PLASTIPAK PACKAGING, INC. v. PREMIUM WATERS, INC., Appeal No. 2021-2244 (Fed. Cir. December 19, 2022). Before Newman, Stoll, and Stark. Appealed from W.D. Wis. (Judge Conley).

Background:

Plastipak sued Premium Waters for infringement of twelve patents which concern a plastic bottle with a neck portion that contains threads for screwing on and off a bottle cap, a discontinuous tamper-evident formation to show that the bottle has been opened, and a support flange. These patents generally include two limitations: an X-dimension of the neck portion from the flange to the top being 0.580 inches or less ("X-dimension limitation") and the discontinuous tamper-evident formation ("TEF limitation"). Each patent lists Mr. Darr and Mr. Morgan as inventors.

Premium Waters argued for invalidity of all patents due to nonjoinder of a third unnamed co-inventor, Mr. Falzoni, under pre-AIA 35 U.S.C. §102(f)[1]. While working on a project, Falzoni sent an email to Darr with a 3D model of a bottle with a neck portion finish that explicitly showed the TEF limitation. Although the 3D model did not have a flange and thus did not explicitly show the X-dimension limitation, Falzoni testified that, from an assumed flange position, the X dimension of the 3D model was about 0.563 inches. Premium Waters then filed a summary judgment motion for invalidity that the patents are invalid due to nonjoinder of an unnamed co-inventor who contributed to the conception of the X-dimension and the TEF features. Plastipak argued that Falzoni did not contribute sufficiently. His 3D model did not show the X-dimension feature, and, for the TEF feature, he merely contributed the state of the art. The district court granted Premium Water's summary judgment motion. Plastipak appealed.

Issue/Holding:

Did the district court err in invalidating the patents for nonjoinder of an unnamed co-inventor on summary judgment? Yes, reversed and remanded.

Discussion:

The Federal Circuit reminded that summary judgment is proper only when the movant shows that there is no genuine dispute of any material facts even when all facts and reasonable inferences are drawn in the light most favorable to the nonmoving party. That is, to invalidate the patents on summary judgment, Premium Waters had to present evidence from which all reasonable fact finders, taking the evidence in the light most favorable to Plastipak, would have to conclude that Falzoni actually contributed to the conception of the invention.

The Federal Circuit stated that the record reflects otherwise. The email from Falzoni to Darr did not explicitly show the X-dimension feature, and the email specifically asked Darr to finish off the design. Plastipak's expert testified that the 3D model does not have a definite flange position, and thus its X-dimension cannot be determined. Plastipak also produced prior art that showed that the TEF feature was merely the state of the art.

[1] Pre-AIA §102(f) bars the issuance of a patent where an applicant did not invent the subject matter being claimed. This section is now eliminated in the AIA under which a derivation proceeding is available instead.