

Keywords: disclaimer, priority, claim construction, continuity of disclosures

General: A disclaimer in the specification of a patent specifically excludes subject matter from the invention possessed by the patentee. Removing limitations by rescinding the disclaimer in further continuation patents broadens the description of the invention and would not be within the scope of the invention as described in the prior patent.

Akeva L.L.C. v. Nike, Inc., Adidas America, Inc.
United States Court of Appeals for the Federal Circuit
No. 2019-2249
Decided July 16th 2020

I. Facts

Akeva L.L.C. (Akeva) owns a portfolio of footwear patents including U.S. Patent Nos. 5,560,126 ('126 patent); 6,966,130 ('130 patent); 7,114,269 ('269 patent); 5380,350 ('350 patent); and 7,540,099 ('099 patent). The '130, '269, '350, and '099 patents all claim priority to the '126 patent and are referred to as the Continuation Patents. The previously listed patents are directed to improvements in rear soles and midsoles of athletic shoes. The specification of the '126 patent discloses the problem of rear sole wear in athletic shoes and discloses that the heel of the shoe typically wears out much faster than the rest of the shoe. To address this problem Akeva discloses a shoe having a rear sole “detachably secured to and rotatably mounted to the heel support.” The specification also discloses a graphite insert for the midsole to reduce midsole compression and provide additional spring. The '126 patent thus discloses a solution to the problem of a conventional fixed rear sole by replacing it with either a detachable rear sole that can be replaced or a rear sole that is rotatable. Claim 25 of the '126 patent provides a representative example of the claimed subject matter:

25. 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 upper and lower surfaces and supported
between at least a portion of the rear sole and at least a portion
of the heel region....

'126 patent claim 25 (emphasis added).

The Continuation Patents claim priority to the '126 patent through a chain of intervening continuations including the previously litigated U.S. Patent No. 6,604,300 ('300 patent). The '300 patent is a continuation-in-part of the '126 patent. In a previous appeal to the Federal Circuit (*Akeva I*), it was found that the '300 patent specification disclaimed conventional fixed rear soles.¹ The claim term “rear sole secured” was construed to mean “selectively or permanently fastened but not permanently fixed into position”. As filed, the '296 patent has the same specification of the '300 patent but the specification for the '296 patent was amended during prosecution to circumvent the disclaimer language relied upon by the Federal Circuit in *Akeva I* to construe the term “rear sole secured” in an effort to claim shoes having conventional fixed rear soles. The remaining

¹ See *Akeva L.L.C. v. Adidas-Salomon AG*, 208 F. App'x 861, 864–65 (Fed. Cir. 2006) (*Akeva I*)

Continuation Patents are continuations of the '296 patent and were similarly amended either at filing or during prosecution.

In the present case, Akeva sued Nike Inc. and Adidas America Inc. for infringement of claims of the '126 patent and the Continuation Patents. All of the accused shoes have conventional fixed rear soles. In a motion for summary judgement, the defendants argued that the term "rear sole secured" in the '126 patent claims, just as with the claims of the '300 patent asserted in *Akeva I*, could not include a shoe with a conventional fixed rear sole. The district court declined to apply collateral estoppel against Akeva's proposed construction in light of the previous decision in *Akeva I* because the '126 patent does not share an identical written description with the '300 patent. However, the district court reviewed the '126 patent specification and found that it also disclaimed conventional rear fixed soles from the invention, concluding that rear sole secured in the context of the patent means "rear sole selectively or permanently fastened, but not permanently fixed in position." That is, the rear sole could be (1) detachable or (2) attached and rotatable, but a conventional fixed rear sole was not within the scope of the claim term.

The district further ruled that Akeva's amendments to the specification of the Continuation Patents added new matter by broadening the scope of the disclosure and therefore could not claim priority to the '126 patent (since both the '300 patent and the '126 patent were found to disclaim and disavow conventional fixed rear sole shoes). As a result, and because Nike's accused product was on sale before the filing date of the Continuation Patents, the Continuation Patents were invalid under 35 U.S.C. § 102. Akeva appealed the decision.

II. Issues

- 1) Did the district court err in finding that the '126 patent disclaimed a shoe with a conventional fixed rear sole?
- 2) Did the district court err in finding that the Continuation Patents cannot claim priority to the '126 patent?

III. Discussion

1) No. The court agreed with the district court's finding that the '126 specification clearly disclaims shoes with conventional fixed rear soles. The court noted that "[w]here 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."² The court found that numerous statements in the specification made it clear a conventional fixed rear sole is not within the scope of the invention. For example, the Description of the Preferred Embodiments section of the specification describes multiple embodiments, with each embodiment requiring a detachable or rotatable rear sole. Akeva argued that the '126 patent does not disclaim conventional rear fixed soles because the specification discloses two distinct inventions: (1) The rotatable and/or detachable rear soles and (2) the flexible plate in the midsole. The court disagreed, because the specification consistently describes the invention as a shoe with a detachable or rotatable fixed sole that may have a flexible plate (e.g., graphite inserts), i.e., the court was unable to find any disclosure in the specification of the flexible

² In *SciMed Life Systems Inc. v. Advanced Cardiovascular Systems Inc.* 242 F.3d 1337, 1341 (Fed. Cir. 2001)

plate being present without an accompanying description of a detachable or rotatable sole. Akeva also argued that the doctrine of claim differentiation supports its position. The court disagreed and reaffirmed that Akeva's claim differentiation argument is inapposite because the claims in question encompass both non-detachable, rotatable rear soles, as well as detachable rear soles under the district courts claim construction, with which the court agreed.

2) No. The court next turned to the district court's assertion that the Continuation Patents may not properly claim priority to the '126 patent. The court asserted that to claim priority to a patent earlier in the priority chain, the case law emphasizes that there must be a continuity of disclosures.³ Thus, for the Continuation Patents to be entitled to claim priority to the '126 patent, there must be continuity of disclosures, which here includes the '300 patent. The disclaimer in the '300 patent specifically excluded an athletic shoe with the conventional fixed rear sole and midsole insert from the patent's scope. The court asserted that this disclaimer resulted in breaking any continuity of disclosure for that embodiment. As a result the Continuation Patents cannot reach through the '300 patent to claim an earlier priority date for claims directed to a shoe having a conventional rear fixed sole. Akeva referred to *Hakim v. Cannon Avent Group*⁴, as an example of disclaimers of claim scope that were successfully rescinded in a later-filed continuation patent. The court found that this case involved disclaimers made during *prosecution*, unlike the specification disclaimer in the present case. In the *Hakim v. Cannon Avent Group* case, the written description that supports the claims existed in prior patents and the patent owner then in subsequent applications filed a statement *rescinding the prior-made prosecution disclaimer*. In contrast the current case rescinded a disclaimer in the specification, thus adding new subject matter and breaking the chain of priority in regard to the Continuation Patents.

Conclusion

In order to maintain priority in a continuation patent, the continuation patent may not introduce new matter that breaks the chain of priority for the asserted claims. A disclaimer in the specification of a patent specifically excludes subject matter from the invention possessed by the patentee. Removing limitations by rescinding the disclaimer in further continuation patents broadens the description of the invention and would not be within the scope of the invention as described in the prior patent.

³ *In Hollmer v. Harari*, 681 F.3d 1351, 1355 (Fed. Cir. 2012)

⁴ *See Hakim v. Cannon Avent Group, PLC*, 479 F.3d 1313, 1317–18 (Fed. Cir. 2007)