

Keywords: Invalidity; indefiniteness; claim limitations including measurements; claim limitations including calculations; expert testimony

General: When drafting, ensure claim terms are defined in the specification, even if applicant thinks they are generally known in the art. Also consider providing example calculations or measurements if included in claims. When litigating, ensure a party provides a counter argument to each argument presented, including expert testimony. Consider providing arguments in the alternative.

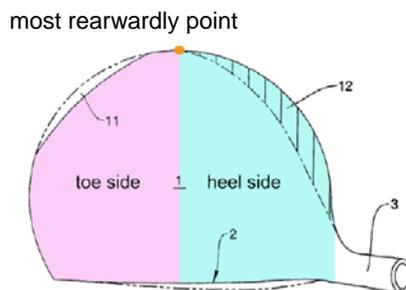
Saso Golf, Inc. v. Nike, Inc.
United States Court of Appeals for the Federal Circuit
No. 2020-1456
Decided February 10, 2020

I. Facts

Saso Golf sued Nike for infringement of U.S. Patent No. 5,645,495 (“the ‘495 patent”). The ‘495 patent claims a particular golf club shape. The lower court (District Court for Northern District of Illinois) held the claim invalid as indefinite. The Federal Circuit affirmed.

Claim 7 of the ‘495 patent, the only claim-at-issue, is directed to the shape of a golf club, specifically a “metallic wood type” club such as a driver. According to the ‘495 patent, the innovation is in shifting the center of gravity of the club head to the heel side (the half of the club head nearest the player) away from the toe side (the half of the club head furthest from the player). The advantage of this invention, according to the ‘495 patent, is to help a player avoid twisting the club head when hitting a golf ball and thus help avoid hook shots.

In the annotated figure below, the dashed lines represent the prior art, while the solid lines represent the invention of the ‘495 patent. The figure shows how the heel-side has a bulge (12) and the toe-side has a shallow indentation (11).



Annotated Figure 1, Appellant’s Br. 30.

The claim requires that the “back profile shape between the toe and a most rearwardly point of said metallic wood type head having a radius of curvature that is larger than the radius of curvature of said back side profile shape between the most rearwardly point of said metallic wood type head and the heel.”

A larger radius of curvature means a flatter curve, while a smaller radius of curvature means a sharper curve. The claim thus requires that the radius of curvature on the toe side is larger (i.e., flatter) than the radius of curvature on the heel side (i.e., sharper).

Determining infringement requires three steps:

- (1) measuring the radius of curvature of the “back side profile shape” of the club head between the club’s “toe” and its most rearwardly point;
- (2) measuring the radius of curvature of the back side profile shape between the club’s “heel” and its most rearwardly point; and
- (3) determining whether the first value is larger than the second value.

The measurements require picking a specific point on the toe and heel from which to measure. The parties dispute (1) whether the size, shape, and locations of the toe and heel regions are reasonably certain and (2) where within them to begin measurements is reasonably certain.

District Court Proceedings

The district court held that claim 7 was indefinite, finding that an artisan would not know from where on the toe side and heel side to measure to the most rearwardly point to determine the radii of curvature. The court noted that the radius of curvature measurement is not described in the specification. Defendant Nike presented three experts, each of whom noted that the terms “toe” and “heel” are susceptible to different interpretations. Nike argued that because these terms are susceptible to different interpretations, an artisan would not be able to determine the locations of the “toe” and the “heel” without further definition in the specification. Thus, concluded Nike, an artisan would not know from where to measure the radii of curvature.

Saso countered with its own expert testimony that all terms at issue “have a definite and readily ascertainable meaning to one of ordinary skill in the art,” which the district court did not find persuasive. Characterizing Saso’s expert testimony as “conclusory,” the Federal Circuit noted that Saso’s expert did not say anything to define the horizontal boundaries of the toe and heel, from which to make the radii of curvature measurements. Instead, Saso’s expert opined that the edges of the toe and heel were irrelevant. Saso argued an artisan would know to measure from the edges of the toe and heel, but did not provide any explanation of how to determine the locations of those edges.

II. Issues

- A. Did the district court clearly err in finding that an artisan would not know from where on the toe and heel the radii of curvature are measured?
- B. Did the district court properly find that claim 7 is indefinite?

III. Discussion

- A. **No.** The Federal Circuit noted that factual findings underlying the legal conclusion of indefiniteness – such as findings regarding the knowledge of a skilled artisan – are reviewed for clear error. The Court pointed to Nike’s three experts who each testified that an artisan did not consider terms “toe” and “heel” to have a single definition. The Federal Circuit found that that the “consistent thrust” of their testimony was that an artisan would not be able to choose a point related to the toe and heel from which to measure because “toe” and “heel” are general terms.

The Federal Circuit was also not impressed by Saso’s position to counter Nike’s three experts. The Court remarked that, “[m]ore importantly,” Saso never explained how to find the boundaries of the toe and heel. Instead, Saso’s “lone expert” on the issue testified that the exact boundaries of the toe and heel “need not be determined.” The Court’s opinion characterizes Saso’s expert testimony as “conclusory” three times and underscored the absence of evidence to counter Nike’s experts:

The district court gave the parties a narrow question: “from *where* ... does one measure[?]” And the court clearly instructed the parties to explain “why skilled artisans would adopt those proposed points.” The district court credited Nike’s experts’ opinions that an artisan would not know where to measure because *Saso provided no explanation of how an artisan could determine the locations*.

Emphasis added.

- B. **Yes.** The Federal Circuit noted the Supreme Court’s test for indefiniteness in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014), that a patent is indefinite if its claims, “read in light of the specification ... and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” The Court also pointed to precedent specific to calculations: “a claim may be invalid as indefinite when (1) different known methods exist for calculating a claimed parameter, (2) nothing in the record suggests using one method in particular, and (3) application of the different methods result in materially different outcomes for the claim’s scope.” *Ball Metal Beverage Container Corp. v. Crown Packaging Tec., Inc.*, No. 2020-1212, 2020 WL 7828776, at *3 (Fed. Cir. Dec. 31, 2020).

Applying this precedent, the Court found that “changes in the starting point of the measurements can change the results of the measurement” and thus “for an artisan to be reasonably certain whether a golf club falls within the scope of the patent, they must be reasonably certain of the measurement points.” Therefore, the Court held that claim 7 is indefinite, given that “it is not clear from where on each surface one measures to the most rearwardly point to determine the radii of curvature.”

The Court also rejected Saso’s argument that the district court applied an indefiniteness standard that the Supreme Court overturned in its decision in *Nautilus*, finding that Saso had explicitly waived the argument by stating that *Nautilus* was “a different label for the same thing” as the previous standard. The Court also held that the district court’s decision was “consistent with” the reasonable certainty standard articulated in *Nautilus*.

IV. Conclusion

A claim is indefinite if, when read in light of the specification and the prosecution history, the claim fails to inform with reasonable certainty those skilled in the art about the scope of the invention. If a claim includes calculations or measurements, and different methods exist for performing such calculations or measurements, and the different methods result in materially different outcomes for the claim’s scope, the claim is indefinite. Thus, when drafting patents, it is a best practice to ensure all claim terms are defined in the specification. Where the claim terms include calculations or measurements, it is advisable to include examples of such calculations or measurements or at least specify which method should be used to perform the calculations or measurements. When litigating, ensure that you provide a counter argument to each argument presented (including expert testimony). Consider providing arguments in the alternative.