



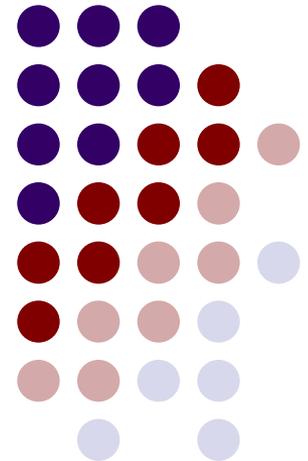
Birch
Stewart
Kolasch
Birch LLP

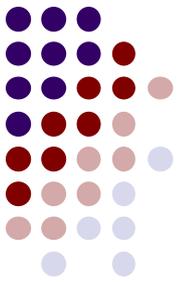
Claims to Methods of Improving Properties: *NASSAU v. ACUSHNET*

BSKB firm lunch lecture

May 7, 2014

Rick Gallagher



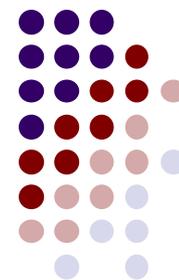


NASSAU v. ACUSHNET

Plaintiff Nassau Precision Casting Co. Inc. alleged that certain golf clubs infringed Nassau's U.S. Patent No. 5,486,000. The Defendants were Acushnet Co., Inc., Cobra Golf Co., and Puma N.A., Inc., referred to collectively as "Acushnet." The golf clubs in question were the Cobra S9, the Cobra UFi, and Cobra S2 clubs.

Summary Judgment of non-infringement was granted in favor of the Defendants.

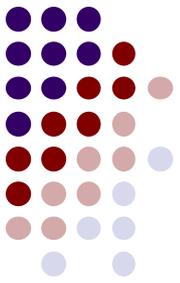
NASSAU v. ACUSHNET



U.S. District Court,
Eastern District of New York
10-CV-4226
Decided April 17, 2013

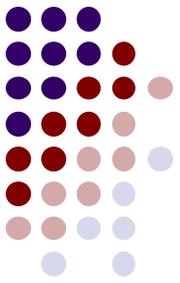
This case has been appealed to the CAFC

NASSAU v. ACUSHNET



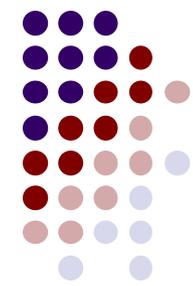
Nassau alleged that the Accused Clubs infringed Nassau's '000 patent. The '000 patent contains language regarding the redistribution of weight and construction material from locations near the top of a golf club head to other locations near the bottom of the golf club head.

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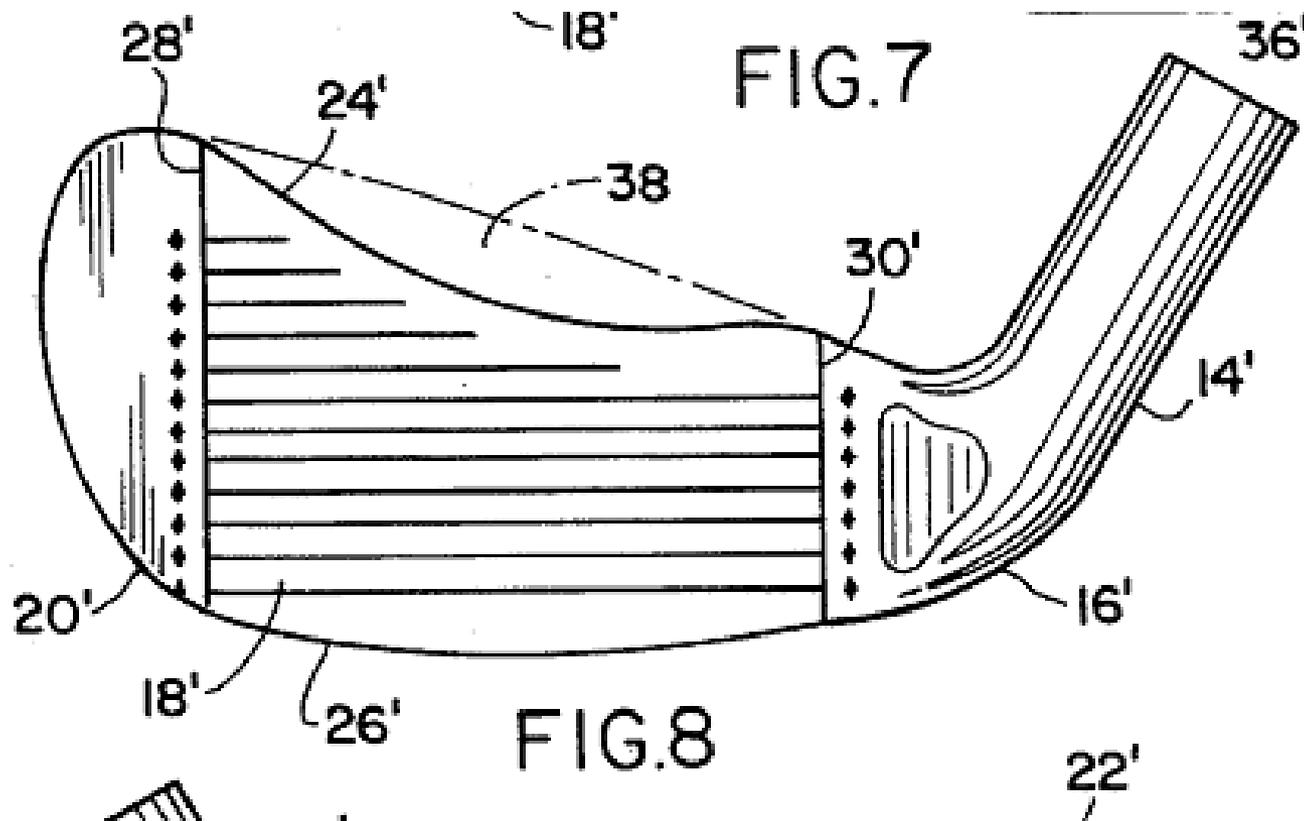


Following is a reproduction of Figure 8 from the '000 patent.

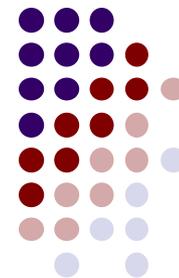
An area of significance in this case is identified by reference numeral 38.



NASSAU v. ACUSHNET

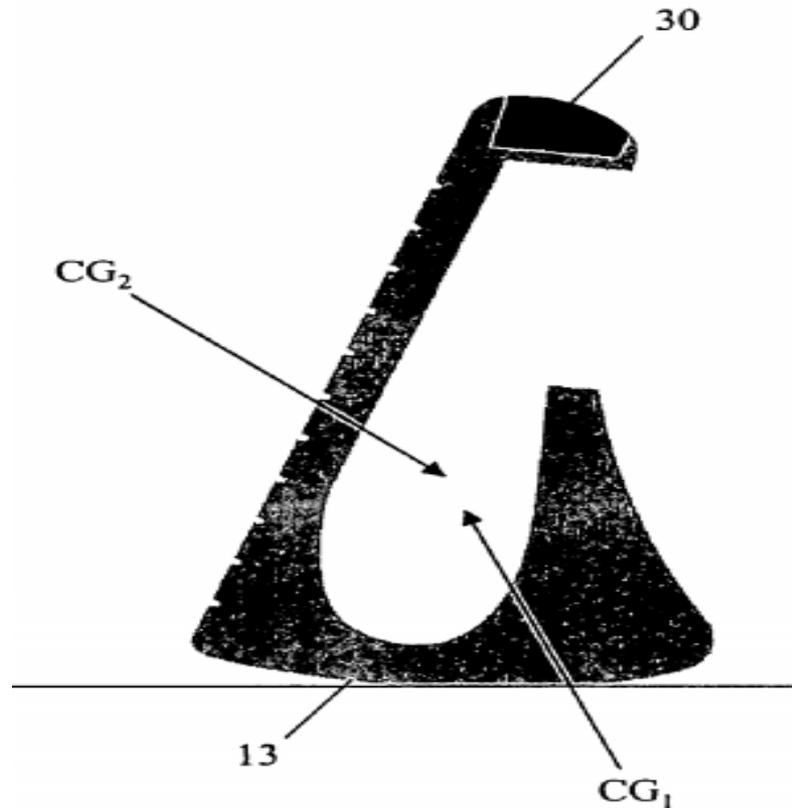
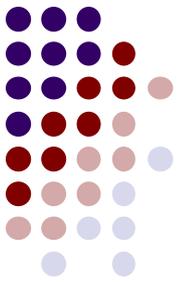


NASSAU v. ACUSHNET

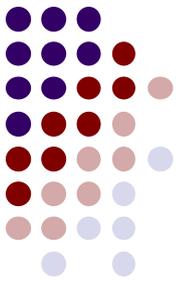


Following is a reproduction of a drawing showing an Accused Club. An area of significance in this case in the Accused Club is identified by reference numeral 30.

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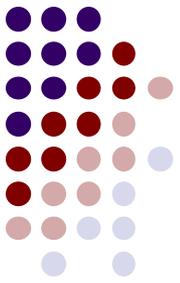


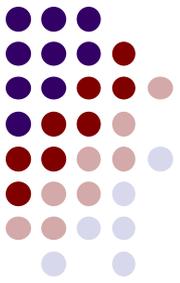
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The following slide is an actual picture of a Cobra S2 clubhead.

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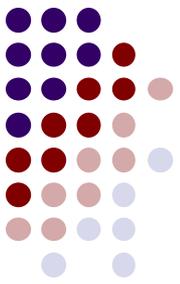




NASSAU v. ACUSHNET

The court interpreted Claim 1 of the '000 patent as prohibiting the removal of construction material from a ball-striking portion of the club.

Because the Accused Clubs removed material from what the court considered to be a ball-striking area of the club, the court found the Acushnet did not infringe Claim 1.

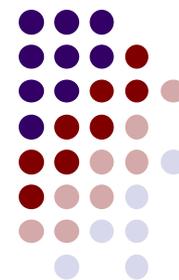


NASSAU v. ACUSHNET

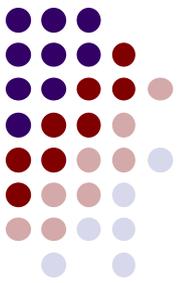
Claim 2 of the '000 patent involved the removal and distribution of a “determined weight” of material.

The court found that Acushnet removed a determined weight, but also incorporated a lightweight polymer insert in the area where the determined weight had been removed.

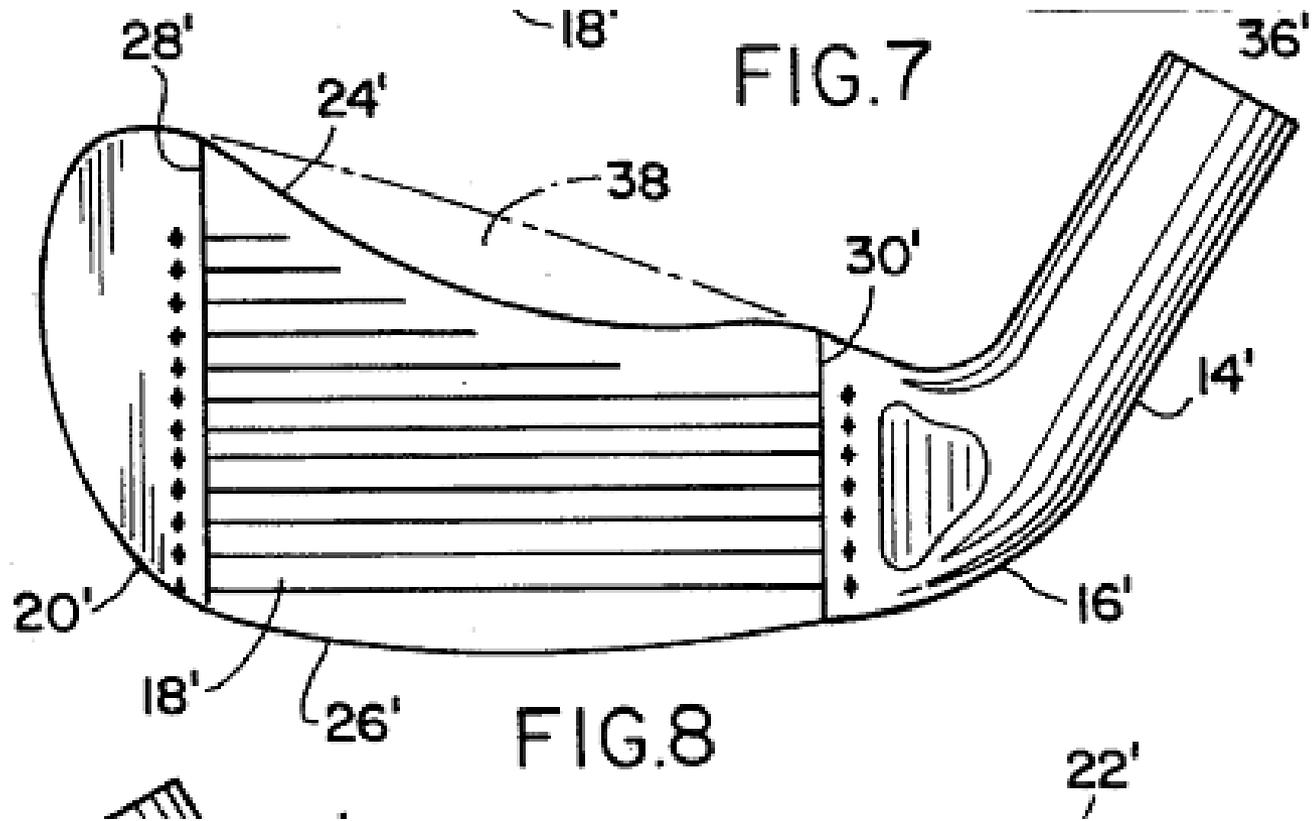
NASSAU v. ACUSHNET



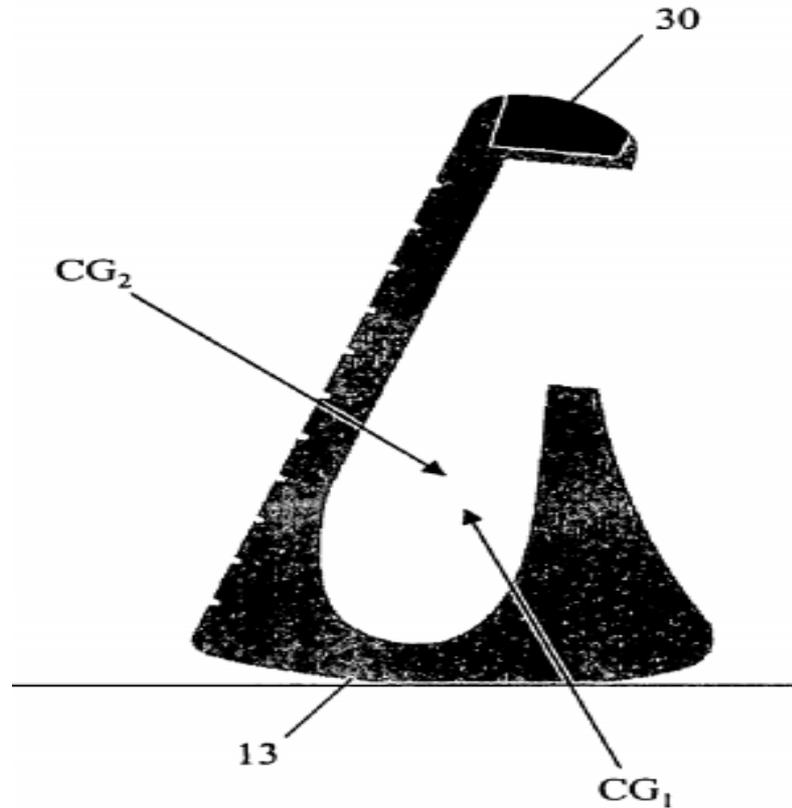
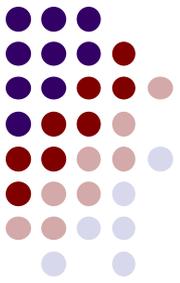
Therefore, because some of the original weight remained in Acushnet's club head, the court held that Nassau could not show that the Accused Clubs infringed claim 2 of the '000 patent.



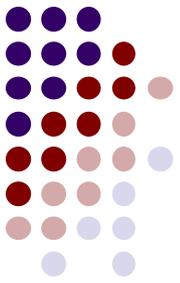
NASSAU v. ACUSHNET



NASSAU v. ACUSHNET



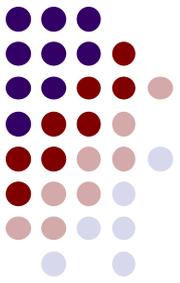
NASSAU v. ACUSHNET (background)



Acushnet had also argued that the ‘000 patent was invalid over prior art, and that a “no adverse consequence” limitation in claim 1 rendered that claim indefinite.

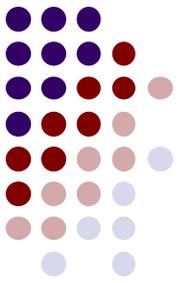
However, since Summary Judgment was granted on non-infringement grounds, the court did not reach those arguments.

NASSAU v. ACUSHNET (background)



Lowering the center of gravity of a golf club head, with all else being equal, produces higher flight in a golf ball struck by the club. Prior art approaches to optimizing trajectory involved adding weight to the club head in locations such as to the left and right of the club face (that is, the toe and heel of the club head). However, this provided a heavier club, which leads to slower speed in the swing.

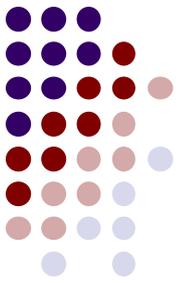
NASSAU v. ACUSHNET (claim 1)



1. In a golf iron club head of a type having a ball-striking body of weight-imparting construction material inclined at a selected angle for driving a struck golf ball a corresponding selected height during its trajectory, said body having spaced apart top and bottom surfaces bounding a ball striking surface therebetween,

.....

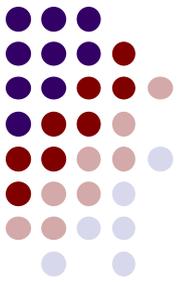
NASSAU v. ACUSHNET (claim 1)



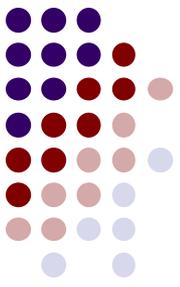
... the method of improving weight distribution comprising removing construction material from said top surface, relocating said removed construction material from said top surface to clearance positions below said top surface located adjacent opposite ends of said bottom surface

.....

NASSAU v. ACUSHNET (claim 1)



... whereby said removed construction material from a location not used during ball-striking service of said golf iron is of no adverse consequence thereto and said removed construction material in said relocated positions contributes to increasing said height attained by a struck golf ball.

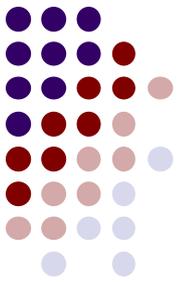


NASSAU v. ACUSHNET (claim 1)

Claim 1 has 4 significant limitations:

- removing material from a location not used to strike a ball in the top surface of a golf club head;
- relocating the removed material to positions at adjacent opposite ends of the bottom surface;
- lack of “adverse consequences” due to the removal and relocation; and
- contribution by the removal and relocation of club head material to increase height of a golf ball struck by the club head.

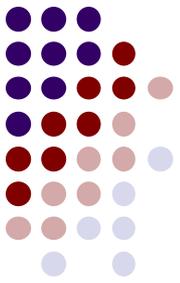
NASSAU v. ACUSHNET (claim 1)



The court held that the Accused Clubs do not infringe claim 1 due to their failure to make use of the claim 1 requirement that “said removed construction material [is] from a location not used during ball-striking service of said golf iron.”

We will consider the court’s rationale for this in detail later in the presentation.

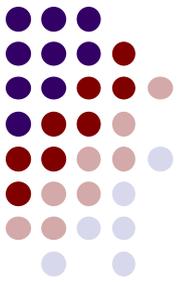
NASSAU v. ACUSHNET (claim 2)



2. A method of improving the weight-distribution of a selected construction material constituting a golf iron club head with a ball-striking surface bounded in a vertical perspective by top and bottom surfaces and in a horizontal perspective by toe and heel portions

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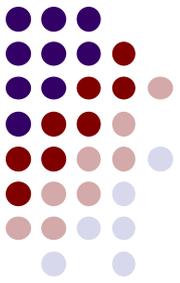
NASSAU v. ACUSHNET (claim 2)



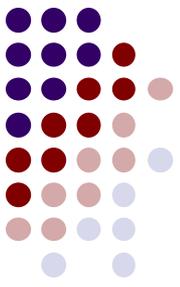
... said method comprising the steps of removing construction material from a central portion of said top surface, determining the weight of said removed construction material, and

.....

NASSAU v. ACUSHNET (claim 2)



... embodying as part of selected bottom areas of said toe and heel of said club head said removed construction material having said determined weight, whereby the weight is distributed to said selected bottom areas without any increase in the overall weight of the club head.



NASSAU v. ACUSHNET (claim 2)

Claim 2 differs from claim 1 primarily by requiring that:

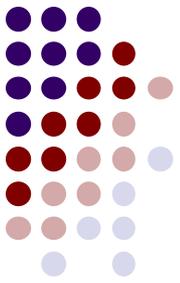
the overall weight of the club head must remain constant;

construction material must be removed from the ‘central portion’ of the top surface; and

the relocated construction material must be equal to the weight of the removed material.

There are no ‘not used during ball-striking service’ and ‘no adverse consequences’ limitations in claim 2.

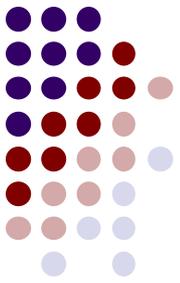
NASSAU v. ACUSHNET (claim 2)



Claim 2 requires removal and redistribution of a ‘determined weight’ of material within the club head. The court found that the Acushnet design removed a determined weight, but also incorporated a polymeric insert in the area where the determined weight had been removed. Therefore, because some of the weight remained in Acushnet’s club head, Nassau could not show that the Accused Clubs infringed claim 2.

NASSAU v. ACUSHNET

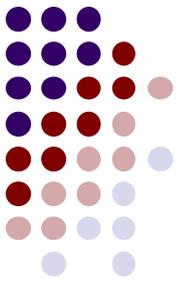
(design or manufacturing method?)



Before finding non-infringement for these reasons, the court provided a detailed discussion of how it construed what type of method is contemplated by the claims.

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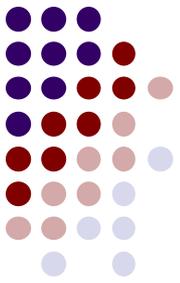
(design or manufacturing method?)



Claim 1 recites “In a golf iron club head ..., the ***method of improving weight distribution*** comprising removing construction material ... and embodying as part of selected bottom areas ... of said club head said removed construction material”

NASSAU v. ACUSHNET

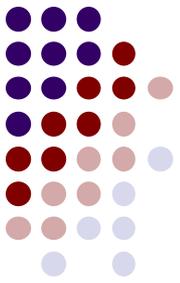
(design or manufacturing method?)



Claim 2 recites “A ***method of improving the weight distribution*** ... comprising the steps of removing construction material ... and embodying as part of selected bottom areas ... of said club head said removed construction material”

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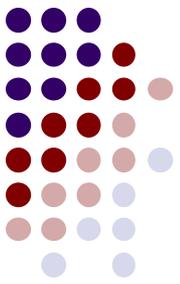
(design or manufacturing method?)



The Defendant, Acushnet, argued that the recitations of “removing” of materials in the claims indicate that the claims are drawn to a physical process – that is, a manufacturing process.

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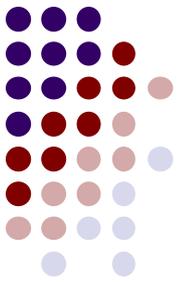
(design or manufacturing method?)



Acushnet pointed out that the patent contains disclosure that “[t]he present invention is for a golf iron club head in which a determined amount of head material is removed from the top edge of the head, and redistributed at a location which does not interfere with ball-striking operation of the club.”

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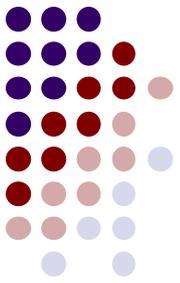
(design or manufacturing method?)



Acushnet contended that because Nassau failed to provide any evidence that the Accused Clubs were manufactured by physically redistributing material in a club head, there should be a summary judgment of non-infringement in favor of Acushnet.

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(design or manufacturing method?)

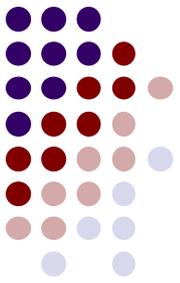


Acushnet argued that due to their recitation in claims 1 and 2 of “removing” and “relocating” construction material to other areas of the golf club head, the claims are describing physical processes.

The district court rejected Acushnet’s argument that claims 1 and 2 in the ‘000 patent describe a manufacturing process.

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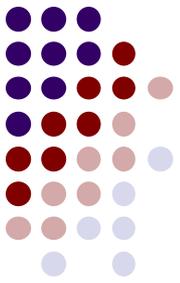
(design or manufacturing method?)



The court indicated that “Defendants’ proposed construction of Claims 1 and 2 does not account for the contextualized meaning of words such as ‘remove,’ ‘relocate,’ ‘construction material,’ and ‘weight distribution’ as used in the ‘000 Patent.”

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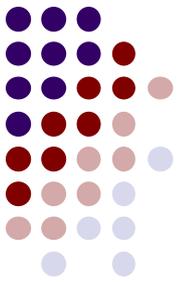
(design or manufacturing method?)



The court pointed out that “Claims 1 and 2 explicitly claim ‘method[s] of improving ... weight distribution,’ not methods of physically manufacturing golf club heads.”

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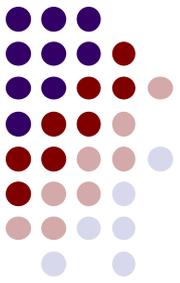
(design or manufacturing method?)



The court placed emphasis on the fact that the specification “consistently states the invention claimed in the ‘000 Patent is a method for improving weight distribution, not a method for physically manufacturing golf club heads.”

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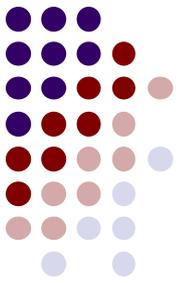
(design or manufacturing method?)



The court also expressly referred to that statement in the specification that “[I]t is an object to achieve, using weight distribution, sweet spot-enhancement.”

NASSAU v. ACUSHNET

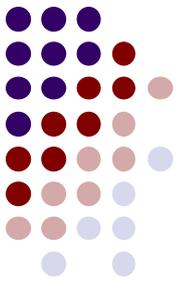
(design or manufacturing method?)



The court referred to a statement in the Nassau specification that known prior art efforts to lower the center of gravity of a golf club add weight to the bottom of the club, resulting in a heavier club, while Nassau avoids making the club heavier by redistributing weight from the top to the bottom of the club, thus maintaining the same overall weight.

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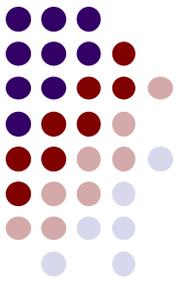
(design or manufacturing method?)



The court concluded based on this that “the novelty of the ‘000 Patent lies not in an inventive method of physically manufacturing a golf club head, but in the design steps taken to achieve a golf club head with a lowered” center of gravity.

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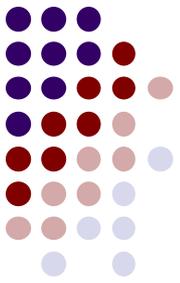
(design or manufacturing method?)



The court said that “words such as ‘remove’ and ‘relocate’ are not to be interpreted literally to direct a machinist to remove steel from the top of the club head and then weld that steel to the bottom. Rather, the Court reads those words as convenient, though imprecise, descriptors of design principles.”

NASSAU v. ACUSHNET

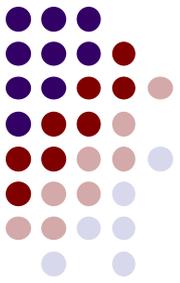
(design or manufacturing method?)



The court held that persons “in the field of club design would understand ‘remove’ and ‘relocate’ as referring to shifting construction material in a golf club head design in order to achieve a desired weight distribution.”

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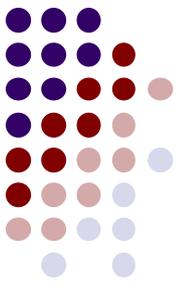
(design or manufacturing method?)



The foregoing finding by the court that the claims were referring to design approaches rather than to actual manufacturing steps takes a realistic view of the patentee's intentions.

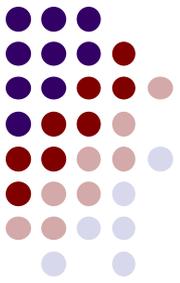
As we'll see later, the court's holding regarding non-infringement of claim 1 ignores the patentee's intentions.

NASSAU v. ACUSHNET (claim 2)



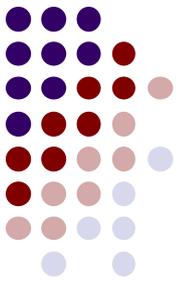
The court held that the Accused Clubs do not infringe claim 2, because claim 2 requires “removing construction material from a central portion of [the] top surface” and “embodying as part of [the bottom of the club] said removed construction material.” This requires that – during the design process – ***all*** of the construction material or weight removed from the top of the club be relocated to the bottom of the club.

NASSAU v. ACUSHNET (claim 2)



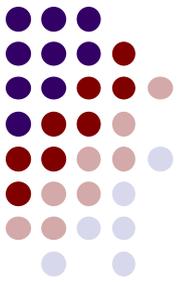
In the Accused Clubs, a polymer insert replaces an equivalent volume of the steel which is removed from the top of the club head, so that some of the weight determined by the weight of the removed construction material remains in the design of the club head topline in the form of the weight of the polymer insert.

NASSAU v. ACUSHNET (claim 2)

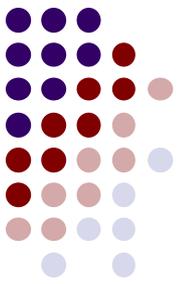


The court held that, therefore, “Plaintiff cannot show the Accused Clubs infringe Claim 2 of the ‘000 Patent.”

NASSAU v. ACUSHNET (claim 1)

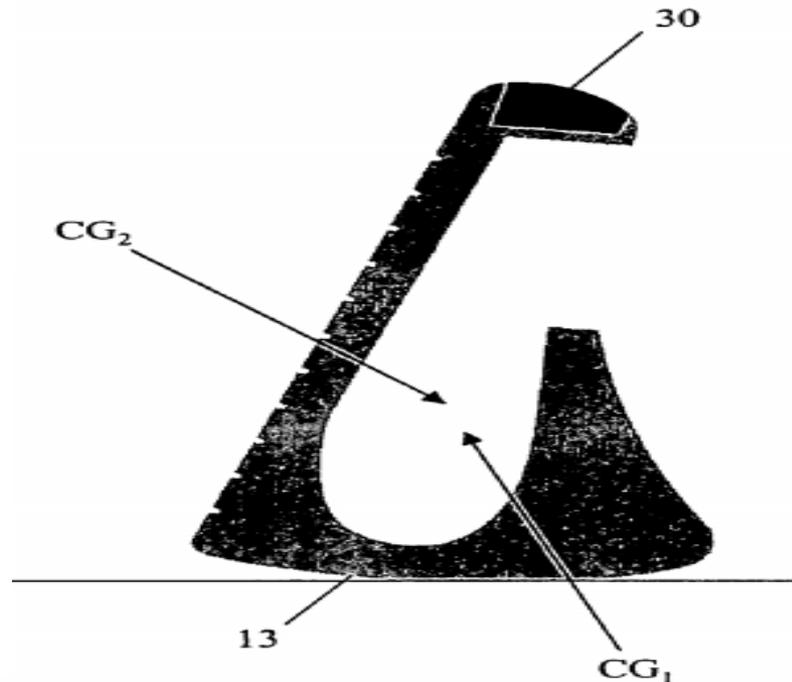


The court held that the Accused Clubs do not infringe claim 1 due to their failure to make use of the claim 1 feature that “said removed construction material [is] from a location not used during ball-striking service of said golf iron.”

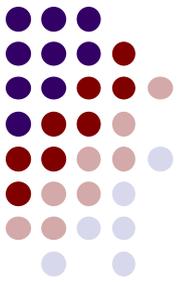


NASSAU v. ACUSHNET (claim 1)

The court recognized that the center topline is not normally used to strike a golf ball, but indicated that “every location of the club face is sometimes used to strike a golf ball.”

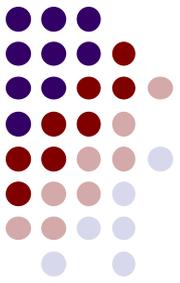


NASSAU v. ACUSHNET (claim 1)



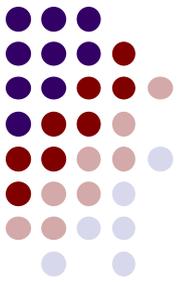
In the words of the court, “because every location of the club face is sometimes used to strike a golf ball, ‘a location not used during ball-striking service’ necessarily refers to some location of the club head other than the face, such as the rear area.”

NASSAU v. ACUSHNET (claim 1)



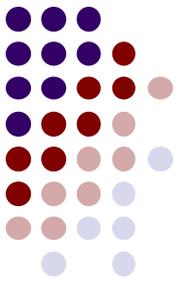
The court stated that “Had Claim 1 recited removal of material from a location not ‘normally’ or ‘typically’ used to strike a golf ball, the Court might have concluded the claim permits the removal of material from the center topline. But, as drafted, Claim 1 does not permit removal of material from that location.”

***NASSAU v. ACUSHNET* (claim 1)**



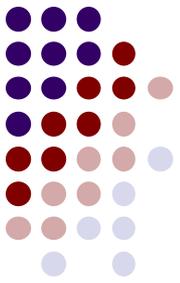
The court justified this approach by citing language from *Kara Tech. Inc. v. Stamps.com Inc.*, 582 F.3d 1341 (Fed. Cir. 2009) at 1348: “The claims, not specification embodiments, define the scope of patent protection. The patentee is entitled to the full scope of his claims, and we will not limit him to his preferred embodiment or import a limitation from the specification into the claims.”

NASSAU v. ACUSHNET (claim 1)



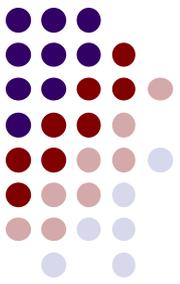
The court noted that the specification taught that material could be removed from the top edge because “in the typical use of a golf club iron, the ball is never intentionally struck near or at the top of the club face.”

NASSAU v. ACUSHNET (claim 1)



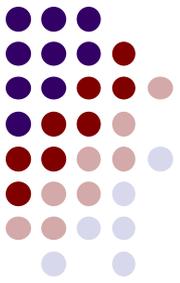
The court held that the phrase “a location not used during ball-striking service” is broad and encompasses any location on the golf club head that is actually used to strike a golf ball. “The use of words such as ‘typical’ or ‘normally’ logically narrows the meaning to the phrase However, those words are not found in Claim 1 and therefore do not limit its terms.”

***NASSAU v. ACUSHNET* (claim 1)**



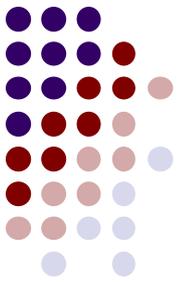
Recognizing that a patentee can be his or her own lexicographer, the court cited *Thorner v. Sony Computer Entertainment Am. LLC*, 669 F.3d 1362 (Fed. Cir. 2012) at 1365 for the proposition that “It is not enough for a patentee to simply disclose a single embodiment or use a word in the same manner in all embodiments, the patentee must ‘clearly express an intent’ to redefine the term.”

NASSAU v. ACUSHNET (claim 1)



The court said that “Here, the ‘000 Patent does not clearly indicate that ‘a location not used during ball-striking service’ bears the narrower definition of a location not typically or normally used during ball-striking service.”

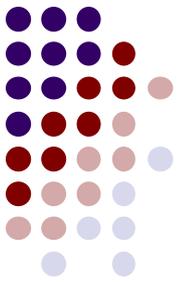
NASSAU v. ACUSHNET (claim 1)



The court went on to note that the '000 Patent specification expressly disavows any possible narrowing of the claim terms based on the specification.

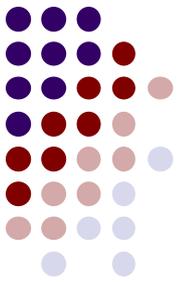
In support of this, the court referred to the boilerplate recitation at the end of the specification as follows:

NASSAU v. ACUSHNET (claim 1)

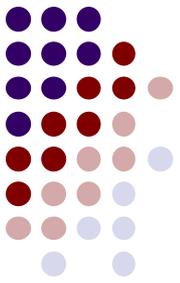


“... it is to be understood that [the disclosed golf club head and method are] merely illustrative of the presently preferred embodiment of the invention, and that no limitations are intended to the detail of construction or design herein shown other than as defined in the appended claims.”

NASSAU v. ACUSHNET (claim 1)



The court held that since the Accused Clubs remove construction material from an area that is sometime, even if unintentionally, used to strike a golf ball, the Accused Clubs do not practice the “location not used during ball-striking” limitation and therefore do not infringe claim 1 of the ‘000 patent.

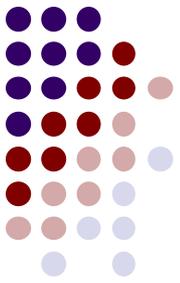


conclusion

When it came to the theme of the claims – that is, design principles rather than manufacturing steps – the court imposed a standard of reasonableness on the words used in the claims.

However, when it came to construing the scope of the words used in the claims, the court stuck the patentee with a broad construction, even though it clearly was not intended.

NASSAU v. ACUSHNET



This case is scheduled for a hearing at the CAFC on Friday, May 9, 2014.

-The End -