

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 involving United States Patent No. 6,123,900 (“the ‘900 patent”), owned by defendant Arthur L. Vellutato, Sr. and licensed to defendant Veltek Associates, Inc. (collectively “Veltek”). Jurisdiction is proper under 28 U.S.C. §§ 1331 and 1338. Presently before me is plaintiff Miller Products Co., Inc.’s (“Miller”) motion for summary judgment (the “Motion”) that the ‘900 patent is invalid on the ground that the patent examiner was barred by *res judicata* from issuing it. (D.I. 96.) For the reasons that follow, I will deny the Motion.

II. BACKGROUND

As this order is mainly for the benefit of the parties, I will summarize only the facts pertinent to Miller’s motion.

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.¹ (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 Appeals 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.² (*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 26.³

¹The '900 patent, entitled "Method of Sterilization," claims a method of sterilizing alcohol contained in an aerosol container and a method of storing the sterilized alcohol composition. See '900 patent, claims 1, 6, 9.

²The Board decided Veltek's appeal based on appealed claims 1 and 14 with respect to the obviousness rejection advanced by the examiner on appeal. (D.I. 97, Exh. A, at 2.)

³Independent 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.⁴

III. STANDARD OF REVIEW

A 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). The evidence must be viewed in the light most favorable to the non-movant and all reasonable inferences must be drawn in favor of the non-moving party. *Id.* at 255; *Baker Oil Tools, Inc. v. Texas Iron Works, Inc.*, 828 F.2d 1558, 1566 (Fed. Cir. 1987).

A patent shall be presumed valid. 35 U.S.C. § 282. 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 convincing evidence. *Robotic Vision Sys., Inc. V. View Eng’g, Inc.*, 189 F.3d 1370, 1377 (Fed. Cir. 1999).

IV. DISCUSSION

Miller moves for summary judgment on the basis that claims 1-5 and 9 of the '900 patent are invalid because the Examiner was barred from issuing them by the doctrine of *res judicata*.⁵ (D.I. 96.) Miller states that, when claims have been rejected

⁴Claims are renumbered by the PTO upon allowance of a patent application.

⁵Claims 6-8 of the '900 patent are directed to storing a sterilized alcohol composition for use in a sterile environment. Miller argues that “[t]he obviousness of those steps is overwhelming” and “[t]o allow these claims is to ignore the Constitutional standard of patentability.” (D.I. 97 at 6.) These bald statements do not rise to the level of clear and convincing evidence that is required to rebut the presumption of validity attached to the '900 patent.

by the Examiner and that rejection has been affirmed by the Board, the doctrine of *res judicata* precludes the Examiner from issuing claims in a continuation application that are patentably nondistinct from the rejected claims. (D.I. 97 at 3, 5.) Miller further argues that claims 1-5 and 9 of the '900 patent are substantively the same as certain rejected application claims of the '049 application, and, thus, these claims are invalid. (D.I. 97 at 5.)

Miller has the burden of establishing a *prima facie* case of invalidity by clear and convincing evidence. *Robotic Vision*, 189 F.3d at 1377; *see also Ashland Oil, Inc. v. Delta Resins & Refractories Inc.*, 776 F.2d 281, 291 (Fed. Cir. 1985). After considering Miller's arguments and Veltek's response, I find that Miller has not sustained its burden with respect to the Motion. Miller has not presented clear and convincing evidence that the rejected application claims of the '049 application are patentably nondistinct from or substantively the same as claims 1-5 and 9 of the '900 patent.

Veltek identifies several terms in claims 1 and 9 of the '900 patent that did not appear in rejected application claim 1, e.g., "aerosol container," "aerosol spray container," and "spray nozzle," among others. (D.I. 100 at 11.) Veltek argues that these recitations alone render claims 1 and 9 substantively different from the rejected application claims. (D.I. 100 at 12.) Miller offers no evidence to counter Veltek's argument regarding these new claim terms.

As one representative argument, Miller contends that patent claim 1 is "identical in substance" to rejected application claims 1 and 19, as rejected application claim 19 incorporates the subject matter of rejected application claim 1 and "calls for the chemical composition to be a mixture of alcohol pressurized with an inert gaseous

element.” (D.I. 97 at 5.) In response, Veltek states that rejected application claim 19 does not require the composition to be pressurized with the inert gaseous element and that “the claim only requires that the step of charging the container ‘include’ the step of pressurizing.” (D.I. 100 at 12, n.10.) Miller does not address Veltek’s position regarding the pressurizing step in its reply brief. (D.I. 105 at 2, 3.) Since Miller has failed to present clear and convincing evidence that the claims of the ‘900 patent are patentably nondistinct from or substantively the same as the rejected ‘049 application claims, the presumption of validity of the claims of the ‘900 patent remains intact.⁶ Thus, Miller’s motion will be denied.

V. CONCLUSION

Accordingly, it is hereby ORDERED that Miller’s Motion (D.I. 96) is DENIED. It is so ordered.

Kent A. Jordan
UNITED STATES DISTRICT JUDGE

October 17, 2003
Wilmington, Delaware

⁶I have similarly considered Miller’s remaining arguments with respect to claims 2-5 and 9 of the ‘900 patent and find that Miller has not presented clear and convincing evidence of their invalidity.