

Federal Circuit Reduces Certainty - *Multilayer Stretch Film Holdings, Inc. v. Berry Plastics Corp.*

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Markush claims are generally closed claims. When a claim recites the phrase “group consisting of,” this signals that the group is a Markush group, thus only including those elements listed in the Markush group and excluding all others. For example, if a claim recites a composition selected from a group consisting of A, B, and C, then that claim covers elements A, B, and C. A composition containing A, B, or C would infringe the claim. In order to claim mixtures of A, B, and C (e.g., composition of A plus B) the draftsman should include qualifying language such as “and combinations thereof” or “at least one of the following,” for example. Although this is a well-settled area of patent law,¹ the Federal Circuit may have muddied the waters in this recent decision.^{1A}

Multilayer Stretch Cling Film Holdings (“Multilayer”) sued Berry Plastics for patent infringement of U.S. Patent No. 6,265,055 (“055 patent”).² The patent-at-issue has two independent claims, Claims 1 and 28.³ Multilayer’s complaint stated that the Accused Films infringed at least Claim 1.⁴

Claim 1 reads:

I. A multi-layer, thermoplastic stretch wrap film containing seven separately identifiable polymeric layers, comprising:

(a) two identifiable outer layers, at least one of which having a cling performance of at least 100 grams/inch, said outer layer being selected from the group consisting of [LLDPE], [VLDPE], and [ULDPE] resins, said resins being homopolymers, copolymers, or terpolymers, of ethylene and alpha-olefins; and

(b) five identifiable inner layers, with each layer being selected from the group consisting of [LLDPE], [VLDPE], [ULDPE], and [mLLDPE] resins; said resins

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are homopolymers, copolymers, or terpolymers, of ethylene and C3 to C20 alpha-olefins;

wherein each of said two outer layers and each of said five inner layers have different compositional properties when compared to a neighboring layer.⁵

Claim 28 is the same as Claim 1, but includes the following additional limitation: “wherein at least one of said inner layers comprises a [mLLDPE] resin. . . .”⁶ The Accused Films included inner layers made from blends of the mLLDPE, LLDPE, LDPE, PP, and ULDPE resins.⁷ The district court granted Berry’s motion for summary judgment of non-infringement based on the court’s claim construction, wherein “group consisting of” was construed as including only those resins listed in the claim and no other resins. Claims 1 and 28 covered only inner layers made from the resins LLDPE, VLDPE, ULDPE, or mLLDPE and did not cover blends. The court also held Claim 10, that recited the film of Claim 1, “wherein at least one said inner layer comprises [LDPE] homopolymers,”⁸ as invalid for indefiniteness (35 U.S.C. § 112, fourth paragraph) because it failed to further limit the claim on which it depends.⁹

Multilayer appealed the district court’s grant of summary judgment of non-infringement and the invalidation of Claim 10, arguing that the district court erred in its claim constructions. There were two claim constructions at issue before the Federal Circuit: (1) whether “consists of” should be construed as an open term to include resins other than the ones listed in the claim; and (2) whether the Markush groups of Claims 1(b) and 28(b) should include blends of the listed resins.

Should “consisting of” have the same meaning as “comprising”?

The district court’s claim construction that the Markush groups of Claims 1 and 28 did not include mixtures of mLLDPE, VLDPE, ULDPE, and LLDPE, seemed entirely consistent with court precedent.¹⁰ According to the district court’s claim construction, if a claim recites “a layer selected from a group consisting of mLLDPE, VLDPE, ULDPE, and LLDPE,” then only those films having a layer made from *only* mLLDPE, VLDPE, ULDPE, or LLDPE would infringe; blends of the individual resins would not infringe.

On appeal, Multilayer argued that “the intrinsic evidence clearly establishes that the Markush groups in claims 1 and 28 should be construed as open”¹¹ and cites no authority for the proposition that “consisting of” means “comprising.”¹² Rather, Multilayer cites the Specification that discloses the use of resins other than those listed in Claims 1 and 28 as support.¹³ The court explained that the use of the transitional phrase “consisting of” creates a very strong presumption that the claim is closed to unrecited elements.¹⁴ The court noted that it is possible that a patentee could become “his own lexicographer” and define “consisting of” differently than how it is understood in patent law, which was not the case based on these facts.¹⁵ Multilayer also argued that because LDPE, a resin not listed in Claims 1, is recited in

dependent claims 18 and 19, then Claim 1 should be construed as open so as to include other resins such as LDPE.¹⁶ The court rejected this argument because a dependent claim cannot change the scope of an independent claim.¹⁷ The Federal Circuit was unpersuaded, affirming the district court that “consisting of” is a closed term.¹⁸ As a result, Claim 10 was rendered indefinite: Claim 1 excludes LDPE, while Claim 10 includes it.¹⁹ Any dependent claim that fails to narrow the claim from which it depends is indefinite and therefore invalid.²⁰

The “Abbott Presumption”^{20A}

The court next considered whether claims 1 and 28 were closed to blends of LLDPE, VLDPE, ULDPE, and mLLDPE. The court noted that in *Abbott Labs*, the court held that the transitional phrase “consisting of” created a presumption that a Markush group was closed to mixtures of recited elements, but that this presumption could be overcome by the specification or the other claims.²¹ This statement seems at odds with *Abbott Labs*:

If a patentee desires mixtures or members of the Markush group, the patentee would need to add qualifying language while drafting the claim. . . . Thus, without expressly indicating the selection of multiple members of a Markush grouping, a patentee does not claim anything other than the plain reading of the closed claim language. . . . Abbott’s claims do not have such qualifying language.²²

Applying this “Abbott presumption” to the facts of the case, the court cites the Abstract (“the resins used in the film . . . may be blended”), the Summary of the Invention (“at least two of the resins may be blended”), and the Detailed Description (“inner layers . . . can contain ‘blended’ LLDPE within a single layer”).²³ The court concludes from the teaching or suggestion in the Specification that blends may be used to constitute “unequivocal” support that the Markush group is open to blends.²⁴

As added support for the proposition that the Markush groups of Claims 1(b) and 28 (b) were open to blends, the court found that there was nothing in the prosecution history “to suggest that blends are excluded” or to contradict the specification.²⁵ In *Abbott Labs*, the court used the patent prosecution history to support the closed nature of the claims.²⁶ Abbott narrowed the claims during prosecution to avoid a §112 rejection and gain allowance.²⁷ In contrast, Multilayer’s patent prosecution history is quite different. Claims 1 and 28 as issued are the same as filed and remained unchanged through three reexaminations.²⁸

Practical Consequences

The Federal Circuit, in *Multilayer v. Berry Plastics*, has changed Markush practice by speaking the “Abbott presumption” into being. It was one thing, as was the case in *Abbott*, to use the patent prosecution history as support for the conclusion that the Markush group was

closed. It is quite another thing to look beyond the claim to the specification to change the plain meaning of the claim. The “Abbott presumption” has upset a well-settled area of law. Prior to this decision, when confronted with a patent claiming an invention in Markush format, there was certainty in the law—one could look only to the claims and determine whether mixtures were claimed. This Federal Circuit decision complicates what used to be straightforward. If a Markush claim lacks qualifying language, one must also review the specification and the patent prosecution history to make an educated guess as to whether the combination is sufficient to overcome the presumption that the claim is closed to mixtures. For businesses and other entities, this complicates the task of avoiding patent infringement and makes opinion work for patent practitioners more challenging.

It seemed well-settled to Berry Plastics (the accused infringer) as well. Berry filed a Motion for Rule 11 sanctions. In their opinion, to argue that a Markush claim is an open claim is to bring a frivolous argument before the court. On appeal, Berry cross-appealed the denial of Rule 11 sanctions and court held that the Motion “was meritless.”

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¹*Multilayer Stretch Cling Film Holdings, Inc. v. Berry Plastics Corp.*, Nos. 2015–1320, 2015–1477, slip op. at 2 (Fed. Cir. Aug. 4, 2016), <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/15-1420.Opinion.8-2-2016.1.PDF>.

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²U.S. Patent No. 6,265,055 (filed Oct. 13, 1999).

³*Multilayer*, slip op. at 5.

⁴U.S. Patent No. 6,265,055 (filed Oct. 13, 1999). The resins have been abbreviated for better readability. LLDPE = linear low-density polyethylene; VLDPE = very low-density polyethylene; ULDPE = ultra low-density polyethylene; mLLDPE = metallocene catalyzed linear low-density polyethylene. Some of Berry Plastic’s Accused films were blends made from polypropylene (PP) and low-density polyethylene (LDPE).

⁵*Id.* at col. 12.

⁶*Multilayer Stretch Cling Film Holdings, Inc. v. Berry Plastics Corp.*, 63 F. Supp. 3d 786, 795 (W.D. Tenn. 2014).

⁷'055, at col. 10.

⁸*Multilayer*, slip op. at 7–8.

⁹*Id.* at 6 (“Each of five identifiable inner layers must contain only one class of the following resins and no other resins . . .”). For support, see *In re Driscoll*, 562 F.2d 1245, 1249 (C.C.P.A. 1975) (describing members of a Markush group as “alternatively usable” for the purposes of the invention); *Abbott Labs v. Baxter Pharm Prods.*, 334 F.3d 1274, 1281 (Fed. Cir. 2003) (“If a patentee desires mixtures or combinations of the members of a Markush group, the patentee would need to add qualifying language while drafting the claim.”).

¹⁰*Multilayer*, slip op. at 12.

¹¹*Id.* at 12–14.

¹²*Id.* at 14–15.

¹³*Id.* at 12.

¹⁴*Id.* at 14 (referring to *Conoco, Inc. v. Energy & Environmental Int’l*, 460 F.3d 1349, 1359 n.4 (Fed. Cir. 2006)).

¹⁵*Id.* at 14–15.

¹⁶*Multilayer*, slip op. at 16 (citing *N. Am. Vaccine, Inc. v. Am. Cyanomid Co.*, 7 F.3d 1571, 1577 (Fed. Cir. 1993) (“The dependent claim cannot wag the independent claim dog.”)).

¹⁷*Id.* at 17–18.

¹⁸*Id.* at 19–20.

¹⁹The ‘055 patent made it through the original patent prosecution and three reexaminations without Claim 10 getting rejected as indefinite.

²⁰*Id.* at 22.

^{20A}*Abbott Labs v. Baxter Pharm. Prods.*, 334 F.3d 1274, 1280 (Fed. Cir. 2003).

²¹*Abbott Labs*, 334 F.3d at 1281.

²²*Multilayer*, slip op. at 25.

²³*Id.* at 23.

²³*Id.* at 25.

²⁴*Abbott Labs*, 334 F.3d at 1281.

²⁵*Id.*

²⁶See Public Pair for U.S. Patent No. 6,265,055 (claims as filed); U.S. Application Nos. 90/006,336; 90/008,347; and 90/009,644.