

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/008,817	Patent Under Reexamination 5779566	
	Examiner Jimmy G. Foster	Art Unit 3993	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 09 August 2007 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) PTO-892, b) PTO/SB/08, c) Other: _____

1. The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

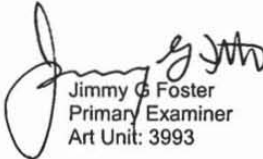
For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) by Treasury check or,
b) by credit to Deposit Account No. _____, or
c) by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).


Jimmy G. Foster
Primary Examiner
Art Unit: 3993

cc:Requester (if third party requester)

U.S. Patent and Trademark Office
PTOL-471 (Rev. 08-06)

Office Action in *Ex Parte* Reexamination

Part of Paper No. 20071003

Art Unit: 3993

DECISION

A substantial new question of patentability affecting claims 1-37 of United States Patent Number 5,779,566 to Wilens is raised by the request for *ex parte* reexamination.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,779,566 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

After filing of a request for reexamination by a third party requester, any document filed by the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in reexamination proceedings in a manner provided in 37 CFR 1.248. See 37 CFR 1.550(f).

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52 (a) and (b), and must contain any fees required by 37 CFR 1.20(c).

Patent owner is notified of the opportunity to waive the time for filing a Patent Owner's Statement if patent owner does not intend to file one. This waiver may be made by filing appropriate correspondence to the Office in response to this Order, including a statement clearly indicating that patent owner will not be filing a Patent Owner's Statement.

The Request indicates that requester considers claims 9 and 14 of Wilens to be unpatentable over Canadian Patent No. 1,264,495¹ to Bonito et al (Bonito).

¹ The document number 1,264,494 was inaccurately cited in the Request

The Request also indicates that requester considers claim 8 of Wilens to be unpatentable over Bonito in view of Patent Abstracts of Japan Publication No. 02-209173 to Matsuzaki et al (Matsuzaki).

The Request also indicates that requester considers claim 9 of Wilens to be unpatentable over the publication "Easy to Use Operating Instructions, Eagle Scoremaster Golf Computer," published 1981 ("the Scoremaster Reference") in view of "Sharp Electronic Organizer Model ZQ-5000 ZQ-5200 Operation Manual," published 1990 ("the Sharp Reference").

Additionally, the Request on page 3 *non-specifically* indicates that requester considers claims 1-37 of Wilens to be unpatentable over various reference combinations involving Bonito, Matsuzaki, the Scoremaster Reference, the Sharp Reference, Patent Abstracts of Japan Publication No. 03-155883 to Murakawa, and the publication "The PGA Manual of Golf," Wiren, 1991 ("the PGA Reference"). However, a detailed explanation in the Request of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested, more precisely indicates that requester in the Request considers the claims respectively to be unpatentable over the following specifically pointed out combinations:

The Request indicates that requester considers claims 1-5 and 9 of Wilens to be unpatentable over a combination of the Scoremaster Reference and the Sharp reference.

The Request indicates that requester considers claim 6 of Wilens to be unpatentable over a combination of the Scoremaster Reference, the Sharp reference and Matsuzaki.

The Request indicates that requester considers claims 7, 9, 10, 11, 14 and 18 of Wilens to be unpatentable over the Bonito.

The Request indicates that requester considers claims 13, 15 and 17 of Wilens to be unpatentable over a combination of Bonito, the Scoremaster and the Sharp reference.

The Request indicates that requester considers claim 8 of Wilens to be unpatentable over a combination of Bonito in view of Matsuzaki.

The Request indicates that requester considers claim 16 of Wilens to be unpatentable over a combination of Bonito and the Sharp reference.

The Request indicates that requester considers claims 12, 19-21, 24, 25, and 30-37 of Wilens to be unpatentable over a combination of Bonito the PGA reference.

The Request indicates that requester considers claims 22 and 23 of Wilens to be unpatentable over a combination of Bonito, the PGA reference and Sharp.

The Request indicates that requester considers claims 26-29 of Wilens to be unpatentable over a combination of Bonito, the PGA reference and Matsuzaki.

It is agreed that the consideration of the Bonito raises a substantial new question of patentability as to claims 9 and 14 of Wilens substantially for the reasons set forth on pages 4-7, 9-13 and the Claim Charts 1 and 2 of the Request. Bonito discloses a golf cart computer which can record information, such as score, handicap, etc. (see page 14, lines 22-26), and which can recall such information (see page 2, lines 7-11; page 3, lines 13-18) and a wide range of other information, such as golf course landscape features and conditions. The computer can further provide such information, on demand, as data and pictorial representations on a display screen (see page 2, lines 12-16; page 2, line 29 through page 3, line 1; also Fig. 9 and page 4, lines 16-18; page 6, line 31 through page 7, line 2). Alternatively, the course information may be provided in a text format only, at the player's discretion (see Fig. 8 and page 15, lines 25-28). The computer therefore includes display of the various features of the course and playing aspects of the game, theoretically helping the golfer to play a better game and thereby improve the golfer's score (see page 1, line 9 through page 2, line 6).

The cart computer includes said display and includes memory storage and data entry devices, such as a light-pen and keyboard-entry keys (see page 2, lines 7-17; page 2, line 29 through page 3, line 18; page 5, line 26 through page 6, line 30). The memory holds multiple "screens" of golf play information, which further includes multiple screens that have screen-dependent data input fields, regarding the nine or eighteen holes of golf. For example, the computer is equipped with a light pen that may be used to mark, as with an asterisk, the golfer's

position on the graphical representation of the hole on the display, for each hole as the game is played (page 6, lines 10-13 and lines 22-24). Upon this being done, physical distances on the golf course, represented by the distances from the asterisk to any graphics representation of a land feature of the golf course, may then be computed and displayed (see page 6, lines 13-19). The light pen may also be used to indicate a selection from a displayed list. The memory will also hold player-input information (see page 2, lines 7-10). Regarding this, the keyboard may be used to incrementally input the score of each hole played into memory (*ibid*), and the cumulative score, up to and including that hole or the previous hole, also may be computed, stored in memory, and displayed at the data region on the game-interactive screen (page 3, lines 13-25; page 6, lines 31-37). This means that at least the cumulative score for the last hole in combination with the display of the last hole will provide post-game information (and therefore a post-game screen). Additionally, the handicap, player names, etc., which will have been initially input by way of the keyboard upon a pre-game prompting by the computer (page 14, lines 22-26), may also be displayed in the data region of the screen (see Fig. 3). The keyboard is also used to select the type of graphical output to the display on the screen from a variety of presentations which may be provided, as well as to determine what types of data information will be provided on the screen (see page 2, line 29 through page 3, line 12; page 5, lines 26-31; page 6, line 37 through page 7, line 2; page 10, lines 11-19; page 15, lines 25-28; page 16, lines 3-8). Further, there is a plug-in graphics memory module which may be used to update the computer regarding course changes and conditions, which can be conveniently inserted into the computer as the need arises (see page 7, line 32 through page 8, line 3; page 8, lines 16-20). Additionally there is a two-way communications link provided between the cart computer and a remote printer on the course for printing off the results, as well as other information, at the end of the game (page 8, lines 21-28; page 9, lines 13-22).

The subject matter disclosed by Bonito is relevant to claimed subject matter of claim 9 which substantially calls for, among other things:

providing a computer with a memory and data selection entry keys, storing plurality of information screens that include screen-dependent data input fields, selectively displaying information screens on the display in a logical sequence of pre-game and game-interactive screens so that data is prompted by

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