

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SKYHAWKE TECHNOLOGIES, LLC,
Petitioner,

v.

L&H CONCEPTS, LLC,
Patent Owner.

Case IPR2014-00437
Patent 5,779,566

Before JAMES T. MOORE, PATRICK R. SCANLON, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35. U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

SkyHawke Technologies, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 8–11, 14, and 18 of U.S. Patent No. 5,779,566 (Ex. 1001, “the ’566 patent”) pursuant to 35 U.S.C. § 311. Patent Owner L&H Concepts, LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition. We instituted *inter partes* review of claims 8–11, 14, and 18 in a decision dated August 21, 2014 (Paper 7, “Inst. Dec.”).

Claims	Ground	References
8–11, 14, and 18	§ 103	Palmer, ¹ Osamu, ² and Vanden Heuvel ³

Patent Owner responded to the Petition by arguing, *inter alia*, the combination of references would not have been made by one of ordinary skill in the art, the prior art does not teach every element of the claims, and the testimony of the Petitioner’s witness lacks credibility and should be given no weight (Paper 19, “PO Resp.”). We entertained oral argument in this proceeding on April 27, 2015. A transcript of the hearing is included in the record. Paper 30.

The Board has jurisdiction under 35 U.S.C. § 6(c). In this Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, we determine that the record adduced at trial supports a conclusion that Petitioner has demonstrated by a preponderance of the evidence that the

¹ WO 92/04080, Mar. 19, 1992 (Ex. 1005, “Palmer”).

² GB 2 249 202 A, Apr. 29, 1992 (Ex. 1006, “Osamu”).

³ US 5,426,422, June 20, 1995 (Ex. 1007, “Vanden Heuvel”).

claims for which trial was instituted, claims 8–11, 14, and 18, are unpatentable.

II. THE '566 PATENT

The '566 patent is involved in litigation. Petitioner states that the '566 patent is asserted in co-pending civil action *L&H Concepts, LLC v. SkyHawke Technologies, LLC*, No. 2:13-cv-00199-JRG (E.D. Tex.). Pet. 2–3. We observe that the civil action has been transferred to the Southern District of Mississippi as No. 3:14-cv-00224. An amended order staying that proceeding was entered July 7, 2014. Docket Entry 76. A motion is pending to lift the stay. *See* *L&H Concepts, LLC v. SkyHawke Techs, LLC*, No. 3:14-cv-00224(S.D. Miss. Apr. 10, 2015)(Docket Entry 83)(“MOTION to Lift Stay for Purposes of Fact Discovery by L&H Concepts, LLC”).

The '566 patent was also involved in an ex-parte reexamination proceeding, number 90/008,817. A reexamination certificate, US 5,779,566 C1, was issued on March 31, 2009. The patentability of claims 1–37 was confirmed during that proceeding. A final decision in IPR2014-00438, which challenges different claims of the '566 patent, is being issued on the same day as this decision.

The claims relate to a computer with a display for user interaction before, during, and after a game. The unit is said to be a “recording, reporting and advising” unit. Ex. 1001, Abstract.

III. ILLUSTRATIVE CLAIM

Claim 8 of the '566 patent is a method claim and illustrative of the claims at issue in this proceeding:

8. A method for recording and reporting golf information to increase a player's ability to improve from experience, comprising the following steps:

storing a plurality of pre-game, game-interactive and post-game information screens in a memory of a computer unit having a display for selectively displaying one or more of the information screens, the information screens including screen-dependent data input fields for entry of data;

displaying in sequential fashion one or more pre-game information screens and prompting entry of data which defines parameters of an upcoming game;

providing a choice among a plurality of game-interactive information screens for recording data during the game defined by the parameters entered in the pre-game information screens;

displaying a chosen game-interactive information screen;

entering data in the chosen game-interactive information screen corresponding to a game as the game is played and simultaneously recording entered data in the memory of the computer unit;

providing post-game reports based on the data entered in the game-interactive information screen; and

providing one or more game-interactive advice/feedback information screens.

Ex. 1001, 18:5–30.

IV. ANALYSIS OF CLAIM CHALLENGES

A. The Level of Ordinary Skill in the Art in 1993

We first turn to the testimony of the Petitioner’s witness, Professor Carl A. Gutwin (hereinafter “Dr. Gutwin”). We look to this Declaration to discern his viewpoint on the level of ordinary skill in the art. He testifies that he has more than 20 years of experience in the field of computer science and computer-human interaction. Ex. 1012 ¶ 3. His credentials and CV provide sufficient evidence for us to deem him to be an expert witness. *Id.* ¶¶ 4–9, App. A.

According to Dr. Gutwin, the relevant field is human-computer interaction. *Id.* ¶ 11. Also according to Dr. Gutwin, the prior art demonstrates that a person of ordinary skill in the field at the time the '566 patent was effectively filed, was aware of and capable of designing key-based interactive systems using known interface techniques. *Id.* ¶ 13.

Patent Owner's witness, Mr. Alan Ball, while not having as extensive an educational background as Dr. Gutwin, nonetheless has significant experience. Ex. 2014 ¶¶ 5–10. His experience persuades us that he too is qualified as an expert witness. According to Mr. Ball, the field is to be more narrowly circumscribed than Dr. Gutwin has indicated. Instead of human computer interaction, Mr. Ball thinks the more appropriate field is handheld sports, particularly golf, recording devices. *Id.* ¶ 11.

We think neither witness is persuasive on this point, and the inventor's original disclosure is closer to the actual state of the art at the time the invention was made.

We thus turn to the Patent Specification, at Ex. 1001, 2:27–40, as representative of a more objective form of evidence.

In its most basic form the inventive apparatus is a comfortably handheld, self-contained computer unit having a non-volatile memory, a power source, a general output display for selectively displaying a plurality of informational screens stored in the memory, and a program that determines logical screen and information sequence and processes the data entered. The unit is provided with key entry means for retrieving and selectively displaying various screens from the memory on the display and for entering game data into each screen to be stored in the memory. The provision of a general output display, the variety of specialized screens for organization of data, and the handheld portability of the invention result in a device with nearly unlimited potential.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.