

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
EL PASO DIVISION**

SPIRA FOOTWEAR, INC.,	§	
	§	
Plaintiff,	§	
	§	
v.	§	EP-07-CA-00103-KC
	§	
ALEXANDER ELNEKAVEH d/b/a	§	
INNOVATION WIZARD, AROA	§	
MARKETING, GADGET	§	
UNIVERSE, STRONG IDEA, and	§	
ESRIM VE SHEVA HOLDING	§	
CORP.,	§	
	§	
Defendant.	§	

ORDER

On this day, the Court considered “Plaintiff’s Motion to Strike” (“Motion to Strike”) and “Plaintiff’s Motion for Preliminary Injunction and Brief in Support Thereof” (“Motion for Preliminary Injunction”). For the reasons set forth herein, Plaintiff’s Motion to Strike is **DENIED** and Plaintiff’s Motion for Preliminary Injunction is **DENIED**.

I. BACKGROUND

This case involves a claim by Plaintiff Spira Footwear, Inc. (“Plaintiff”) against Defendant Alexander Elnekaveh d/b/a Innovation Wizard, Aroa Marketing, Gadget Universe, Strong Idea, Inc., and Esrin Ve Sheva Holding Corp. (“Defendant”) for patent infringement.

On March 15, 2005, the United States Patent and Trademark Office (“PTO”) issued Plaintiff the United States Letters Patent No. 6,865,824 (“’824 Patent”), titled “Fluid Flow System for Spring-Cushioned Shoes.” Pl.’s Mot. for Prelim. Inj. 1, Ex. B. The patent abstract for the ‘824 patent reads as follows:

A fluid flow system for a spring-cushioned shoe is disclosed. The sole of the shoe includes a vacuity, a spring disposed within the vacuity, and a fluid passageway in fluid communication with the vacuity. The fluid flow passageway allows fluid, such as air, to escape the vacuity when the volume of the vacuity is reduced during a foot strike.

Id.

The '824 patent contains three claims. *Id.* The first claim states:

A shoe comprising:

a shoe sole defining a vacuity;

a spring disposed within the vacuity;

a fluid passageway in fluid communication with the vacuity, the passageway configured to allow eructative evacuation of fluid from the vacuity upon a reduction in the volume of the vacuity; and

a second vacuity in said shoe sole in fluid communication with the passageway, wherein the first vacuity, the second vacuity and the passageway are hermetically sealed from the exterior of the shoe.

Id.

The patent states that the vacuities are hermetically sealed from the outside environment to prevent air exchange between the vacuities and the exterior of the shoe, and to limit the amount of moisture and particles that enter the vacuity. *Id.* The patent states that, “[s]ealing is accomplished, e.g., by adhesively attaching inner sole to second surface.” *Id.* The patent also states “while trapped air in a shoe sole is thought to be desirable because the air provides cushioning and return force, in spring-cushioned shoes, the air interferences with the predictable operation of the spring.” *Id.* It further states that:

[I]f there is no passageway allowing the eructative escape of air from a compressed vacuity to the surrounding environment, the spring in the vacuity and the air in the vacuity cooperate to produce an effective spring force, which is greater than that of the spring acting alone. The spring effect of the air is less predictable and less controllable than the return force provided by the spring itself,

and therefore can diminish performance of the shoe.

Id.

The second claim states: “The shoe of claim 1, wherein the hermetically sealed vacuities and passageway contain ambient air at atmospheric pressure.” *Id.* Finally, the third claim states: “The shoe of claim 1, wherein the hermetically sealed vacuities and passageway contain a gas at less than atmospheric pressure.” *Id.*

Defendant manufactures and sells a shoe marketed under the name “Gravity Defyer” (the “Gravity Defyer”). Pl.’s Mot. for Prelim. Inj. 2. Plaintiff claims that the Gravity Defyer contains a vacuity in the heel portion of the shoe, within which is a set of springs. *Id.* Underneath the toe portion of the Gravity Defyer is a second vacuity. *Id.* Between the first and second vacuities is a fluid flow passageway, which facilitates the movement of air from the first to the second vacuity. *Id.* The inner sole of the Gravity Defyer is adhesively attached to the remaining structure. *Id.*

Andrew Krafzur (“Krafzur”), Plaintiff’s Chief Executive Officer, declares that both Plaintiff and Defendant advertise and sell their shoes in the Sky Mall catalog available on most airplanes. *Id.* In addition, Defendant has advertised its shoes in Popular Mechanics, a magazine which supports Plaintiff’s shoe technology. *Id.* Finally, at the Boston Marathon, numerous individuals expressed their belief to Krafzur that Defendant’s shoes were, in fact, using the wave spring technology of Plaintiff’s shoes. *Id.*

Defendant claims that in May 2003, Plaintiff filed the ‘824 patent application as part of a divisional application of its parent application, no. 09/982,520. Def.’s Surreply to Pl.’s Reply Brief 2. In January of 2005, Defendant claims that Plaintiff filed application no. 10/436,935, which was part of a divisional application of the ‘824 patent application. *Id.* In March 2005,

Plaintiff obtained the '824 patent. *Id.* Only then, in June 2005, did Plaintiff file an Information Disclosure Statement, including seven of eight patents which raise prior art problems. *Id.* 2-3 (citing Ex. 2).

Defendant retained the services of Ian L. Morrison ("Morrison") to assess Plaintiff's claims of patent infringement and to analyze the validity and enforceability of the '824 patent. Decl. of Ian Morrison in Support of Opp'n to Mot. for Prelim. Inj. ¶ 2 ("Morrison Decl."). Morrison is a professional mechanical and manufacturing engineer from California with over forty years of experience as a mechanical engineer in engineering design, testing, and analysis, including the design of compressed air and hermetically sealed systems. Decl. of Ian Morrison in Support of Opp'n to Mot. for Prelim. Inj. ¶ 1 ("Morrison Decl."). Morrison obtained a degree in Mechanical Engineering from Stow College of Engineering in Glasgow, Scotland, and prior to obtaining his degree he received technical training at the Rolls-Royce Aero-Engine Division in Glasgow Scotland. *Id.*

In his declaration, Morrison testifies that in order to examine the validity of the '824 patent and to assess Plaintiff's claims of patent infringement, he first examined the '824 patent using the ordinary dictionary definition of certain terms used in the patent. *Id.* ¶ 4. For example, he used dictionary.com, available at <http://dictionary.reference.com>, to define "eructative evacuation" as "to belch or emit violently." *Id.* With this definition, he construed the relevant portion of Claim 1, which reads:

a fluid passageway in fluid communication with the vacuity, the passageway configured to allow eructative evacuation of fluid from the vacuity upon a reduction in the volume of the vacuity. . . ;

to mean:

a fluid passageway in fluid communication with the vacuity, the passageway configured to allow fluid to belch from or to be emitted violently from the vacuity upon a reduction in the volume of the vacuity. . . .

Id.

He testified that this construction of the term is consistent with the '824 patent since the fluid in the sealed vacuity would build pressure that is later "emitted violently" to the narrower passageway by a reduction in volume of the vacuity. *Id.* Morrison then used the McGraw Hill Dictionary of Scientific and Technical Terms to define "hermetically sealed" as "air tight seal."

Id. With this definition, he construed the relevant portion of Claim 1, which reads:

a second vacuity in said shoe sole in fluid communication with the passageway, wherein the first vacuity, the second vacuity and the passageway are hermetically sealed from the exterior of the shoe.

to mean:

a second vacuity in said shoe sole in fluid communication with the passageway, wherein the first vacuity, the second vacuity and the passageway are sealed airtight from the exterior of the shoe.

Id.

He testified that this construction is consistent with the disclosure in the '824 patent, which states, in part, that "Vacuities 20 and 22 and passageway 24 of FSSA 6 are hermetically sealed from the outside environment at atmospheric pressure, to prevent air exchange between the vacuities and the exterior of the shoe, and to limit the amount of moisture and small particles that enter the vacuities." *Id.*

After construing the terms within the '824 patent, Morrison then physically examined the Gravity Defyer by cutting it open to analyze its constructions and operation. *Id.* ¶ 5. He testified that his examination of the Gravity Defyer reveals that the Gravity Defyer does not allow for

“eructative evacuation” of fluid and that there is no “hermetically sealed” vacuity or passageway as specified in the ‘824 patent. *Id.* Instead, the Gravity Defyer includes a leather insole with holes placed onto a layer of open cell foam over a layer of porous paper on top of a rubber sole. *Id.* It also includes a heel portion that is not air tight. *Id.* Morrison testified that air displaced from the heel cavity simply vents through two openings at the arch area of the sole that lead toward the front portion of the shoe, and that there is no air or fluid emitted violently from the heel. *Id.* Morrison testified that a similar structure exists at the front portion of the Gravity Defyer as well. *Id.* ¶ 6. In sum, Morrison testified that the Gravity Defyer is substantially different from, and operates differently from, the shoe described in the ‘824 patent because it does not require hermetically sealed vacuities and because it involves no violent emission of air or fluid. *Id.* ¶ 7.

In addition to comparing the Gravity Defyer with the ‘824 patent, Morrison compared various pieces of prior art, including United States Patent No. 1,069,001 (“‘001 patent”) issued on July 29, 1913, with the ‘824 patent. *Id.* ¶ 8. Morrison testified that each limitation of Claim 1 in the ‘824 patent is found in the ‘001 patent as summarized below:

CLAIM 1 OF ‘824 PATENT	‘001 PATENT
A shoe comprising:	Figure 1, which depicts a shoe.
a shoe sole defining a vacuity;	Figure 1, which depicts a shoe sole defining a vacuity.
a spring disposed within the vacuity;	Figure 1, which depicts a spring within the vacuity.

<p>a fluid passageway in fluid communication with the vacuity, the passageway configured to allow eructative evacuation of fluid from the vacuity upon a reduction in the volume of the vacuity; and</p>	<p>Figure 2, which depicts a fluid passageway (i.e. tube 7) in fluid communication with the vacuity, and tube 7 configured to allow eructative evacuation/belching of fluid from the cushioned heel upon a reduction in volume of the cushioned heel. See also '001 Patent, lines 84-85 (“As shown in Figs. 1 and 2, the sole and heel sections are connected by a tube 7. . . .”) and 101-06 (“The valve, however, may be of such a type as to enable air to be drawn into the sole and heel sections by collapsing the same under the pressure of the foot and then allowing said sections to expand to draw air therein. Other fluids or liquids may, however, be introduced through the tube to serve as the cushioning medium.”).</p>
<p>a second vacuity in said shoe sole in fluid communication with the passageway, wherein the first vacuity, the second vacuity and the passageway are hermetically sealed from the exterior of the shoe.</p>	<p>Figure 2, which depicts a second vacuity in fluid communication with the passageway/tube 7. The first vacuity, the second vacuity, and the passageway are hermetically sealed. See also '001 Patent, lines 12-15 (“. . . whereby air or other fluid or liquid may be confined therein to act as a cushioning medium.”).</p>

Id.; see also Morrison Decl., Ex. G.

Morrison also testified that two other limitations in the '001 patent were present in the '824 patent. *Id.* ¶ 9. First, he testified that the limitation in Claim 2 of the '824 patent of “ambient air at atmospheric pressure” is disclosed in the '001 patent at lines 90 through 93, which read: “. . . where said tube communicates with a check valve casing 9 suitably fastened to the counter and communicating with the outside atmosphere.” *Id.* Second, he testified that the limitation in Claim 3 of the '824 patent of “a gas at less than atmospheric pressure” is disclosed in the '001 patent at lines 102-105, which read: “The valve, however, may be of such a type as to enable air to be drawn into the sole and heel sections by collapsing the same under the pressure of the foot and then allowing said sections to expand to draw air therein.” *Id.*

Finally, Morrison testified that he had been advised that Plaintiff cited eight patents in an International Search Report in 2002 and an International Preliminary Examination Report in 2003, and that he had “studied these eight patents and evaluated their disclosures and conclude[d] that

these patents are relevant to the subject matter of the claims of the '824 patent." *Id.* ¶ 10.

II. DISCUSSION

A. Motion to Strike

Plaintiff asks this Court to strike the declaration of Defendant's expert, Morrison. *See generally* Pl.'s Mot. to Strike. Plaintiff first argues that Morrison's engineering license in California is delinquent. *Id.* at 1. Plaintiff next argues that Morrison does not specialize in shoes or patents, and thus cannot render an expert opinion as to whether Defendant is infringing Plaintiff's patent, whether Plaintiff's patent is valid, and whether certain patents are relevant to Plaintiff's patent. *Id.* at 2. Plaintiff also disputes Morrison's method of referring to an ordinary dictionary to define certain terms instead of the patent specification itself. *Id.* at 3. Finally, Plaintiff argues that this Court should strike Morrison's opinions because they are mere conjecture and speculation. *Id.*

Defendant responds first by setting forth the reasons as to why Morrison's engineering license appeared delinquent in certain records, but was not, in fact, delinquent. Def.'s Resp. in Opp'n to Pl.'s Mot. to Strike ¶ 4. Specifically, Defendant explains that Morrison mailed his renewal notice and payment in a timely manner on two occasions, but that the California Board for Professional Engineers and Land Surveyors did not process them for indeterminate reasons. *Id.* He has since, however, resolved the problem. *Id.* Defendant next responds by arguing that Morrison's testimony is relevant, reliable, and admissible because he is a mechanical engineer with over forty years of experience in mechanical engineering design, testing, and analysis, including the design of compressed air and hermetically sealed systems. *Id.* ¶ 5. Finally, Defendant argues that Plaintiff's concern regarding Morrison's ability to testify about Plaintiff's shoes is a red

herring, because the focus of the instant suit is Plaintiff's patent, and not Plaintiff's commercial products. *Id.* ¶ 8.

Courts often rely upon expert testimony in patent infringement cases. *See, e.g., Liquid Dynamics Corp. v. Vaughan Co.*, 449 F.3d 1209, 1221 (Fed. Cir. 2006); *Micro Chem., Inc., v. Lextron*, 317 F.3d 1387, 1392-93 (Fed. Cir. 2003); *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1355-56 (Fed. Cir. 2001); *Hybrid Patents, Inc. v. Charter Commc'ns, Inc.*, 2007 U.S. Dist. LEXIS 22384, at *14 (E.D. Tex. Mar. 28, 2007); *Sanitec Indus. v. Micro-Waste Corp.*, 2006 U.S. Dist. LEXIS 36460, at *5 (S.D. Tex. June 2, 2006); *Hakim v. Cannon Avent Group, PLC*, 2005 U.S. Dist. LEXIS 16829, at *3 (W.D. La. May 4, 2005). Whether expert testimony should be admitted at trial is a procedural issue governed by the law of the regional circuit within which the district court sits. *Micro Chem., Inc.*, 317 F.3d at 1390-91 (applying Fifth Circuit law to evidentiary challenge in patent infringement case).

Federal Rule of Evidence 702 provides that expert testimony is admissible if it is relevant and reliable. FED.R.EVID. 702; *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 141 (1999) (citing *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 593-97 (1993)). It is the district court's task to determine whether evidence is relevant and reliable. *Kumho*, 526 U.S. at 147. To aid the district court in determining whether evidence is relevant and reliable, the United States Supreme Court set forth certain factors that a trial judge may consider when ruling upon admissibility of expert testimony, including whether the theory or technique: (1) can or has been tested; (2) has been subjected to peer review or publication; (3) has a high known or potential rate of error and standards controlling its operations; and (4) enjoys general acceptance within the relevant scientific community. *Daubert*, 509 U.S. at 593-95. Nonetheless, these factors do not constitute

a definitive checklist or test. *Kumho*, 526 U.S. at 150. Rather, the Rule 702 inquiry is a flexible one and leaves the trial court with broad discretion in determining the admissibility of evidence. *Id.* at 152. In addition to the requirements of Rule 702, Federal Rule of Evidence 703 provides, in part, that “[t]he facts or data in the particular case upon which an expert bases an opinion or inference may be those perceived by or made known to the expert at or before the hearing.” FED.R.EVID. 703.

As an initial matter, this Court is satisfied that Morrison is currently licensed as an engineer. The Board of Professional Engineers and Land Surveyors sent Morrison a letter dated June 8, 2007, wherein they explain that they did not process his two earlier renewal payments for “indeterminate reasons,” but that they received his third check and backdated it to the original mailing date of the first payment. *Id.*, Ex. 1 at 4. Within that letter, they assure Morrison that his license is active. *Id.* Accordingly, to the extent Plaintiff objects to the affidavit of Morrison on the basis that he is not a certified engineer, the Court **OVERRULES** the objection.

With respect to the content of Morrison’s testimony, this Court finds that it satisfies the requirements of Rules 702, 703, and *Daubert*. First, Morrison is an engineer with over forty years of experience in engineering design, testing, and analysis, including the design of compressed air and hermetically sealed systems. Morrison Decl. ¶ 1. The Court finds that he is more than qualified to examine and testify about a shoe designed by engineers and involving compressed air and hermetically sealed systems. Moreover, in construing the patent claims of the ‘824 patent, Morrison’s “technique” consisted of referring to a dictionary to construe the relevant claims. *See Id.* ¶ 4. In construing patent claims, the Federal Circuit has stated that the specification is the best guide to the meaning of claim terms, but has nonetheless expressly

“authorized district courts to rely on extrinsic evidence, which ‘consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317, 1321 (Fed. Cir. 2005). Indeed, the Federal Circuit has stated that:

Within the class of extrinsic evidence, the court has observed that dictionaries and treatises can be useful in claim construction. We have especially noted the help that technical dictionaries may provide to a court ‘to better understand the underlying technology’ and the way in which one of skill in the art might use the claim terms. Because dictionaries, and especially technical dictionaries, endeavor to collect the accepted meanings of terms used in various fields of science and technology, those resources have been properly recognized as among the many tools that can assist the court in determining the meaning of particular terminology to those of skill in the art of the invention. Such evidence, we have held, may be considered if the court deems it helpful in determining ‘the true meaning of language used in the patent claims.’

Phillips, 415 F.3d at 1318 (internal citations omitted).

In addition to using a generally accepted technique in construing the claims, Morrison took pains to examine the relevant terms in the context of the written description, rather than in a vacuum. *See Phillips*, 415 F.3d at 1313 (quoting *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005)). In sum, Morrison is qualified to render an expert opinion in the instant matter, he rendered an opinion that is relevant and reliable to the issues at hand, and he used accepted methods in rendering his opinion. Accordingly, to the extent Plaintiff objects to the affidavit of Morrison based on the fact that he is not qualified to render opinions in this matter and/or that his opinions are not relevant or reliable, the Court **OVERRULES** the objections. Morrison’s Declaration will be allowed for purposes of ruling on the Motion for a Preliminary Injunction.

B. Motion for Preliminary Injunction

Plaintiff argues that Defendant's Gravity Defyer literally infringes on its '824 patent, and thus seeks a preliminary injunction enjoining Defendant from manufacturing, marketing, and selling the Gravity Defyer. See generally Pl.'s Mot. for Prelim. Inj. "Plaintiff does not believe that the doctrine of equivalents is necessary in this case since Defendant's product literally infringes Claim 1 of the '824 Patent." *Id.* at 5.

Defendant responds by arguing that the Gravity Defyer does not infringe the '824 patent, and that even if it did, the '824 patent is invalid. Def.'s Opp'n 1.

The United States Court of Appeals for the Federal Circuit has exclusive jurisdiction over appeals from final decisions of district courts when the district court's jurisdiction in the underlying matter is based, in whole or in part, upon Title 28 U.S.C. § 1338. 28 U.S.C. § 1295(a)(1); *Logan v. Burgers Ozark Country Cured Hams, Inc.*, 263 F.3d 447, 451 (5th Cir. 2001). Section 1338 grants district courts original jurisdiction over any civil action arising under any Act of Congress relating to patents. 28 U.S.C. § 1338(a); *Logan*, 263 F.3d at 451. It follows then, that the law of the Federal Circuit, and not the Fifth Circuit, binds district courts in addressing patent infringement claims. See *Adell Corp. v. Elco Textron, Inc.*, 51 F.Supp.2d 752, 754 (5th Cir. 1999) (citing *Beverly Hills Fan Co. v. Royal Sovereign Corp.*, 21 F.3d 1558, 1564-65 (Fed. Cir. 1994)); *Crystal Semiconductor Corp. v. Opti Inc.*, 1997 U.S. Dist. LEXIS 20608, at *6 (W.D. Tex. July 14, 1997) (same).

In order to obtain a preliminary injunction, the moving party must establish four factors: (1) a substantial likelihood of success on the merits of the substantive claim; (2) a substantial threat that the movant will suffer irreparable injury if the injunction is denied; (3) that the threatened injury to the movant outweighs any damage the injunction might cause the non-

movant; and (4) that the injunction will not disserve the public interest. *Sanofi-Synthelabo v. Apotex, Inc.*, 470 F.3d 1368, 1374 (Fed. Cir. 2006); *see also Reliant Energy Servs. v. Enron Can. Corp.*, 349 F.3d 816, 826 n.7 (5th Cir. 2003) (requiring the same elements). Individually, these factors are not dispositive. *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1350 (Fed. Cir. 2001). Rather, the district court must weigh each factor against the others. *Id.*

A preliminary injunction is an extraordinary equitable remedy, designed “to prevent irreparable injury so as to preserve the court’s ability to render a meaningful decision on the merits.” *Canal Auth. of Fla. v. Callaway*, 489 F.2d 567, 576 (5th Cir. 1974) (citing *Hoover v. Morales*, 164 F.3d 221, 224 (5th Cir. 1998)). All four elements are mixed questions of law and fact. *Hoover*, 164 F.3d at 224.

1. Likelihood of success on the merits

Plaintiff argues that it is likely to succeed on the merits of its patent infringement claim because the Gravity Defyer literally infringes the ‘824 patent. Pl.’s Mot. for Prelim. Inj. at 7. Specifically, Plaintiff asserts that the elements of Claim 1 of the ‘824 patent are: (1) a shoe sole defining a vacuity; (2) a spring within the vacuity; (3) a second vacuity; (4) a passageway to allow air to go from one vacuity to another; where (5) air within the vacuities is sealed from the outside of the shoe. *Id.* Plaintiff further argues that the Gravity Defyer literally infringes Claim 1 of the ‘824 patent because it contains: (1) two vacuities within the sole of the shoe, which are the same as elements 1 and 3 of Claim 1; (2) a spring within one of the vacuities, which is the same as element 2 of Claim 1; (3) a passageway to allow air to move from one vacuity to another, which is the same as element 4 of Claim 1; where (4) air within the vacuities is sealed from the outside of the shoe, which is the same as element 5 of Claim 1. *Id.* As such, Plaintiff argues, “Defendant

has literally infringed Claim 1 of the ‘824 Patent.” *Id.* Plaintiff further argues that the fact that Defendant depicts a shoe with an air valve on its website even though it does not manufacture a shoe with an air valve should be deemed an admission that Defendant was aware of Plaintiff’s shoe technology at the time it created the Gravity Defyer. *Id.* Plaintiff argues that prior art does not involve spring-cushioned shoes, like Plaintiff’s shoes. Pl.’s Reply to Def.’s Opp’n to Pl.’s Mot. for Prelim. Inj. 3. Finally, Plaintiff argues that it fully disclosed all prior art to the PTO in its original “Parent Application” for United States Patent No. 6,665,957 in October of 2001, and thus did not engage in any inequitable conduct. *Id.* 1-2.

Defendant first responds by arguing that the Gravity Defyer does not infringe the ‘824 patent because the ‘824 patent contains two key limitations not present in the Gravity Defyer. Def.’s Opp’n ¶ 8. Specifically, Defendant argues that the Gravity Defyer is not contain the following limitations: (1) a passageway configured to allow eructative evacuation of fluid from the vacuity upon a reduction in volume of the vacuity; and (2) the requirement that first vacuity, second vacuity, and passageway be hermetically sealed from the exterior of the shoe. *Id.* ¶¶ 11-12. Instead, Morrison declares that the Gravity Defyer features two openings at the arch area of the sole that lead to the front portion of the shoe, through which air displaced from the heel can vent. *Id.* ¶ 12. Air displaced from the front portion of the Gravity Defyer arguably flows around or through a porous paper, open cell foam, and leather insole, or even back to the heel portion of the shoe through the two openings in the arch area. *Id.* As such, Defendant claims that the Gravity Defyer does not infringe the ‘824 patent. *Id.* ¶ 15.

Defendant next argues that even if the Gravity Defyer infringes the ‘824 patent, the ‘824 patent is invalid based upon the prior art doctrine. *Id.* ¶ 7. Defendant argues that the ‘001 patent

constitutes an anticipatory prior art reference under 35 U.S.C. § 102(b), which discusses each and every limitation of Claim 1 of the '824 patent. *Id.* ¶ 18. Although not argued by Plaintiff, Defendant further argues that Claims 2 and 3 are also anticipated by the '001 patent which discusses “ambient air at atmospheric pressure” and “a gas at less than atmospheric pressure.” *Id.* ¶ 19.

Finally, Defendant argues that there is substantial evidence that the named inventors of the '824 patent, Francis Levert and David Krafzur, withheld material information from the PTO during prosecution of the '824 patent and did so with an intent to deceive the PTO. *Id.* ¶ 24. Specifically, Defendant argues that Levert and Krafzur knew of prior art patents before the '824 patent was issued in March 2005, because the prior art patents were cited in 2002 and 2003 search reports requested by Levert and Krafzur in connection with their international application for the '824 patent. *Id.* ¶ 26.

In order to establish likelihood of success on the merits of a patent infringement claim – the first element necessary to obtain a preliminary injunction – a moving party must show two things: (1) that it will likely prove that the non-moving party infringed its patent; and (2) that its patent will withstand challenges to validity and enforcement. *Amazon.com*, 239 F.3d at 1350; *Apotex*, 470 F.3d at 1374. The court must perform an infringement and validity analysis on a claim-by-claim basis. *Amazon.com*, 239 F.3d at 1351. If the non-moving party raises substantial questions concerning either infringement or validity, the court must not issue a preliminary injunction. *Id.* at 1351.

a. Infringement

An infringement analysis involves two steps. *Id.* First, the court must determine the

meaning and scope of the claims at issue by “construing the claims.” *Id.* “Only when a claim is properly understood can a determination be made whether the claim ‘reads on’ an accused device or method, or whether the prior art anticipates and/or renders obvious the claimed invention.” *Id.* The general rule is that claims should be construed, if possible, to sustain their validity. *Phillips*, 415 F.3d at 1327. The court must give claims the same meaning for purposes of both infringement and validity. *Amazon.com*, 239 F.3d at 1351. In construing claims, courts may rely on both intrinsic and extrinsic evidence. *Phillips*, 415 F.3d at 1317.

Intrinsic evidence includes the claims themselves, the patent specification, and the prosecution history. *Id.* at 1313. As a general matter, courts should give claims their ordinary and customary meaning – that is, the meaning that the term would have to a person of ordinary skill in the art in question at the time of invention. *Id.* at 1312-13. Claims must also be read in view of the patent specification of which they are a part. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995). A person of ordinary skill in the art in question is deemed to read the claim term in the context of the claim in which the disputed term appears and in the context of the entire patent and specification. *Phillips*, 415 F.3d at 1312-13. The specification, itself, contains a written description of the invention and must enable a person of ordinary skill in the art to make and use the invention. *Markman*, 52 F.3d at 979. The specification acts as a dictionary to explain the invention and may define terms used in the claim. *Id.* at 980. “[A] patentee is free to be his own lexicographer,” but any special definition must be clearly defined in the specification. *Id.*

External evidence includes all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises. *Phillips*, 415 F.3d at

1317; *Markman*, 52 F.3d at 980. Though less significant than the intrinsic record in determining the legally operative meaning of claim language, extrinsic evidence can shed useful light on the relevant art. *Id.*

After a court construes the claim, it must then undertake the second step in an infringement analysis – comparing the properly construed claim with the accused device to determine whether the accused device contains all of the claim limitations, either literally or by a substantial equivalent. *Amazon.com*, 239 F.3d at 1351. Literal infringement requires the patentee to prove, by a preponderance of the evidence, that the accused device contains each limitation of the asserted claim(s).” *Amazon.com*, 239 F.3d at 1351 (quoting *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir. 2000)); *Biovail Corp. Int'l v. Andrx Pharms., Inc.*, 239 F.3d 1297, 1303 (Fed. Cir. 2001). “Infringement under the doctrine of equivalents requires that the accused product contain each limitation of the claim or its equivalent.” *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1359 (Fed. Cir. 2000). “An element in the accused product is equivalent to a claim limitation if the differences between the two are ‘insubstantial’ to one of ordinary skill in the art.” *Id.*

In the instant case, Plaintiff only alleges literal infringement of Claim 1 of its ‘824 patent. As stated above, Claim 1 of the ‘824 patent reads as follows:

A shoe comprising:

a shoe sole defining a vacuity;

a spring disposed within the vacuity;

a fluid passageway in fluid communication with the vacuity, the passageway configured to allow eructative evacuation of fluid from the vacuity upon a reduction in the volume of the vacuity; and

a second vacuity in said shoe sole in fluid communication with the passageway, wherein the first vacuity, the second vacuity and the passageway are hermetically sealed from the exterior of the shoe.

This Court can construe several aspects of Claim 1 using intrinsic evidence only. The ordinary and plain meaning of the terms reveal that Claim 1 describes, in part: (1) a shoe; (2) with a vacuity, opening, or cavity; and (3) a spring within that vacuity, opening, or cavity. The ordinary and plain meaning of the terms also reveal that Claim 1 describes the shoe as containing: (4) a second vacuity, opening, or cavity that is connected to the first vacuity, opening, or cavity by (5) a passageway designed to allow air to flow between the two vacuities, openings, or cavities. It is the next two elements that require this Court to look beyond the ordinary and plain meaning of the patent terms, namely the elements that describe: (6) a passageway configured to allow “eructative evacuation” of fluid, presumably air, from the vacuity, opening, or cavity upon a reduction in volume of the vacuity, opening, or cavity; and (7) the two vacuities, openings, or cavities and the one passageway all “hermetically sealed” from the exterior of the shoe.

The patent specification never defines the terms “hermetically sealed” or “eructative evacuation.” It does, however, provide some guidance or context within which the terms should be construed. First, the patent indicates that the vacuities and passageway must be hermetically sealed to both prevent air exchange between the vacuities, openings, or cavities, and the exterior of the shoe and to prevent moisture and particles from entering the vacuities, openings, or cavities. It further states that “[s]ealing is accomplished, e.g., by adhesively attaching inner sole to second surface.” Thus, while the term “hermetically sealed” is not formally defined, the Court has at least one example of what is meant by “hermetically sealed” and understands that it is an important limitation for the fluid flow design system contemplated by Plaintiff.

Similarly, the term “eructative evacuation” is never defined, but its importance is underscored by passages from the patent specification. Specifically, the patent indicates that while trapped air in a shoe is thought to be desirable by providing cushioning, it is not desirable in spring-cushioned shoes because the air interferes with the operation of the springs. The patent indicates that if there is no passageway allowing eructative evacuation or escape of air from the compressed vacuity, then the spring effect is less predictable and less controllable, diminishing the performance of the shoe. As such, the patent specification indicates that “eructative evacuation” of fluid or air is another important limitation in the fluid flow design system contemplated by Plaintiff.

While the Court must consider this context in construing the claim, the context alone does not provide a definition for the terms at issue such that the Court can determine whether or not the claim reads on the accused device. For this, the Court must turn to extrinsic evidence in the absence of intrinsic evidence. Plaintiff provided no extrinsic evidence in the form of dictionaries, treatises, or expert testimony to aid in defining the terms in its ‘824 patent. Defendant provided extrinsic evidence in the form of Morrison’s testimony.

Morrison used an accepted method – the dictionary – to define the term “hermetically sealed” as “air tight seal,” and to define the term “eructative evacuation” as “to belch or emit violently.” These definitions are consistent with the context described above. For example, defining “hermetically sealed” as “air tight seal” is consistent with the patent specification’s indication that the hermetic seal is designed to prevent air exchange between the vacuities and the exterior of the shoe and to prevent moisture and particles from entering the vacuities. Defining the term “eructative evacuation” as “to belch or emit violently” is consistent with the patent

specification's indication that evacuation or escape of air from the compressed vacuity is necessary to allow optimal operation of the springs. In fact, in light of the patent specification, the main purpose of the fluid flow system is to secure violent emission of air from the compressed vacuity so that air in the vacuity will not interfere with the operation of the springs. In light of these findings, the Court will accept Morrison's definitions of "hermetically sealed" and "eructative evacuation" in construing the claim.

Now that the Court has construed the claim, it must determine whether or not the accused device infringes on the claim. The only evidence regarding the design of the Gravity Defyer is found in Plaintiff's Motion for Preliminary Injunction and Morrison's testimony. From these two sources, it appears as though the Gravity Defyer consists of: (1) a shoe; (2) with a vacuity, opening, or cavity in the heel portion; (3) which vacuity opening, or cavity contains a set of springs; and (4) a second vacuity, opening, or cavity in the toe portion; (5) connected by a fluid flow passageway that facilitates the movement of air between the two vacuities; and (6) wherein the inner sole of the Gravity Defyer is adhesively attached to the remaining structure.

Morrison testifies that the '824 patent contains two limitations not found in the Gravity Defyer – namely the requirements that the vacuities be hermetically sealed and that the structure allow for eructative evacuation of air between vacuities. Morrison drew this conclusion after examining the Gravity Defyer. He noted that neither the toe nor heel portion of the Gravity Defyer is hermetically sealed or air tight, but rather that displaced air can vent through openings in the arch area of the sole and other portions of the shoe. He also noted that the Gravity Defyer does not require that air or fluid be eructatively evacuated or violently emitted from the vacuity, but rather air may pass naturally and flow around and through the materials in the Gravity Defyer.

This Court agrees with Morrison, at least at this stage, and finds that that Plaintiff is not likely to succeed on the merits of its claim for patent infringement. There are too many differences between the '824 patent and the Gravity Defyer to conclude otherwise. As discussed above, the '824 patent was specific in detailing the importance of “hermetically sealed” vacuities and the requirement that air be “eructatively evacuated” from the vacuities. These limitations are simply not found in the Gravity Defyer. Thus, Plaintiff’s Motion for Preliminary Injunction is denied.

b. Validity

Even if this Court were to conclude that Plaintiff provided likelihood of success on the merits of its patent infringement claim, the Court would need to examine the validity of the '824 patent.

Title 35 U.S.C. § 282 provides that a patent shall be presumed valid, and that the burden of establishing invalidity rests on the party asserting invalidity. 35 U.S.C. § 282; *Roper Corp. v. Litton Sys.*, 757 F.2d 1266, 1270 (Fed. Cir. 1985). In other words, “[a] patent is born valid” and remains valid until a challenge proves that it is no longer valid. *Id.* At the preliminary injunction stage, the court may find that substantial questions regarding patent validity exist on evidence that would not support such finding at trial. *Amazon.com*, 239 F.3d at 1358. For example, the test for invalidity at trial is “clear and convincing evidence,” whereas the test for invalidity at the preliminary injunction stage is “vulnerability.” *Id.* at 1358-59. “The showing of a substantial question as to invalidity thus requires less proof than the clear and convincing showing necessary to establish invalidity itself.” *Id.* at 1359.

When moving for a preliminary injunction, a patentee need not establish validity of a patent beyond question, but must present a clear case supporting the validity of the patent. *Amazon.com*, 239 F.3d at 1359. A patentee might present such a case by showing that the patent had withstood previous challenges or by showing that the patent's validity enjoyed a long period of industry acquiescence. *Id.*

A patent may be invalidated if the court finds that it was "anticipated" by prior art. 35 U.S.C. § 102; *Apotex, Inc.*, 470 F.3d at 1375. A finding that a patent is invalid as being "anticipated" under 35 U.S.C. § 102 requires a finding that each and every claim limitation is found either expressly or inherently in a single prior art reference. *Apotex, Inc.*, 470 F.3d at 1375. "An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention." *ATD Corp. v. Lydall*, 159 F.3d 534, 545 (Fed. Cir. 1998).

In the instant case, Defendant argues that the '824 patent was anticipated by the '001 patent, thus rendering the '824 patent invalid. Defendant supports this assertion with Morrison's testimony. As well-summarized in Morrison's chart reprinted above, there exists at least a question as to whether each and every claim limitation of the '824 patent is found either expressly or inherently in the '001 patent, thus rendering the '824 patent vulnerable. Moreover, Plaintiff has not presented evidence that its patent has withstood previous challenges or that the patent's validity has enjoyed a long period of industry acquiescence – both facts which would tend to support the validity of the patent. At this stage, vulnerability is sufficient to deny a preliminary injunction. As such, even if this Court were to find that Defendant infringed Plaintiff's '824

patent, the Court would nonetheless deny the Motion for Preliminary Injunction.

c. Enforceability and inequitable conduct

A court may declare a patent unenforceable based on inequitable conduct if an applicant fails to disclose material information or submits materially false information to the PTO during prosecution, with the intent to mislead or deceive the examiner. *McKesson Info. Solutions, Inc. v. Bridge Med., Inc.*, 2007 U.S. App. LEXIS 11606, at *35 (Fed. Cir. May 18, 2007). The party asserting inequitable conduct must prove materiality and intent by clear and convincing evidence. *Id.* at *37. The court must then balance the levels of materiality and intent to determine whether the questioned conduct amounts to inequitable conduct. *Id.*

Whether or not information is “material” for purposes of an inequitable conduct analysis may be judged by the “reasonable examiner” standard. *Id.* at *35. In other words, material information includes any information that a reasonable examiner would “substantially likely consider important in deciding whether to allow an application to issue as a patent.” *Id.* (citing *Akron Polymer Container Corp. v. Exxel Container*, 148 F.3d 1380, 1382 (Fed. Cir. 1998)). Information may be considered material, even if it would not invalidate a patent. *Id.* at *36. “However, a withheld otherwise material [piece of information] is not material for the purposes of inequitable conduct if it is merely cumulative to that information considered by the examiner.” *Id.* (citing *Digital Control Inc. v. Charles Mach. Works*, 437 F.3d 1309, 1319 (Fed. Cir. 2006)). The scope and content of prior art and its import are questions of fact. *Id.*

In addition to materiality, inequitable conduct requires intent to deceive, not just intent to withhold. *Id.* Intent to deceive is “proven by inferences drawn from the facts, with the collection of inferences permitting a confident judgment that deceit has occurred.” *Id.* It cannot be inferred

from a simple decision to withhold information where the reasons for withholding are plausible.

Id. Finally, a finding that certain conduct amounts to “gross negligence” does not justify an inference of intent to deceive. *Id.* at *37. Rather, the conduct, viewed in light of all evidence, including evidence of good faith, “must indicate sufficient culpability to require a finding of intent to deceive.” *Id.*

The Federal Circuit has held that “it can not be inequitable conduct for an applicant not to resubmit, in the divisional application, the information that was cited or submitted in the parent application.” *ATD Corp.*, 159 F.3d at 547; *see also Transmatic v. Gulton Indus.*, 849 F.Supp. 526, 541 (E.D. Mich. 1994), *aff’d in pertinent part, rev’d in part*, 53 F.3d 1270 (Fed. Cir. 1995) (cited by the Federal Circuit in *ATD Corp.* for the proposition that “a material reference that is already of record in parent application need not be resubmitted by the applicant in a continuing application”). Recently, however, the Federal Circuit also held that failure to resubmit a material reference in a continuing application was sufficient to constitute inequitable conduct when: “(1) the examiner of one application was not apprised of the adverse decisions by another examiner in a closely-related application; (2) the application disclosed the closely-related application only in the context of prior art cited in that application, but failed to mention the adverse decisions; and (3) the applicant made statements to the examiner inconsistent with the other examiner’s decisions, i.e. that nothing in the prior art disclosed three-node communication.” *McKesson Info. Solutions, Inc.*, 2007 U.S. App. LEXIS 11606, at *72.

The instant case is unlike *McKesson* because there is no evidence that Plaintiff sought approval of patent applications pending before two separate examiners or that Plaintiff made statements to one examiner inconsistent with another patent examiner’s decisions. *McKesson* was

an extremely fact-intensive case, with complexities not involved here. In this case, the only issue is whether Plaintiff should have resubmitted information in a subsequent divisional application when it had already submitted the same information in a parent application before the same patent examiner. *ATD Corp.* makes clear that such conduct is not “inequitable” for purposes of an inequitable conduct analysis. Thus, in light of the record as it now stands, the Court finds that Plaintiff did not engage in inequitable conduct.

2. Irreparable injury

Plaintiff argues that because it has shown likelihood of success on the merits, irreparable injury should be presumed. Pl.’s Mot. for Prelim. Inj. 7.

Defendant responds by arguing that Plaintiff has failed to establish likelihood of success on the merits, and thus is not entitled to a presumption of irreparable injury. Def.’s Opp’n 9.

Defendant further argues that even if sales of the Gravity Defyer “may” impact Plaintiff’s own sales, that alone does not establish irreparable injury. *Id.*

“A preliminary injunction will not issue simply to prevent a mere possibility of injury, even where prospective injury is great. A presently existing, actual threat must be shown.” *Zenith Radio Corp. v. United States*, 710 F.2d 806, 809 (Fed. Cir. 1983) (citing *S.J. Stile Assoc. Ltd. v. Snyder*, 646 F.2d 522, 525 (Fed. Cir. 1981)). When a patent holder has clearly established validity and continuing infringement, irreparable injury will be presumed. *Atlas Powder Co. v. Ireco Chems.*, 773 F.2d 1230, 1232 (Fed. Cir. 1985) (citing *Smith Internat’l, Inc. v. Hughes Tool Co.*, 718 F.2d 1573, 1581 (Fed. Cir. 1983)).

In the instant case, Plaintiff has failed to show likelihood of success on the merits of its infringement claim and the validity of its ‘824 patent. As such, Plaintiff is not entitled to the

presumption of irreparable injury. As Plaintiff has failed to establish the first two elements necessary to issue a preliminary injunction, Plaintiff's Motion for Preliminary Injunction is denied.

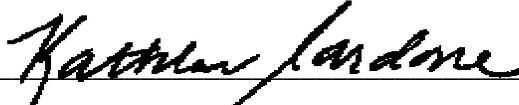
III. CONCLUSION

In light of the above, Plaintiff's Motion to Strike (Doc. No. 15) is **DENIED** and Plaintiff's Motion for Preliminary Injunction (Doc. No. 5) is **DENIED**.

As this case is merely at the preliminary injunction stage, both parties still have an opportunity to undertake discovery and file future motions. **IT IS THEREFORE ORDERED** that the parties meet, confer, and submit a Report of Parties Planning Meeting, as discussed in this Court's Standing Order Regarding Pretrial Deadlines, by no later than **July 31, 2007**. At that time, the Court will issue a Scheduling Order governing future deadlines in this case.

SO ORDERED.

SIGNED on this 9th day of July 2007.


KATHLEEN CARDONE
UNITED STATES DISTRICT JUDGE