

DISAVOWAL

Poly-America L.P. v. API Industries, Inc., 2016-1200,
2016 U.S. App. LEXIS 18486 (Fed. Cir. Oct. 14, 2016)

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November 2, 2016



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Introduction

- Current legal standards (claim construction, disavowal)
- Procedural history
- Federal Circuit's (FC's) ruling
- Points to remember

Parties

Poly-America, L.P.: Manufacturers of Trash Bags, Construction Film, Premium Vapor Barriers, Husky Orange Guard, Drop Cloths, Lawn Edging, Stretch Wrap.

API Industries, Inc.: Manufactures plastic can liners, custom bags, and films



Main Topics

- Non-infringement
- Claim construction

Procedural History

- Poly-America alleged that the products of AP Industries infringe Poly-America's patent.
- API filed a counter claim.

Procedural History (Cont)

- A drawstring being interpreted as being capable of being stretched or expanded is consistent with the *specification*.
- The District Court, turned to extrinsic evidence including *Webster's Dictionary* (1993).
- According to the District Court, additional support for inwardly-extended short seals is found in the *prosecution history*.

Procedural History (Cont)

- The District Court remarked on conventional drawstring trash bags with short seals.
- The District was unpersuaded that the adopted construction would improperly import a "reduced opening" limitation into claims 10 and 11.

Procedural History (Cont)

- Following claim construction, Poly-America stipulated to non-infringement, and the District Court entered final judgment in API's favor.
- Poly-America appealed the District Court's entry of judgment in favor of API.

Claim Construction (*Markman*)

- The meaning of words used in patent claims is determined by four sources in order of priority:
 - The written description accompanying the patent claims is most relevant;
 - The documentation of the history of the patent as it went through the application;
 - Standard dictionaries of English;
 - Finally, if all else fails, expert testimony from experts "skilled in the art" at issue.

Claim Construction (Cont)

- Ordinary and customary meaning
- Exceptions
 - 1) a patentee acts as his own lexicographer, and
 - 2) the full scope of the claim term is disavowed in the specification or during prosecution.

Doctrine of Prosecution Disclaimer

- Old: correspondence is not always allowed to enlarge, diminish, or vary the language of a patent.
- New: specific meanings disclaimed during prosecution cannot be recaptured.

Disavowal

- Language in the specification or the prosecution history.
- Need not be explicit.
- An inventor may disavow claims lacking a particular feature when the specification distinguishes or disparages prior art based on the absence of that feature.

Omega v. Raytek

- Prosecution disclaimer must be unambiguous.
- The District Court construed phrases as excluding a laser beam directed inside the energy zone.
- The Federal Circuit concluded that the trial court had incorrectly assumed that a laser beam directed inside the energy zone could not at the same time outline that zone.

Disclaimer/Prosecution History Estoppel

- Doctrine of Disclaimer: precludes patentees from recapturing specific meanings disclaimed during prosecution.
- Prosecution History Estoppel: prevent a patentee from obtaining under the doctrine of equivalents coverage of subject matter that was relinquished during prosecution.

Policy Issues for Disclaimer

- Provide public notice
- Support patentee's right to obtain broad patent coverage

Policy Issues for Disclaimer (Cont)

- Expanding the scope of Disclaimer too far might be too stringent, since *Festo* can already impose an almost un rebuttable presumption.
- It is hard to know where to draw the line in knowing which elements not mentioned in a claim should be included in order to avoid a defense of anticipation (*McCarty*).

Poly-America's Patent

<p>(12) United States Patent Ross</p> <p>(24) REDUCED OPENING ELASTIC DRAWSTRING BAG</p> <p>(75) Inventor: Michael A. Ross, Dallas, TX (US)</p> <p>(73) Assignee: Poly-America, L.P., Grand Prairie, TX (US)</p> <p>(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1109 days. This patent is subject to a terminal disclaimer.</p> <p>(21) Appl. No.: 12/262,027</p> <p>(22) Filed: Oct. 30, 2008</p> <p>(65) Prior Publication Data US 2010/0111452 A1 May 6, 2010</p> <p>(51) Int. Cl. B65D 33/28 (2006.01)</p> <p>(52) U.S. Cl. USPC 383/75</p> <p>(58) Field of Classification Search USPC 383/72 See application file for complete search history.</p> <p>(56) References Cited U.S. PATENT DOCUMENTS</p> <p>3,010,640 A 11/1961 Kugler 3,029,853 A 4/1962 Piazza 3,738,567 A 6/1973 Ruda 4,762,430 A 8/1988 Bullard 5,133,607 A * 7/1992 Bonke 383/75 5,265,962 A 11/1993 Ogawa et al. 6,003,717 A * 12/1999 Long 220/495.11 6,059,458 A 5/2000 Belias et al.</p>	<p>(10) Patent No.: US 8,702,308 B2</p> <p>(45) Date of Patent: *Apr. 22, 2014</p> <p>6,394,651 B2 5/2002 Jackson 6,585,415 B2 7/2003 Malaspina 6,921,202 B2 7/2005 Raterman 6,939,042 B2 9/2005 Rusnak et al. 6,994,469 B2 * 2/2006 Sleight et al. 383/43 7,137,737 B2 * 11/2006 Schneider 383/75 8,523,439 B2 * 9/2013 Ross 383/75 2001/0019638 A1 * 9/2001 Fox et al. 383/75 2006/0165319 A1 7/2006 Patridge et al. 2013/0301958 A1 * 11/2013 Ross 383/75</p> <p>FOREIGN PATENT DOCUMENTS</p> <p>DE 19636511 A1 3/1998 EP 0978459 A1 2/2000 WO WO 2006/050576 A1 5/2006</p> <p>* cited by examiner</p> <p><i>Primary Examiner</i> — Gary Elkins <i>Assistant Examiner</i> — Christopher Demerce (74) <i>Attorney, Agent, or Firm</i> — Brandon J. Lee</p> <p>(57) ABSTRACT</p> <p>The present invention is directed toward an improved construction of an elastic drawstring trash bag. The elastic drawstring trash bag described herein is comprised of a plastic bag made from two panels. An elastic drawstring is provided within <u>base opening along the top</u> of the two panels. The upper opening of the elastic drawstring bag is reduced <u>by the bag in its relaxed state</u> by <u>decreasing</u> the distance between the interior edges of the short seals used to weld the drawstrings and bag together. Like an ordinary non-elastic drawstring bag, the elastic drawstring is pulled through access cutouts centrally located along the upper edge of the bag. When the bag of the present invention is in a relaxed state, the reduced upper opening width of the elastic drawstring bag is therefore less than bag proper width, allowing a consumer to <u>put the elastic drawstring bag over the lip of a trash receptacle</u> and allowing the elastic drawstrings to snugly fit around the trash can.</p> <p>16 Claims, 3 Drawing Sheets</p>
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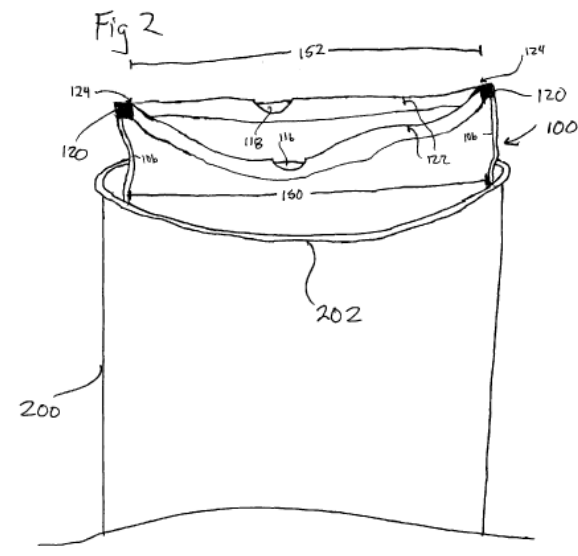
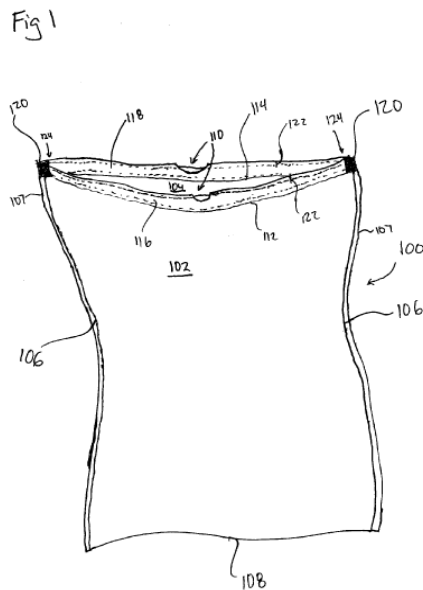
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Poly-America's Patent (Cont)

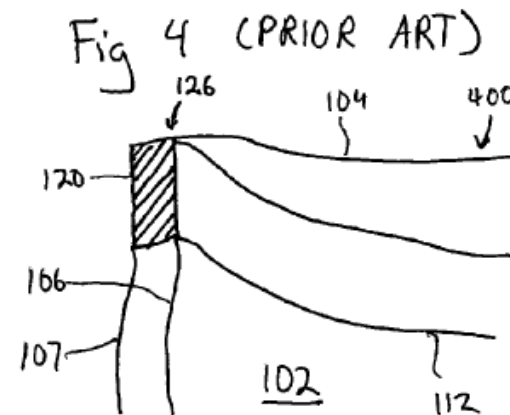
...[T]he *relaxed circumference of the upper opening* of the elastic drawstring bag 100 may be *reduced* to less than the circumference of the trash receptacle 200.

...[W]hen the elastic drawstring bag 100 is in its relaxed configuration, the *circumference of the upper opening* can be *less than* the upper lip 202 of the trash receptacle 200 due to the *reduced upper opening width 152* between the interior edges 124 of the *short seals 120*.



Poly-America's Patent (Cont)

[W]ith conventional non-elastic drawstring bags 400 it is undesirable and unnecessary to provide a short seal any larger than the distance from the edge 107 to the side seal 106 of the bag.



Poly-America's Patent (Cont)

SUMMARY OF THE INVENTION

The present invention is directed toward an improved construction of an elastic drawstring trash bag. The elastic drawstring trash bag is comprised of a polymeric bag which is made from a first panel and a second panel. A first hem is provided along the upper edge of the first panel. Similarly, a second hem is provided along the upper edge of the second panel. A first elastic drawstring is disposed within the first hem while a second elastic drawstring is disposed within the second hem.

Embodiments of the elastic drawstring bag contemplated by the present invention have an upper opening with a width that is less than 97% of the width of the rest of the bag (by virtue of the extended short seals). Another aspect of the present

In looking at both FIG. 1 and FIG. 2, it is important to note that one of the characteristics of the present invention is a reduction in the upper width 152 (when the bag is in a relaxed state) of the bag 100 resulting from the extended short seals 120. In the typical embodiment of the present invention as

Poly-America's Patent (Cont)

An enlarged view of an upper corner of a conventional non-elastic drawstring bag is shown in FIG. 4, as known in the prior art. An enlarged view of an upper corner of an embodiment of the present invention is also shown in FIG. 3 to better illustrate some of the differences. Looking first at FIG. 4, in conventional non-elastic drawstring bags, the width of the short seals 120 are minimized so as to not use extra plastic, which does not add any capacity to the bag. Therefore, with conventional non-elastic drawstring bags 400 it is undesirable and unnecessary to provide a short seal any larger than the distance from the edge 107 to the side seal 106 of the bag. The

Claims in Poly-America's Patent

1. An elastic drawstring trash bag comprising:

...a relaxed upper opening width defined by a *distance* between the interior edge of the *first short seal* and the interior edge of the *second short seal* when the bag is in a relaxed state, the relaxed upper opening width being *less* than the *bag proper width*(emphasis added).

16. An elastic drawstring trash bag comprising:

...the *distance* between an interior edge of the *first short seal* and an interior edge of the *second short seal* being *less* than a *bag proper width* of the polymeric bag (emphasis added).

Claims in Poly-America's Patent

10. An elastic drawstring trash bag comprising:
a first hem ... having a first *elastic* drawstring disposed therein,
a second hem ... having a second *elastic* drawstring disposed
therein, [and]

...[a] first panel, the first elastic drawstring, [a] second panel, and the
second elastic drawstring *inseparably joined* together at a *first short seal*
and at a *second short seal*... (emphasis added).

13. The elastic drawstring bag of claim 10, further comprising: the ratio
of a distance between the first seal and the second seal to a width of
the bag proper being greater than 94% but *less than 100%* (emphasis
added).

Prosecution History

Description in Amendment on 2012-07-09

Schneider Relaxed Upper Opening Width Same As (Not Less Than) Bag Proper Width

As Examiner noted, when the portions of the side seals extend above the bottom of the hem in Schneider, the side seals in the hem area are identical to the short seals as claimed and described by Applicant. Considering the Schneider side seals (and short seals), Applicant's independent claims unambiguously define two relative distances, what Applicant refers to as the "bag proper width" and the "relaxed upper opening width." Applicant's claims, as supported by

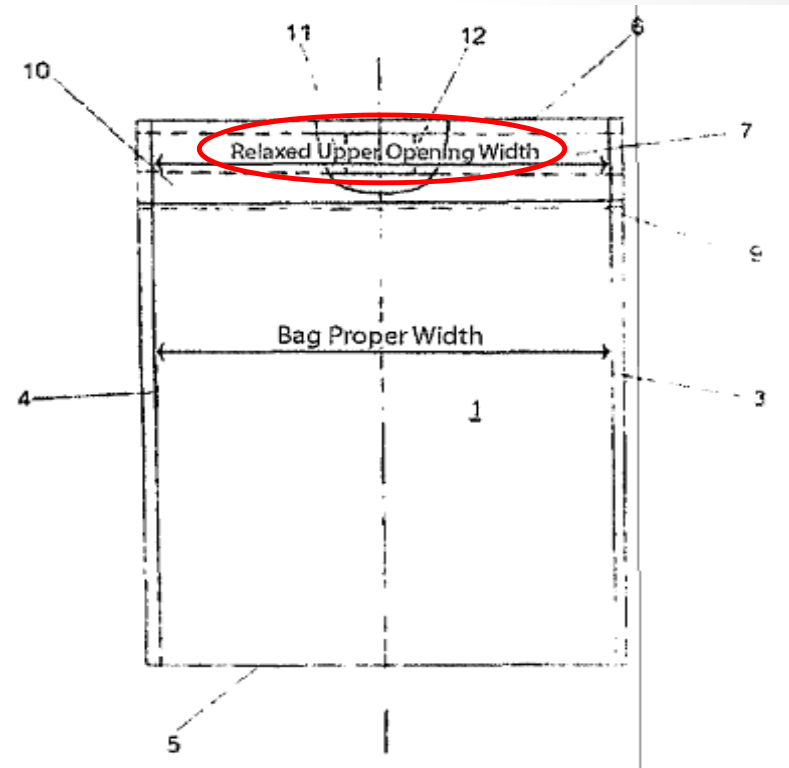


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Prosecution History (Cont)

*Schneider's Figure 1
(marked up) from
Amendment on 2012-07-09*



Prosecution History (Cont)

Description in Examiner's September 2012 Interview Summary

Examiner agreed that the amendment filed 7/9/2012 defines over the art of record. Specifically, Examiner agreed that the prior art fails to teach elastic drawstrings welded into the bag hem at short seals that form an upper opening that is smaller than the width of the bag. Further search and consideration will be given to the claims.



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Poly-America's Arguments

- Claim 10 does not have an express limitation requiring a narrow bag opening (compelling evidence of no disavowal in *Unwired Planet*).
- Using construction of “short seal” for claim 10 results in redundancy with claims 1 and 16.
- Limitation in Claim 13 requiring bag opening to be less than 100% would be superfluous.

Poly-America's Arguments (Cont)

- Specification includes an embodiment including a bag without a narrowed opening.
- Features described in specification that are drawn toward an embodiment for a narrowed opening are described in dependent claim.
- July 2012 Amendment states that claim 10 recites features distinguishing over prior art including “the first elastic drawstring, the second panel, and the second elastic drawstring [being] *inseparably joined* (emphasis added).”
- July 2012 Amendment quotes language from claims 1 and 16, not claim 10.

Poly-America's Arguments (Cont)

There is no explicit statement resulting in disavowal of claim scope because specification never states "all embodiments" include a narrow opening.

API's Arguments

- Prior Art Fig. 4 as illustrated in Poly-America's Patent illustrates an upper corner not being extended.
- Poly-America's specification describes narrowed opening as characteristic of "present invention."
- Poly-America's July 2012 Amendment indicates all of independent claims "require a narrowed upper opening" and "short seals extended inwardly."

API's Arguments (Cont)

- Poly-America's July 2012 Amendment includes an *explicit disavowal* of claim scope.
- In particular, Poly-America's July 2012 Amendment indicates "[c]laims 1-16 have been rejected"; and Schneider fails to disclose features "as required by Applicant's independent claims" because the *distance* between the interior edges of Schneider's *short seals* is *identical* to the *distance* between the interior edges of Schneider's *side seals*.

API's Arguments (Cont)

- The description in Poly-America's Patent stating that features as illustrated in Figs. 1 and 2 are related to the "present invention."
- The Title and Abstract of Poly-America's Patent state "[r]educed opening" or "reduced upper opening."

Federal Circuit's Reasoning

- Reviewed District Court's decision *de novo*.
- The specification and prosecution history of Poly-America's patent contain clear and unequivocal statements.
- Poly-America's reply contains a clear and unmistakable disavowal of short seals that do not extend inwardly.

Federal Circuit's Decision

- The District Court correctly construed the terms "short seal" to require inward extension and correctly entered judgment in favor of appellee.

Was the FC Right?

Did the FC overly rigidly apply the tenets of claim construction set forth *Phillips...*

or....

correctly construe the term

“short seal” to require inward extension?

Take-Aways

- Use broad language in various parts of application including the Title, Abstract, and Summary of Invention.
- Describe features in the specification as “*characteristics of embodiments of the present invention*” not “characteristics of the present invention.”

Take-Aways (Cont)

- Describe features illustrated in Figures related to features showing different characteristics in the invention as being related to different embodiments.
- Describe features recited in dependent claims and pertaining to each inventive concept in a broad scope.

Take-Aways (Cont)

- Prepare a response to an Office Action including separate descriptions for independent claims having different scopes.
- Consider whether to not describe features in the remarks in a response to an Office Action that are not recited in independent claims.
- If necessary, draft dependent claims reciting features more clearly distinguishing over prior art references than features recited in independent claims, in a varying scope.

Take-Aways (Cont)

- Possibly discuss with the Examiner during the Interview the different inventive concepts recited in different independent claims and consider the pros/cons of the chosen strategy.
- If possible, discuss with the Examiner the description in the Examiner's Interview Summary.

QUESTIONS?



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