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4 UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
5 AT SEATTLE

6 G3 GENUINE GUIDE GEAR INC.,

7 Plaintiff,

8 v.

9 MARKER DEUTSCHLAND GMBH,
10 et al.,

11 Defendants.

C15-561 TSZ

ORDER

12 THIS MATTER comes before the Court pursuant to *Markman v. Westview*
13 *Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), to construe certain terms in U.S. Patent
14 No. 8,746,728 B2 (“the ’728 Patent”), which discloses a heel unit for alpine ski bindings.
15 Having reviewed the parties’ briefs and all other papers filed in connection with claim
16 construction, and having heard the arguments of counsel, the Court enters the following
17 order.

18 **Background**

19 Alpine skiing or touring involves both downhill and uphill travel on skis. When
20 an individual is skiing downhill, both the toes and the heels of his or her alpine ski boots
21 are connected to the skis. In contrast, when an individual is ascending or touring, only
22 the toes of his or her boots remain pivotally engaged with the skis; the heels are able to
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1 move up and down with respect to the skis. The invention disclosed in the '728 Patent is
2 an apparatus that can transition between (i) holding a ski boot heel onto an alpine ski for
3 downhill travel, and (ii) releasing the heel for touring use of the ski.

4 For safety reasons, alpine touring bindings are designed to release the ski boots in
5 the event that the user falls while skiing downhill. In addition, when a ski boot detaches
6 from a ski while the heel binding is in the downhill mode, brake arms that are attached to
7 the ski will automatically deploy into the snow. Automatic deployment of these brake
8 arms, however, is neither necessary nor desired when the skis are being used in ascent or
9 touring mode. The '728 Patent discloses an apparatus that can transition between
10 (i) locking the brake arms in a raised position (away from the snow) during the touring
11 mode, and (ii) allowing automatic deployment of the brake arms in the event of a fall
12 while traveling downhill.

13 Plaintiff G3 Genuine Guide Gear Inc. is the assignee of the '728 Patent. Plaintiff
14 manufactures and markets the "Onyx" brand of alpine ski bindings, which include both a
15 toe and a heel unit. The toe unit is not at issue in this litigation. In this action, plaintiff
16 alleges that defendants Marker Deutschland GmbH and Marker Volkl USA, Inc., which
17 make and/or sell the "Marker Kingpin" brand of alpine ski bindings, are infringing
18 independent Claims 1, 11, and 29, and dependent Claims 2, 12, 13, 18, 19, 32, 33, 35, 37,
19 38, and 39 of the '728 Patent. See Ex. B to Am. Compl. (docket no. 15-2 at 3); see also
20 Pla.'s Infringement Contentions (docket no. 25). The four terms (or phrases) that the
21 parties ask the Court to construe are each set forth in at least one of the three independent
22 claims at issue, Claims 1, 11, and 29.

1 Claims 1, 11, and 29 of the '728 Patent are similar, but they differ in a few
2 important ways. Claim 1 discloses an “apparatus for selectively holding a footwear heel
3 to a snow travel aid,” ’728 Patent at Col. 15, Lines 47-48, whereas Claims 11 and 29
4 disclose a “binding kit” comprising either (i) “toe and heel units for holding footwear to a
5 snow travel aid,” *id.* at Col. 17, Lines 17-18, or (ii) “toe holding and heel holding units
6 for holding footwear to a snow travel aid,” *id.* at Col. 18, Lines 63-64. As indicated in
7 the ’728 Patent, in this context, “footwear” is typically a ski boot, and a “snow travel aid”
8 is usually a ski. *Id.* at Col 2, Lines 57-58. The main difference between Claim 1, on the
9 one hand, and Claims 11 and 29, on the other hand, involves the scope of the invention,
10 with Claim 1 focusing on solely the heel, while Claims 11 and 29 describe binding kits
11 having both toe and heel units.

12 The heel unit disclosed in Claim 1 has five primary components: (i) a “base”
13 mountable to the ski; (ii) an “upper portion” that is “slidably engageable with the base”
14 for “controllable movement” by the user into a downhill or a touring position; (iii) a
15 “connector” for “connecting the apparatus to the heel” of the ski boot; (iv) a “brake” that
16 is “moveable between a braking position whereby the brake is positioned to contact snow
17 and a raised position whereby the brake would be positioned above the snow,” and (v) a
18 “brake holder” that is “moveable in response to movement of the upper portion between
19 the downhill and touring positions” and that holds the brake “in the raised position when
20 the upper portion is in the touring position.” *See* ’728 Patent at Col. 15, Lines 49-67.

21 The downhill and touring positions are defined as follows: (i) in the downhill position,
22 “the connector would be connected to the heel,” and (ii) in the touring position, which is
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1 “spaced rearwardly from the downhill position,” the connector “would be disconnected
2 from the heel.” *Id.* at Col. 15 at 55-59. Claim 1 also requires that “single motions of a
3 lever in opposite directions result in complete movement in opposite directions between
4 the downhill and touring positions.” *Id.* at Col. 15, Line 67 – Col. 16, Line 2.

5 The heel units disclosed in Claims 11 and 29 are similar to the heel unit described
6 in Claim 1 with two exceptions: (i) Claims 11 and 29 do not include the “brake” and
7 “brake holder” limitations of Claim 1; and (ii) unlike Claim 1, Claims 11 and 29 contain
8 the additional limitation that “complete movement in at least one direction between the
9 downhill and touring positions is actuated by a single motion of an actuator.” *Id.* at
10 Col. 17, Lines 34-36 & Col. 19, Lines 16-18. Claim 11 indicates that the “actuator” is a
11 “lever,” and has language similar to Claim 1 requiring that “single motions of the lever in
12 opposite directions” must “result in complete movement in opposite directions between
13 the downhill and touring positions.” *Id.* at Col. 17, Lines 37-40. In contrast, Claim 29
14 does not dictate that the actuator be a lever or that “single motions . . . result in complete
15 movement.” *See id.* at Col. 18, Line 63 – Col. 19, Line 18.

16 The parties disagree about the interpretation of four terms: (i) the phrases in
17 Claims 1, 11, and 29 that define, in slightly different ways, the “upper portion,” which is
18 “slidably engageable with the base for controllable movement” between the downhill and
19 touring positions; (ii) the limitation in Claims 1 and 11 that “single motions” in “opposite
20 directions” of a lever or actuator “result in complete movement” between the downhill
21 and touring positions; (iii) the limitation in Claims 11 and 29 that “complete movement in
22 at least one direction between the downhill and touring positions is actuated by a single
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1 motion” of a lever or actuator; and (iv) the language in Claim 1 describing the “brake
2 holder.” Neither party asserts that any of the words used in the disputed claim terms have
3 other than their ordinary or plain meaning. Indeed, the terms are straightforward and
4 easily understood to mean what they say. With regard to the first three terms at issue,
5 however, defendants contend that the additional words “when [or while] footwear is
6 attached to the upper portion” must be imported into the claim. With regard to the fourth
7 disputed term, defendants seek to include as a limitation that the brake holder must
8 transition between downhill and touring positions “without two-handed or dual motion
9 activity on the part of a user.”

10 **Discussion**

11 **A. Claim Construction Standards**

12 The Court has both the authority and the obligation to construe as a matter of law
13 the meaning of language used in a patent claim. *Markman*, 52 F.3d at 979. In doing so,
14 the Court must consider the intrinsic evidence in the record, meaning the claims, the
15 specification, and the prosecution history. *Id.* The words of a claim are generally
16 assigned their “ordinary and customary meaning.” *Phillips v. AWH Corp.*, 415 F.3d
17 1303, 1312 (Fed. Cir. 2005). The ordinary and customary meaning of a claim term is the
18 definition ascribed to it by “a person of ordinary skill in the art in question at the time of
19 the invention.” *Id.* at 1313. The context in which a claim term is used may also be
20 instructive. *Id.* at 1314. For example, if a claim refers to “steel baffles,” the language
21 implies that baffles are not necessarily made of steel. *Id.* The other claims of a patent
22 may also illuminate the meaning of a term, through *inter alia* consistent usage of the
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1 same term, or inclusion in a dependent claim of an additional term not present in the
2 related independent claim. *Id.* at 1314-15.

3 Claims must also be read in light of the specification. *Markman*, 52 F.3d at 979.
4 The specification is “the single best guide to the meaning of a disputed term.” *Phillips*,
5 415 F.3d at 1315. If the specification reveals a definition given to a claim term that
6 differs from the meaning it would otherwise possess, the inventor’s lexicography trumps
7 the ordinary and customary, or dictionary, construction. *Id.* at 1316. In considering the
8 specification, however, the Court must take care not to import limitations from the
9 specification into the claims. *Id.* at 1323. The Federal Circuit has “repeatedly warned”
10 against confining the claims of a patent to the specific embodiments described in the
11 specification. *Id.*

12 Similar to the specification, the prosecution history evidences how the inventor
13 understood the terms used in the patent. *Id.* at 1317. Because the prosecution history,
14 however, represents the “ongoing negotiation” between the United States Patent and
15 Trademark Office and the applicant, it might suffer from a lack of clarity and is often less
16 useful for claim construction purposes than the specification. *Id.* In addition, although
17 the prosecution history “can and should be used to understand the language used in the
18 claims,” it may not itself “enlarge, diminish, or vary” the limitations in the claims.
19 *Markman*, 52 F.3d at 980.

20 The Court may, in its discretion, consider extrinsic evidence as an aid in deriving
21 the “true meaning” of the language employed in the patent. *Id.* (quoting *Seymour v.*
22 *Osborne*, 78 U.S. 516, 546 (1870)). Extrinsic evidence may include expert or inventor
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1 testimony, dictionaries, and learned treatises. *Id.* Extrinsic evidence is generally less
 2 reliable than intrinsic evidence in construing the claim terms, and the Court must assess
 3 such evidence accordingly, bearing in mind the flaws inherent in each type of extrinsic
 4 evidence. *See Phillips*, 415 F.3d at 1318-19. Moreover, extrinsic evidence may not be
 5 used to vary or contradict the terms of the claims in the patent. *Markman*, 52 F.3d at 981.

6 **B. Disputed Claim Terms**

7 **1. When/While Footwear is Attached**

8 According to defendants, the phrase “when/while footwear is attached to the upper
 9 portion” should be read into at least two terms in each of the three independent claims at
 10 issue, namely: (i) the “upper portion” terms of Claims 1, 11, and 29; (ii) the “complete
 11 movement” terms of Claims 11 and 29; and (iii) the “single motions” terms of Claims 1
 12 and 11. The language that defendants seek to add is highlighted in the following chart.

TERM	Claim 1	Claim 11	Claim 29
UPPER PORTION	wherein, <u>when footwear is attached to the upper portion</u> , the upper portion is slidably engageable with the base for controllable movement by a user of the upper portion relative to the base into: (i) a downhill position whereby the connector would be connected to the heel, and (ii) a touring position spaced rearwardly from the downhill position whereby the connector would be disconnected from the heel;	wherein, <u>when footwear is attached to the upper portion</u> , the upper portion is slidably engageable with the base for controllable movement by a user of the upper portion relative to the base into: (i) a downhill position whereby the connector would be connected to the footwear heel, and (ii) a touring position spaced rearwardly from the downhill position whereby the connector would be disconnected from the footwear heel;	wherein, <u>when footwear is attached to the upper portion</u> , the upper portion is slidably engageable with the base for controllable movement of the upper portion relative to the base into: (i) a downhill position whereby the connector would be connected to the footwear heel while the footwear toe is gripped by the toe unit, and (ii) a touring position spaced rearward from the downhill position whereby the connector would be disconnected from the footwear heel while the footwear toe is gripped by the toe unit;

TERM	Claim 1	Claim 11	Claim 29
COMPLETE MOVEMENT	N/A	wherein complete movement in at least one direction between the downhill and touring positions is actuated by a single motion of an actuator, <u>while footwear is attached to the upper portion</u> ; and	wherein complete movement in at least one direction between the downhill and touring positions is actuated by a single motion of an actuator, <u>while footwear is attached to the upper portion</u> .
SINGLE MOTIONS	. . . and wherein single motions of a lever in opposite directions, <u>while footwear is attached to the upper portion</u> , result in complete movement in opposite directions between the downhill and touring positions.	wherein the actuator is a lever and single motions of the lever in opposite directions, <u>while footwear is attached to the upper portion</u> , result in complete movement in opposite directions between the downhill and touring positions.	N/A

Defendants advance three theories for why the phrase “when/while footwear is attached to the upper portion” should be included in the claim terms at issue: (i) the context of the claim terms requires such reading; (ii) the ’728 Patent’s disparagement of the prior art supports such interpretation; and (iii) a disclaimer allegedly reflected in the prosecution history warrants importing such limitation. Defendants’ arguments lack merit.

a. Context of Claim Terms

Defendants assert that, in defining the downhill and touring positions as connected to the heel and not connected to the heel, respectively, the “upper portion” claim terms require that a boot be attached to the binding. This contention ignores the fact that Claim 1 discloses only a heel apparatus, which is necessarily not connected to the heel of the footwear while in the touring position.¹ To construe the “upper portion” claim term

¹ Defendants rely on the specification’s discussion of “some embodiments,” in which a “lever that actuates translation of the heel unit does so in a single motion or ‘throw,’” *see* ’728 Patent at Col. 4, Lines 62-63, but the passage defendants quote, which is focused on the lever, and not on the footwear, does not

1 as calling for the boot to be attached while at the same time not connected would render
2 Claim 1 nonsensical.

3 Defendants further argue that the '728 Patent's repeated use of the phrases "by a
4 user" and "by the user," as in the Abstract's statement that the "upper portion is slidably
5 engageable with the base for movement *by a user* into a downhill position and a touring
6 position spaced rearwardly from the downhill position," Ex. A to Am. Compl. (docket
7 no. 15-1 at 2) (emphasis added), connotes that, during the conversion from downhill to
8 touring mode, a person must be wearing footwear attached to the binding. In focusing on
9 the user, defendants confuse the invention claimed in the '728 Patent with its operation.
10 The '728 Patent discloses an apparatus, not a method of use, and notably, of the more
11 than 25 figures in the specification, the few that contain a ski boot, and thereby indirectly
12 refer to a user, concern solely the prior art, and not the invention. Defendants' analysis is
13 also overbroad, failing to distinguish between the footwear and its components. The heel
14 of the footwear is by definition disconnected from the binding when the upper portion is
15 in touring mode; only the toe of the footwear is envisioned by Claims 11 and 29 (but not
16 by Claim 1) to remain gripped by the toe unit.

17 To the extent defendants instead meant to suggest that the toe of the footwear,
18 rather than the entire ski boot, must be attached to the upper portion during the transition
19 between downhill and touring positions, any such language would be merely duplicative.

21 support, and in fact contradicts, their suggestion that the footwear must remain attached; it explicitly
22 contemplates that the "projections of the heel unit" will be "fully disengaged from the heel in the touring
mode," *id.* at Col. 4, Line 65 – Col. 5, Line 1.

1 In its preamble, Claim 11 already requires that the toe unit be “configured to grip the
2 footwear at only the footwear toe to retain the footwear on the snow travel aid
3 independent of the heel unit.” *See* ’728 Patent at Col. 17, Lines 17-22; *see also Proveris*
4 *Scientific Corp. v. Innovasystems, Inc.*, 739 F.3d 1367, 1372 (Fed. Cir. 2014) (“A
5 preamble is generally construed to be limiting if it ‘recites essential structure or steps, or
6 if it is necessary to give life, meaning, and vitality to the claim.’”). Similarly, Claim 29
7 explicitly describes the upper portion as “slidably engageable . . . into: (i) a downhill
8 position whereby the connector would be connected to the footwear heel while the
9 footwear toe is gripped by the toe unit, and (ii) a touring position . . . whereby the
10 connector would be disconnected from the footwear heel while the footwear toe is
11 gripped by the toe unit.” *See* ’728 Patent at Col. 19, Lines 6-15 (emphasis added). Thus,
12 defendants’ additional verbiage is simply superfluous.

13 Defendants’ position also ignores the tense of the verbs used in the “upper
14 portion” terms of Claims 1, 11, and 29. In all three independent claims, the patentee used
15 the auxillary “would” with the infinitive verb “be” to convey a hypothetical meaning, as
16 in “a downhill position whereby the connector would be connected to the heel” and
17 “a touring position . . . whereby the connector would be disconnected from the heel.”
18 ’728 Patent at Col. 15, Lines 55-59 (emphasis added); *see also id.* at Col. 17, Lines 29-
19 33; *id.* at Col. 19, Lines 9-15. This phrasing is actually a truncated conditional sentence,
20 properly understood as indicating that, if the heel unit were in the downhill position, the
21 connector would be connected to the heel, whereas, if the heel unit were in the touring
22 position, the connector would not be connected to the heel. *See* Webster’s 3d New Int’l
23

1 Dictionary 2638 (1981) (defining “would” as “used in auxiliary function in the
2 conclusion of a conditional sentence to express a contingency or possibility (if he were
3 coming, he ~ be here now)”); *see also* RANDOLPH QUIRK ET AL., A COMPREHENSIVE
4 GRAMMAR OF THE ENGLISH LANGUAGE § 4.64, at 234 (1985) (“Would (and sometimes,
5 with a 1st person subject, should) may express hypothetical meaning in main clauses:
6 If you pressed that button, the engine would stop. If there were an accident, we
7 would/should have to report it.” (emphasis in original)). The user, however, need not be
8 in the footwear, and the footwear need not be attached to the upper portion, for the heel
9 unit to be in either the downhill or touring position.

10 Contrary to defendants’ contention, construing the words “would be” as signifying
11 a possible status of the upper portion does not render meaningless the phrases in which
12 they appear, which each begin with “whereby.” Defendants suggest that, absent their
13 proposed requirement that the ski boot be attached during translation between downhill
14 and touring modes, the “upper portion” terms of the claims at issue would be effectively
15 truncated as follows:

16 wherein the upper portion is slidably engageable with the base for
17 controllable movement by a user of the upper portion relative to the base
18 into:

18 (i) a downhill forward position ~~whereby the connector would be connected~~
19 ~~to the heel~~, and

19 (ii) a touring rearward position spaced rearwardly from the ~~downhill~~
20 forward position ~~whereby the connector would be disconnected from the~~
21 ~~heel~~

21 *See* Defs.’ Brief at 16 (docket no. 19) (alterations in original). Defendants’ reasoning is
22 flawed. Regardless of whether the positions are called “forward” and “rearward” or
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1 “downhill” and “touring,” the conditions associated with the positions still apply. The
2 positions are defined by whether the heel of the footwear, if present, would or would not
3 be connected, but the boot need not actually be on the ski for the different positions to be
4 achieved.

5 **b. Disparagement of Prior Art**

6 In support of their argument that the limitation “when/while footwear is attached
7 to the upper portion” must be read into at least two of the terms of Claims 1, 11, and 29,
8 defendants cite the background section of the specification, which describes the manner
9 in which the prior art, namely alpine touring bindings sold under the brand DYNAFIT,
10 transitioned between the downhill and touring positions:

11 To switch between touring and downhill modes with the DYNAFIT™
12 system, it is necessary to rotate the heel unit so that the pins either engage
13 the footwear heel (downhill mode) or face away from the heel (touring
14 mode). When the pins are facing away, the footwear heel is free to move
15 upward and downward. . . . In order to switch from downhill mode to
16 touring mode it is necessary to either forcibly release the pins from the
17 fitting on the heel (not recommended) or disengage the toe unit from the
18 footwear, so that the footwear completely exits from the binding system
19 whereupon the heel unit may be rotated to a position in the touring mode.
20 This can be difficult to do in deep snow or on steep slopes.

21 ’728 Patent at Col. 2, Lines 12-28. Defendants contend that this passage manifests the
22 patentee’s intent to disavow operation of the invention, *i.e.*, movement between downhill
23 and touring positions, without the footwear attached, relying primarily on Openwave Sys.,
Inc. v. Apple Inc., 808 F.3d 509 (Fed. Cir. 2015).

24 Openwave teaches that an inventor may disavow claim scope by disparaging a
25 particular feature or embodiment. *Id.* at 513; *see also SciMed Life Sys., Inc. v. Advanced*

1 Cardiovascular Sys., Inc., 242 F.3d 1337, 1341 (Fed. Cir. 2001) (when the specification
2 “makes clear that the invention does not include a particular feature, that feature is
3 deemed to be outside the reach of the claims of the patent”). Openwave, however, also
4 makes clear that the standard for disavowal of claim scope is “exacting.” 808 F.3d at
5 513; see also Thorner v. Sony Computer Entm’t Am. LLC, 669 F.3d 1362, 1366 (Fed. Cir.
6 2012). To deem a particular feature or embodiment disavowed, the Court must conclude
7 that the specification is “both so clear as to show reasonable clarity and deliberateness,
8 and so unmistakable as to be unambiguous evidence of disclaimer.” Openwave, 808 F.3d
9 at 513. Mere criticism of a particular embodiment encompassed by the plain meaning of
10 a claim term is not sufficient to constitute disavowal. Thorner, 669 F.3d at 1366. Rather,
11 disavowal via disparagement requires that the specification go “well beyond expressing
12 the patentee’s preference” and contain derogatory statements about a particular feature or
13 embodiment that “reasonably may be viewed as a disavowal.” Openwave, 808 F.3d at
14 513.

15 The language in the specification of the ’728 Patent on which defendants rely does
16 not even come close to meeting these standards. The statement that converting the
17 DYNAFIT system from downhill to touring mode “can be difficult” in certain situations
18 does not indicate a preference, let alone rise to the level of disavowing transitions
19 between downhill and touring positions without the footwear being attached to the skis.

1 Moreover, unlike in *Openwave*² or *SciMed*,³ in this case, defendants point to no word or
2 phrase actually appearing in Claims 1, 11, or 29 that must be interpreted in light of the
3 alleged disparagement of the prior art. *See SciMed*, 242 F.3d at 1344 (claim construction
4 “begins and ends in all cases with the actual words of the claim” (quoting *Renishaw plc v.*
5 *Marposs Societa’ per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998))). Rather, defendants
6 are improperly attempting to import into the claims at issue an additional limitation that is
7 based on the specification’s description of the prior art. *See Thorner*, 669 F.3d at 1366
8 (“We do not read limitations from the specification into claims; we do not redefine
9 words.”). Defendants have crossed the line between “using the specification to interpret
10 the meaning of a claim and importing limitations from the specification into the claim.”
11 *See Phillips*, 415 F.3d at 1323.

12
13 ² *Openwave* involved three patents, each setting forth a method and architecture for an interactive two-
14 way data communication network. One of the patents used the claim term “mobile device,” another
15 contained the claim term “wireless mobile telephone,” and the remaining patent employed the claim term
16 “two-way communication device.” 808 F.3d at 511. The issue in *Openwave* was whether these claim
17 terms should be assigned their “ordinary meaning” or whether, because of repeated disparagement in the
18 specification of prior art “intelligent devices,” the claim terms should be interpreted not to include mobile
19 devices containing “computer modules.” *Id.* at 511-12. At the time of the invention in 1995, “intelligent
20 devices” could not be updated without physically changing the devices themselves, were large in size,
expensive to produce, had problems with battery life, and did not have sufficiently powerful processors.
Id. at 512. The patentee devised a way of dividing the computing power between a mobile device and a
remote server, thereby eliminating the need for the mobile device to have full computing capacity. *Id.* In
the specifications, the patents indicated that a cellular telephone was “not a combination of a computer
module and a wireless communication module as in prior art attempts to create an intelligent telephone”
and that a cellular telephone used “only a microcontroller” and did not require “a separate computer
module as in the prior art.” *Id.* at 514. The specifications were “rife with remarks that disparage and,
therefore, disclaim mobile devices that incorporate computer modules,” and the Federal Circuit affirmed
the district court’s conclusion that the claim terms excluded devices employing “computer modules,” but
not those incorporating “microprocessors.” *Id.* at 514 & 517.

21 ³ In *SciMed*, which involved two types of catheters in the prior art, namely dual lumens or coaxial lumens,
22 the Federal Circuit held that the patentee disavowed dual-lumen configurations by disparaging them in the
23 specification and by repeatedly describing the present invention as using the coaxial design. 242 F.3d at
1340-45.

1 c. **Disclaimer in Prosecution History**

2 An inventor may also disavow claim scope by disclaiming it while prosecuting the
3 patent. *See Springs Window Fashions LP v. Novo Indus., L.P.*, 323 F.3d 989, 994 (Fed.
4 Cir. 2003) (“the prosecution history limits the interpretation of claim terms so as to
5 exclude any interpretation that was disclaimed during prosecution”). Arguments made
6 during prosecution to overcome prior art must be considered when construing the claims
7 of a patent in order to protect the public’s right to rely on such statements. *Rheox, Inc. v.*
8 *Entact, Inc.*, 276 F.3d 1319, 1325 (Fed. Cir. 2002); *see also Omega Eng’g, Inc. v. Raytek*
9 *Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003); *Springs Window*, 323 F.3d at 995 (“The
10 public notice function of a patent and its prosecution history requires that a patentee be
11 held to what he declares during the prosecution of his patent.”). Nevertheless, the
12 standard for prosecution history estoppel is a “high one.” *Avid Tech., Inc. v. Harmonic,*
13 *Inc.*, 812 F.3d 1040, 1045 (Fed. Cir. 2016).

14 For a disclaimer to attach, the allegedly “disavowing actions or statements made
15 during prosecution [must] be both clear and unmistakable.” *Id.*; *see also Springs*
16 *Window*, 323 F.3d at 994 (indicating that a disclaimer “must be effected with ‘reasonable
17 clarity and deliberateness’”). If the prosecution history is merely vague, ambiguous, or
18 “amenable to multiple reasonable interpretations,” the Court must refrain from narrowing
19 the claim scope on prosecution disclaimer grounds. *Avid*, 812 F.3d at 1045; *see Omega*,
20 334 F.3d at 1324 (indicating that the Federal Circuit has “declined to apply the doctrine
21 of prosecution disclaimer where the alleged disavowal of claim scope is ambiguous,” but
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1 when the patentee “has unequivocally disavowed a certain meaning to obtain his patent,”
2 the claims will be interpreted in a manner “congruent with the scope of the surrender”).

3 Defendants suggest that, in a November 2013 response to non-final office action,
4 the patentee disclaimed transitioning between downhill and touring positions without the
5 footwear attached. In the November 2013 response, Claim 1 was amended to include the
6 limitation “wherein single motions of a lever in opposite directions result in complete
7 movement in opposite directions between the downhill and touring positions.” Ex. 2 to
8 Defs.’ Brief (docket no. 19-2 at 3). Former Claim 41, which became Claim 11, was also
9 amended to include this same limitation. *Id.* (docket no. 19-2 at 6). Moreover, a new
10 claim, identified as Claim 65 and later renumbered as Claim 29, was proposed, with the
11 following explanation:

12 [W]e submit that the additional features recited in enclosed claim 65 will
13 avoid these Examiner’s allegations because Schiele et al. is not applicable
14 in the manner suggested by the Examiner. The Examiner alleges that
15 Schiele et al. discloses a toe unit configured to grip the footwear at only the
16 footwear toe to retain the footwear on the snow travel aid independent of
17 the heel unit while permitting forward and rearward pivoting. . . .
18 However, Schiele et al. does not disclose a toe unit that is configured to
19 grip footwear at only the footwear toe and retain the footwear on the snow
20 travel aid independent of the heel while permitting forward and rearward
21 pivoting. . . . The portions identified by the Examiner as toe and heel units
22 in the device of Schiele et al. translate forward or rearward together, as a
23 single unit. . . . The cited references contain no suggestion that with such a
toe heel unit combination, one can make use of rearward translation of the
heel unit to disconnect the heel unit while the toe continues to grip the
footwear to allow for touring.

20 *Id.* (docket no. 19-2 at 14-15) (emphasis added).

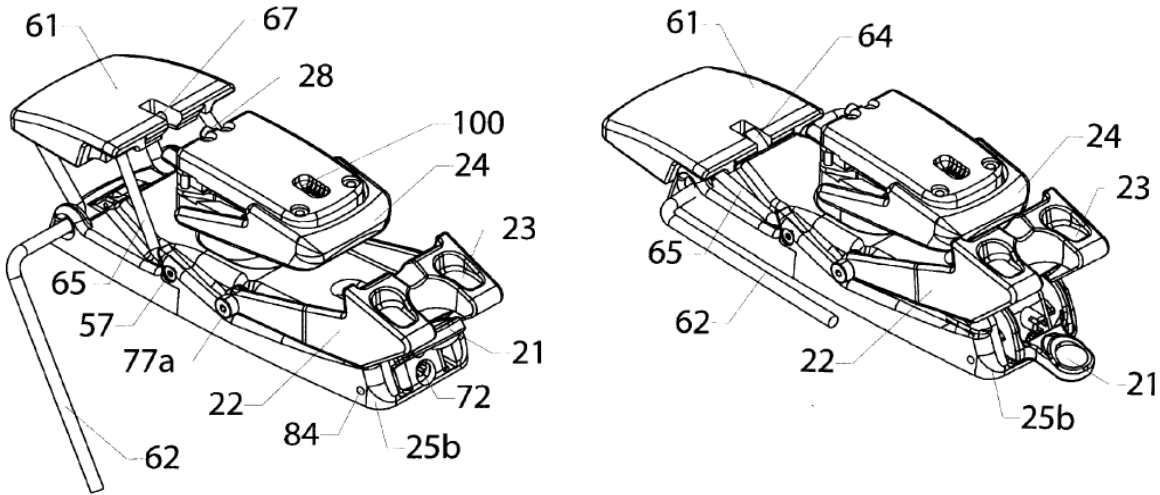
21 Nothing in the prosecution history cited by defendants indicates that the footwear
22 must remain attached to the upper portion during the transition between downhill and
23

1 touring modes. Rather, the amendments to Claims 1 and 11 (née 41) required only that
2 “single motions of a lever in opposite directions” accomplish complete movement
3 between the downhill and touring positions. This language does not require that the
4 footwear be attached to the upper portion for the lever to switch back and forth and
5 satisfy the claim limitation. With regard to the clarification concerning the prior art
6 (Schiele et al.), to the extent defendants contend the patentee’s statements narrowed the
7 scope of Claims 1 and 11, their argument ignores the context of such statements. The
8 patentee’s comments pertained only to the new claim originally denominated as
9 Claim 65, which became Claim 29, and thus, they provide no basis for importing into
10 Claims 1 and 11 the proposed “when/while footwear is attached to the upper portion”
11 limitation.

12 As to Claim 29, the above-quoted material regarding the prior art merely explains
13 that, contrary to the Examiner’s belief, the Schiele patent does not disclose a toe unit that
14 would retain the toe of the footwear on the snow travel aid independent of the heel, but
15 instead involves toe and heel units that move forward and backward in tandem. The
16 Schiele invention is therefore distinguishable because the ’728 Patent describes a heel
17 unit that moves forward and backward with respect to the toe unit. This difference
18 between the prior art and the invention at issue would exist regardless of whether the
19 footwear was attached to the snow travel aid. Defendants simply have not offered, in
20 support of their proposed claim term constructions, the type of “clear and unmistakable”
21 or “reasonably clear and deliberate” statements that reflect an “unequivocal disavowal”
22 of claim scope.

1 **2. Brake Holder**

2 The following diagrams from the '728 Patent depict the heel unit of Claim 1, with
3 integral snow brake, in both downhill and touring configurations:



11 '728 Patent at Figs. 20B & 22B. The drawing on the left shows the downhill mode, in
12 which, in the absence of a ski boot, the brake platform (61) is elevated, and the brakes
13 (62) are in the deployed position. In the figure on the right, the brake platform (61) is
14 latched and the brakes (62) are locked in the raised position to allow for ascent or touring.

15

16 To lock the brakes in the raised position for touring, downward pressure must be
17 applied to the brake platform after the heel unit has been transitioned to the touring mode.
18 Defendants assert that, because this extra step of pushing down on the brake platform is
19 required, the brake holder does not switch from downhill to touring mode automatically.
20 Defendants further postulate that, if a user applied the necessary downward force to the
21 brake platform with his or her hands, as opposed to his or her ski boot, the brake holder
22 of the '728 Patent would not be novel over the prior art. Thus, with respect to the "brake
23

holder” term of Claim 1, defendants propose three alterations: (i) substitute “with” for “in response to movement of”; (ii) substitute “to hold” for “the break holder for holding”; and (iii) add the phrase “without two-handed or dual motion activity on the part of a user when transitioning between downhill and touring positions.” These suggested changes are highlighted in the following chart.

TERM	Claim 1	Defendants’ Proposed Construction
BRAKE HOLDER	a brake holder moveable in response to movement of the upper portion between the downhill and touring positions, the brake holder for holding the brake in the raised position when the upper portion is in the touring position	a brake holder moveable with the upper portion between the downhill and touring positions, to hold the brake in the raised position when the upper portion is in the touring position <u>without two-handed or dual motion activity on the part of a user when transitioning between downhill and touring positions</u>

Defendants’ views stem from a misunderstanding about the apparatus disclosed in Claim 1 of the ’728 Patent. Although defendants are correct that, after the actuator or lever (21) is moved from the downhill to the touring position, the user must depress the brake platform in order to raise and lock the brakes, defendants’ focus on this activity, which occurs after, and not contemporaneously “with” the upper portion’s transition from the downhill to the touring position, is misplaced. The claimed scope of the “brake holder” involves the latching mechanism underneath and adjacent to the brake platform, which changes configuration when the lever is switched between the downhill and touring positions. In the downhill mode, the hook (64) will not engage with the brake platform, whereas in the touring mode, it “is rotated forward such that when the platform is forced downward to raise brake arms 62 from the snow, latch portion 67 of brake link 65 will engage the hook and the brake platform will be retained in a position with brake

1 arm 62 elevated from the snow.” See ’728 Patent at Col. 14, Lines 30-40. Contrary to
2 defendants’ premise, the brake holder (as opposed to the brake platform) does, in fact,
3 “automatically” switch from a downhill (incapable of locking) to a touring (capable of
4 locking) configuration. The claim language “moveable in response to movement of the
5 upper portion between the downhill and touring positions” adequately captures this
6 concept, and defendants’ attempt to incorporate an additional requirement that the brake
7 platform be subsequently secured during a hands-free operation is improper.⁴

8 In addition, defendants’ reliance on the theory of prior art disparagement is
9 misplaced. In a discussion of the prior art, the patentee indicated:

10 The snow brake for the DYNAFIT™ binding is positioned to not contact
11 snow while in the touring mode by the user forcing the heel plate of the
12 brake downwards while simultaneously rotating the heel unit to a position
13 in the touring mode. This requires a two-handed or other dual motion
14 activity on the part of the user, which can be difficult to accomplish while
15 in deep snow or when poised in a precarious location.

16 ’728 Patent at Col. 2, Line 32-39. As with the “footwear attached” limitation defendants
17 wanted to incorporate into other claim terms, defendants fail to identify a statement in the
18 specification that rises to the requisite level of disparagement, and they point to no word
19 or phrase actually appearing in the “brake holder” term of Claim 1 that must be construed
20 in light of any disparagement of the prior art. See SciMed, 242 F.3d at 1344 (claim
21 construction “begins and ends in all cases with the actual words of the claim”); compare
22 Fenner Invs., Ltd. v. Cellco P’ship, 778 F.3d 1320, 1323-26 (Fed. Cir. 2015) (affirming

21 ⁴ Defendants’ proposed language is also illogical given the nature of the invention. It attempts to exclude
22 from claim scope only two-handed or dual motion activity, but the amount and direction of force required
23 to depress the brake platform can be generated with only one hand and in a single motion.

1 the district court’s ruling that, based on the specification and prosecution history, the term
2 “personal identification number,” in the context of personal communication services,
3 meant the number associated with an individual, and not the number assigned to a
4 particular device). Defendants are simply attempting to create a limitation where none
5 previously existed.

6 **3. Claim Construction Is Not Required**

7 The Federal Circuit has recognized that “[w]ords are symbols, linguistic
8 embodiments of information sought to be communicated, and, as such, can be imperfect
9 at representing their subject.” *Fenner*, 778 F.3d at 1323. “Judicial ‘construction’ of
10 patent claims aims to state the boundaries of the patented subject matter, not to change
11 that which was invented.” *Id.*; *see also Renishaw*, 158 F.3d at 1250 (“The construction
12 that stays true to the claim language and most naturally aligns with the patent’s
13 description of the invention will be, in the end, the correct construction.”). With respect
14 to the four claim terms at issue, defendants have not identified any word or phrase that
15 inadequately or confusingly expresses the scope of the invention; rather, defendants seek
16 to rewrite the language that received the United States Patent and Trademark Office’s
17 imprimatur.

18 The four claim terms at issue require no interpretation. Although plaintiff has
19 offered its own constructions, they merely restate the claim terms using slightly different
20 sequences of the words in the claim terms and/or their synonyms. The Court need not
21 engage in a similar effort. *See Ballard Med. Prods. v. Allegiance Healthcare Corp.*, 268
22 F.3d 1352, 1358 (Fed. Cir. 2001) (“*Markman* does not require a district court to follow
23

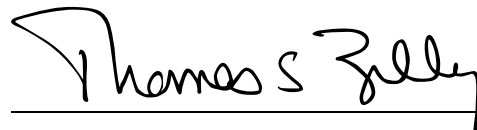
1 any particular procedure in conducting claim construction. It merely holds that claim
2 construction is the province of the court, not a jury. . . . As long as the trial court
3 construes the claims *to the extent necessary* to determine whether the accused device
4 infringes, the court may approach the task in any way that it deems best.” (emphasis
5 added)); *Static Control Components, Inc. v. Lexmark Int’l, Inc.*, 502 F. Supp. 2d 568,
6 575-76 (E.D. Ky. 2007).⁵ The “upper portion,” “complete movement,” “single motions,”
7 and “brake holder” terms of Claims 1, 11, and/or 29 are entirely self-explanatory.

8 **Conclusion**

9 For the foregoing reasons, the Court DECLINES to further construe the disputed
10 claim terms. The Court makes no ruling concerning whether the independent and/or
11 dependent claims of the ’728 Patent “read on” the allegedly infringing devices.

12 IT IS SO ORDERED.

13 Dated this 25th day of August, 2016.

14
15 

16 Thomas S. Zilly
17 United States District Judge

18
19 ⁵ In *Static Control*, the district court criticized one side’s “exhortation to attach a synonym to self-defined
20 and simple words” because it invited “a meaningless result that mocks the notion of construction.” 502
21 F. Supp. 2d at 576. The district court used as an example the term “dog,” which a party might argue, in
22 light of intrinsic evidence, must be construed as weighing less than 50 pounds. *Id.* at 575. Such party
23 might also contend that its accused dog is non-infringing because it weighs more than 50 pounds.
According to the district court in *Static Control*, determining whether a “dog” has a maximum weight
would be an exercise in claim construction. *Id.* On the other hand, deciding whether “dog” means
“canine” is a pointless endeavor, prompting the query of how an accused “dog” would infringe but an
accused “canine” would not. *Id.*