

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*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

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 (“the ’566 patent”) pursuant to 35 U.S.C. § 311. Patent Owner L&H Concepts, LLC filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition. We have jurisdiction under 35 U.S.C. § 314. For the reasons that follow, we authorize institution of an *inter partes* review.

I. BACKGROUND

An inter partes review may be instituted only if “the information presented in the [Petition and Preliminary Response] shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Petitioner challenges claims 8–11, 14, and 18 of the ’566 patent as obvious under 35 U.S.C. § 103(a). Pet. 7. We authorize institution of *inter partes* review of claims 8–11, 14, and 18, but only on certain grounds as discussed below.

A. The ’566 Patent (*Ex. 1001*)

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.

The ’566 patent was 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. None of the references utilized in the

reexamination proceeding or initial prosecution is presently the subject of this Petition. Trial is being instituted in IPR2014-00438, which challenges different claims of the '566 patent, on the same day as this institution.

B. Illustrative Claim

Claim 8 of the '566 patent is illustrative of the claims at issue:

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

C. The Prior Art

Petitioner relies on the following prior art:

Vanden Heuvel et al. (hereinafter “Vanden Heuvel”)	US 5,426,422 WO 92/04080	June 20, 1995 (filed Apr. 11, 1994)
Palmer	WO 92/04080	Mar. 19, 1992
Osamu	GB 2 249 202 A	Apr. 29, 1992

Turbotax[®] User Manual (Oct., 1992) (hereinafter “Turbotax[®]”)

The Nintendo[®] Game Boy[®] Compact Video Game System Owner’s Manual (1989) (hereinafter “Game Boy[®]”)

EA SPORTS[®] Presents PGA[®] Tour Golf Instruction Booklet (1991) (hereinafter “PGA[®] Tour Golf”)

The Ultra Golf[®] Instruction Booklet for the Nintendo[®] Game Boy[®] (1992) (hereinafter “Ultra Golf[®]”)

D. The Asserted Grounds

Petitioner challenges claims 8–11, 14, and 18 of the ’566 patent on the following grounds (Pet. 7):

Claims 8–11, 14, and 18 as unpatentable under 35 U.S.C. § 103(a) over Palmer, Osamu, and Vanden Heuvel;

Claim 18 as unpatentable under 35 U.S.C. § 103(a) over Palmer, Osamu, Vanden Heuvel, and Turbotax[®]; and

Claims 8–11, 14, and 18 as unpatentable under 35 U.S.C. § 103(a) over Game Boy[®], Ultra Golf[®], and PGA[®] Tour Golf.

E. Claim Interpretation

The Board interprets claims using the “broadest reasonable construction in light of the specification of the patent in which [they] appear[.]” 37 C.F.R. § 42.100(b); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). As Figure 1 of the

instant patent provides a visual frame of reference which is useful in understanding the claim language, Figure 1 is reproduced below.

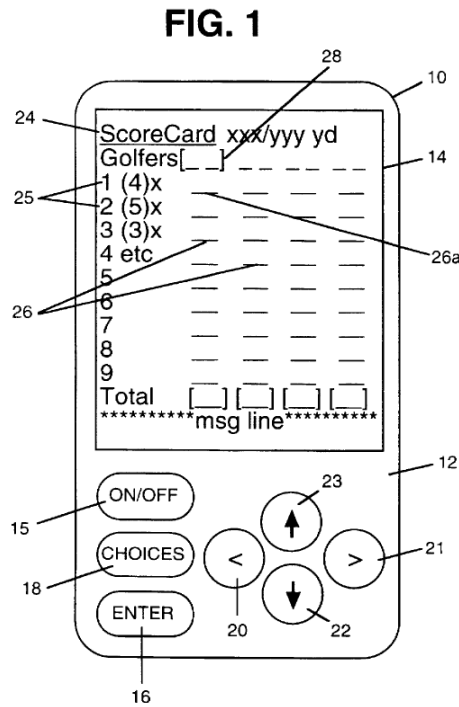


Figure 1 is a plan view of an embodiment of the '566 patent.

We are cognizant of the fact that the patent which is the subject of this proceeding will expire July 14, 2015. For the purposes of this Decision, we need not address the issue of alternative interpretations under different claim construction standards. The final decision in this matter may be rendered prior to the expiration of the '566 patent. In addition, claim construction is preliminary at this stage in the proceeding and may be modified later.

i. Preamble Language

Petitioner concludes that the preambles of the claims are nonlimiting. Pet. 17. Patent Owner disagrees. Prelim. Resp. 4. Patent Owner asserts that the preambles give life to the meaning of the claims in reciting an apparatus for recording and reporting data from golf or sports events. Prelim. Resp. 4.

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