United States District Court,
S.D. Iowa, Central Division.

MOMENTUS GOLF, INC,
Plaintiff.
v.
CONCEPT SPORTS, INC,
Defendant.

June 5, 2002.

MEMORANDUM OPINION

PRATT**, J.**

Plaintiff, Momentus Golf, Inc. ("Momentus") brought a complaint for Declaratory Judgment pursuant to 28 U.S.C. s. 2201, seeking declaratory relief stating that a device produced and sold by Momentus, The Momentus Strength Trainer, does not infringe the patent of Defendant, Concept Sports, Inc. ("CSI"), U.S. Patent No. 5,215,307 (the " '307 Patent") and that the '307 Patent is invalid. CSI has brought a counterclaim against Momentus for infringement of the '307 Patent. The parties agreed to submit briefs on the proper construction of the '307 Patent, pursuant to Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed.Cir.1995), *aff'd* 517 U.S. 370 (1996), before proceeding to expert discovery, dispositive motions and trial, and the Court so ordered on April 19, 2002. The Court heard arguments regarding construction of the '307 Patent on May 1, 2002, and now issues this Memorandum Opinion stating how it construes the disputed terms of the '307 Patent.

Interpretation and construction of a patent claim is a matter of law for the court. Markman, 517 U.S. at 389-90. On the other hand, the Federal Circuit has warned that district courts should not "under the rubric of claim construction ... give a claim whatever additional precision or specificity is necessary to facilitate a comparison between the claim and the accused product." PPG Indus. v. Guardian Indus. Corp., 156 F.3d 1351 (Fed.Cir.1998).

To determine the meaning of patent claims, the court should rely on the language of the claim, the specification, and the prosecution history. Vitrionics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). "Claim interpretation begins with the language of the claim itself." National Recovery Technologies, Inc. v. Magnetic Separation Systems, Inc., 166 F.3d 1190, 1195 (Fed.Cir.1999); see also Bell Communications Research, Inc. v. Vitalink Communcations Corp., 55 F.3d 615, 619 (Fed.Cir.1995). The words of a claim are usually given their ordinary and customary meaning as understood by one reasonably skilled in the relevant art. *Vitrionics* at 1582. A patentee may, however, expressly or impliedly define terms in the specification to mean something other than the meaning that it would be given by persons experienced in the field of invention. *Id.* "The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention." *Bell Communications Research* at 621-22. While the specification acts positively in claim interpretation by providing additional information,

the prosecution history acts negatively by eliminating any protection for subject matter that was canceled from claims during prosecution. Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 564 (Fed.Cir.2000)(en banc); *cert. granted, rev'd on other grounds* 2002 WL 1050479, at (U.S. May 28, 2002). "The [C]ourt may receive extrinsic evidence to educate itself about the invention and the relevant technology, but the [C]ourt may not use extrinsic evidence to arrive at a claim construction that is clearly at odds with the construction mandated by the intrinsic evidence." Karlin Technology, Inc. v. Surgical Dynamics, Inc., 177 F.3d 968, 971 (Fed.Cir.1999).

The parties in this case not only disagree on the interpretation of certain terms in the '307 Patent claim, the parties also disagree on which terms they disagree. CSI contends the only term in the '307 Patent claims that requires interpretation is "counterbalanced." Momentus, on the other hand, believes several terms in the '307 Patent claims require interpretation by the Court. Without a doubt, with respect to some of these terms, such as "weights," "on opposite ends," or "simulate hitting a golf ball from a golf tee," Momentus attempts to read ambiguity into fairly clear terms and then it proceeds to request an unusually narrow construction from the Court. With respect to other terms, the Court's construction does appear to serve a useful purpose. In any case, the Court shall examine each claim term for which Momentus seeks construction and determine first whether such construction is necessary and then construe the term if it is necessary.

The '307 patent is the result of prosecution between CSI and the United States Patent and Trademark Office (the "PTO"), which is the relevant background for this Opinion, not the facts of this litigation and the details of the device produced and sold by Momentus.

The '307 Patent contains one independent claim:

A method of training a person to properly swing a golf club and strengthen the muscles for swinging a golf club comprising the steps of;

providing a counterbalanced golf club training device having an elongated shaft with a golf grip located between substantially similar, symmetrical about the longitudinal axis of said shaft, counterbalanced weights on opposite ends thereof, said weights having no ball striking face thereon for striking a golf ball, and

performing the backswing, downswing and followthrough of a golf club swing to simulate hitting a golf ball from a golf tee without striking a golf ball while one of said weights is spaced a substantial distance above a ball teed position.

In its brief, Momentus highlighted several different words or phrases that it believes require further interpretation by the Court. "Counterbalanced device" and "counterbalanced weights," cited as separate terms by Momentus, both relate to the parties' dispute about whether the weights in the device must be equal or balance on a fulcrum between them. Both parties agree the term "counterbalanced" requires the Court's construction and the Court shall analyze these two items together.

The other terms noted by Momentus are (2) "weights," (3) "substantially similar," (4) "on opposite ends," (5) "symmetrical about the longitudinal axis of said shaft," (6) "no ball striking face thereon for striking a golf ball," (7) "backswing, downswing, and follow through of a golf club swing," and (8) "simulate hitting a golf ball from a golf tee without striking a golf ball." Momentus further claims that certain terms are incapable of construction, such as "a golf ball," "a golf tee," and (9) "a substantial distance above a ball teed position."

1. Counterbalanced

Momentus contends that the plain meaning of "counterbalance" is that two weights are in perfect equilibrium about an axis, as two weights would balance on a legal scale. CSI argues for a broader definition of the term. In their initial response to Momentus's interrogatory on their definition of the term, CSI offered several dictionary definitions that alternatively offer constructions as narrow as that which Momentus seeks, and ones that are as broad as that CSI claims, which is that "counterbalance" simply means weights opposing or acting against each other. Just one example is the definition given by the American Heritage Dictionary of the English Language: "1. To act as a counteracting force, influence, or weight to; counterpoise. 2. To oppose with equal force; offset." Other dictionary definitions provided by CSI confirm that the common usage of "counterbalanced" yields two possible interpretations, a narrow one claimed by Momentus and a broad one claimed by CSI. FN1

FN1. Merriam Webster's WWWebster Dictionary: 1: a weight that balance another 2: a force or influence that offsets or checks an opposing force.

Cambridge International Dictionary of English: a weight or force which balance another one.

Online Plain Text English Dictionary: To oppose with an equal weight or power; to counteract the power or effect of; to countervail; to equiponderate; to balance.
The evidence strongly points to CSI's broader interpretation of the term "counterbalanced." First, there is language in the patent specification, which is the first place a court should look in interpreting claim language beyond the claim itself, which states "[a]s appropriate, the weight at one end may be different from the weight at the opposite end." '307 Patent, col. 2: 44-46. FN2 Momentus explains this language away by citing *Unique Concepts, Inc. v. Brown,* 939 F.2d 1448, 1562 (Fed.Cir.1991) which held that a patentee cannot use an exception to a limitation discussed in their patent specification to get around the limitation in general. This argument, however, is badly circular. Momentus argues that the specification language that states that the weights need not be equal is an exception to the general limitation that the weights are equal. Therefore the Court should conclude the weights must be equal. Indeed, this argument assumes its conclusion, that a limitation exists which requires the equality of the weights. In fact, nearly all the intrinsic and extrinsic evidence contradicts this assumption.

FN2. Momentus claims that this specification language is used in reference to a baseball-related device that was ultimately excluded from the patent, but a reading of the paragraph in question simply does not support this.

The patent specification explains that the problem the invention seeks to solve is that "additional weight on the end of the golf club shaft adversely affects the balance of the golfer. The weight tends to pull the golfer toward the weight." '307 Patent, Col. 1: 8-11. Thus, the balance that the weight on the other end of the club is intended to strike is not that of a pendulum, requiring precisely equal weights, but the balance of a golfer, holding the club at an angle, which may not require equal weights.

While not at all dispositive, an impressive piece of extrinsic evidence is that Momentus itself uses the term "counterbalance" to describe its device, the Momentus Strength Trainer. Thus, Momentus argues that the Court should apply a narrower definition to CSI's '307 Patent than Momentus, presumably a practitioner

skilled in the art, uses for its own product.

One other nondispositive item of extrinsic evidence weighs in favor of Momentus's interpretation. In a deposition of the inventor listed on the '307 Patent, Larry Huffman, Mr. Huffman testifies that he intended the weights in the device patented by the '307 Patent to be equal. Nevertheless, the Federal Circuit made it clear in *Markman* that "the subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of the claim (except as is documented in the prosecution history)." Momentus argues that this rule seeks only to bar the self-serving claims of an inventor in favor of the patent owner, which is not the case here; however, the Federal Circuit in *Markman* offered a quite separate rationale for disregarding the claims of the inventor.

[C]ommonly the claims are drafted by the inventor's patent solicitor and they may even be drafted by the patent examiner in an examiner's amendment (subject to the approval of the inventor's solicitor). While presumably the inventor has approved any changes to the claim scope that have occurred via amendment during the prosecution process, it is not unusual for there to be a significant difference between what an inventor thinks his patented invention is and what the ultimate scope of the claims is after allowance by the PTO.

Markman at 985 (citation omitted). See also Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1380 (Fed.Cir.2000). Given the alienability of patents from their inventors, this rule would be skewed if it only discounted an inventor's testimony with respect to the scope of claim construction when the inventor's incentives are in favor of broad construction. Such a rule would put patent purchasers at risk that the inventors may turn up and give testimony that could narrow the scope of their claims. Moreover, such a rule would require district courts to open the claim construction process to evidence regarding an inventor's intentions. Such a step would transmogrify the claim construction process from one of legal construction, as dictated by *Markman,* into a broad fact-finding exercise that the Court is supposed to defer until the resolution of patent infringement and validity.

The Court interprets "counterbalanced" to mean that the weights oppose or act against each other. The Court does not infer from this term that the weights in a device patented by the '307 Patent must be equal or must balance on a fulcrum between the weights.

2. Weights

This term is an example of where Momentus has sought ambiguity where none existed. With respect to weights, Momentus asks in its brief if a specific quantity is implied. If Momentus's counsel read claim 2 of the '307 Patent, he would read "wherein each of said weights weigh between 2 and 6 pounds." Other than the variable of quantity, Momentus does not suggest any other possible ambiguity for the term "weights."

3. Substantially Similar

The modification of the claim term "counterbalanced weights" with "substantially similar" also betrays the Momentus interpretation of "counterbalanced weights" as being equal. "Substantially similar" certainly allows for some difference between the weights. On the other hand, it would certainly seem that this modifier does constrain the claim in that the weights cannot differ too much. Thus, the Court is left to shed light on the question of how similar is substantially similar. Momentus offers that "similar" is typically defined as likeness or resemblance or having the same shape. It seems reasonable to this Court that the modifier "substantially similar" would require the weights to have shapes and sizes that are alike, but not

necessarily identical. In particular, if the weights are not equal, they may, by necessity, be different sizes. In that instance, the weights could still be "similar" in the geometric sense of the term by sharing the same shape.

4. Opposite Ends

The only question that Momentus raises with respect to the term "opposite ends" is whether this term constrains the patented device's shaft from extending beyond the weights. CSI counters that Momentus raises this question in order to determine whether the Momentus Strength Trainer infringes the '307 Patent, since its device has a club head attached to the end of one of the weights on that device.FN3 Clearly, given the Federal Circuit's admonition in *PPG Indus*. to avoid the extension of claim construction into infringement questions, this is a question better left for the infringement stage.

FN3. This question then devolves into whether the Momentus Strength Trainer possesses one shaft that extends beyond the weights, or two, one between the weights and a second attached with a club head.

5. Symmetrical about the longitudinal axis of said shaft

Momentus asks whether this term means the weights must correspond in size, form, and arrangement about the longitudinal axis. The modifier "substantially similar" would seem to answer the question with respect to size and form, and the term "on opposite ends" would seem to describe the arrangement. The only nonredundant use for this phrase of which the Court can conceive is that if one were to draw a line along the device's shaft through both weights, the weights would not skew to either side of that line. Such an interpretation is consistent with the patent's illustrations and other modifiers.

6. Said weights having no ball striking face thereon for striking a golf ball

Once again, with this term, Momentus attempts to create ambiguity where none is apparent. A plain reading of this claim language would indicate that the weights on the device would not possess a golf club head. Nevertheless, Momentus asks "does it require *not* 'a ball striking face for *not* striking a golf ball,' or not?" If Momentus is asking whether the device must not possess a ball-striking face for striking a golf ball, it would seem they are asking a question that directly relates to whether the Momentus Strength Trainer infringes the '307 Patent, not the meaning of this term. For the reasons described above, pursuant to *PPG Indus.,* the Court declines to answer this question.

7. Backswing, downswing, and followthrough of a golf club swing

The original claim language submitted was "practicing movements associated with a golf swing." The patent examiner insisted on the removal of this language and it was replaced with the "backswing, downswing, and follow through of a golf club." At the hearing, CSI's counsel conceded that a movement covered by the patented method must entail all three stated elements, a backswing, downswing, and follow through. On the other hand, CSI's counsel argued against the Court interpreting this term as requiring a "complete" swing as opposed to a partial one, arguing that one person's full swing may not be another's. A subjective standard as to what is a full swing should not pose a problem for the enforcement of this patent. If the backswing and followthrough is "full" for the individual swinging the golf club training device, then it is covered by the claim language, otherwise, it would fall within the broader language of "practicing movements associated with a golf swing" that was eliminated by the patent examiner.

8. Simulate hitting a golf ball from a golf tee without striking a golf ball

This language confirms that the individual using the patented method must take what is, for the individual, a full swing. Momentus argues that it is not clear from the plain language whether this part of the claim requires a normal golf swing or exercises related to a golf swing. In this case, it appears that both possibilities that Momentus posits evades the plain meaning of the language. On one hand, a simulation of a swing may not necessarily take place at the same speed as a normal swing. On the other hand, both parties would agree that the patent method does not cover any exercise related to a golf swing, indeed similar language was stricken from the original patent application. The Court construes this language as requiring a full golf swing but not necessarily at full speed.

Momentus also argues that the terms "golf ball" and "golf tee" are incapable of interpretation because it is unclear whether these objects are real or imagined. Momentus argues that if the "golf ball" and the "golf tee" were not required to be present, the language "without striking a golf ball" is redundant. On the other hand, given the fact that the patented device does not have a ball striking face, the language is redundant in any case. Since the device does not have a ball striking face and since the patent claim restates the obvious implication that an individual using the device would simulate hitting a golf ball from a golf tee without successfully striking a golf ball, the Court does not believe it is necessary to ascertain whether the "golf ball" and the "golf tee" in the simulation must actually exist. Nor does the Court find it necessary to embark on this ontological question just to avoid any hint of redundancy in the claim language.

9. Substantial distance above a ball-teed position

Momentus claims this language defies interpretation. CSI claims it speaks for itself. The Court believes that given that it is already established that the individual using the patented method is simulating a golf swing, and that according to claim 3 the device is no longer than 30 inches, it is inevitable for an individual of normal physiology that one of the weights, if not both, would be "spaced a substantial distance above a ball-teed position." Thus, this language is probably redundant, and once again the Court will not graft a bizarre construction onto the claim language in an effort to avoid redundancy. The Court concurs with CSI that the language speaks for itself.

IT IS SO ORDERED.

S.D.Iowa,2002.
Momentus Golf, Inc. v. Concept Sports, Inc.

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