

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

E.I. DuPONT de NEMOURS)
AND COMPANY,)
)
Plaintiff,)
)
v.) Civil Action No. 99-696-SLR
) (consolidated with 99-903-SLR)
SACKS INDUSTRIAL CORPORATION,)
)
Defendant.)

MEMORANDUM ORDER

I. INTRODUCTION

Currently before the court in this patent case is a motion for summary judgment filed by plaintiff E.I. DuPont de Nemours and Company. Plaintiff has moved for summary judgment on the basis that certain claims of defendant Sacks Industrial Corporation's U.S. Patent No. 5,826,390 (the "'390 patent") are anticipated by two prior art references.¹ For the following reasons, the court shall deny plaintiff's motion.

II. BACKGROUND

Defendant's '390 patent, entitled "Building Wall Membrane," claims a vapor permeable fabricated membrane for use in an exterior wall or party wall of a building. When attached to the

¹Plaintiff initiated this action in this District for declaratory relief that defendant's '390 patent is invalid and not infringed. Defendant later filed an action against plaintiff in the United States District Court for the District of Colorado, alleging that plaintiff infringed the '390 patent. The infringement action was transferred to Delaware, and the two cases were consolidated. (D.I. 20)

wall, the membrane forms vertical passageways that permit the escape of trapped moisture. Plaintiff argues that claims 1, 2 and 4-11 of the '390 patent are invalid because they are anticipated by two prior art references ("Yoshida" and Sato").² At issue is the language of independent claims 1 and 10 of the '390 patent. Claim 1 discloses:

1. A vapour permeable prefabricated membrane for use in an exterior wall of a building, said membrane comprising a sheet of vapour permeable material and a plurality of non-collapsible furring spacers incorporated on said sheet such that when abutting a flat surface in said exterior wall, passageways are formed between said sheet of material and the surface which said spacers abut so as to permit a substantially free flow of moisture in a downwardly direction when in place in said wall.

Claim 10 discloses:

10. A vapour permeable membrane for use in an exterior wall of a building, comprising:
a non-collapsible sheet of vapour permeable material corrugated and adapted for application to a building wall so that when abutting a flat surface, passageways are formed which permit the substantially free flow of moisture in a downwardly direction when in place in said wall.

Yoshida is entitled, "Wall Structure," and discloses a sheet containing plural protruding members that form a ventilation layer with a gap that allows air flow within walls. (D.I. 27, Ex. 2) Sato is entitled, "Exterior Wall Panel," and discloses an

²Yoshida and Sato are Japanese patent applications, published more than one year before the application date of the '390 patent, but never examined by the Japanese Patent Office. Yoshida and Sato were not cited by the United States Patent and Trademark Office during its examination of the '390 patent.

air permeable waterproof sheet that is fixed to the back surface of a ventilation member which has a prescribed spacing and an exterior wall material fixed to its front surface. (D.I. 27, Ex. 3) Plaintiff argues that Yoshida and Sato fully disclose a vapor permeable membrane that, either by non-collapsible spacers or by corrugation of the non-collapsible membrane itself, creates vertical passageways that allow for the flow of moisture within a wall. Defendant contends that none of the claim limitations are disclosed by Yoshida and Sato because they require a waterproof membrane, which is not vapor permeable.³ The references also do not limit their inventions to corrugated membranes or spacers that are non-collapsible and form vertical passageways.

III. STANDARD OF REVIEW

A court shall grant summary judgment only 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). The moving party bears the burden of proving that no genuine issue of material fact exists. See Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 n.10 (1986). "Facts that could alter the outcome are 'material,' and disputes are 'genuine' if evidence exists from which a rational person

³The parties disagree on the meaning of the term "waterproof" to one of ordinary skill in the art.

could conclude that the position of the person with the burden of proof on the disputed issue is correct." Horowitz v. Fed. Kemper Life Assurance Co., 57 F.3d 300, 302 n.1 (3d Cir. 1995) (internal citations omitted). If the moving party has demonstrated an absence of material fact, the nonmoving party then "must come forward with 'specific facts showing that there is a genuine issue for trial.'" Matsushita, 475 U.S. at 587 (quoting Fed. R. Civ. P. 56(e)). The court will "view the underlying facts and all reasonable inferences therefrom in the light most favorable to the party opposing the motion." Pa. Coal Ass'n v. Babbitt, 63 F.3d 231, 236 (3d Cir. 1995). The mere existence of some evidence in support of the nonmoving party, however, will not be sufficient for denial of a motion for summary judgment; there must be enough evidence to enable a jury reasonably to find for the nonmoving party on that issue. See Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 249 (1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it has the burden of proof, the moving party is entitled to judgment as a matter of law. See Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986).

IV. DISCUSSION

An invention is anticipated under 35 U.S.C. § 102(b) if it "was patented or described in a printed publication in this or a foreign country . . . more than one year prior to the date of

application for patent in the United States." 35 U.S.C. § 102(b). The first step of an anticipation analysis is claim construction, and the second step involves a comparison of the construed claim to the prior art. See Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1346 (Fed. Cir. 2000). A question of fact, anticipation is established if every element of a properly construed claim is present in a single prior art reference. See Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc., 45 F.3d 1550, 1554 (Fed. Cir. 1995). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed. Cir. 1991). "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." Scripps, 927 F.2d at 1576. "In determining whether a patented invention is anticipated, the claims are read in the context of the patent specification in which they arise and in which the invention is described. If needed to impart clarity or avoid ambiguity, the prosecution history and the prior art may also be consulted in order to ascertain whether the patentee's invention is novel or was previously known to the art." Glaverbel, 45 F.3d at 1554. Thus, the factual inquiry relevant to the anticipation analysis is whether a single prior art reference discloses every element of the challenged claim and

enables one skilled in the art to make the anticipatory subject matter. See, e.g., PPG Indus., 75 F.3d at 1566.

In the case at bar, the court concludes that at this stage of the proceedings, a finding of invalidity based on anticipation is premature. The court must first construe the meanings of "vapour permeable," "corrugated" and "non-collapsible," among other terms of the '390 patent, to determine if the Yoshida and Sato references anticipate its claims. Absent agreement by the parties and the consent of the court, claim construction is reserved for the conclusion of discovery and the filing of case dispositive motions.

V. CONCLUSION

Therefore, at Wilmington this 19th day of March, 2001;

IT IS ORDERED that plaintiff's motion for summary judgment of invalidity under 35 U.S.C. § 102(b) is denied, without prejudice to renew consistent with the scheduling order in place.

United States District Judge