United States District Court,
S.D. New York.

Jack HERMAN,
Plaintiff.
v.
WILLIAM BROOKS SHOE COMPANY, Cabela's, Inc., Gates-Mills, Inc., W.L. Gore & Associates, Inc., L.L. Bean, Inc., Recreational Equipment, Inc., Raven Industries, Inc., Rocky Shoes and Boots, Inc., Norm Thompson Outfitters, Inc., and U.S. Cavalry, Inc,
Defendants.

No. 95 Civ. 1324(PKL)

Jan. 24, 2000.

Hopgood, Calimafde, Kalil & Judlowe, LLP, New York, NY, John M. Calimafde, Ward & Olivo, New York, NY, John W. Olivo, Jr., John F. Ward, for Plaintiff, of counsel.

Morgan & Finnegan, LLP, New York, NY, David H. Pfeffer, Michael A. Nicodema, Barry A. Schindler, for Defendants, of counsel.

AMENDED OPINION AND ORDER

LEISURE**, J.**

Plaintiff Jack Herman brings this action alleging patent infringement by defendants. Pursuant to Rule 56 of the Federal Rules of Civil Procedure, defendants move for summary judgment on plaintiff's claims, alleging the invalidity of plaintiff's patent due to anticipation by the prior art.

For the reasons stated in this Opinion, defendants' motion for summary judgment is GRANTED.

BACKGROUND

The Court presumes familiarity with the facts set forth in its Memorandum Order, dated April 26, 1996, issued in connection with this action. *See* Herman v. William Brooks Shoe Co., 1996 WL 208198 (S.D.N.Y. Apr. 26, 1996). Thus, the Court here discusses only those facts relevant to the instant motion.

In 1995, defendants filed three distinct motions for summary judgment in this case. On January 4, 1996, all three motions were fully submitted to the Court. Two of the three motions challenged the validity of plaintiff's patent for anticipation by the prior art, pursuant to 35 U.S.C. s. 102. The third motion challenged the enforceability of plaintiff's patent, alleging inequitable conduct by plaintiff in connection with his patent application. On April 26, 1996, the Court granted defendants' third motion for summary judgment, holding plaintiff's patent unenforceable, and denied defendants' remaining motions as moot. *See* Herman, 1996 WL

208198 at *7. On March 21, 1997, the United States Court of Appeals for the Federal Circuit vacated this Court's grant of summary judgment, holding that the enforceability issue involved factual questions best left to the trier of fact. *See* Herman v.. William Brooks Shoe Co., 111 F.3d 142 (Fed.Cir.1997). On remand, the Court now considers defendants' two surviving motions for summary judgment alleging the invalidity of plaintiff's patent for anticipation by the prior art. FN1

FN1. These motions were held in abeyance between June 1997 and December 1998, during which time a motion to bifurcate the trial of this case and a motion for reconsideration were *sub judice*.

In the first of these two motions, defendants contend that, pursuant to 35 U.S.C. s. 102(b), claim 1 of plaintiff's patent is invalid for anticipation by an earlier patent, U.S. Patent No. 4,204,345, issued to Virginia R. Bradley on May 27, 1980 (hereinafter, "the Bradley patent"). Plaintiff received the patent in suit, U.S. Patent No. 4,550,446 (hereinafter, "the Herman patent"), on November 5, 1985.

In the second motion, defendant W.L. Gore & Associates, Inc. (hereinafter, "Gore") maintains that both claims 1 and 2 of plaintiff's patent are anticipated by description in a printed publication and prior invention and reduction to practice, pursuant to 35 U.S.C. s.s. 102(a) and (g).

DISCUSSION

I. STANDARD FOR SUMMARY JUDGMENT

A moving party is entitled to summary judgment if the Court determines that there exists no genuine issue of material fact to be tried and the party is entitled to judgment as a matter of law. *See* Fed.R.Civ.P. 56; *see also* Celotex Corp. v. Catrett, 477 U.S. 317, 322-323 (1986); General Elec. Co. v. Nintendo Co., 179 F.3d 1350, 1353 (Fed.Cir.1999). The moving party bears the burden of showing that no genuine issue of material fact exists. *See* Adickes v. S.H. Kress & Co., 398 U.S. 144, 157 (1970). "In determining whether there is a genuine issue of material fact, the evidence must be viewed in the light most favorable to the party opposing the motion, with doubts resolved in favor of the opponent." Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc., 145 F.3d 1303, 1307 (Fed.Cir.1998); *see also* Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986).

The construction of a patent, including terms of art within its claims, is exclusively within the province of the Court, to be decided as a question of law. *See* Markman v. Westview Instruments, 517 U.S. 370, 376-91 (1996). By contrast, anticipation by the prior art is a question of fact. *See, e.g.,* Karlin Tech., Inc. v. Surgical Dynamics, Inc., 177 F.3d 968, 974 (Fed.Cir.1999); Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302 (Fed.Cir.1995). However, "[d]espite being issues of fact, infringement and anticipation may still be decided on summary judgment." General Elec., 179 F.3d at 1353; *see also* Oney v. Ratliff, 182 F.3d 893, 895 (Fed.Cir.1999) ("Although anticipation is a question of fact, it still may be decided on summary judgment if the record reveals no genuine dispute of material fact.")

II. DEFENDANTS' s. 102(b) ANTICIPATION CLAIM

Defendants maintain that the Herman patent is anticipated by the prior art, thus rendering the patent invalid and defeating plaintiff's claims of infringement. Because plaintiff enjoys a presumption that his patent is valid as issued, *see* 35 U.S.C. s. 282, defendants must establish their anticipation claim by clear and convincing evidence. *See, e.g.,* Kegel Co. v. AMF Bowling, Inc., 127 F.3d 1420, 1429 (Fed.Cir.1997).

The same legal standard applies to both infringement and anticipation claims. The courts have frequently expressed this rule as: "That which infringes if later anticipates if earlier." *See, e.g.,* Polaroid Corp. v. Eastman Kodak Co., 789 F.2d 1556, 1573 (Fed.Cir.1986). As such, "claims must be interpreted and given the same meaning for purposes of both validity and infringement analyses." SmithKline Diagnostics v. Helen Lab. Corp., 859 F.2d 878, 882 (Fed.Cir.1988). Accordingly, the courts apply the two-part legal test for infringement when evaluating claims of anticipation: "First, the claim must be properly construed to determine its scope and meaning. Second, the claim as properly construed must be compared to the accused device or process." Carroll Touch, Inc. v. Electro Mechanical Sys., 15 F.3d 1573, 1576 (Fed.Cir.1993).

A. Construction of Plaintiff's Patent

To adjudicate defendants' argument that claim 1 of the plaintiff's patent is invalid, the Court must first ascertain the meaning of that claim as a matter of law. *See Markman*. FN2 In construing patent claims, the courts must generally confine their review to intrinsic evidence, but may resort to extrinsic evidence where intrinsic evidence is insufficient to resolve ambiguity in a disputed claim term. *See* Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582-84 (Fed.Cir.1996). Thus, the language of the patent is controlling and the meaning of a patent claim is a question of law to be decided by the Court. *See, e.g*. Karlin, 177 F.3d at 971.

FN2. The Supreme Court in *Markman* wrote that "[t]he construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis. Patent construction in particular 'is a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be right, in performing such a duty, than a jury can be expected to be." ' 517 U.S. at 388 (quoting Parker v. Hulme, 18 F. Cas. 1138, 1140 (No. 10,740) (C.C.E.D.Pa.1849)).

Summary judgment is especially appropriate where, as here, the only dispute between the parties concerns claim interpretation. *See, e.g.,* General Mills, Inc. v. Hunt-Wesson, Inc., 103 F.3d 978, 980 (Fed.Cir.1997). In the instant case, plaintiff admits that the Bradley patent contains most elements of claim 1, the sole independent claim of the patent in suit. *See* Pl. Loc. R. 3(g) Stmt. Plaintiff contends, however, that his patent teaches a "breathable" waterproof sock-like device, while the alleged prior art patent, the Bradley patent, teaches a waterproof sock-like device that is not "breathable." *See id*. at para. 3. Because the Bradley patent teaches a waterproof sock-like device "preferably made from a suitable plastic that is lightweight, flexible and preferably air permeable," Bradley pat., col. 1, ll. 53-55, the parties' dispute can be reduced to a debate over the equivalency of plaintiff's "breathable" and Bradley's "air permeable." As such, it presents issues of claim interpretation amenable to summary disposition. *See* General Mills, 103 F.3d at 980. Should the Court find as a matter of law that these two terms are equivalent, there remain no factual issues to preclude summary judgment.

Defendants maintain that claim 1 of plaintiff's patent is invalid for anticipation by the Bradley patent. Claim 1 teaches:

A sock-type article adapted to be worn on the foot and having sole and heel regions adjacent to the sole and heel regions of a foot when worn, said sock-type article being substantially entirely formed of a light-weight, flexible material defining an interior space receivable of a foot, said material being substantially

waterproof to prevent passage of water into said interior of the sock-type article through said material and at the same time moisture vapor permeable to allow passage of evaporated perspiration which may be formed on the foot from said interior of the sock-type article through said material, whereby the foot will be maintained as dry as possible when the sock-type article is worn thereon.

Herman pat., col. 4, ll. 11-24.

Although the parties might prefer to substitute their own nuanced definitions for the terms used in plaintiff's patent and the asserted prior art patent, the Court must give these terms their ordinary meanings for purposes of claim construction. *See, e.g.,* K-2 Corp. v. Salomon S.A., 191 F.3d 1356, 1362 (Fed.Cir.1999) ("The general rule is that terms in the claim are to be given their ordinary and accustomed meaning.") (citing Johnson Worldwide Assoc., Inc. v. Zebco Corp., 175 F.3d 985, 989 (Fed.Cir.1999)). Thus, plaintiff must accept the plain meaning of the words contained within his patent rather than proffer an alternative reading of these terms. *See, e.g.,* Intervet Amer. v. Kee-Vet Lab., 887 F.2d 1050, 1053 ("No matter how great the temptations of fairness or policy making, courts do not rework claims. They only interpret them.") The Court "cannot alter what the patentee has chosen to claim as his invention." SSIH Equipment S.A. v. U.S. Int'l Trade Comm., 718 F.2d 365, 278 (Fed.Cir.1983).

"Claim construction begins with the words of the claim." Karlin, 177 F.3d at 971. "When construing a claim, a court should first look to the intrinsic evidence, i.e., the patent itself, its claims, written description, and, if in evidence, the prosecution history." *Id.* "The court may receive extrinsic evidence to educate itself about the invention and the relevant technology, but the court may not use extrinsic evidence to arrive at a claim construction that is clearly at odds with the construction mandated by the intrinsic evidence. *Id.* "In defining the meaning of key terms in a claim, reference may be had to the specification, the prosecution history, prior art, and other claims. This is not, however, to be confused with reading into a claim a limitation appearing in the specification but not in the claim." Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1566 (Fed.Cir.1992) (internal citations omitted).

Accordingly, the Court first considers the language used in plaintiff's patent. In the claim at issue, claim 1, the term "moisture vapor permeable" is used. Elsewhere, in claim 5 and in the specification, the term "breathable" is introduced. According to the *American Heritage Dictionary of the English Language* (3d ed.1992), "breathable" means "permitting air to pass through." FN3 The dictionary gives as its example, "a breathable fabric." The dictionary defines "air" as "a colorless, odorless, tasteless, gaseous mixture, mainly nitrogen (approximately 78 percent) and oxygen (approximately 21 percent) with lesser amounts of argon, carbon dioxide, hydrogen, neon, helium, and other gases." The dictionary also gives an alternate usage: "This mixture *with varying amounts of moisture* and particulate matter, enveloping Earth; the atmosphere" (emphasis added). Thus, the term "breathable" describes a material that allows both gases and moisture vapor to pass through it. As such, the language used in claim 1, "moisture vapor permeable," is essentially synonymous with "breathable." Accordingly, under either term, the Herman patent teaches a sock that is both waterproof and permits air, including moisture vapor, to pass through it.

FN3. Courts commonly consult ordinary dictionaries in order to determine the proper construction of terms used in patent claims. *See, e.g.* Karlin, 177 F.3d at 971.

B. Comparison of Plaintiff's Patent and Alleged Prior Art Patent

Having construed the language of plaintiff's patent claims, the Court proceeds to consider whether the asserted prior art patent anticipates plaintiff's patent. Anticipation, like infringement, poses a question of fact. *See, e.g., Karlin; Hoover*. But anticipation may be decided on summary judgment where there are no genuine issues of material fact to be decided. *See, e.g., General Mills*. "For summary determination to be proper, there must be no genuine dispute whether the limitations of the claimed invention are disclosed, either explicitly or inherently, by an allegedly anticipating prior art reference." Hazani v. United States Int'l Trade Commission, 126 F.3d 1473, 1477 (Fed.Cir.1997).

"Anticipation under 35 U.S.C. s. 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention." Rockwell Int'l Corp. v. U.S., 147 F.3d 1358, 1363 (Fed.Cir.1998). "To anticipate a claim, a prior art reference must disclose every feature of the claimed invention, either explicitly or inherently." Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047. Thus, to succeed on their claim, defendants must demonstrate by clear and convincing evidence that some piece of prior art discloses each element of claim 1 of plaintiff's patent. For the issue to be decided on summary judgment, the Court must conclude that a reasonable jury could only find that all elements of the claimed invention are described in a single reference, sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. *See, e.g.,* In re Spada, 911 F.2d 705, 708 (Fed.Cir.1990).

The Bradley patent is without question a single reference. More importantly, it explicitly contains every element of claim 1 of plaintiff's patent. The Court divides claim 1 into eight elements, for purposes of comparison with the Bradley patent: (1) A sock-type article (2) adapted to be worn on the foot and (3) having sole and heel regions adjacent to the sole and heel regions of a foot when worn, (4) said sock-type article being substantially entirely formed of a light-weight, flexible material (5) defining an interior space receivable of a foot, (6) said material being substantially waterproof to prevent passage of water into said interior of the sock-type article through said material and (7) at the same time moisture vapor permeable to allow passage of evaporated perspiration which may be formed on the foot from said interior of the sock-type article through said material, (8) whereby the foot will be maintained as dry as possible when the sock-type article is worn thereon. The Bradley patent likewise teaches a "tubular sock," Bradley pat., col. 2, l. 51, worn "over the foot," *id.,* col. 1, l. 31, "having a toe portion, heel portion, and upper portion," *id.,* col. 1, l. 52, "made from a suitable plastic that is lightweight [and] flexible," *id.,* col. 1, ll. 53-54, "shaped in the form of a unitary sock-like structure," *id.,* col. 1, ll. 50-51, that is "liquid impermeable," *id.,* col. 2, l. 52, and "preferably air permeable," *id.,* col. 1, ll. 54-55, "for maintaining the feet dry," *id.,* col. 1., ll. 19-20.

Plaintiff admits that every element of his claim 1 is taught by the Bradley patent, with the exception of the requirement of "moisture vapor permeability" or "breathability." *See* Pl. Loc. R. 3(g) Stmt. Thus, the Court need only consider the disputed element, the so-called "breathability" element. As the Court established in the previous section, "breathability" and "moisture vapor permeability" must be accorded their ordinary meaning; *i.e.,* permitting air, including moisture vapor, to pass through.

The Bradley patent indicates that "[t]he sock-like structure is preferably made from a suitable plastic that is lightweight, flexible and preferably air permeable." The *American Heritage Dictionary of the English Language* (3d ed.1992), defines "permeable" as "that can be permeated or penetrated, especially by liquids or gases." As discussed, *supra,* the dictionary includes "moisture and particulate matter" in its definition of "air."

Plaintiff maintains that the Bradley patent discloses a sock that is "preferably air permeable (not moisture vapor permeable)." Pl. Brief at 5. But because air permeability necessarily encompasses permeability to the

moisture vapor contained in air, the Court finds these terms to be equivalent as they are used in the Bradley and Herman patents. Thus, it is possible to conclude as a matter of law that the Bradley patent anticipates this element of plaintiff's claim 1.

Plaintiff attempts to cloud what is essentially a question of law under *Markman* by introducing extrinsic evidence as to what he now believes "breathable" to mean, and his expert's views on the technical differences between air permeability and moisture vapor permeability. Nevertheless, plaintiff must rely on the words he actually included in his patent claims. Plaintiff contends that the examples of "air permeable" materials listed in the Bradley patent have much lower moisture vapor transmission rates (MVTRs) than does GORE-TEX; the former have MVTRs of 0.03 to 135 g/m ^{2} per day, while GORE-TEX has an MVTR of over 1000 g/m ^{2} per day. *See* Pl. Brief at 4-6. Essentially, plaintiff argues that, while the Bradley patent *might* teach the use of a moisture vapor permeable material, it does not require a material *as* moisture vapor permeable as plaintiff might use in enabling his patent. While this may well be true, it cannot change the fact that plaintiff's patent *does not* specifically teach the use of GORE-TEX, nor does it require the use of a material that falls within a particular range of MVTRs. Thus, despite plaintiff's belated view that the use of a *highly* moisture vapor permeable material (with an MVTR of 1000 g/m ^{2} per day or greater) would represent a patentable advance of the art taught by the Bradley patent, he is stuck with the *generic* requirement of moisture vapor permeability actually contained in his patent claims. Accordingly, notwithstanding plaintiff's resort to extrinsic evidence, it is clear that plaintiff's claim 1 reads on the art taught by the Bradley patent.

Although plaintiff is not prohibited from offering expert evidence as to the proper construction of terms at issue in this case, such expert testimony may be considered only when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence. *See, e.g.,* Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1308 (Fed.Cir.1999); Bell & Howell Document Management Prods. Co. v. Altek Sys., 132 F.3d 701, 706 (Fed.Cir.1997); Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1579 (Fed.Cir.1996). Here, plaintiff offers the expert testimony of Dr. Howard M. Relles, a chemist, for the proposition that moisture vapor permeability and air permeability are not interchangeable terms. *See Relles Decl.* Although Relles' testimony is unnecessary, as the Court finds no ambiguity in the plain language of plaintiff's patent, it should be noted that even Dr. Relles concedes that "air permeable" might be "meant to include all gaseous molecules including water in the vapor state." *Relles Decl.* at para. 9. Relles concludes that even if this is true, as the Court now holds, the MVTRs of Bradley's suggested materials are much lower than the MVTR of GORE-TEX. This line of testimony is clearly inappropriate under the above-cited cases, particularly insofar as it proposes that the Court read new requirements-namely, the use of GORE-TEX or another high-MVTR material-into the patent. Accordingly, because the Bradley patent literally anticipates each element of claim 1 of the patent in suit, the plaintiff's patent is invalid under 35 U.S.C. s. 102(b), and his infringement claims against defendants must be dismissed with prejudice.

Defendants note that dismissal of plaintiff's entire action is warranted if the Court finds as a matter of law that plaintiff's patent is invalid for anticipation by the prior art. *See* Defs. Brief at 1. Plaintiff does not contest this conclusion in his papers. Because plaintiff accuses defendants of infringement of claim 1 only, a determination that claim 1 is anticipated obviates consideration of the remaining six claims of plaintiff's patent. Furthermore, it is unnecessary for the Court to consider defendant Gore's motion for summary judgment on 35 U.S.C. s.s. 102(a) and (g) grounds, as it is made moot by this Opinion and Order.

CONCLUSION

For the reasons set forth above, defendants' motion for summary judgment on 35 U.S.C. s. 102(b) grounds is hereby GRANTED, defendant Gore's motion for summary judgment on 35 U.S.C. s.s. 102(a) and (g) grounds is hereby DENIED as moot, and this action is DISMISSED with prejudice. As the prevailing parties, defendants shall be awarded costs pursuant to Fed.R.Civ.P. 54(d)(1).

SO ORDERED.

S.D.N.Y.,2000.
Herman v. William Brooks Shoe Co.

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