiently definite to constitute a patentable limitation.") (emphasis added). TCI itself made a similar argument in its Response to Environ's Interrogatories regarding Claim 31: "the term small is not defined in the specification is extremely ambiguous thereby rendering the claim vague and indefinite."

At first glance, the elimination of "small" does not appear problematic. This is not a case where the patentee changes a defined limit to an undefined one, thus broadening the claim. *See, e.g.,* Quantum, 65 F.3d at 1581 (ruling patentee impermissibly broadened claim when changed the phrase "at least 600 tpi" to "at least *approximately* 600 tpi"). Here, instead, the patentee eliminated an indefinite term. On the surface, such a change appears neutral, not affecting the substance of the claim.

But TCI raises the issue of whether use of an indefinite term renders the entire claim invalid. TCI argues that if the meaning of "small" could not be determined, then no device would infringe Claims 30, 31 or 32. *See* 35 U.S.C. s. 112, 2d para. ("The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."). It follows logically, TCI continues, that the subject matter of Claims 33 to 47 would not infringe Claims 30 to 32; because they would not infringe, the new claims are broader than the original claims. To complicate matters, Environ itself uses language which supports this argument: "It is impossible to see what device may have infringed original claim 32 if, as TCI has explicitly responded, the meaning of 'small' cannot be determined." (P.'s Opp'n at 14).

The test for whether a claim is invalid under the second paragraph of s. 112 is whether a person of ordinary skill in the art would understand what is claimed when the claim is read in light of the specifications. *See, e.g.,* Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed.Cir.1986). It appears that the subject matter of this invention, as shown in the specifications, is the structure of the underground piping system, not its size. At this stage, however, it is unclear whether size information is necessary to claim this structure with particularity, as required by s. 112. If testimony reveals that a person of ordinary skill in the

art would not require size information to understand what is claimed, then the term "small" would not render the claim indefinite, and thus invalid. Rather, "small" would be surplusage which could be eliminated without broadening the claim. Summary judgment at this juncture, however, would be inappropriate.

TCI's final argument is that Claims 33 to 41 are broader than Claims 30 to 32 because they describe only "fluid migration" rather than "fluid *and gas* migration." Environ maintains that "fluid and gas" was redundant because gas may be a fluid. In support, Environ quotes the following definition:

fluid n 1: a substance that alters its shape in response to any force however small, that tends to flow or to conform to the outline of its container, *and that includes gases* and liquids and in a strictly technical sense certain plastics and solids and mixtures of solids and liquids capable of flow.

Webster's at 877 (emphasis added). Because "fluid and gas" is literally redundant, elimination of "and gas" does not enlarge the scope of the claims. Thus, I find that the omission of "gas" from Claims 33 to 41 does not violate s. 305.

An order follows.

ORDER

AND NOW, this 27th day of August, 1997, upon the reasoning in the attached Memorandum, Defendant's Motion for Partial Summary Judgment that Claims 33 to 47 of U.S. Patent No. 5,297,896 are invalid is DENIED.

E.D.Pa.,1997.

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