

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

PLASTIPAK PACKAGING, INC.,

Plaintiff,

v.

OPINION AND ORDER

20-cv-098-wmc

PREMIUM WATERS, INC.,

Defendant.

In this action, plaintiff Plastipak Packaging, Inc., alleges that defendant Premium Waters, Inc., infringes a number of asserted claims in 12, related patents-in-suit, all concerning the “neck finish” of a plastic bottle. While not disputing that its plastic water bottles infringe Plastipak’s patents-in-suit, Premium Waters asserts several invalidity defenses, a number of which are now the subject of both parties’ cross-motions for summary judgment. (Dkt. ##105, 116.) The court will grant defendant’s motion for summary judgment in light of overwhelming evidence that plaintiff failed to name all of the correct inventors for each of the patents-in-suit in violation of 35 U.S.C. § 102(f).¹

UNDISPUTED FACTS²

A. Overview of the Parties

Plastipak is a Delaware corporation, with its principal place of business located in

¹ Despite plaintiff’s motion for summary judgment as to infringement of all of the asserted claims being unopposed, the parties could not reach a stipulation on infringement, with both sides casting aspersions on the other party. Defendant’s reluctance appears to be rooted mainly in its position that it cannot infringe an invalid patent, but there is nothing to suggest that plaintiff was seeking entry of partial judgment on infringement grounds, rather than entry at the time of final judgment *provided* the patents survive defendant’s myriad invalidity challenges. Regardless, given the court’s finding on defendant’s nonjoinder challenge, this issue is now moot.

Michigan. Plastipak manufactures and sells containers and packaging for consumer products, including bottled water. Defendant Premium Waters is both incorporated and maintains its principal place of business in Minnesota. Premium Waters is a manufacturer and supplier of bottled water products. While it is principally located in Minnesota, Premium Waters also owns and operates a bottled-water manufacturing plant in Chippewa Falls, Wisconsin, which is located within this judicial district.

B. Patents-in-Suit

Plastipak alleges that Premium Waters manufactures, uses and sells plastic water bottles and preforms that infringe the following twelve patents: 8,857,637 (“the ’637 patent”); 9,033,168 (“the ’168 patent”); 9,139,326 (“the ’326 patent”); 9,403,310 (“the ’310 patent”); 9,522,759 (“the ’759 patent”); 9,738,409 (“the ’409 patent”); 9,850,019 (“the ’019 patent”); 10,023,345 (“the ’345 patent”); 10,214,311 (“the ’311 patent”); 10,214,312 (“the ’312 patent”); 10,266,299 (“the ’299 patent”); and 10,457,437 (“the ’437 patent”).³ As directed by the court, Plastipak has reduced its asserted claims to 21 as reflected in the following table:

Patent	Claim(s)
'637 patent	30, 34
'168 patent	12, 15, 28

² Unless otherwise noted, the following facts are material and undisputed. Given the voluminous proposed findings, the court limits this section to the key, overarching facts and addresses other undisputed facts as specific arguments in the opinion that follows.

³ More specifically, Plastipak contends that 10 different products infringe one or more of the asserted claims, including Premium Waters’ 10 oz., 0.5 L, 20 oz., 24 oz., 0.7 L, and 1 L-sized bottled water products, which are then sold under various brand names including Glacier Clear.

'326 patent	29
'310 patent	3,14
'759 patent	29
'409 patent	8
'019 patent	30
'345 patent	28
'311 patent	14
'312 patent	7, 11
'299 patent	2, 5, 9, 12, 26
'437 patent	30

Each of the patents-in-suit is titled “Lightweight Plastic Container and Preform,” and as suggested by their title, each generally relates to reducing the weight of plastic containers and the plastic preforms from which they are made. The same two individuals, Richard C. Darr and Edward V. Morgan, are named as the sole inventors on all 12 patents.

The '637 patent issued on October 14, 2014, from U.S. Application Serial No. 11/749,501, filed on May 16, 2007.⁴ Application 11/749,501 was itself a continuation-in-party of U.S. Application Serial No. 11/368,860 (“the '860 application”), filed on March 6, 2006, which issued as U.S. Patent No. 7,608,159, which is not asserted in this case. In addition to the '637 patent, the other, 11 related patents were issued between May 19, 2015, and October 29, 2019. The specifications for the '168, '326, '310 and '759 patents all incorporated by reference the entirety of the '860 application, among other earlier patent applications. The remaining six patents were all filed as a continuation of the application from which an earlier patent issued. As a result, the patents-in-suit all claim

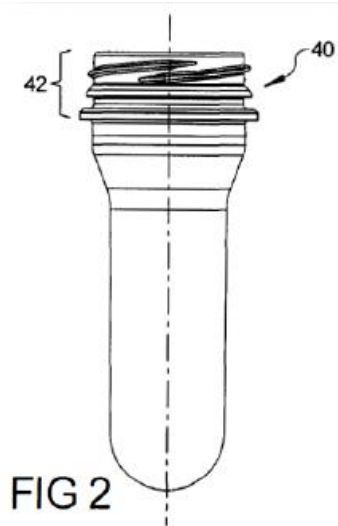
⁴ A Certificate of Correction was issued on January 6, 2015.

priority to the original May 16, 2007, application that issued as the '637 patent, and plaintiff's technical expert purports to opine that all of the asserted claims of the patents-in-suit are "entitled" to that effective filing date.

Plaintiff submits additional findings specific to its motion for summary judgment on infringement (Pl.'s PFOFs (dkt. #119) ¶¶ 200-34), but as explained above, the court will not recount these facts since there is no dispute that the accused products infringe the patents-in-suit. The parties also propose facts relevant to various invalidity challenges, which the court will address as relevant in the opinion below, rather than recite them in detail here.

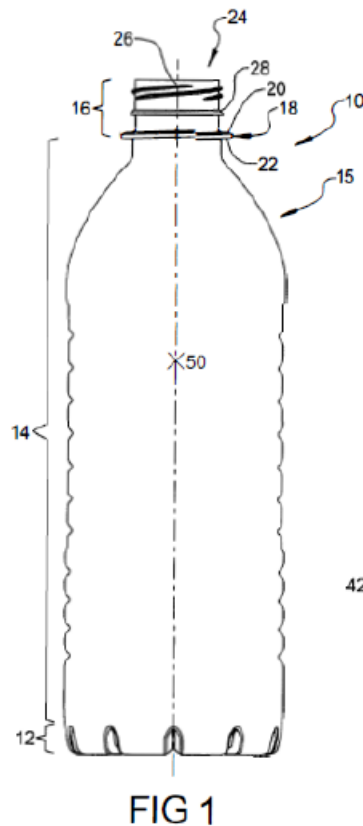
C. Background of Technology

The plastic bottles accused of infringement are comprised primarily of polyethyleneterephthalate ("PET"). Such bottles generally are created using a two-step process: (1) manufacturing a "perform" via "injection molding" and (2) "blow-molding" the preform into a bottle. Figure 2 of the '637 patent depicts a plastic preform as shown below:



(Def.'s PFOFs (dkt. #107) ¶ 41.) A preform includes a neck portion (often referred to as a “neck finish”), indicated by reference number 42 above, and beneath the neck portion, a lower portion that resembles a test tube.

Figure 1 of the '637 patent illustrates a bottle formed from a preform:



Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.