TechRoadmap Directions

Intellectual Property Issues of Interest to High Tech Companies

Vol 6 Issue 5 **May-June 2006**

in this issue

Who else should read this?

Click the Mailbox to go to an on-line version of *Directions* suitable for forwarding.

Request a no cost review

We would be happy to schedule a visit to your facility to help you review the good and not so good IP practices you use. Sign up on our web site with the link below.

Request a Review

IP Links of Interest

- **US Patent Office** A host of useful, official information.
- **UTEK-EKMS** A strategic IP management partner of TechRoadmap.
- **The Patent Cafe** An on-line portal for IP matters.
- **AlvaMed, LLC** A medical device consulting company we work with.
- **Technology Insurance Special Risk** An specialist in insurance for technology companies - for example, patent insurance
- **Forward this newsletter** Takes you to the on-line version for forwarding

Welcome

Directions is published 11 times a year - usually with a combined July/August issue. This year we are combining the May and June issues.

Imagine walking into a store and seeing what you believe to be your patented invention sitting on the shelf - being sold by someone with whom you had once been in license negotiations. That's what happened to Dr. Harold Shoenhaus when he went into a Johnson & Murphy shoe store in 2002. **He promptly sued**.

This month's Directions examines what happens when someone forgets that in your claims, every word is presumed to be there for a reason and will be examined with great care by the court.

Every Movement Has a Meaning

In the Hula, nothing is arbitrary - as the saying goes, every little movement has a meaning of its own. So too with your patent claims. Extra words mean extra limitations and careless words can change what you intended.

Acting as your Director of Intellectual Property, TechRoadmap will work with your patent attorney to develop the best claim set possible.

If the claims fit...

The last thing Dr. Harold Schoenhaus expected to see in the Johnson & Murphy (J&M) shoe store was a shoe incorporating a heel cup to prevent hyperpronation. He was surprised because such an orthotic was an invention he patented a decade earlier, tried to license to Johnson & Murphy, and ultimately ended up with no license agreement.

When he sued, J&M fought back. They pointed out that Schoenhaus had patented a rigid orthotic insert to go into a shoe, whereas they sold a shoe that **provided the function of Schoenhaus's heel cup but without all of the specific limitations** in Schoenhaus's claims. The District Court, and then the CAFC, agreed with J&M.

Where did Schoenhaus go wrong? Basically he (or his attorney) put **too many words in his patent claims and didn't use those words in a consistent manner**. Claims 1 and 2 of the patent read in relevant part:

1. An ***orthotic device*** for preventing hyperpronation of a human foot comprising a ***deep rigid*** heel seat to cup the calcaneus, said heel cup being medially offset and laterally tilted by a sufficient amount to maintain the calcaneus in approximately 5 degrees of varus . . . .
2. A footwear product having as an element thereof an ***orthotic device*** as claimed in claim 1.

The J&M shoe *was* indeed a "footwear product" that provided the same support as the invention. And Schoenhaus *had* described in the application that his invention could be a shoe that incorporated this support function. But **the court ruled he never claimed the specially built shoe, thereby dedicating that part of his invention to the public**.

Claim 2, which Schoenhaus thought covered this aspect of his invention was flawed. If, as he suggested, one definition of the invention (the "orthodic device") is "*a shoe with a special heel cup*", then substituting that definition into claim 2 yields: **"A shoe including *a shoe with a special heel cup*". This is not a valid claim.** Since claims are presumed valid once a patent issues, the patent examiner "must" have rejected the "shoe with a special heel cup" as a version of the invention.

Okay, said Schoenhaus, let the invention be just the heel cup. The J&M shoe does have a semi-rigid heel cup and therefore infringes. Nope. In claim 1, the independent claim, the scope of the invention (an "orthotic device") is limited by the two modifying adjectives, "deep" and "rigid". And try as he might, Schoenhaus **could not convince the court that "rigid" in the claim meant anything other than the ordinary meaning of rigid** (particularly since the examiner had suggested its inclusion).

Schoenhaus learned the hard way that every word in a patent's claims has a meaning that does not change, so if word meanings in your claims don't fit your invention, you had better try on another size.

What Are Your Thoughts?

Has the wording of a patent claim ever caused you a problem? Have you, like Dr. Schoenhaus, found out a patent didn't protect you like you expected? Or have you thought you had to license a patent, only later to discover that you were not really blocked from building your product?

Let me know your experiences. Reply to this email or send me a note directly at bruceahz@techroadmap.com

Disclaimer

Nothing in this newsletter should be construed as legal advice. TechRoadmap serves as an interface between companies and their legal counsel.

:: bruceahz@techroadmap.com
:: http://www.techroadmap.com
617-243-0007