

United States Court of Appeals for the Federal Circuit

PLASTIPAK PACKAGING, INC.,
Plaintiff-Appellant

v.

PREMIUM WATERS, INC.,
Defendant-Appellee

2021-2244

Appeal from the United States District Court for the
Western District of Wisconsin in No. 3:20-cv-00098-wmc,
Judge William M. Conley.

Decided: December 19, 2022

CHRISTOPHER ROBERT DILLON, Fish & Richardson P.C.,
Boston, MA, argued for plaintiff-appellant. Also repre-
sented by WHITNEY REICHEL; AHMED JAMAL DAVIS,
CHRISTOPHER DRYER, Washington, DC; OLIVER RICHARDS,
San Diego, CA.

JEFFREY COSTAKOS, Foley & Lardner LLP, Milwaukee,
WI, argued for defendant-appellee. Also represented by
KIMBERLY KRISTIN DODD, SARAH ELIZABETH RIEGER;
DANIEL FLAHERTY, ANDREW GROSS, Chicago, IL.

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Before NEWMAN, STOLL, and STARK, *Circuit Judges*.

STARK, *Circuit Judge*.

In this patent case, the District Court granted summary judgment in favor of Defendant-Appellee Premium Waters, Inc. (“Premium Waters”), finding that Plaintiff-Appellant Plastipak Packaging, Inc.’s (“Plastipak”) twelve patents-in-suit were invalid for nonjoinder under pre-AIA 35 U.S.C. § 102(f) (2006).¹ On appeal, the parties dispute whether summary judgment was proper. We reverse and remand.

I

A

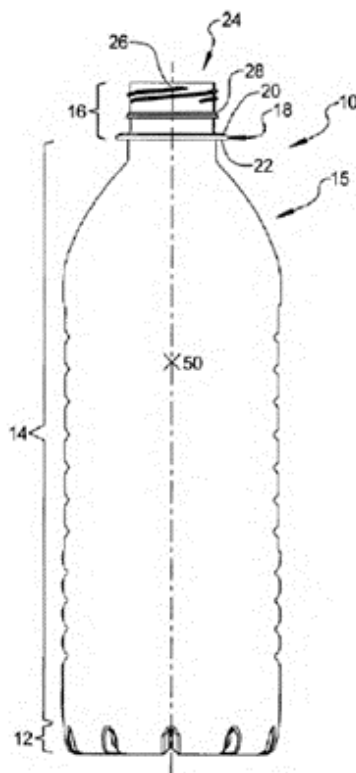
Plastipak owns U.S. Patent Nos. 8,857,637; 9,033,168; 9,139,326; 9,403,310; 9,522,759; 9,738,409; 9,850,019; 10,023,345; 10,214,311; 10,214,312; 10,266,299; and 10,457,437.² Each patent is entitled “Lightweight Plastic Container and Preform” and claims priority to U.S. Application No. 11/749,501, filed on May 16, 2007, which was a continuation-in-part of U.S. Application No. 11/368,860, filed on March 6, 2006. Each patent lists Richard C. Darr and Edward V. Morgan as inventors.

¹ AIA refers to the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011). Because the application that led to the patents-in-suit never contained a claim having an effective filing date on or after March 16, 2013, or a reference under 35 U.S.C. §§ 120, 121, or 365(c) to any patent or application that ever contained such a claim, pre-AIA law applies. See AIA § 3(n)(1), 125 Stat. at 293.

² Each patent or patent application will be referred to by the last three digits of its patent or application number.

All twelve patents-in-suit generally concern plastic containers and plastic container preforms with a neck portion (also called a neck finish).³ The neck portion contains threads for screwing on or off a closure (e.g., a bottle cap); a continuous or discontinuous tamper-evident formation (“TEF”) to show that the bottle has been opened; and a support flange (also called a support ring) to facilitate handling during manufacturing.

One view of such a bottle is found in Figure 1 of the '637 patent:

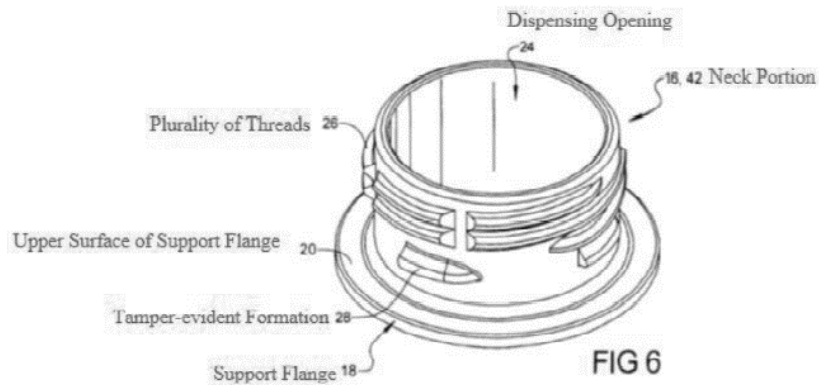


³ We follow the parties’ and District Court’s convention of referring to the “containers” with which the patents are concerned as bottles. “Preforms” become fully formed plastic bottles during the manufacturing process.

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J.A. 41. The neck portion (16) includes a support flange (18) with an upper surface (20) and a lower surface (22).

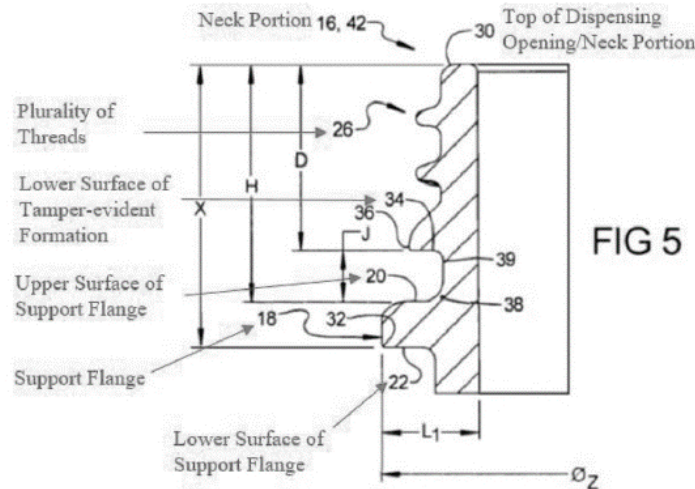
A close-up view of a neck portion is shown in Figure 6 of the '637 patent (annotated by the parties with the names of the numbered features):



J.A. 5305. The TEF (28) in this Figure 6 embodiment is discontinuous; that is, there are multiple TEFs rather than a single, continuous formation.⁴

⁴ The patents and parties use the singular and plural terms “TEF” and “TEFs” interchangeably, and we do so as well.

A cross-sectional side view of a neck portion is shown in Figure 5 of the '637 patent (again annotated by the parties in accordance with the patent):



J.A. 5305. The X dimension in Figure 5 (delineated by the vertical line to the far left of the diagram) represents a measurement of the vertical distance from the top of the dispensing opening/neck portion (30) to the lower surface of the support flange (22), including the threads and a TEF. Decreasing the magnitude of the X dimension can result in lighter weight bottles and preforms, with related economic and manufacturing benefits.

The patents-in-suit can be split into two groups. Seven patents – the '637, '168, '759, '409, '019, '345, and '312 – have claims reciting neck portions with an X dimension of 0.580 inches or less. For simplicity, and following the lead of the parties and the District Court, we refer to this as the “X Dimension Limitation” and this group of seven as the “X

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