

United States District Court,  
W.D. Washington, at Seattle.

**HOCKERSON-HALBERSTADT, INC,**  
Plaintiff.

v.

**COSTCO WHOLESALE CORPORATION,**  
Defendant.

No. C03-1188L

**Nov. 30, 2004.**

Don L. Nauman, Santa Rosa, CA, James E. Uschold, New Orleans, LA, Malcolm Stephen Harris, Harris Mericle & Wakayama, Seattle, WA, for Plaintiff.

David Allen Lowe, Lawrence D. Graham, Douglas Anderson Grady, Black Lowe & Graham, Seattle, WA, for Defendant.

### **ORDER CONSTRUING CLAIM OF THE '895 PATENT**

**ROBERT S. LASNIK, District Judge.**

Plaintiff Hockerson-Halberstadt, Inc. ("HHI") is the owner of United States Patent No. 4,322,895 ("the '895 patent"), which relates to a stabilized athletic shoe. The parties dispute some of the terms of claim one; none of the terms in dependent claims 2 and 3 is disputed. HHI alleges that Costco infringed on the '895 patent by making, using, selling, offering for sale and/or importing men's and women's Court Classic shoe models, which embody the patented invention.

Determining whether a particular product or method infringes an existing patent involves a two-step analysis. The Court must first identify the proper construction of the asserted patent claim, an exercise which the Supreme Court has determined is a matter of law, *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577. 384-91 (1996). After the claim has been properly construed, the fact finder determines whether the accused device infringes the claim. Although there are numerous sources to which the Court may look for guidance when construing patent claims, the Federal Circuit has imposed restrictions on both the sequence in which the sources can be considered and their availability in certain circumstances.

It is well-settled that, 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. Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language.

First, we look to the words of the claims themselves, both asserted and nonasserted, to define the scope of the patented invention. Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his or her own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.

Thus, second, it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning. The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication. As we have repeatedly stated, "[c]laims must be read in view of the specification, of which they are apart." The specification contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make and use it. Thus, the 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.

Third, the court may also consider the prosecution history of the patent, if in evidence. This history contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims. As such, the record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims. Included within an analysis of the file history may be an examination of the prior art cited therein.

In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it is improper to rely on extrinsic evidence. In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper. The claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely. In other words, competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention. Allowing the public record to be altered or changed by extrinsic evidence introduced at trial, such as expert testimony, would make this right meaningless. The same holds true whether it is the patentee or the alleged infringer who seeks to alter the scope of the claims.

*Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582-83 (Fed.Cir.1996) (citations omitted). There is a "heavy presumption" that claim language will be given its ordinary meaning as understood by one of ordinary skill in the art. *Bell Atlantic Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1268 (Fed.Cir.2001) (quoting *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed.Cir.1999)). One propounding a construction that is not the ordinary meaning of a claim term must show that the intrinsic evidence "clearly redefines" the term such that one reasonably skilled in the art would be on notice that the patentee intended to forego the ordinary meaning in favor of his or her own definition. *Elekta Instr. v. O.U.R. Scientific Int'l*, 214 F.3d 1302, 1307 (Fed.Cir.2000) After considering the ordinary meaning and description in the specifications, it is appropriate to consider the prosecution history of the patent to determine "whether the patentee intended to deviate from a term's ordinary and customary meaning or that the patentee disclaimed or disavowed subject matter, narrowing the scope of the claim terms." *Nystrom v. TREX Company, Inc.*, 374 F.3d 1105, 1112-13 (Fed.Cir.2004) (internal quotation and citations omitted); *see also Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951, 956 (Fed.Cir.2000) ("Statements made during prosecution commit the inventor to a particular meaning of a claim that is binding during litigation").

In this litigation, the parties have identified six terms in claim 1 of the ' 895 patent which require construction. Claim 1 reads as follows; disputed terms appear in bold:

1. An Athletic Shoe comprising a sole having a midsole formed of a resilient force-absorbing material, an outsole mounted below the midsole, said outsole being formed of a **durable material** for contact with a surface,

an upper mounted on the sole, the upper having a counter forming a heel cup having **exterior sidewalls with lower** edges,

a support band carried on the upper rim of the midsole and secured about the sidewalls of the heel cup, said band extending upwardly and merging with the **vertical midspan** of the heel cup for supporting and stabilizing the heel cup relative to the sole during contact of the sole onto the surface when in use,

said midsole comprising a forefoot position and heel portion means, said heel portion means being pyramid shaped in lateral cross section with a **lower rim** having opposite sides which flare outwardly to locations which lie **sufficiently laterally beyond** the lower edges of the heel cup for substantially stabilizing the shoe during initial contact on the surface along one side of the sole,

the opposite sides of the **lower rim** of the heel portion means having a lateral width greater than the lateral width of the **heel cup midspan**, and

the midsole and support band having **wall means which inclines upwardly from the lower rim of the heel portion means to the heel cup midspan** for resisting flexing of the sidewalls of the heel cup relative to the sole during said initial contact on the surface along one side of the sole.

Having reviewed the memoranda, declarations, and exhibits FN1 submitted by the parties (including the Amended Joint Claim Chart submitted on October 5, 2004), and having heard the arguments of counsel and the additional evidence offered at the hearing on November 18, 2004, the Court finds:

(1) The term "durable material" is not clearly defined in the claim or in the specification and is therefore given its ordinary meaning, namely a material which has the characteristic of being durable. Neither the specification nor the ordinary meaning of "durable material" requires that the outsole and midsole be formed from different material, or that the outsole material be *more* durable than the midsole material, as suggested by Costco.

(2) Regarding construction of the term "exterior sidewalls with lower edges," the dispute is over the location of the lower edges. The claim language and specifications do not address the location of the lower edges. The parties have not offered a definition of "lower edges" used in the industry. The Court finds that one skilled in the art at the time of the invention would have understood that the "lower edges" arc located at the point, in lateral cross-section, where the sidewall meets the top surface of the pyramid shaped midsole.

(3) The term "vertical midspan" is not defined in the claim. The specifications state, "The support band extends upwardly to merge along the line 40 with the vertical midspan of the heel cup and also extends upwardly to merge along the line 42 with the sides of the upper which arc above the rear portion of the

forefoot." The parties both note that the term is not ordinarily used in the industry. Costco argues that "mid" means "in the middle or center" and "span" means "the extent or measure of space between two points." Costco contends that the vertical midspan of the heel cup must be located at the center of the span between the top and bottom of the heel cup. The Court finds that the claim language and specifications do not contain the limitation advanced by Costco.

HHI argues that the vertical midspan is the "place where a support band is secured about the sidewalls of a heel cup which is formed from a counter;" the support band can be secured anywhere on the heel cup. Based on the claim language and the purpose of the invention, the Court construes the term "vertical midspan" to mean the place where the support band is secured about the sidewalls of the heel cup, provided that it is secured to a spot where it will support and stabilize the heel cup relative to the sole during contact of the sole onto the surface when in use.

(4) The "lower rim" is not defined in the claim. The parties agree that "lower rim" is not a term typically used in the shoe business. HHI's proposed construction is the "lower edge or border of the heel portion of the pyramid shaped midsole." Costco's proposed construction is the "lowest edge of the sole of the shoe, taken at a location that actually touches the ground." The specifications do not define the location of the lower rim. During reexamination, HHI distinguished its patent from the Fukuoka '358 shoe by stressing that the Fukuoka '358 shoe did not have an outwardly flared rim to provide stabilization *during heel contact with the surface*.

Accordingly, the Court construes the term "lower rim" as the lowest edge or border of the heel portion of the pyramid shaped midsole at a point where the shoe actually touches the ground during heel contact with the surface. This construction is consistent with the language of the claim, the prosecution history, and the purpose of the invention.

(5) The term "sufficiently laterally beyond" is not defined in the claim or in the specification. Neither party has offered a definition used in the industry. HHI argues that the term means that the "distance between the opposite sides of the lower rim of the pyramid shaped midsole in lateral cross-section must be wider than the distance between the lower edges of the sidewalls of the heel of the cup in the same lateral cross-section." Costco argues that "the ratio of the width of the lower rim to the width of the lower edge of the heel cup must be at least greater than 1.25." Neither the claim nor the specifications contains the limitation proposed by Costco.

In 1993, HHI added to the claim language requiring that the width of the lower rim be 1.25 times wider than the width of the lower edges of the heel cup sidewalls, and argued that the ratio was an "important and critical" distinction over a competitor's product. Later during the reexamination, HHI removed the 1.25 ratio requirement and replaced it with the "he sufficiently laterally beyond" language issued in the reexamination certificate. Based on this prosecution history, the specifications and the plain language of the claim, the Court finds that the ratio is not limited to 1.25 or greater. Rather, the opposite sides of the lower rim in lateral cross-section must extend sufficiently laterally beyond the lower edges of the sidewalls of the heel of the cup in the same lateral cross-section for substantially stabilizing the shoe during initial contact on the surface along one side of the sole.

(6) The claim requires "the midsole and support band having **wall means which inclines upwardly from the lower rim of the heel portion means to the heel cup midspan** for resisting flexing of the sidewalls of the heel cup relative to the sole during said initial contact on the surface along one side of the sole." The

Court has construed the terms "lower rim" and "vertical midspan" in this Order, *supra*. The specifications state that the midsole and support band "form a structure having substantially straight walls inclining between the vertical midspan of the heel cup and lower rim of the sole."

HHI contends that this term means, "A structure for resisting flexing of the sidewalls of the heel cup relative to the sole during said initial contact on the surface along one side of the shoe." HHI's construction ignores the words "inclines upwardly" and does not address where the wall means incline to or from. A claim should be construed so as not to render any of the words superfluous. Costco argues that the term means, "The physical outer face of the midsole must incline upwardly along the entire length from the lower rim to the heel cup midspan." It appears that Costco's proposed construction is unlikely to further the purpose of the wall means of resisting flexing.

The Court finds that based on the claim language, the specifications, and the purpose of the invention, this term means that the midsole and support band form a structure which must incline upwardly from the lower rim to the heel cup midspan for resisting flexing of the sidewalls of the heel cup relative to the sole during said initial contact on the surface along one side of the sole.

It is so ORDERED.

FN1. The Court has considered the expert testimony produced by the parties only as it relates to what one of ordinary skill in the art would have understood at the time the patent issued.

W.D.Wash.,2004.

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