MULTILAYER STRETCH CLING FILM HOLDINGS, INC. v. BERRY PLASTICS CORP., Appeal No. 2015-1420, 1477 (Fed. Cir. August 4, 2016) (Dyk, Plager and Taranto). Appealed from W.D. Tenn. (Judge Young).

Background:

Multilayer filed a patent infringement suit alleging that Berry's plastic stretch films infringed Multilayer's patent. During the district court's *Markman* hearing, the district court construed a Markush group recited in the independent claims of the patent. For example, independent claim 1 recited "five identifiable inner layers, with each layer being selected from the group consisting of linear low density polyethylene, very low density polyethylene, ultra low density polyethylene, and metallocene-catalyzed linear low density polyethylene resins..."

The district court construed the claimed Markush group as limiting each of the five layers to being made of one of the listed resins, and excluding all other resins, or any blend/combination of the listed resins. The district court granted Berry's motion for summary judgment of non-infringement based on these claim constructions. Multilayer appealed.

Issues/Holdings:

Did the district court err in construing the claimed Markush group to be limited to only the listed elements? No, affirmed.

Did the district court err in construing the claimed Markush group to exclude blends/combinations of the listed elements? Yes, reversed and remanded.

Discussion:

The Federal Circuit held that a Markush group that uses "consisting of" creates a very strong presumption that the claim element is limited only to the recited group, which may be overcome by a contrary showing in the specification or the prosecution history. Multilayer argued that the Markush group is open to other resins because the specification lists other resins that may be used and a dependent claim adds additional resins to the Markush group. The Federal Circuit dismissed this argument stating that merely reciting additional resins in the specification is not sufficient to overcome the strong presumption. The Federal Circuit further held that a dependent claim that adds additional resins to a Markush group using "consisting of" is an improper dependent claim under 35 U.S.C. §112(d).

Following *Abbott Labs. v. Baxter Pharm. Prods., Inc.*, 334 F.3d 1274 (Fed. Cir. 2003), the Federal Circuit held that use of the term "consisting of" creates a presumption that the claimed group excludes the use of mixtures, combinations, or blends of the elements, except where the intrinsic evidence overcomes this presumption. The Federal Circuit held that the intrinsic evidence of the patent overcomes this presumption because the claimed "linear low density polyethylene" is a broad term that encompasses "metallocene-catalyzed linear low density polyethylene", which is also recited within the Markush group. The Federal Circuit held that because at least some of the resins listed in the Markush group overlap each other, the group does not recite entirely different species. Further, a dependent claim recites that the claimed layer "comprises a blend of at least two of said resins" referring to the resins recited in the Markush group. Thus, the Federal Circuit held that the district court erred because the Markush group should be construed to be open to blends/combinations of the listed resins.