

## Kratz, Quintos &amp; Hanson, LLP – IP Newsletter

**“WHERE THE SPECIFICATION MAKES CLEAR THAT THE INVENTION DOES NOT INCLUDE A PARTICULAR FEATURE, THAT FEATURE IS DEEMED TO BE OUTSIDE THE REACH OF THE CLAIMS OF THE PATENT.”**

*Wishing you a safe and healthy season.*

**By: Mel R. Quintos**

**Introduction** In the case of *Akeva L.L.C. v. Nike, Inc., Adidas America, Inc.*, decided on July 16, 2020, the U.S. Court of Appeals for the Federal Circuit (CAFC) looked into the specification (including the Summary of the Invention, Field of the Invention, and Background of the Invention sections) and Abstract of the patent in suit (U.S. Patent No. 5,560,126 or ‘126 patent) to determine whether the claim term “*rear sole secured*” may be interpreted to mean “*permanently-fixed into position.*” If so, a large group of shoe manufacturers, including Asics, Nike, Inc., Adidas America Inc., New Balance Athletic Shoe Inc. and Puma North America Inc., would infringe Akeva L.L.C.’s ‘126 patent claims.

**Background** In addition to owning the ‘126 patent, Akeva L.L.C. (Akeva) owns a portfolio of additional footwear patents, including U.S. Patent Nos. 5,560,126; 6,966,130; 7,114,269; 5,380,350; and 7,540,099. The later mentioned patents all claim priority to the ‘126 patent and are referred to as the “Continuation Patents.” Akeva sued Asics, Nike, Adidas, New Balance, and Puma in the U.S. District Court for the Middle District of North Carolina alleging infringement of certain claims of the ‘126 patent. The district court granted all the defendants’ Summary Judgment of: (1) no infringement as to the ‘126 patent, and (2) invalidity as to the asserted claims of Akeva’s Continuation Patents.

Claim 25 of the ‘126 patent recites as follows:

A shoe comprising:

an upper having a heel region;

a *rear sole secured* below the heel region of the upper; and

a flexible plate having an upper and lower surfaces and supported between at least a portion of the rear sole and at least a portion of the heel region of the upper, peripheral edges of the plate being restrained from movement relative to an interior portion of the plate in a direction substantially perpendicular to a major axis of the shoe so that the interior portion of the plate is deflectable relative to the peripheral edges in a direction substantially perpendicular to the major axis of the sole.

Emphasis added.

**CAFC Analysis: Claim Construction** The issue in this case is whether the term “rear sole secured” encompasses conventional *fixed* rear soles. The Field of Invention section of the specification of the ‘126 patent describes “[t]he present invention” as “relat[ing] generally to an improved rear sole for footwear and more particularly, to a rear sole for an athletic shoe with an extended and more versatile life and better performance in terms of cushioning and spring.” More importantly, the Background of the Invention section of the specification then goes on to explain that, with conventional athletic shoes: “the sole is *attached* to the upper as a one-piece structure, with the rear sole being *integral* with the forward sole.” Emphasis added.

The Summary of the Invention section of the specification goes on to further explain that the invention is a shoe that:

includes an upper, a forward sole attached to the upper, a heel support attached to the upper, and a *rear sole detachably secured or rotatably mounted to the heel support*. [Emphasis added.]

In its detailed description of the invention, set forth in the Description of the Preferred Embodiments section of the specification, numerous embodiments, illustrated in similarly numerous figures, *all* require a *detachable* or *rotatable rear sole* that is received within a recess of a heel support. Further stated in this description is a statement that states: “[t]he general features of the first embodiment [according to the patent] will apply to *all embodiments* unless otherwise noted.” The remaining portion of the description focused on the different ways of *detachably* or *rotatably* securing the rear sole within the recess of the heel support (e.g., press-fitting, protrusions and slots, tongue and groove, use of locking ring, etc.). The Abstract likewise recites “a heel support for receiving a *rotatable and replaceable* rear sole to provide longer wear.” Thus, there is overwhelming evidence in the written specification of the ‘126 patent to interpret or construe the claim term, “rear sole secured,” to *only* mean: “rear sole selectively or permanently fastened, *but not permanently fixed into position.*”

**CAFC Analysis: Invalidity** On another matter regarding the Continuation Patents of Akeva mentioned above, these patents claim priority to the earlier filed ‘126 patent. Akeva acknowledges that the accused Nike shoe becomes prior art and therefore, the Continuation Patents are invalid if they are not entitled to the earlier filing date of the ‘126 patent. According to the CAFC:

[t]o claim priority to a patent earlier in the priority chain, our case law emphasizes that there must be a continuity of disclosure. [Citations omitted.] \* \* \* Thus, in this case, to be entitled to claim priority to the ‘126 patent, *there must be adequate written description support for the Continuation Patent claims through the chain of applications leading back to the ‘126 patent.*

In the earlier filed patent, Akeva “specifically excluded an athletic shoe with the conventional fixed rear sole and midsole insert from the patent’s scope;” and therefore because the ‘126 patent disclaims and does not disclose shoes with a conventional fixed rear sole, Akeva’s Continuation Patents cannot now claim priority to the earlier filed ‘126 patent. Thus, the alleged infringing Nike shoe with a conventional fixed rear sole becomes prior art and invalidates Akeva’s Continuation Patent claims.

**CAFC Decisions** *First*, the defendants’ alleged infringing shoes have conventional *fixed* rear soles, and therefore do not infringe Akeva’s ‘126 claimed rear sole that is “*not permanently fixed into position.*” *Second*, Akeva’s Continuation Patent claims cannot claim priority to the earlier filed ‘126 patent; and thus, the conventional fixed rear soles in Nike’s shoes become prior art and invalidate Akeva’s Continuation Patent claims.

**Summary and Key Points** It is important to remember that when highlighting the advantages or benefits of an invention, *in any part of a U.S. patent application*, be careful not to disclaim any structural arrangements or features of the invention. In this case, Akeva appears to have been overzealous in highlighting the advantages or benefits of its *detachable* rear sole without having realized that it has disclaimed the teachings of a *fixed* rear sole.

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