

CAFC Refuses to Crack Open Summary Judgment of Invalidity for Non-Joinder in Bottle Patent Appeal

Plastipak Packaging, Inc., v. Premium Waters, Inc. (Federal Circuit 2022)

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The Court of Appeals for the Federal Circuit (“CAFC”) recently reversed and remanded the Western District of Wisconsin’s summary judgment holding of invalidity for 12 patents belonging to Plastipak Packaging, Inc. (“Plastipak”) in an infringement action it brought against Premium Waters, Inc. (“Premium Waters”). The CAFC based its decision on a finding a genuine material dispute as to the invalidity theory adopted by the lower court, non-joinder of an inventor under pre-AIA 35 U.S.C. § 102(f).

This case dealt with plastic disposable water bottles, like those sold in grocery stores and vending machines. Plastipak’s patents-at-issue particularly dealt with technology for the “Tamper Evident Formation” (“TEF”) that indicates whether the bottle cap has been opened. Premium Waters argued that two TEF features—a discontinuous TEF (see FIG 6) and the “X-Dimension” (see FIG 5) —were invented by Alessandro Falzoni, a third-party designer not named as a co-inventor on any of the patents.

The pre-AIA version of 35 U.S.C. § 102(f) bars a patentee when “he did not himself invent the subject matter sought to be patented.” An inventor is anyone who contributed in some significant manner to the conception or reduction to practice of the invention and not merely an explanation the current state of the art or well-known concepts. *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed. Cir. 1998). Failure to name the co-inventor of even a single claim may invalidate an entire patent for non-joinder. *Id* at 1348-49. That said, and although not addressed here, a patent owner may be entitled to save the validity of its patent by petition to the Director of the USPTO or by judicial decree per 35 U.S.C. § 256. Unlike inequitable conduct claims, invalidity by non-joinder does not require an intent to deceive.

The CAFC weighed the evidence presented by the parties including correspondence and testimony from Falzoni, testimony of named inventors, and prior art references shown as evidence of what a POSA would have known at the time of patenting. Although the CAFC found Premium Waters’ evidence that Falzoni was indeed a non-joined co-inventor was compelling, it did not negate the evidence presented by Premium Waters, which was sufficient to evoke skepticism and create a material dispute of fact. Thus, summary judgment was inappropriate and the CAFC reversed and remanded.

Generally, the law has trended away from extinguishing patent rights for problems with inventorship since the AIA. But the CAFC’s treatment of non-joinder in this case leaves some aspects of the law undecided, such as whether today’s § 256 would allow Plastipak to correct inventorship or whether the inventorship requirement allows for a post-AIA patent to be similarly invalidated. Patent challengers should have hope in this theory, and patent owners should be advised to properly list or correct inventorship of their patents.

