

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SkyHawke Technologies, LLC
Petitioner

v.

L&H Concepts, LLC
Patent Owner

Cases IPR2014-00437 & IPR2014-00438
Patent 5,779,566

DECLARATION OF PETER WILENS

1. I am making this declaration at the request of the Real Party in Interest L&H Concepts in the matter of Inter Partes Review of U.S. Patent No. 5,779,566.
2. I am being compensated for my work. My compensation does not depend on the outcome of this proceeding.
3. In forming the opinions I express below, I considered:
 - a. The '566 Patent (Ex. 1001 in IPRs 2014-00437 & 438);
 - b. Petitions by SkyHawke (Paper 1 in IPRs 2014-00437 & 438);
 - c. Decision of Institution of Inter Partes Review as to the '566 Patent in IPR2014-00437 (Paper 7);
 - d. Decision of Institution of Inter Partes Review as to the '566 Patent in IPR 2014-00438 (Paper 7);
 - e. Ex. 1005 – 1007 (Palmer, Vanden Heuvel, and Osamu) in IPRs 2014-00437 & 438;
4. A copy of my resume is attached to the back of my declaration.
5. I am the named inventor of the '566 patent. I personally developed the technology set forth in the '566 patent, and I am (and was at the time the '566 was filed) well versed in the field of handheld sports recording devices.
6. As was set forth in the “Field of the Invention” and “Summary of the Invention” section of the '566 patent, I believe that my inventions (as set forth in the '566 patent) were in the field of handheld sports recording devices.
7. Handheld sports recording devices involve a range of unique challenges

and issues in their design that are either not present or are insignificant in other types of electric devices, even other handheld electronic devices.

8. First, a handheld sports recording device must be able to operate successfully when used exclusively outdoors, as the golf scoring device that I described in the '566 patent. Many people at the present time forget the challenges involved in using the handheld sized LCD displays of the early 1990s in outdoor applications. The display technology of the time, namely LCD screens, possessed numerous weaknesses and challenges not present in the handheld device screens used today. First among these were the issues using the display in direct sunlight, which tended to “washout” the display making it difficult or impossible to read.

9. For this reason, at the time of my invention, engineers in my field did not believe that an input mechanism dependent on screen selections could be successfully used in a handheld sports recording device. This can be seen in the prior Palmer and Osamu devices, which both rely exclusively on a keyboard of marked keys that could be easily seen even in direct sunlight, such as Figure 3 of Palmer or Figure 3 of Osamu.

10. In fact, at the time that I filed the '566 patent application, I was unaware of any handheld sports recording device that used a screen dependent entry mechanism. The fact that SkyHawke has not cited a prior art reference to the Patent Office that included such a device further verifies that no such device existed prior

to the '566 patent.

11. I understand that the mere fact that no one had previously developed a handheld sports recording device with a screen dependent entry mechanism is not enough to make an idea patentable, because an idea can nonetheless be obvious. However, the use of a screen dependent entry mechanism was far from obvious when I filed the '566 patent due to the challenges involved in creating a device that could successfully use a screen dependent entry mechanism despite the challenges posed by exclusive outdoor use.

12. SkyHawke and its expert are correct that screen dependent data entry was used prior to my invention in the on-TV menus used with VCRs and even in some pagers, but these devices were regarded as primarily (if not exclusively) indoor devices. In the case of a pager, as described in the Vanden Heuvel reference, they were also devices where the temporary inability to read the screen was not an impediment to successful use. The pager user could simply walk indoors if they needed to read the pager. A handheld sports recording device offered no such luxury – especially in the sport of golf. Data needed to be entered continuously and almost constantly while golf was being played. Players could not simply leave the course to read their screens or delay their games and the games of everyone behind them on the course by waiting for more favorable LCD screen reading conditions. These barriers prevented those of ordinary skill in the art from even considering the use of

screen dependent data fields for use in a handheld sport recording device, such as golf devices like the Palmer and Osamu references.

13. In the early 1990s, however, I began to think that it might be possible to develop a handheld sport recording device that could use screen dependent data fields to create a new type of sports recording device interface. In particular, I believed that as LCD screen technology evolved, a screen dependent entry mechanism could be successfully developed into a handheld sports recording device through careful division of the information screens into a series and sequence of pre-game, game interactive, and post-game screens. As shown in the '566 patent, by dividing the sport to be recorded and reviewed into pre-game, game interactive, and post-game information screens and further displaying those screens to a user in a defined sequential fashion or a defined logical sequence, it was possible to overcome the deficiencies of the LCD display technology of the time through ordered presentation and organization of data and data entry in a way not previously done.

14. As part of my development efforts, I approached several manufacturing companies under NDA, including JABIL and Saturn Electronics and Engineering, to manufacture a handheld device as described in the '566 patent. At both JABIL and Saturn Electronics and Engineering, I met with a variety of technicians that were experienced in building handheld electronic devices of that time and following the instructions of device designers to do so. At both places, I was told that handheld

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