

Keywords: claim construction, anticipation, inherency, importation of claim limitations from the specification

General: The court reversed the district court's invalidity determination for two Prima Tek patents relating to floral arrangements. The asserted claims were anticipated by a reference that met the "without pot means" limitation, the "floral holding material" limitation, and the "crimping and overlapping fold" limitation. The district court interpreted the first two limitations too narrowly, and for the third, the reference inherently supplied the limitation.

Prima Tek II L.L.C. v. Polypap S.A.R.L.
75 U.S.P.Q.2d 1219 (Fed. Cir. 2005)
Decided June 22, 2005

I. Facts

Polypap S.A.R.L. ("Polypap") and Prima Tek L.L.C. ("Prima Tek") are competitors in the floral arrangement market. Appellee, Prima Tek, is the owner of U.S. Patent Numbers 5,410,856 (the '856 patent) and 5,615,532 (the '532 patent). Polypap sells the accused infringing product, a disposable device for holding floral arrangements called the Bouquett'O. In 1999, Prima Tek filed a suit against Polypap alleging infringement of claim 15 of the '856 patent and claim 9 of the '532 patent.

The district court granted a non-infringement summary judgment for Polypap, which was appealed to the Federal Circuit. On appeal, the Federal Circuit held that the district court had incorrectly limited the claim language by failing to give terms their ordinary meaning. Because of this error, the Federal Circuit vacated the district court's decision. On remand, the district court held that Polypap had infringed the claims and enjoined them from making, using or selling the product. Polypap then appealed the district court's decision to the Federal Circuit.

Generally, Prima Tek's asserted claims describe a floral grouping in which flower stems are inserted into floral foam, the foam wrapped in a sheet of material and tied near the top. Claim 15 of the '856 patent recites 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 limitations for "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." Polypap argued that Prima Tek's claims were anticipated.

The court noted that there was extensive prior art pertaining to products and methods for floral arrangements, dating back to 1899. To simplify matters, the court addressed the more recent Charrin reference, a published French patent application, to analyze whether the claims at suit were anticipated. The Charrin reference provides an embodiment in which flowers are inserted into a mass of wetted moss about which a cover made of waterproof material is wrapped. The cover is also tied at the top by passing a cord through holes in the cover and tightening the cord. Prima Tek acknowledged that the Charrin reference anticipated the claims but for three limitations:

- 1) the "without any pot means" limitation,
- 2) the alleged requirement that the floral holding material hold its shape, and
- 3) the crimping limitation (found only in claim 15 of the '856 patent).

With respect to the “without any pot means” limitation of the Prima Tek claims, the district court construed the terms as “any material . . . which supports the floral grouping without a closed bottom receptacle such as a flower pot, vase, etc.” At oral argument on appeal, Polypap sought a construction for “pot means” as a “shell-like structure that supports a grouping of flowers.” Prima Tek urged a construction of “a container, or anything that serves like a container, to hold the floral holding material into place.”

With respect to the second limitation, the district court construed the term “floral holding material” to require that the material hold its predetermined shape. In its infringement analysis, the court followed the Federal Circuit’s prior construction of “floral holding material” to mean it “[h]as an upper end, a lower end and an outer peripheral surface and is constructed of a material capable of receiving a portion of the floral grouping without any pot means.” However, for anticipation analysis the district court altered the claim construction by adding the limitation “that the material is capable of holding its predetermined shape.” This interpretation of the claim distinguished the Prima Tek claims from the Charrin reference.

With respect to the crimping limitation, the district court found that the Charrin reference does not include the crimping and overlapping fold limitations of claim 15 of the ‘856 patent. The Charrin reference disclosed the tying of a sheet of material with a string laced through holes in the sheet. Polypap argued that, although the reference does not include the limitation, the limitation is inherent in the apparatus.

II. Issue

- A. Did the district court properly construe the Prima Tek claims for the anticipation and validity analyses?

III. Discussion

- A. No. The Federal Circuit found that the district court misinterpreted the claims in question with respect to the three limitations asserted by Prima Tek. The Federal Circuit construed the “pot means” limitation by referring to the dictionary meaning of “pot,” which is defined as a “rounded metal or earthen container. . . .” The court stated that Charrin clearly satisfies the “without any pot means” limitation because the reference does not use a metal or earthen container, instead Charrin uses wire tied around moss. With respect to the second limitation, the Federal Circuit held that the district court had erred by adding the limitation that the “floral holding material” holds its predetermined shape. The court stated that the language is not a limitation because it was merely disclosed as a preferred embodiment in the specification. Under the court’s corrected construction, after removing the shape-holding restriction, Charrin did meet the claim’s meaning. Lastly, the Federal Circuit agreed with Polypap’s inherency argument with regard to the crimping limitations of the ‘856 patent. They held that the crimping folds were inherent in Charrin because a figure in the reference portrays crimping folds and testimony confirmed that the feature was inherent.

IV. Conclusion

Claim 15 of the ‘856 patent and claim 9 of the ‘532 patent were held invalid as anticipated by the Charrin reference. As a result, the district court’s finding of infringement by Polypap was reversed.