United States District Court,
D. Oregon.

Ian WHATLEY,
Plaintiff.
v.
NIKE, INC,
Defendant.

No. Civ. 98-963-AS

June 25, 2002.

David W. Axelrod, Michael A. Cohen, Schwabe, Williamson & Wyatt, Portland, Oregon, Alan Federbush, Lyon & Lyon, White Plains, New York, for plaintiff.

Daniel R. Barnhart, Bullard Smith Jernstedt Harnish, Portland, Oregon, Mark T. Banner, Christopher J. Renk, Matthew P. Becker, Banner & Witcoff, Chicago, Illinois, for defendant.

OPINION AND ORDER

REDDEN**, J.**

On April 9, 2002, Magistrate Judge Ashmanskas filed Findings and Recommendation after holding a hearing pursuant to Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370 (1996) on the construction of the term "cushioning" in plaintiff's claims. Judge Ashmanskas recommended that the plaintiff's definition of the term "cushioning" be sustained, the alternative definition urged by the defendant be rejected, and the term be construed to mean "to reduce vertical impact forces."

Defendant filed a timely objection to Judge Ashmanskas's Findings and Recommendation, to which plaintiff responded. Defendant then requested, and was granted, an opportunity to file a reply memorandum. Plaintiff filed a surreply.

The matter is now before me pursuant to 28 U.S.C. s. 636(b)(1) and Rule 72(b) of the Federal Rules of Civil Procedure. Section (b)(1)(A) authorizes a magistrate to hear and determine any pretrial matter pending before the court except certain specified "dispositive" motions. *United States v. Raddatz,* 447 U.S. 670, 673 (1980). Review by the district court of the magistrate's determination of dispositive motions excepted under s. 636(b)(1)(A) is *de novo*. Fed.R.Civ.P. 72(b); Bhan v. NME Hospitals, Inc., 929 F.2d 1404, 1414 (9th Cir.1991).

In his Findings and Recommendation, Judge Ashmanskas found that "cushioning" had an ordinary and customary meaning, as defined by the dictionary. He concluded that plaintiff's proffered claim construction

was consistent with that dictionary meaning.

Defendant contends that there is no ordinary and customary meaning of "cushioning" to one of ordinary skill in the art, and that Judge Ashmanskas should have resorted to the specification and to prior art in construing the claims. Nike urges that "cushioning" be construed to mean "to reduce vertical impact forces by a meaningful amount, i.e., absorb shock in an amount sufficient to prevent or reduce chronic or acute injuries to the lower limbs of the wearer."

I agree with Judge Ashmanskas that there is "no meaningful distinction" between a layman's understanding of the term and that term as it is used in the footwear industry. I further agree that the claim language is consistent with that understanding. I am not persuaded by defendant's contentions that 1) Judge Ashmanskas should have looked for guidance to the specification or the prior art and 2) that the specification and the prior art support defendant's proffered construction.

Accordingly, I ADOPT Magistrate Judge Ashmanskas's Findings and Recommendation filed April 9, 2002 (doc. # 292). The term "cushioning" is construed to mean "to reduce vertical impact forces."

IT IS SO ORDERED.

FINDINGS AND RECOMMENDATION

ASHMANSKAS**, Magistrate J.**

Before the court is the issue of claim construction of the language of United States Patent No. 5,060,401 (the " '401" patent) and United States Patent No. 5,279,051 (the " '051" patent). The '401 and '051 patents disclose a footwear "external cushioning spring."

The court conducted a *Markman* hearing on the issue of claim construction on April 4, 2002. After consideration of the filings and the materials and testimony presented, I recommend the following claim construction.

DISCUSSION

I. Legal Standards

The analysis of an action for patent infringement involves two steps: (1) the proper construction of the asserted claim; and (2) a determination of whether the accused method or product infringes the claims as properly construed. *See* Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed.Cir.1995) (en banc), *aff'd* 517 U.S. 370 (1996). "Construction of a patent, including the terms of art within its claims, is exclusively within the province of the court." *Markman,* 52 F.3d at 372. Whether the claims, properly construed, infringe a product or process is generally a question of fact for the jury. *Id*. at 390.

"In interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). The court should first examine the words of the claims themselves in order to define the scope of the patented invention. *See* Dow Chemical Co. v. Sumimoto Chemical, 257 F.3d 1364, 1372 (Fed.Cir.2001); Vitronics, 90 F.3d at 1576. The claim language

specifies " 'the subject matter which the applicant regards as his invention." ' Markman, 517 U.S. at 373 (quoting 35 U.S.C. s. 112). Claim language is given its "ordinary and accustomed meaning as understood as understood by one of ordinary skill in the art." Dow Chemical, 257 F.3d at 1372. Courts cannot rewrite claims, but must "give effect to the terms chosen by the patentee." K-2 v. Corporation v. Solomon S.A., 191 F.3d 1356, 1364 (Fed.Cir.1999).

The "ordinary and accustomed meaning" of a claim is presumed correct and any party seeking to convince a court that a term has some other meaning bears the burden of demonstrating why such an alteration is required. K-2 Corporation, 191 F.3d at 1362. This may be accomplished in two ways: (1) if a different meaning is "clearly and deliberately set forth" in the intrinsic materials of the patent; or (2) if use of the ordinary and accustomed meaning would "deprive the claim of clarity." *Id*. In making this assessment, the court should approach the issue using common sense and "the understanding of those of ordinary skill in the art" of the patent at issue. *Id*. at 1365.

After an examination of the claims themselves, the court should review the patent specification "to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." Vitronics, 90 F.3d at 1582. The specification should describe the invention " 'in such full, clear, concise, and exact terms as to enable any person skilled in the art ... to make and use the same." ' Markman, 517 U.S. at 373 (quoting 35 U.S.C. s. 112). "[T]he specification is always highly relevant to the claim construction analysis. Usually it is dispositive; it is the single best guide to the meaning of a disputed term." Vitronics, 90 F.3d at 1582. However, "[t]hat claims are interpreted in light of the specification does not mean that everything expressed in the specification must be read into all the claims." SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121 (Fed.Cir.1985) (internal quotations omitted). *See also* Markman, 52 F.3d at 980 ("the written description does not delimit the right to exclude. That is the function and purpose of the claims."); Enercon GmbH v. Int'l Trade Comm., 151 F.3d 1376, 1384 (Fed.Cir.1998) ("This court has repeatedly stated that while claims are to be construed in light of the specification.... Generally, particular limitations or embodiments appearing in the specification will not be read into the claims.") (citations omitted), *cert. denied,* 526 U.S. 1130 (1999). Specifications may aid in claim interpretation but may not be used to add limitations. E.I. DuPont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433 (Fed.Cir.), *cert. denied,* 488 U.S. 986 (1988); *See also* Dow Chemical Co. v. Astro-Valcour, Inc., 47 F.Supp.2d 294 (N.D. New York 1999) (stated advantage in specification should not be read as a requirement of a claim), *case affirmed on other grounds,* 267 F.3d 1334 (Fed.Cir.2001).

Finally, the third type of intrinsic evidence that the court may consider is the prosecution history of the patent. The prosecution history includes the complete records of the proceedings before the Patent and Trademark Office ("PTO"), including any re-examination proceedings, and any representations made by the applicant about the scope of the claims. *See* Vitronics, 90 F.3d at 1582-83.

If analysis of the intrinsic evidence alone resolves any ambiguity in a disputed claim term, "it is improper to rely on extrinsic evidence other than that used to ascertain the ordinary meaning of the claim limitation." Dow Chemical, 257 F.3d at 1373, *citing* Vitronics, 90 F.3d at 1582 (citations omitted). FN1 As clarified by the Federal Circuit, this holding from *Vitronics* does not mean that a court may not consider extrinsic evidence in construing a patent claim; "[r]ather, *Vitronics* merely warned courts not to *rely* on extrinsic evidence in claim construction to contradict the meaning of claims discernable from ... the intrinsic evidence." Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1307 (Fed.Cir.1999) (emphasis in original).

FN1. This limitation is required so that competitors may rely on the public records to determine the scope of the patentee's claimed invention. Vitronics, 90 F.3d at 1582-83.

"Extrinsic evidence is that evidence which is external to the patent and file history, such as testimony, inventory testimony, dictionaries, and technical treatises and articles." Id. at 1584. FN2 While dictionaries are also considered "extrinsic," they "hold a 'special place' and may sometimes be considered along with the intrinsic evidence when determining the ordinary meaning of claim terms." Dow Chemical Co., 257 F.3d at 1372.

FN2. In construing the claims, the court may also consider the doctrine of claim differentiation. That doctrine allows that "[w]here some claims are broad and others narrow, the narrow claims limitations cannot be read into the broad whether to avoid invalidity or to escape infringement." United States v. Telectronics. Inc., 857 F.2d 778, 783 (Fed.Cir.1988), *cert. denied,* 490 U.S. 1046 (1989).

II. Claim Construction

The sole issue presented with the parties' request for a partial Markman determination is the meaning of the term "cushioning" as it appears in the plaintiff's patent claims. The '401 patent includes 22 claims which describe an article of footwear which includes an "angled strip of resilient elastic material" that acts as an "external cushioning spring" fixed on the midsole "such that a vertical force on said footwear created by a wearer of said footwear striking said outsole on a solid surface causes said angled strip to bend between said ends and absorb a portion of said force." The term "external cushioning spring" appears in claims 1, 2, 15 and 16 of the '401 patent and claims 1-4 and 45-48 of the '051 patent.

The ordinary and accustomed meaning of the term "cushioning" as defined by the dictionary, and as pertinent here, is "to protect against or absorb shock." Websters II, New Riverside University Dictionary (1984), p. 340.

The '041 patent abstract explains that the invention is useful because it acts to "absorb a portion of the force" created by the wearer when he walks, runs or engages in other sporting activities. In the "summary of the invention," the patentee explains that the proposed angled elastic strip placed on the mid sole of the shoe is "fixed in a manner" such that the angled strip bends and absorbs a portion of the force. The specification also explains two particular advantages of the design and placement of the angled strip: the first being a "stabilizing effect" to minimize pronation; the second is expressed as follows:

The spring is particularly advantageous when used on athletic footwear for persons running at high speeds, e.g. during races, and for persons who constantly jump up and down, e.g. in basketball. Because of the shock-absorbing effect of the springs the vertical impact forces associated with such sports are reduced, and thus chronic and acute injuries to the lower limbs [are] prevented or reduced.

The defendant argues that the term "cushioning" as used in the plaintiff's patents necessarily includes a reduction in vertical impact forces to prevent or eliminate injuries to the lower limbs of the wearer. Defendant relies upon the above quoted language in the patent specification and the use of the term "cushioning" in prior art. Plaintiff contends that "cushioning" simply means the absorption of a portion of the vertical force of the shoes' wearer.

At the *Markman* hearing, defendant offered expert testimony from Dr. Joseph Hamill, a professor of biomechanics from the University of Massachusetts. Dr. Hamill is an expert in footwear biomechanics and, according to his testimony, the term "cushioning" as used in the footwear design industry generally means the absorption, reduction or "attenuation" of shock from vertical forces. FN3 Thus, in this case, there is no meaningful distinction between a layman's understanding of the term "cushioning" and that term as it is used in the footwear design industry. Therefore, the ordinary and accustomed meaning of the term "cushioning" is the absorption of vertical force. This is the definition urged by the plaintiff; because the defendant urges a different interpretation given other language in the file specification, defendant bears the burden of proving that its alteration is required. *See* K-2 Corp., 191 F.3d at 1362.

FN3. Dr. Hamill's industry definition appears on page 19 of his power point presentation. While Dr. Hamill ultimately agrees with Nike's definition of the term "cushioning," he did so only in reference to plaintiff's patent.

The plaintiff's proffered construction is consistent with the actual claim language and the ordinary and accustomed meaning of the term "cushioning." The claims themselves repeatedly reference the absorption of force. The language of the specification relied upon by the defendant, when viewed in its full context, states a claimed advantage. As the court in *Dow Chemical Co. v. Astro-Valcour, Inc.* held, a stated advantage in a claim specification may not be relied upon to "limit the scope of the invention itself by adding a requirement not found there." 47 F.Supp.2d at 298. Specifications may be used to assist in interpreting a claim, but may not be used to alter a claim. E.I. DuPont, 849 F.2d at 1433. Defendant's counter definition would violate this principal of claim construction. Further, defendant's own expert was unable to quantify the amount of force absorption necessary to prevent injuries given the large number of variables involved in activity related injuries. Thus, the plaintiff's failure to specify a claimed absorption rate does not create an ambiguity in the claim terms.FN4

FN4. During oral argument, defendant argued that the amount of force absorption performed by several of the accused devices found on Nike shoes is so infinitesimal as to have no significance. The court notes that whether the accused devices have any viable function, so as to be patentable at all, goes to a separate question regarding patent viability and/or infringement defenses-issues not presently before the court.

Finally, the defendant claims that the court must accept its claim construction because to do otherwise would render the term "spring" superfluous. Defendant argues that because plaintiff has defined the term "spring" as a device that absorbs a portion of force, the term "cushioning" must mean something else.

Defendant's argument construes the plaintiff's deposition testimony and his claim construction far too narrowly. Plaintiff's definitions of the terms "cushioning" and "spring" are not identical: plaintiff defines a "spring" as a device that absorbs some degree of force and then returns that force; plaintiff defines "cushioning" as absorbing and reducing vertical impact force. As defined by the plaintiff, "cushioning" does not repel force and a "spring" would not necessarily reduce vertical impacts.

CONCLUSION

Based upon the foregoing, I recommend that the plaintiff's definition of the term "cushioning" be sustained

and the alternative definition urged by the defense be rejected. As such, the term "cushioning" should be construed to mean: "to reduce vertical impact forces."

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