

## CASE LAW UPDATE

September 21, 2005

<b>CASE</b>	Prima Tek II LLC v. Polypap (Fed. Cir. June 22, 2005)
<b>MAIN ISSUE(S)</b>	Can a claim be anticipated by a prior art reference where a limitation of the claim is inherent in the drawings of the prior art reference?
<b>EXECUTIVE SUMMARY</b>	Patent claims were found anticipated by a prior art reference where limitations not expressly found in the reference were inherent from the drawings of the reference.
<b>KEY TERMS</b>	Claim Construction; Inherent Disclosure

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**PROCEDURAL POSTURE** Prima Tek (Patent Holder) sued Polypap for infringement of U.S. Patent Nos. 5,410,856 and 5,615,532 (herein the '856 and '532 patents, respectively). The district court granted summary judgment of non-infringement. The Federal Circuit held the district court used incorrect claim construction and vacated and remanded. On remand, the district court held the claims of the patents valid and infringed by Polypap. The Federal Circuit reversed finding the claims invalid as anticipated by a prior art reference. Judges: Gajarsa, Plager, and Dyk

**FACTS** Prima Tek and Polypap are competitors in the floral products market. Polypap's product is a semicircular piece of plastic that can be formed into a device for holding floral arrangements. The asserted claims of Prima Tek's patent describe an assembly and method for displaying a floral grouping. Claim 15 of the '856 patent includes a "floral holding material," the absence of any "pot means," and a "crimped portion in the sheet of material" having "at least one overlapping fold." Claim 9 of the '532 patent includes "providing a floral holding material," the absence of any "pot means," and "disposing banding means about the sheet of material ... causing the banding means to press a portion of the sheet of material against the outer surface of the floral holding material."

The court considered a prior art reference, which is a published French patent application naming Andre Charrin (herein the Charrin reference). Prima Tek agreed that the Charrin reference anticipates the claims of their patent but for three limitations: (1) the "without any pot means," (2) the alleged requirement that the floral holding material hold its shape, and (3) the crimping limitation. The court found that Charrin disclosed each of these limitations.

**HOLDING** The Federal Circuit REVERSED the district court's finding of infringement finding the claims of the patent invalid as anticipated by express and inherent limitations in the Charrin reference.

**COURT'S REASONING** The Federal Circuit stated that they have previously held that a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. Citing MEHL/Biophile Int'l Corp. v. Milgraum 192 F.3d 1362 (Fed. Cir. 1999) The Federal Circuit found that the undisputed evidence shows that crimping and overlapping folds are inherent to the Charrin reference. The drawings show a sheet of material tied up around a flower pot by a string such that the material has overlapping folds and is crimped. Moreover, Philippe Charrin provided testimony that when tightened, the string would create overlapping folds in the sheet of material. Under these circumstances the Federal Circuit concluded that the claims were anticipated by the Charrin reference and invalid.

**PANEL** Dyk, Gajarsa, Plager (Unanimous decision)