United States District Court,
W.D. Washington.

K2 CORPORATION, an Indiana corporation,
Plaintiff.
v.
SALOMON S.A., a French corporation, and Salomon/North America,
Inc. a Delaware corporation Defendants.

No. C98-0462D

July 10, 1998.

ORDER GRANTING DEFENDANTS' MOTION FOR SUMMARY JUDGMENT AND DENYING PLAINTIFF'S MOTIONS

DIMMICK**, District J.**

THIS MATTER comes before the court on plaintiff's motion for a preliminary injunction and both parties' cross-motions for summary judgment. The materials filed, and the arguments of counsel heard on June 30, 1998, have been fully considered. Because there is no genuine issue of material fact for trial, the case may be decided on summary judgment as a matter of law pursuant to Federal Rule of Civil Procedure 56.

I BACKGROUND

Plaintiff K2 Corporation ("K2") contends that defendants Salomon S.A. and Salomon/North America ("Salomon") infringed its patent for in-line skates, U.S. Patent No. 5,437,466 and the reexamined U.S. Patent No. B1 5,437,466 (collectively, the "Meibock patent"). Salomon's TR-series skate and the Meibock patent both feature a breathable inner shoe affixed to a rigid external structure. This design provides comfort (air-circulation) and performance (quick response due to the shoe's firm connection to a rigid structure).

The parties dispute the scope of, essentially, one aspect of the Meibock patent:

said non-rigid shoe portion being *permanently affixed* to said base portion *at least at said toe area and said heel area* for substantially preventing movement therebetween at least in a horizontal plane ....

(Salomon's Summary Judgment Motion, Exh. 4, column 2, lines 14-18 (Meibock Patent, Claim 1) (emphasis added).) More specifically, they dispute the meaning of "permanently affixed." FN1

FN1. K2 says that Salomon infringed Claim 1, while Salomon replies that it did not infringe Claims 1, 5, and 6. Claim 5 provides:
said non-rigid shoe portion being *permanently interconnected* with said base portion *at least at said toe area and said heel area* for substantially preventing movement therebetween at least in a horizontal plane ....

(Salomon's Summary Judgment Motion, Exh. 4, column 2, lines 45-49 (Meibock Patent, Claim 5) (emphasis added).) Claim 6 similarly provides:
said non-grid upper portion being *non-removably affixed* to said rigid base adjacent *both said heel and toe*

portions of said base for substantially preventing movement therebetween at least in a horizontal plane ....

(*Id.,* at column 3, lines 21-25 (Meibock Patent, Claim 6) (emphasis added.)

The parties agree that Claims 1, 5, and 6 contain equivalent language. The same analysis applies to all three. With Salomon's skate, the shoe is permanently riveted to the base portion at the toe area, but is screwed into the base at the heel with a hex-head screw. Because such a screw may be removed, Salomon says that its skate does not violate K2's patent. K2 argues that "permanently" affixed does not mean "permanently"; it means "firmly" affixed to prevent movement along a horizontal plane. That is, "permanently" must be interpreted according to the functional language that follows it.

K2 argues, therefore, that the TR skate infringes the Meibock patent either literally or under the doctrine of equivalents. Salomon responds that the skate does not infringe the patent literally and that K2 is precluded from invoking the doctrine of equivalents because of prosecution history estoppel.

II DISCUSSION

A. Literal Infringement

A literal infringement analysis entails two steps: (1) determining the meaning and scope of the patent claims asserted to be infringed; and (2) comparing the properly construed claims to the device accused of infringing. Markman v. Westview Instruments, Inc ., 52 F.3d 967, 976 (Fed.Cir.1995) (en banc), *aff'd,* 116 S.Ct. 1384 (1996). The first step, claim construction, is a matter of law. Id. at 979.

1. *Claim Construction*

The court considers three evidentiary sources: (1) the claims; (2) the specification; and (3) the prosecution history. *Id*. Extrinsic evidence, such as expert and inventor testimony, dictionaries, and learned treatises, may also be used to aid understanding but may not vary or contradict the terms of the claims. *Id*. at 980-91. "Without an express intent to impart a novel meaning to claim terms, an inventor's claim terms take on their ordinary meaning." York Products, Inc. v. Central Tractor, 99 F .3d 1568, 1572 (Fed.Cir.1996).

K2 argues that "permanently affixed" is synonymous with "fixed," "secured," and "firmly held" in light of its prosecution history, especially because "permanently" was added to differentiate its Meibock patent from the existing Johnson patent, U .S. Patent No. 5,331,752. K2 says that the Johnson patent provided for an easily removable shoe portion which could be used by the commuter-skater for walking but was loosely attached during skating. During the PTO's reexamination of the K2 patent, additional language was added to require affixation "at least at said toe area and said heel area for substantially preventing horizontal movement therebetween at least in a horizontal plane." K2 argues, therefore, that "permanent" affixation means "more fixed," because of its function, to prevent horizontal movement.

This argument is unconvincing. First, nowhere in the claim, specification, or prosecution history is "permanently" defined this way.

Second, the Johnson patent suggests that the Meibock patent used "permanently" to mean "non-removable" rather than "secured." The Johnson patent provides for "locking of the shoe in a stationary position for high performance skating, comfortable commuter, recreational or competitive skating," (Salomon's Motion for Summary Judgment, Exh. 21, column 3, lines 66-68), and "means for engagement provided to secure said shoe in a fixed position ... for substantially preventing movement of said shoe ... along a predetermined line of travel ...." (*Id.,* at column 9, lines 46-49.) As Salomon notes, K2 analyzes a skate, the Rollerblade Metroblade, that embodies one form of the Johnson patent; the Johnson patent itself does not provide for

loose affixation of the boot.

Third, the prosecution history favors Salomon's interpretation. In an early rejection of the Meibock patent, the examiner said:

Bourque et al[.] teaches permanently affixing a non-rigid shoe portion to a skate support means. While Johnson intends its non-rigid shoe portion to be removable, this does not preclude the possibility that one of ordinary skill in the art would find it obvious to permanently attach the non-rigid shoe to the support.

(*Id.,* Exh. 20, at 195.) The Bourque patent, U.S. Patent No. 4,773,658, shows an ice skate boot permanently affixed to the base by use of an adhesive. (Id., Exh. 36, front page.) Similarly, a French patent provides for affixing a soft shoe to an in-line skate base by using screws at the toe and the heel. (Id., Exh. 27, 28, 37). That patent predates the Meibock patent and was cited by K2 in its reexamination. If that affixation was "permanent," as defined by K2, the French patent suggests an obvious alteration to the Johnson patent that would call into question even the requirement in the Meibock patent for permanent affixation at the toe and heel areas.

2. *Comparison*

If one removes the Salomon skate's hex-head screw at the heel, the heel portion of the inner shoe lifts up. This does not constitute "permanent" affixation at the heel area under a properly construed claim. No literal infringement occurred. *See* Wolverine World Wide, Inc. v. Nike, Inc., 38 F.3d 1192, 1199 (Fed.Cir.1994) ("If an express claim limitation is absent from the accused product, there can be no literal infringement as a matter of law.")

B. The Doctrine of Equivalents and Prosecution History Estoppel

Under the doctrine of equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." Warner-Jenkinson Co. v. Hilton Davis Chemical, 117 S.Ct. 1040, 1045 (1997). The court asks whether two devices do the same work in substantially the same way to accomplish substantially the same result. Id. at 1052. This is an objective test, i.e., a competitor's intent is irrelevant. *Id*. Equivalence is a question of fact for the jury. *Id*. at 1053 (approving of Federal Circuit decision that equivalence was question of fact).

K2 argues that the doctrine of equivalents applies here because a hex-head screw is the equivalent to a permanent form of affixation, such as a rivet, and it prevents movement of the shoe along a horizontal plane. The doctrine of equivalents is, however, limited by a question of law: whether prosecution history estoppel precludes considering it.

Prosecution history estoppel ("PHE") precludes "a patentee from regaining, through litigation, coverage of subject matter relinquished during prosecution of the application for the patent." Wang Laboratories, Inc. v. Mitsubishi Electronics, 103 F.3d 1571, 1577-78 (Fed.Cir.), *cert. denied,* 118 S.Ct. 69 (1997). The court examines the patentee's statements and actions before the PTO during prosecution and asks what a competitor reasonably may conclude the patentee surrendered to gain issuance of the patent. Id. at 1578. Once PHE limits the scope of the patent, "the patentee may not recover for infringement where infringement would require an equivalence between a claim element and an aspect of the accused item that falls within the estoppel." *Id*.

Salomon argues that PHE applies because (1) K2 modified its claim language to require permanent affixation because its patent was originally rejected due to the Johnson patent and other prior art; (2) based on the PTO's reexamination process, K2 added specific language regarding the toe and heel areas and

horizontal movement; and (3) Salomon's skate is not permanently affixed at the heel area.

The burden is on the patent holder to establish the reason for an amendment required during patent prosecution. Warner-Jenkinson Co., 117 S.Ct. at 1051. In absence of such an explanation, the court presumes "that the PTO had a substantial reason related to patentability for including the limiting element added by amendment. In those circumstances, prosecution history estoppel would bar the application of the doctrine of equivalents as to that element." *Id*.

K2 has advanced no credible reason for why the claim does not mean what it says. Upon reexamination, the patent claim was amended to provide for affixation "at least at said toe area and said heel area." This means that the location of affixation is important: just at the heel or just at the toe is not enough. The prosecution history suggests that such changes were made to differentiate further the Meibock patent from prior art such as the Johnson patent, which shows affixation at the toe and the mid-sole.

Interpreted most favorably to K2, it would be unclear why such amendments were made. The court then would presume that the changes were based on a substantial reason related to patentability. Therefore, regardless, prosecution history estoppel applies as a matter of law.

III CONCLUSION

In summary, Salomon's TR-series skate does not literally infringe upon K2's Meibock patent. Prosecution history estoppel precludes the court from applying the doctrine of equivalents to compare the Salomon skate's affixation at the heel to K2's patent.

Therefore, the Court grants summary judgment in favor of Salomon. It denies K2's summary judgment motion and dismisses its preliminary injunction motion as moot.

The Clerk of the Court is directed to send copies of this order to counsel of record.

W.D.Wash.,1998.
K2 Corp. v. Salomon S.A.

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