United States District Court,
D. Maryland.

Anthony John ANTONIOUS Plaintif,
Anthony John ANTONIOUS Plaintiff.
v.
SPALDING & EVENFLO COMPANIES, INC,
et al Defendants.

April 27, 1998.

MEMORANDUM AND ORDER RE PATENT CLAIM CONSTRUCTION

GARBIS**, District J.**

In this case, Plaintiff sues Defendants for infringement of certain claims of U.S. Patents 5,328,184 ("the '184 Patent") and 5,482,279 ("the '279 Patent"), as well as for infringement of Design Patents Des. 320,056 ("Des.' 056") and Des. 327,308 ("Des '308"). Pursuant to the Amended Scheduling Order, the parties have filed materials relating to what they have identified as claim construction issues. The Court has held a hearing in accordance with Markman v. Westview Instrument, Inc., 116 S.Ct. 1384 (1996) regarding claim construction issues. The Court has considered, for background purposes, the testimony of witnesses FN1 presented at the *Markman* hearing and has had the benefit of the arguments of counsel.

FN1. Each side presented a patent law expert who gave his opinion regarding the prosecution history of the patents at issue and other matters. The opinions have been considered as argument based upon undisputed facts, i.e. the context of the prosecution history file and the patents at issue. In addition, the Defendants presented the testimony of Steven Mahaffey, Director of Product Development and Quality Control for the Top Flight Golf Club Company, a business unit within Spalding Sports Worldwide.

I. *GENERAL PRINCIPLES*

The construction of patent claims is a matter for the court. Markman v. Westview Instruments, Inc., 116 S.Ct. 1384, 1396 (1996). In the process of claim construction, the focus is upon what a person skilled in the pertinent art would have understood to be the meaning of the claim language. Markman v. Westview Instruments, Inc., 52 F.3d 967, 986 (Fed.Cir.1995) (en banc), *aff'd,* 116 S.Ct. 1384 (1996). The court must first look at the basic evidence of record, namely, the language of the claim, the specification, and the prosecution history. Insituform Tech., Inc. v. Cat Contracting, Inc., 99 F.3d 1098, 1105 (Fed.Cir.1996), *cert. denied* 117 S.Ct. 1555 (1997). The claim language itself defines the scope of the claim. Therefore, "a construing court does not accord the specification, prosecution history, and other relevant evidence the same weight as the claims themselves, but consults these sources to give the necessary context to the claim language." Eastman Kodak Co. v. Goodyear Tire & Rubber Co., 114 F.3d 1547, 1552 (Fed.Cir.1997). Although extrinsic evidence such as expert testimony may be considered if needed to assist the court in

understanding the technology at issue or in determining the meaning or scope of technical terms in a claim, Hoechst Celanese Corp. v. BP Chem. Ltd., 78 F.3d 1575, 1579 (Fed.Cir.), *cert. denied,* 117 S.Ct. 275 (1996), reliance on any extrinsic evidence is improper where the public record, i.e., the claims, specification, and file history, unambiguously defines the scope of the claims. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed.Cir.1996).

The Court of Appeals for the Federal Circuit has held that claims should be read in view of the specification. *See, e.g.,* id. at 1582. However, the Federal Circuit cautions against limiting the scope of a claim to the preferred embodiment or specific examples disclosed in the specification. *See, e.g.,* Ekchian v. Home Depot, Inc., 104 F.3d 1299, 1303 (Fed.Cir.1997); *see also* Intervet Am ., Inc. v. Kee-Vet Lab., Inc., 887 F.2d 1050, 1053 (Fed.Cir.1989) ("[L]imitations appearing in the specification will not be read into claims, and ... interpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper." ') (citation omitted).

There is presumed to be "a difference in meaning and scope when different words or phrases are used in separate claims." United States v. Telectronics, Inc., 857 F.2d 778, 783 (Fed.Cir.1988). There is a presumption against construing claims as being so similar as to "make a claim superfluous." *Id.*

II. ***THE '184 PATENT***

The '184 Patent was granted for an alleged invention concerning iron-type golf club heads. The patent discloses golf iron heads with the usual flat striking surface having a rear cavity surrounded by a peripheral mass and a single weight bar as illustrated by Figures 1 and 3:

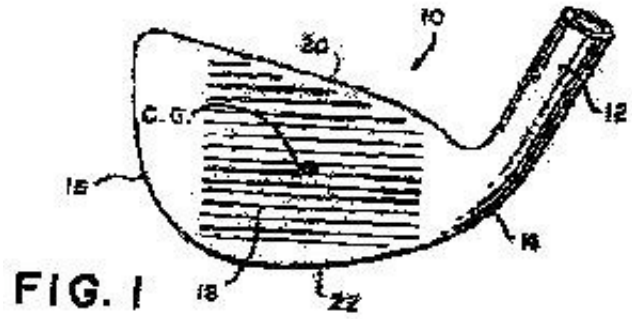


FIG. 1

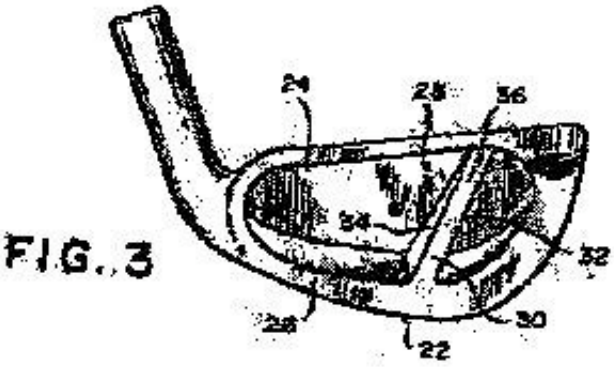


FIG. 3

According to the patent disclosure, the placement of the weight bar improves the transfer of energy to the golf ball when struck. The patent also discloses a set of golf clubs with different placements of the weight bar for each of the differently lofted irons.

A. ***Formed on and Attached Solely to Said Rear Wall Within Said Cavity*** **(Claim 1)** FN2

FN2. This reference to Claim 1 indicates that the quoted language appears in the indicated claim and may, by incorporation or repetition, be in other claims as well.

The parties place at issue the construction to be put on the language that limits the invention to a club head that has "a single weight member formed on and attached solely to said rear wall within said cavity."

The Defendants contend that these words of the claim should be read to mean precisely what the words say. That is, that the weight member is attached solely (i.e.only) to the rear wall (backside of the striking surface) within the cavity. Therefore, the claim would not read on a club having the weight member attached to the peripheral mass and, therefore, not attached *solely* to the rear wall.

Plaintiff states that "the written claims in the utility patents should be construed according to their plain and ordinary meaning. Because the claims are clear on their face, no further interpretation is required." Plaintiff's Opening Brief at 3. However, the Plaintiff then proceeds to argue that this Court should ignore the clear plain meaning of the words "attached solely to said rear wall." Plaintiff wishes these words to mean that in addition to FN3 being attached to the rear wall, the weight member can be attached to the peripheral mass. In an effort to find some meaning for the subject limitation, Plaintiff argues that the term "formed on and attached solely to said rear wall" means that the back bar mass is formed on and attached solely to the club head's rear wall as opposed to being attached to other club structure separate from the rear wall. The Court cannot agree.

FN3. And, perhaps, instead of as well.

Plaintiff argues that the limitation at issue, "attached solely to said rear wall" was added to avoid the prior art in the Sugioka Patent, No. 4,602,787. Defendant argues that the limitation was added to avoid the prior art in the Winquist Patent, No. 3,814,437.

If the subject limitation were added simply to avoid Sugioka, it was drafted far more broadly than necessary. The Court should not rewrite the claim language to narrow a limitation to that which the patentee might have "needed" to avoid a particular reference. On the Sugioka avoidance theory, the patentee deliberately chose to abandon more than was necessary. He cannot rewrite the claim to recover the abandoned coverage at the present stage.

To the extent pertinent, if at all, the Court concludes that the claim limitation likely was, or at least should have been, included to avoid the Winquist reference. Winquist disclosed a single weight member which is attached to (and integral with) the peripheral mass of the club head. It would have been reasonable to distinguish the alleged invention from Winquist by limiting the claim to a club with a weight mass that is not attached to the peripheral mass, but only to the rear wall.

In any event, whatever the patentee's motivation for including the limitation at issue, the limitation is in the claim and will not be ignored.

Plaintiff argues that the claim construction espoused by the Defendant would result in a claim which did not read on any of the preferred embodiments of the invention disclosed in the patent. Plaintiff is incorrect. Furthermore, even if Plaintiff were correct, he would not prevail on the claim construction at issue.

The patent application, as filed, included disclosed embodiments in which the weight bar was integral with

the peripheral mass. The limitation at issue would result in a claim which did not read on these disclosed embodiments. However, Plaintiff is not correct when he asserts that in every one of the disclosed embodiments, the weight member is integral with the peripheral mass.

In Figures 2, 3, 9, and 10, one can see that the weight bar and the peripheral mass are integral. In others, such as Figures 4-8 and 11-20, one cannot tell whether the weight bar is integral with the peripheral mass. In these figures, an expressed integral connection, shown by the absence of a line at the bottom of member 30 in Figures 2 and 3, is not present. It is, of course, possible that there is an integral connection which would not be shown on certain figures, such as Figures 4-8, because of the angle from which the drawing is made. However, this Court does not see in the figures and disclosure any intent to exclude from the disclosure club heads in which the weight bar mass is separate from the peripheral mass. Fairly and reasonably read, the patent disclosure contains embodiments which can be viewed as ones in which the weight member is other than integral with the peripheral mass.

Moreover, the Court emphasizes that even if one could read the patent disclosure so as to include only embodiments in which the weight bar was integral to the peripheral mass, the claim construction would be no different. This patentee used clear language to add a limitation which excludes from coverage a club head in which the weight member is not "attached *solely* to said rear wall."

Plaintiff argues that the patent examiner must have understood the term at issue to cover a club in which the weight member was integral with the peripheral mass. This contention is based upon the fact that examiner asserted that the Gorman Patent No. 5,048,835 "anticipated" FN4 the claimed invention. In the course of prosecution, the patentee never had to confront this conclusion because he was able to persuade the examiner that Gorman was not prior art.FN5

FN4. Gorman would "anticipate" the claim if in Gorman there is found every limitation in the claim, including, therefore, the "attached solely to" limitation. Glaxo, Inc. v. Novapharm Ltd., 52 F.3d 1043, 1047 (Fed.Cir.), *cert. denied,* 116 S.Ct. 516 (1995).

FN5. Plaintiff filed a Declaration Under 37 C.F.R. 1.131 in which he swore that he had reduced his invention to practice prior to the filing date of the Gorman patent.

It is true that using Gorman as an anticipation reference would be contrary to the construction that the Court places upon the subject claim language. However, it is apparent to the Court that the examiner's assertion was, simply, erroneous. To the extent that the examiner may have focused on the matter, he came to the wrong conclusion. This Court has considered, and finds most unreliable, the conclusion of the patent examiners that Gorman shows a "single weight member FN6 ... attached solely to the rear wall."

FN6. Moreover, Gorman does not disclose a club with a *single* weight member, but, rather, one with two or three weight members as shown in Figure 8:



Plaintiff argues that the fact that counsel for the Defendants did not address the "attached solely to" limitation in certain opinions provided to Defendants indicates the invalidity of their position. However, the instant process is not one in which the Court is reviewing, for comprehensiveness or accuracy, the contemporaneous opinions of Defendants' counsel. It may well be that the "attached solely to" argument was a "late starter." However, on its merits, the position is correct.

In sum, the claim language at issue is interpreted to mean what it says. The weight member must be attached solely (i.e.only) to the rear wall (backside of the striking surface) and not attached also to the peripheral mass within the cavity.

B. ***Said Weight Member Consisting Essentially of*** FN7 ***a Single Back Bar Mass*** **(Claim 1)**

FN7. The parties agree that the term "consisting essentially of" as used in the subject phrase means that the back bar mass does not have any elements that would substantially affect the characteristics of the claimed invention in addition to those elements set forth in the claim.

The Defendants seek to read into the foregoing language the additional limitations that the back bar mass have planar surfaces with uniform width. However, the Court does not find it appropriate to read these limitations into the words "back bar mass." Indeed, Claims 14, 15, and 16 (which depend from Claim 1) add limitations including planar sides and, to a degree FN8, uniform width. It may be, as Defendants contend, that these dependent claims add more limitations than just a requirement for planar surfaces and uniform width. Nevertheless, in context, the dependent claims are written consistent with the conclusion that independent Claim 1 lacks limitations of planar surfaces and uniform width. The Court, therefore, construes the subject language to mean what it says or, more precisely, not to mean what it does not say. The term "back bar mass" in Claim 1 is not limited to masses having planar surfaces and uniform width.

FN8. Claim 14 refers to the bar as "generally rectangular in shape."

C. ***Center of Gravity*** **(Claim 1)**

The term "center of gravity" is not used to mean the single point (in a three dimensional sense) at which the club head is balanced along the x, y, and z axis. Rather, in context, the term is used to mean the point on the striking face of the club at which the club head would be balanced on a pivot. The true three dimensional center of gravity point would, necessarily, be to the rear of the club striking face since the striking face is, by definition, a planar surface at the front of the club. Therefore, the true three dimensional center of gravity would have to be somewhere behind the striking face-either inside a part of the club or in a cavity behind the rear wall of the striking surface.

There may well be problems with the patentee's use of the term "center of gravity." In the disclosure, he uses the term "center of gravity" and "center of percussion" as if these refer to the same point. However, the

terms are not synonymous.

The Court construes the claim language "center of gravity" in the claim to have the ordinary, in context, meaning of that particular term. That is, the point on the striking face of the club head at which the club head would be in static balance on a pivot point and not the literal three dimensional center of gravity. The center of gravity apparently cannot be at the center of percussion.FN9 The Court is not now deciding any issue which might be presented by virtue of any misuse of the terms "center of gravity" and "center of percussion."

FN9. It appears that the center of gravity (defined in static context) and the center of percussion (defined in dynamic context) may never be at the same place since the movement of the club head will cause the center of percussion to be closer to the toe than the center of gravity.

D. ***Back Bar Mass Being Sized to Provide a Significant Mass at its Point of Location to Enhance the Energy Transfer of a Golf Ball Being Struck During the Execution of a Golf Stroke*** **(Claim 1)**

The Defendants contend that the subject language should be interpreted to require that the mass be located at the center of percussion. Tr. at 345. FN10 This argument is then tied to the argument that "center of gravity" and "center of percussion" are at the same place. The end result would be that the claim would be internally inconsistent. That is, the claim would expressly call for the mass being "offset ... from ... the club's center of gravity" yet also require that the mass be placed at the center of percussion, which, per the Defendants' argument, is the same place as the center of gravity. The Defendants' position would render the claims incomprehensible.

FN10. Transcript references herein refer to the claim construction hearing held on March 26-27 and April 2 of this year.

The Court does not find a locational limitation in the subject phrase that would require the mass to be at the center of gravity.

E. ***A Set of Iron Type Golf Club Heads*** **(Claim 24)**

Defendants contend that the term "a set of iron type club heads" used in independent claim 24 and dependent claims 25 and 26 includes the limitation that the clubs in the set have the weight bar in the low lofted clubs FN11 be on the toe side of the clubs and the high lofted clubs have the weight bar on the heel side of the clubs. That is, the Defendants seek a limitation whereby the high lofted clubs have the weight bar between the center of gravity and the heel and the low lofted clubs have the weight bar between the center of gravity and the toe.

FN11. It seems agreed that irons 1 through 6 are low lofted while irons 8, 9, PW, and SW are high lofted. A 7 iron could be viewed as either high or low lofted for purposes of this discussion.

There are at least two major problems with Defendants' position.

1. Independent Claim 21 expressly includes the limitations Defendants seek.

2. Independent Claim 24 speaks only of the movement of the weight bar away from the toe as the loft increases. The Claim does not state that, at any stage, the weight would move to the heel side of the center of gravity.

The Court finds that the term "set of iron type golf club heads" does not include a limitation that the weight mass must be on the heel side of the center of gravity for the higher lofted clubs.

F. ***Back Bar Mass*** **(Claim 1)**

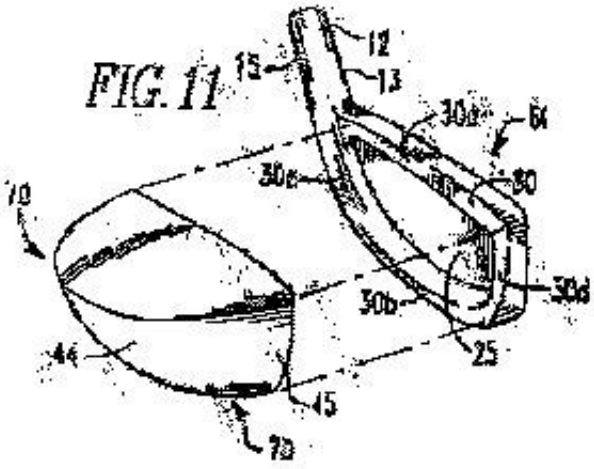
Plaintiff contends that the word "bar" is to be given its ordinary dictionary definition as an object "which is longer than it is wide". *See* Webster's Third New International Dictionary 73-74 (1981). Alternatively, "bar" is defined as "a piece of any material long in proportion to its thickness or width." *See* Oxford English Dictionary 165 (compact ed.1988).

The Defendants seek a broader definition of the word "bar" so as to exclude the requirement that the bar mass has a length greater than its width. Defendants say, for example, that a "bar" could be shaped as a square. However, the Defendants have not proposed a construction for the word "bar" that would include a square. Indeed, Defendants seem to be contending that the word "bar" should be construed to mean an object of any shape at all.

The Court does not find it appropriate to take the shape limitation inherent in the word "bar" out of the claim. The word "bar" will be given its above-quoted ordinary dictionary definition.

III. ***THE '279 PATENT***

The '279 was granted for an alleged invention concerning wood type golf club heads. The disclosed club heads have a striking surface with a peripheral mass and a hosel integrally connected to the club head body as shown by Figure 11:



The placement of the peripheral mass and hosel pursuant to the patent disclosure is alleged to add strength and stability to the club head and minimize pinging when the ball is struck.

A. ***A Hosel Integrally Connected to Said Club Head Body***

The parties allude to some disagreement as to the construction of these terms, but their respective contentions seem to boil down to agreement that "the words [have] their common ordinary meaning." Tr. at 358. Apparently, the debate regarding this term is going to be one as to its application to accused products rather than claim construction.

B. ***Said Club Head Body having a Frontal Body Section and a Rearward Shell Attached to Said Frontal Body Section at the Interface of Said Frontal Body Section and Said Rear Shell*** **(Claim 13)**

The parties debate whether the foregoing language is merely a point of reference or is a limitation with regard to the assembly of the finished club.

Spalding contends that the claim is limited to a club which has (1) a frontal section (comprising the ball striking face, rear club face and a peripheral mass) attached to a(2) rearward shell. Plaintiff seeks to have the words construed to merely reflect the fact that the club head is described in terms of two sections.

The Court concludes that the Defendants' position is correct. The claim requires that the club head have two sections, a frontal portion and a rear portion, which are attached to each other. As stated in the patent, "The frontal body section of the club head includes the ball striking face, a rear club face spaced rearwardly from and opposite the ball striking face, and a peripheral mass that projects outwardly from the rear club face." Col. 2, lines 31-34. The rear portion is a shell.

Plaintiff argues that the claim language broadly covers any finished wood type club head having a front portion and a rear portion. This would essentially remove the limitation that there be two portions that are attached.

The Court's conclusion is confirmed by a review of the Lo Patent No. 5,271,621 and the examiner's comments on the reason for the allowance of Claim 13 (20 as originally filed). The examiner stated:

Claims 20 [13 as issued]-46 are allowable over the prior art of record. Regarding claim 20 [13 as issued], the prior art lacks the teaching for a frontal body section comprising the ball striking face, the rear club face and the peripheral mass and wherein the frontal body section is attached to a rearward shell.

'279 Patent Prosecution History at 67. Thus, the described club must have two sections, a frontal section and a rearward shell, that are attached.

C. ***A Metal Wood-Type Golf Club Head*** **(Claim 13)**

The Court concludes that the subject term should be construed to refer to a type of golf club that had traditionally been made of wood. Drivers and fairway woods are such clubs. There may be others. Spalding seeks to have the term include all metal clubs which have a hollow head structure.FN12 This would encompass, it appears, certain clubs that were not traditionally made of wood, but which were made of metal in the first place. On this theory, the claim language would include products which Spalding refers to

as "trouble woods, hybrid irons (wood, utility woods, etc.) composed of hollow, metal bodies or shells." Defendants' Response at 31.

FN12. Traditionally, woods were made of solid wood, but metal "wood" clubs are hollow or filled with foam. Metal clubs are not solid metal. In fact, a solid metal wood-type club may well be too heavy for practical use.

The Court concludes that metal clubs with hollow heads other than drivers and fairway woods may well be analogous to wood-type golf clubs. But, they are not wood-type golf clubs in the context of the patent unless they are types of clubs that were traditionally made of wood.

In connection with the dispute over the construction of "wood-type club", the parties debate whether the following language adds a limitation to the claim: "thereby providing added strength and stability to the club head and minimizing pinging of the club head when ball contact is made."

This time,FN13 Spalding seeks to have the Court treat the quoted language as a non-limiting description of the effect of the previously described structure. Plaintiff, this time,FN14 seeks to have the Court give operative meaning to the claim language. The Court finds that, to the extent this subsidiary argument is relevant, it finds Plaintiff's position more sound. That is, the quoted claim language should not be ignored altogether. However, this subsidiary issue does not appear to be significant in regard to the "wood-type club" issue.

FN13. Compare Spalding's attempts to have the Court include as limitations language not even found in claims.

FN14. Compare Plaintiff's attempts to ignore other claim limitation language.

D. ***Sole Skimmer Extending Outwardly From the Bottom of Said Club Head in a Front to Rear Direction***

The parties may have some dispute regarding the construction of this language. But, as reflected at the hearing, they seem unable to articulate what their differences are. As stated at the hearing on April 2, 1998:

THE COURT: I don't know what you are disagreeing on.

MR. STROUP: I don't know that we are either ... we seem to both agree that it is a member that extends outwardly from the bottom of the sole.

THE COURT: The bottom of the club.

MR. STROUP: Correct. Extending as the rest of the claim, extending-

THE COURT: Mr. Fagan, I am unable to ascertain what the difference is.

MR. FAGAN: I don't dispute that. I would agree with that as long as it was understood that that member

could be either part of the sole plated-

MR. STROUP: I would certainly not suggest that the claim required that the two members be separate. It goes all the way back to a point we discussed earlier, so I have no disagreement with Mr. Fagan on that.

THE COURT: Wait a minute. Is the issue whether it has to be separate?

MR. STROUP: Not in my mind.

MR. FAGAN: And I don't know, Your Honor, if it is.

THE COURT: You don't know whether it has to be separate?

MR. FAGAN: Right.

THE COURT: Then we don't know if we have a dispute.

MR. STROUP: I don't believe it has to be a separate element, Your Honor, we may not have a dispute.

Tr. at 160-61.

In the current state of the record, there seems to be no issue for resolution with regard to the subject language.

IV. ***THE DESIGN PATENTS***

The Court concludes that no useful function would be served by engaging in a "claim construction" of the design patents separately from the consideration of the motions for summary judgment directed toward such patents. In a summary judgment context, meaningful consideration can be given to the "scope" and "construction" questions in determining whether or not there is a genuine issue of material fact.

V. ***CONCLUSION***

For the foregoing reasons, the Court concludes the following with regard to the construction of the claim terms placed at issue:

A. The '184 Patent

1. The phrase "formed on and attached solely to said rear wall within said cavity" is construed to mean that the weight member must be attached solely (i.e.only) to the rear wall (backside of the striking surface) and not attached also to the peripheral mass within the cavity.

2. The words "said weight member consisting essentially of a single back bar mass" are not construed to impose a limitation that the mass have planar surfaces and uniform width.

3. The words "center of gravity" are construed to mean the point on the striking face of the club head at which the club head would be in static balance on a pivot point.

4. The words "back bar mass being sized to provide a significant mass at its point of location to enhance the energy transfer of a golf ball being struck during the execution of a golf stroke" are not construed to include a locational limitation that the mass be placed at the center of gravity.

5. The words "a set of iron type golf club heads" are not construed to include the limitation that the weight mass must be on the heel side of the center of gravity for the higher lofted clubs.

6. The word "bar" in "back bar mass" is construed to mean an object long in proportion to its thickness or width.

B. The '279 Patent

1. The words "said club head body having a frontal body section and a rearward shell attached to said frontal body section at the interface of said frontal body section and said rear shell" are construed to impose the limitation that the club have two sections which are attached, the frontal section comprising the ball striking face, the rear club face and a peripheral mass and the rearward section being a shell.

2. The words "metal wood type golf club head" are construed to refer to the head for a driver, fairway wood and any other golf club that had traditionally been made from wood.

C. Design patent claim construction shall be considered in connection with any motions for summary judgment and/or jury instruction drafting.

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