

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

MILLER PRODUCTS CO., INC.)
)
 Plaintiff,)
)
 v.) Civil Action No. 01-35-KAJ
)
VELTEK ASSOCIATES, INC.)
and ARTHUR L. VELLUTATO,)
)
 Defendants.)

MEMORANDUM ORDER

I. INTRODUCTION

This is a patent infringement case. Jurisdiction is proper under 28 U.S.C. §§ 1331 and 1338. On January 17, 2001, plaintiff Miller Products Co., Inc. (“Miller”) filed a complaint seeking declaratory judgment of invalidity and non-infringement of United States Patent No. 6,123,900 (issued September 26, 2000) (“the ‘900 patent”) entitled “Method of Sterilization.” On March 5, 2001, Miller filed a first amended complaint, adding a request for declaratory judgment of unenforceability of the ‘900 patent due to inequitable conduct. (D.I. 4.) The ‘900 patent is owned by the defendant Arthur L. Vellutato, Sr. and licensed to defendant Veltek Associates, Inc. (collectively “Veltek”). (D.I. 4 at ¶ 9.) On April 10, 2001, Veltek filed an answer to Miller’s first amended complaint, denying invalidity and unenforceability of the ‘900 patent, counterclaiming for patent infringement of the ‘900 patent by Miller and asserting additional defenses. (D.I. 10.)

Presently before me is Miller's Motion for Summary Judgment of Invalidity of the '900 Patent for Obviousness Pursuant to 35 U.S.C. § 103(a). (D.I. 29.) For the reasons that follow, I will deny the motion.

II. BACKGROUND

The '900 patent claims a method of sterilizing alcohol contained in an aerosol container and a method of storing the sterilized alcohol composition.¹ See '900 patent, claims 1, 6, 9. The sterilization and storage methods described and claimed in the '900 patent were conceived sometime prior to 1992.² (D.I. 41 at 3.) In March 1992, two brief "reader service card"³ descriptions of Veltek's product appeared in *CleanRooms: The Magazine of Contamination Control Technology* ("*CleanRooms*"), a trade journal in the contamination control industry, even though the product was not available for sale at that time. (D.I. 41 at 4, 9.) Veltek did not sell or offer to sell the invention of the '900 patent, now sold under the "Decon-Ahol" name, prior to October 28, 1992. (*Id.*)

¹The invention claimed in the '900 patent is intended for use in clean rooms. See '900 patent at 2:53-58; 5:43-53. A clean room is a sterile work environment usually comprising a forced air system which maintains a positive pressure within the environment and antechamber through which sterile materials can be passed without contaminating the internal environment. (D.I. 30 at 1, f.n.1.)

²Also prior to 1992, Veltek located a Canadian company that, through its offices in England, had a gamma radiation capacity that was suitable for carrying out the sterilization process of the invention embodied in the '900 patent on a commercial basis. (D.I. 41 at 4.) In early 1992 Veltek placed orders with the company for commercial quantities of alcohol-charged pressurized aerosol containers packaged and sterilized according to the invention. (*Id.*)

³Certain trade magazines like *CleanRooms* offer a service, typically called the reader service card, which allows a subscriber or reader of a particular trade magazine to tear from the magazine one or more pre-addressed postcards relating to products described elsewhere in the magazine. (D.I. 41 at 8.)

On October 28, 1993, Veltek filed U.S. patent application Serial No. 08/142,049 (“the ‘049 application”) in the U.S. Patent and Trademark Office (“PTO”), which ultimately matured into the ‘900 patent. (D.I. 41 at 5.) Each of the original application claims 1-20 were rejected under 35 U.S.C. § 103(a) as being obvious to one of ordinary skill over prior art references teaching methods for packaging and sterilizing chemicals. (D.I. 30, Exh. C.) After several amendments by Veltek, the Examiner ultimately issued a final rejection of application claims 1-20 on obviousness grounds. (D.I. 30, Exh. F.) Veltek appealed the Examiner’s decision to the Board of Patent Appeal and Interferences (“Board”). (D.I. 30, Exh. G.) The Board affirmed the Examiner’s final rejection, finding that the claimed methods were obvious in view of the prior art. (*Id.*)

Following the Board’s decision, Veltek filed a Preliminary Amendment to the ‘049 application, canceling all of the appealed claims 1-20 and adding new application claims 21-30. (D.I. 30, Exh. H.) In response to the Preliminary Amendment, the Examiner issued an Office Action stating that application claims 21-25 and 30 were allowed, and that application claims 27 and 28 contained allowable subject matter because the prior art failed to teach “a pressurized aerosol container of alcohol as the chemical composition.” (D.I. 30, Exh. I.) In response to the Examiner’s Office Action, Veltek canceled claim 27 and incorporated the features of claim 27 into application claim 26.⁴

⁴Independent application claim 26 was initially rejected by the Examiner, as was application claim 29, which depended from application claim 26. (D.I. 30, Exh. I.) Once Veltek amended independent application claim 26 and it was allowed by the Examiner, dependent application claim 29 was also allowed. (*Id.*)

(D.I. 30, Exh. J.) Application claims 21-26 and 28-30 then issued as claims 1-9 of the '900 patent.⁵ (*Id.*)

III. STANDARD OF REVIEW

Summary judgment is appropriate in patent suits as in other civil actions. *Rains v. Cascade Industries, Inc.*, 403 F.2d 241, 244 (3d Cir. 1968). The court may grant summary judgment “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 judgment as a matter of law.” Fed. R. Civ. P. 56(c). Thus, summary judgment is appropriate only if the moving party shows there are no genuine issues of material fact that would permit a reasonable jury to find for the non-moving party. *Boyle v. County of Allegheny Pa.*, 139 F.3d 386, 392 (3d Cir. 1998). A fact is material if it might affect the outcome of the suit. *Id.* (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-8, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986)). An issue is genuine if a reasonable jury could possibly find in favor of the non-moving party with regard to that issue. *Id.* In deciding the motion, the court must construe all facts and inferences in the light most favorable to the non-moving party. *Id.*; see also *Assaf v. Fields*, 178 F.3d 170, 173-4 (3d Cir. 1999).

When a party challenges a patent’s validity, the court begins with the statutory presumption of validity. 35 U.S.C. § 282 (“A patent shall be presumed valid.”). Accordingly, “the burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.” *Id.* Invalidity must be shown by clear and

⁵Claims are renumbered by the PTO upon allowance of a patent application.

convincing evidence. *Robotic Vision Sys., Inc. v. View Eng'g, Inc.*, 189 F.3d 1370, 1377 (Fed. Cir. 1999). This presumption of validity is never weakened, and the burden of proving invalidity does not shift from the party asserting invalidity. *Imperial Chemical Industries, PLC v. Danbury Pharmacal, Inc.*, 745 F. Supp. 998, 1004 (D. Del. 1990) (citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1574-5 (Fed. Cir. 1984); *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1360 (Fed. Cir. 1984)). The burden of going forward with evidence rebutting invalidity may shift to the patentee only after the party asserting invalidity has demonstrated a legally sufficient *prima facie* case of invalidity. *Ashland Oil, Inc. v. Delta Resins & Refractories Inc.*, 776 F.2d 281, 291 (Fed. Cir. 1985). If the party asserting invalidity has established a legally sufficient case of invalidity, the court then examines all of the evidence of invalidity together with all of the evidence rebutting invalidity, and determines whether there is clear and convincing evidence of invalidity. *Id.* at 291-2.

IV. DISCUSSION

Miller moves for summary judgment on the basis that all nine claims of the '900 patent are invalid for obviousness. (D.I. 30 at 7.) Thus, Miller has the burden of establishing a *prima facie* case of invalidity by clear and convincing evidence. *Ashland Oil*, 776 F.2d at 291. A patent is invalid for obviousness under 35 U.S.C. § 103

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.

35 U.S.C. § 103(a). The ultimate determination of obviousness is a question of law based on underlying factual inquiries. See *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 1362 (Fed. Cir. 1998) (citation omitted). These inquiries include determining (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) secondary considerations, which include objective evidence of nonobviousness such as long-felt but unsolved need, failure of others and commercial success. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).⁶

In its attempt to make out a *prima facie* case of obviousness, Miller presents the following points. (D.I. 43 at 4.) First, Miller argues that the *CleanRooms* reader service card constitutes a prior art reference. (*Id.*) Second, Miller argues that the *CleanRooms* magazine reader service card was not before the Examiner during prosecution of the application which ultimately issued as the '900 Patent. (*Id.*) Third, Miller argues that the *CleanRooms* reader service card "clearly teaches the sole element that the Examiner thought was not found in the prior art - *i.e.*, the use of pressurized aerosol containers of alcohol." (*Id.*) Miller then asserts that, on the basis of these three points, its motion for summary judgment should be granted as a matter of law.⁷ (*Id.*)

⁶A district court cannot make a proper obviousness determination without undertaking an analysis under *Graham*. See *Greenwood v. Hattori Seiko Co. Ltd.*, 900 F.2d 238, 241 (Fed. Cir. 1990) ("Since the proper *Graham* analysis was not made by the district court, the summary judgment of obviousness under 35 U.S.C. § 103 must be vacated."); *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 872 (Fed. Cir. 1985) ("In patent cases, the need for express *Graham* findings takes on an especially significant role because of an occasional tendency of district courts to depart from the *Graham* test....").

⁷Miller also urges a side-by-side comparison of original application claim 1 from the '490 application, which was rejected by the Board and subsequently canceled by

I disagree, as Miller has failed to conduct the proper analysis for obviousness set forth under *Graham, supra*. Though Miller touches upon the *Graham* factors in footnotes in its opening brief (D.I. 30 at 13,14,16), it has not fully analyzed and supported its position with clear and convincing evidence, nor has Miller demonstrated that no genuine issue of material fact exists with respect to invalidity of the '900 patent due to obviousness.⁸ *Boyle*, 139 F.3d at 392. I will address each of the *Graham* factors in turn.

1. The Scope and Content of the Prior Art

A proper inquiry into the first *Graham* factor should focus on the claims in suit, the art the PTO applied to the claims, and the nature of the problem confronting the inventor. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 442, 449 (Fed. Cir. 1986). It is undisputed that the reader service card that appeared in the March 1992 issue of *CleanRooms* constitutes a prior art reference under 35 U.S.C. § 102 because it is a “printed publication in this...country, more than one year prior to the date of the application for patent in the United States.” 35 U.S.C. § 102(b) (2003); (D.I. 93 at 15:1-7.) The reader service card is also within the scope of the relevant prior art

Veltek with claim 1 of the '900 patent, as part of the obviousness analysis. (D.I. 43 at 7.) I decline to do so. Miller does not cite any authority in support of this novel approach to the obviousness analysis, nor is it supported by *Graham* or its progeny. It seems entirely illogical to compare *canceled* application claim 1 with claim 1 of the '900 patent, as claim 1 of the '900 patent issued from application claim 21 of the First Amendment filed by Veltek, and not from any canceled application claim. (D.I. 30, Exh. J.) Miller seems to ignore this fact.

⁸In fact, at oral argument counsel for Miller represented that “the *Graham* test has no application in this motion as approached by us, by the plaintiff... .” (D.I. 93 at 46:4-6.)

because it is “from the same field of endeavor,” namely, clean room technology, “with which the inventor is involved.” *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992).

However, Miller fails to adequately address the content of the prior art as required under *Graham*. Miller refers to the prior art relied upon by the Examiner during the prosecution of the ‘900 patent as “the prior art of record,” but does not analyze the prior art references or apply their teachings to the claims of the patent in suit. The teachings of the reader service card are not unambiguous. There is a genuine issue of material fact as to whether the reader service card, which describes the Decon-Ahol product as an “isopropyl alcohol aerosol spray” (D.I. 30, Exh. K), teaches a pressurized aerosol container (D.I. 43 at 8) or an unpressurized trigger-type spray (D.I. 41 at 28).

Further, Miller argues that, if the Examiner had the reader service card in front of her together with the prior art of record during her prosecution of the ‘900 patent, she would have rejected claims 1-9 as obvious and invalid under 35 U.S.C. § 103(a). For a claim to be invalid as obvious over a combination of references, there must be a showing of a suggestion or motivation to modify the teachings of a prior art reference. *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1356 (Fed. Cir. 2000). This motivation may arise from the prior art, the knowledge of someone of ordinary skill in the art, or the nature of the problem to be solved. *Id.* Miller has not presented any evidence of a suggestion or motivation to combine the teachings of the reader service card with the prior art of record. Thus, Miller has failed to prove the first *Graham* factor by clear and convincing evidence, and a genuine issue of material fact remains with respect to the scope and content of the prior art.

2. The Differences Between the Claimed Invention and the Prior Art

With respect to the second *Graham* factor, the court must view the claimed invention *as a whole*. *Bausch & Lomb*, 796 F.2d at 449 (citation omitted)(emphasis in original); see also *Applied Materials v. Advanced Semiconductor Materials Am.*, 98 F.3d 1563, 1570 (Fed. Cir. 1996) (“[T]he determination of obviousness, *vel non*, requires that all the evidence be considered together.”). Miller has not discussed “what teachings are relied on from each [prior art] reference, and how each reference differs from the claimed invention.” *Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986). Because Miller has not conducted a meaningful analysis of the scope and content of the prior art, it follows that it has not conducted a meaningful analysis of the differences between the claimed invention and the prior art.⁹ Therefore, Miller has failed to provide a basis for viewing the claimed invention as a whole in light of the prior art, and genuine issues of material fact remain with respect to the second *Graham* factor.

3. The Level of Ordinary Skill in the Art

The *Graham* test for obviousness of a claimed invention includes a factual determination of the level of ordinary skill in the art. *Custom Accessories*, 807 F.2d at

⁹Miller argues that the Examiner’s “unequivocal and **sole**” reason for allowing claims 1-9 of the ‘900 patent was that the prior art of record “failed to teach a pressurized aerosol container of alcohol as the chemical composition.” (D.I. 30 at 15)(emphasis in original). Miller overstates its case. In reality, the Examiner allowed application claims 21-25 and 30 without indicating her reasons for allowance and stated that new application claims 27 and 28 were allowable because the prior art “failed to teach a pressurized aerosol container of alcohol as the chemical composition.” (D.I. 30 at Exh. I.) Therefore, the record is silent as to the Examiner’s reason or reasons for allowing application claims 21-25 and 30 and a question of material fact remains.

962. Without this information, the court cannot properly assess obviousness because the critical question is whether a claimed invention would have been obvious, at the time it was made, to one with ordinary skill in the art. *Id.* The person of ordinary skill in the art is a hypothetical person who is presumed to be aware of all the pertinent prior art.¹⁰ *Id.* Factors that may be considered in determining the level of skill include: the type of problems encountered in the art, prior art solutions, rapidity with which innovations are made, sophistication of the technology, and educational level of the active workers in the field. *Id.*

Miller has not made any effort to apply these factors or define the person of ordinary skill in the art. Miller merely states that “the readership of *CleanRooms* magazine” are “members of the public who are both likely to be of ordinary skill in the art and strongly motivated to practice it.” (D.I. 30 at 16, f.n.13.) This does not rise to the level of clear and convincing evidence and thus genuine issues of material fact remain as to who qualifies as a person of ordinary skill in the art pertaining to clean room technology.¹¹

¹⁰At least one commentator has asserted that, “in the context of a summary judgment motion, the trial judge is really resolving the question by reference to the skill of the layperson, which is, except in rare circumstances, the most favorable view for the patentee.” Robert L. Harmon, *Patents and the Federal Circuit* § 4.3, p. 168 (6th ed. 2003) (citing *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567 (Fed. Cir. 1988)).

¹¹In certain situations, such as simple and easily understandable technology, a specific finding on the level of ordinary skill in the art may be unnecessary because the prior art itself reflects the level of ordinary skill. *Chore-Time Equipment v. Cumberland Corp.*, 713 F.2d 774, 779 (Fed. Cir. 1983). Miller has not persuaded me that this is such a case.

4. Secondary Considerations

As discussed above, Miller has failed to establish a *prima facie* case of invalidity of the '900 patent due to obviousness by clear and convincing evidence. It is Veltek's burden to come forward with evidence of secondary considerations only after Miller has made out a *prima facie* case of invalidity. *Ashland Oil*, 776 F.2d at 291-2. Because Miller has failed to do so, the burden does not shift to Veltek in this case.¹²

V. CONCLUSION

Because genuine issues of material fact remain as to whether the claims of the '900 patent were obvious at the time of the application in light of the teachings of the

¹²I note that Veltek has filed a declaration by Mr. Vellutato wherein he discusses secondary considerations such as commercial success, long-felt but unsolved need, and copying of the Decon-Ahol product. (D.I. 41, Exh. 5.) I make no judgment at this juncture on whether this constitutes objective evidence of secondary considerations.

reader service card and the other prior art of record, Miller's motion for summary judgment of obviousness (D.I. 29) must be and hereby is DENIED. It is so ordered.

Kent A. Jordan

UNITED STATES DISTRICT JUDGE

October 9, 2003

Wilmington, Delaware