United States District Court,
E.D. Louisiana.

HOCKERSON-HALBERSTADT, INC,
v.
NIKE, INC.

Sept. 20, 2001.

ORDER & REASONS

FALLON**, J.**

Pending before the Court are the cross-briefs of the parties on the issue of the proper construction of U.S. Patent No. 4,322,895 (" '895 patent"). Plaintiff, Hockerson-Halberstadt, Inc. ("HHI") argues that there are two permissible constructions of the '895 patent, requiring either one integral piece, or two separate pieces. Defendant Propet, Inc. asserts that the scope of the patent is narrower, and requires two, separately-defined pieces. For reasons set forth below, the Court finds that there are two permissible constructions of the '895 patent.

BACKGROUND

Plaintiff, HHI, owns the '895 patent, which relates to a "stabilized athletic shoe." This patent, originally issued on April 6, 1982, claims a running shoe that provides additional stability, control, and shock absorption. The patented design includes a support band, secured to the upper rim of the midsole and the sides of the heel cup, which stabilizes the heel and resists flexing to the side, should the runner land off-center. *See* Hockerson-Halberstadt, Inc. v. Converse, Inc. 183 F.3d 1369, 1370-71 (Fed.Cir.1999).

In 1991, HHI filed suit against Nike, Inc., Reebok International, Ltd., Hyde Athletic Industries, Inc., L.A. Gear, Inc., Brooks Shoe Inc., and Kinney Shoe Corp. alleging infringement of the '895 patent. Id. At that time, Reebok requested reexamination of the patent from the United States Patent and Trademark Office. The Patent Office granted the request and issued a Reexamination Certificate on August 8, 1995. In 1996, HHI filed suit against additional shoe companies, including Converse and the Defendant, Propet. In May of 1998, this Court granted summary judgment in favor of Converse, finding that HHI impermissibly broadened the scope of its claim during reexamination. In July of 1999, the United States Federal Circuit Court of Appeals reversed, concluding that the reexamined claims did not encompass subject matter beyond the original claim. Id. at 1374-75.

HHI's suit against Propet was stayed pending the Converse appeal, and is the only remaining infringement suit pending before this Court. The parties agree that the Federal Circuit's construction of the '895 claims is dispositive in this case, but disagree sharply over the precise nature of that construction. HHI argues that the invention can be made in two separate pieces, with a clearly-defined midsole and support band, or can be made as one integral piece, in which the midsole and support band are fused. HHI bases this argument on

the original '895 patent, the Reexamination Certificate, and the Federal Circuit's claim construction in the *Converse* case. Specifically, HHI points to amended Claim 3 of the '895 patent, which describes "[a]n athletic shoe as in Claim 2, in which the support band is integral with the midsole." *See* U.S. Patent No. 4, 322, 895. HHI further notes that, in *Converse,* the Federal Circuit explained that "[t]he patent teaches that the support band can be formed 'integral with the upper rim of the midsole" ' or 'can be a separate piece which is secured as by fusion to the sole during manufacture." *See* Converse, 183 F.3d at 1371. Finally, HHI emphasizes that the Reexamination Certificate directs that although the heel portion is claimed as "pyramid shaped" in the original patent, the lateral sides of the pyramid may not be visible because "in the preferred embodiment they merge with the support band." *See* id. at 1369.

Defendant Propet also focuses on the *Converse* decision, the '895 patent, and the Reexamination Certificate, but arrives at a markedly different result. Propet argues that the scope of the '895 patent is much narrower that HHI now asserts. According to Propet, HHI's patent encompasses only shoes that have a clearly-defined pyramid-shaped midsole *and* a separate, well-defined heel band. Propet acknowledges that "HHI's use of the word 'merge' could be taken to mean that the pyramid-shaped midsole is in some way embedded within the structure of Propet's shoes," but dismisses this interpretation, and instead focuses on the lack of the critical pyramid-shape in its shoes. *See* Defendant's Trial Brief at 9. Propet concludes that because its shoes are comprised of one solid piece of plastic material, they do not infringe HHI's patent.

ANALYSIS

Claim construction is a question of law reserved to the judge. *See* Markman v. Westview Instruments, Inc., 517 U.S. 370, 388 (1996) ("The 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."). Accordingly, claim construction determinations are reviewed *de novo*. *See* Cybor Corp. v. FAS Tech., Inc. 138 F.3d 1448, 1456 (Fed.Cir.1998). In construing patent claims, a court should look to the patent itself, its claims and specifications, and the record of proceedings before the Patent and Trademark Office. *See* Vitrionics Corp. v. Conceptronic, Inc. 90 F.3d 1576, 1582 (Fed.Cir.1996).

In this case, the Court is guided by both the language of the '895 patent itself, its reexamination, and the Federal Circuit's construction of the '895 patent in the *Converse* litigation. The '895 patent claims an "athletic shoe comprising a sole having a midsole ... comprising a forefoot portion and a heel portion means, said heel portion being pyramid shaped in lateral cross section." *See* U.S. Patent No. 4,322,895, Claim 1 (Plaintiff's Ex. 2). The '895 patent additionally provides for "[a]n athletic shoe as in claim 2 in which the support band is integral with the midsole." *See* id., claim 3. During reexamination, the patent's specifications were amended to provide for a "preferred embodiment," set forth in the certificate as Figure 6, in which the "the lateral sides of the pyramid are not shown in the cross section ... because in the preferred embodiment they merge with the support band." *See* Reexamination Certificate Issued August 8, 1995 (Plaintiff's Ex.. 2).

The Federal Circuit addressed this "preferred embodiment" in *Converse,* acknowledging that the support band can be "integral" as in Figure 6, or "can be a separate piece secured as by fusion to the sole during manufacture." *See* Converse, 183 F.3d at 1371. Propet correctly notes, however, that the Court in *Converse* repeatedly emphasized the pyramid shape of the midsole, and ultimately found that the'895 patent did not cover the alleged infringing Converse figure, in part, because it lacked this critical pyramid shape. Id. at 1375.

In this case, however, Plaintiff alleges that Defendant's shoe falls within the "preferred embodiment" of an

integrated midsole and support band, and is more appropriately compared to Figure 6 of the Reexamination Certificate than the figure at issue in *Converse* . Plaintiff does not dispute that the pyramid shape is required, only that it need not be visible if the two pieces are, in fact, merged.

Having considered the '895 patent, the Reexamination Certificate, the Federal Circuit's prior construction of the patent, as well as the parties' briefs, the Court finds that the '895 patent is not limited to a two-piece construction. Such a construction would be irreconcilable with both the preferred embodiment and claim 3 of the patent. *See* Vitrionics, 90 F.3d at 1583 (noting that an interpretation finding a preferred embodiment outside the scope of the patent is "rarely, if ever, correct"). Thus, the support band and the midsole may be unitary or in two separate parts. While the patent clearly requires a pyramid-shaped midsole, this shape need not be visible, if the pieces are merged.

CONCLUSION

Accordingly, this Court finds that the '895 patent is subject to two permissible constructions.

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