

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TOPGOLF INTERNATIONAL, INC.,  
Petitioner,

v.

AMIT AGARWAL,  
Patent Owner.

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Case IPR2017-00928  
Patent 5,370,389

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Before LORA M. GREEN, MICHELLE N. WORMMEESTER, and  
AMANDA F. WIEKER, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

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

## I. INTRODUCTION

TopGolf International Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1 and 6 of U.S. Patent No. 5,370,389 (Ex. 1001, “the ’389 patent”). Paper 2 (“Pet.”). Mr. Amit Agarwal (“Patent Owner”), acting *pro se*, filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”; *see also* Paper 7, 2 (suggesting that Mr. Agarwal seek the services of a registered patent attorney who is familiar with the *inter partes* review process)).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any 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; *see* 37 C.F.R. §§ 42.4, 42.108. Upon considering the Petition and the Preliminary Response, we determine that Petitioner has shown a reasonable likelihood that it would prevail in showing the unpatentability of challenged claims 1 and 6. Accordingly, we institute an *inter partes* review of those claims.

### A. *Related Proceedings*

According to the parties, the ’389 patent is at issue in one pending litigation: *Agarwal v. TopGolf International, Inc.*, Case No. 8:16-cv-02641-VMC-JSS. Pet. 1; Paper 3, 1.

### B. *The ’389 Patent (Ex. 1001)*

The ’389 patent issued on December 6, 1994, with Douglas J. Reising as the listed inventor. Ex. 1001. The ’389 patent relates to a golfing game which allows a player to practice both long-range and close-range shots while aiming for different target greens located at varying distances from the teeing area. If the player lands a ball

on one of the greens, he receives a score on a visual display that is located near the teeing area so the player can easily see his score. Each of the greens is sloped so that a ball that lands upon the greens' surface will roll into a hole located at the lowest point of the surface. Each ball has a distinctive marking, either a color code or a bar code, so that it can be determined from which tee the ball was hit. After the ball rolls into the hole of a green, a sensor scans the ball and identifies from which tee the ball was hit. After the ball rolls into the hole of a green, a sensor scans the ball and identifies from which tee the ball came. A score is then added to the visual display at the corresponding tee. Each green can have a different point value, depending upon the difficulty of the golf shot required to land on that green.

*Id.*, Abstract.

Figure 3 of the '389 patent is reproduced below:

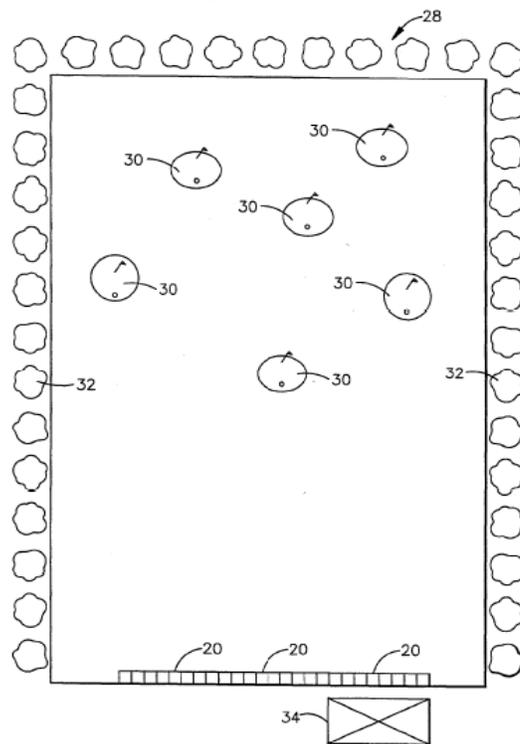


FIG. 3

Figure 3 “is a plan view of an entire driving range constructed in accordance with the principles of the present invention.” *Id.* at 3:21–23. As can be seen

in Figure 3, a driving range 28, which may be bordered by trees 32, has a number of target greens 30 that are positioned at various distances and locations from the teeing area 20.

Figure 4C is reproduced below:

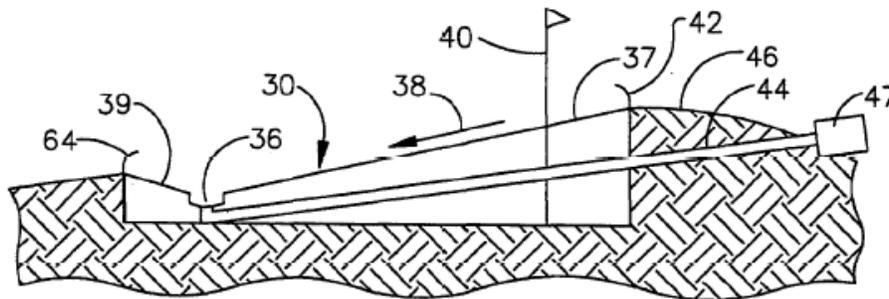


Figure 4C shows a cross-sectional view of one of the target greens. *Id.* at 3:28–29. As shown in the Figure, a target green 30 includes a target flag 40, as well as a receptacle hole 36. *Id.* at 4:29–30. The receptacle hole 36 is located near the front portion of the green and the green is sloped downhill such that the receptacle hole 36 is at the lowest point of the green. *Id.* at 4:30–35. The target flag 40 may be located at any position on the green. *Id.* at 4:55–56. As can be seen in the Figure, the target green “contains a graded rear portion which allows the player to see his ball hitting the green before the ball rolls down into a receptacle hole, which is located at the lowest point of each green.” *Id.* at 2:51–54.

### C. Challenged Claims

Petitioner challenges claims 1 and 6 of the '389 patent. Claim 1 is the only independent challenged claim, is representative, and is reproduced below (formatting added):

1. A method for playing a point-scoring game at a golfing range comprising the steps of:
  - (a) providing a plurality of golfing tees, each of which has an associated scoring device and a plurality of golf balls;
  - (b) providing each golf ball with an identifying characteristic which makes it possible to determine from which tee the golf ball originated;
  - (c) striking one of said golf balls at one of the plurality of golfing tees;
  - (d) providing a plurality of target greens which are remotely located from the plurality of golfing tees,  
each target green having a front portion and a rear portion,  
providing each target green with a receptacle hole and sloping the surface of each target green in a manner to cause said golf ball, once it lands upon the target green, to roll into said receptacle hole,  
said sloped surface forming an asymmetrical concave shape, said sloped surface having said receptacle hole located at its lowest point,  
said sloped surface having a profile, as viewed from the side of said target green, which is greatest in elevation at its rearmost end located at the rear portion of the target green furthest from said golfing tees,  
said profile continuously sloping downward toward the front portion of the target green nearest to said golfing tees, until arriving at said receptacle hole,  
said downward slope travelling substantially more than one-half the distance between the front and rear portions of the target green,  
said profile, as it continues forward from said receptacle hole, continuously sloping upward toward the front portion of the target green,  
said profile's forward most end located at the forward portion of the target green having an elevation that is significantly lower than at its rearmost end,

said upward slope travelling substantially less than one-half the distance between the front and rear portions of the target green;

(e) sensing said identifying characteristic of the golf ball, and identifying from which of said plurality of golfing tees the golf ball originated; and

(f) indexing the score of the scoring device which is located at the golfing tee corresponding to the identifying characteristic of said golf ball.

Ex. 1001, 9:24–68.

Dependent claim 6 adds the limitation of “wherein the step of indexing the score of said scoring device provides a different score value for each of said target greens.” *Id.* at 10:18–21.

#### *D. The Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of claims 1 and 6 of the ’389 patent on the following ground (Pet. 2–3):

<b>References</b>	<b>Basis</b>	<b>Claims Challenged</b>
Bertoncino <sup>1</sup> and Foley <sup>2</sup>	§ 103	1 and 6

Petitioner relies also on the Declaration of Richard Robbins.

Ex. 1003.

## II. ANALYSIS

### *A. Claim Construction*

Petitioner asserts, and Patent Owner does not contest, that the ’389 patent expired as of September 2012. Pet. 9. The Board’s review of the

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<sup>1</sup> Bertoncino, U.S. Patent No. 5,439,224, issued August 8, 1995 (“Bertoncino”) (Ex. 1004).

<sup>2</sup> Foley, U.S. Patent No. 5,163,677, issued November 17, 1992 (“Foley”) (Ex. 1006).

claims of an expired patent is similar to that of a district court's review. *In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). We are, therefore, guided by the principle that the words of a claim "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc) (internal citation omitted). We apply this standard to the claims of the expired '389 patent. *See* Pet. 9 (indicating that the '389 patent is expired). "In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence." *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). There is a "heavy presumption," however, that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) (citation omitted). Petitioner offers a construction for the claim term "target green." Pet 9–10. For purposes of this decision, however, we determine that none of the claim terms require explicit construction. *See, e.g., Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) ("[C]laim terms need only be construed 'to the extent necessary to resolve the controversy.'" (quoting *Vivid Techs, Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

*B. Obviousness over the Combination of Bertoncino and Foley*

Petitioner asserts that claims 1 and 6 are rendered obvious by the combination of Bertoncino and Foley. Pet. 22–60.

i. Overview of Bertoncino (Ex. 1004)

Bertoncino discloses:

A golf range comprising a series of independent targets, each of which consists of a sloped area located at a different distance from a multiplicity of tee stands. The range is also equipped with a scoring system that uses Universal Product Codes on each ball, optical scanners located at each target, and a programmed computer to identify each ball passing through the target and to record pertinent information and statistics to provide golfers with a record of the number and length of shots taken. The computer is also programmed to provide a comparison of information from previous sessions for a particular golfer or other golfers.

Ex. 1004, Abstract.

Figure 3 of Bertoncino is reproduced below:

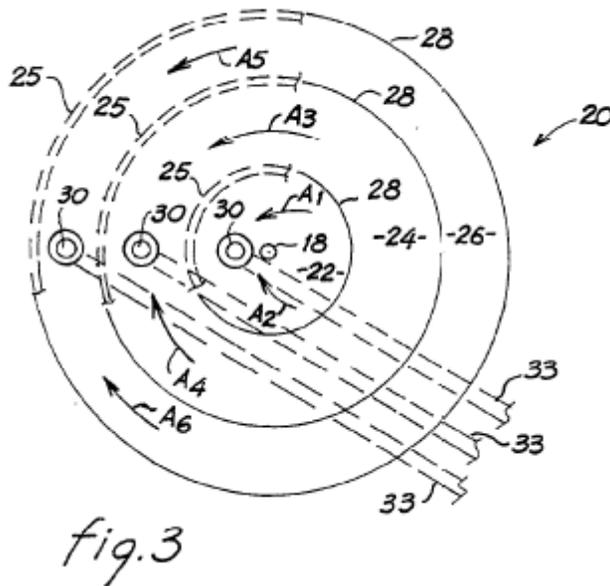


Figure 3 of Bertoncino shows a “plan view of a sloped circular target including three separate and concentric sections.” *Id.* at 4:6–7. Bertoncino teaches that the target 20 “comprises a surface generally sloped toward the tee stands area.” *Id.* at 5:37–39.

Figure 4 of Bertoncino is reproduced below:

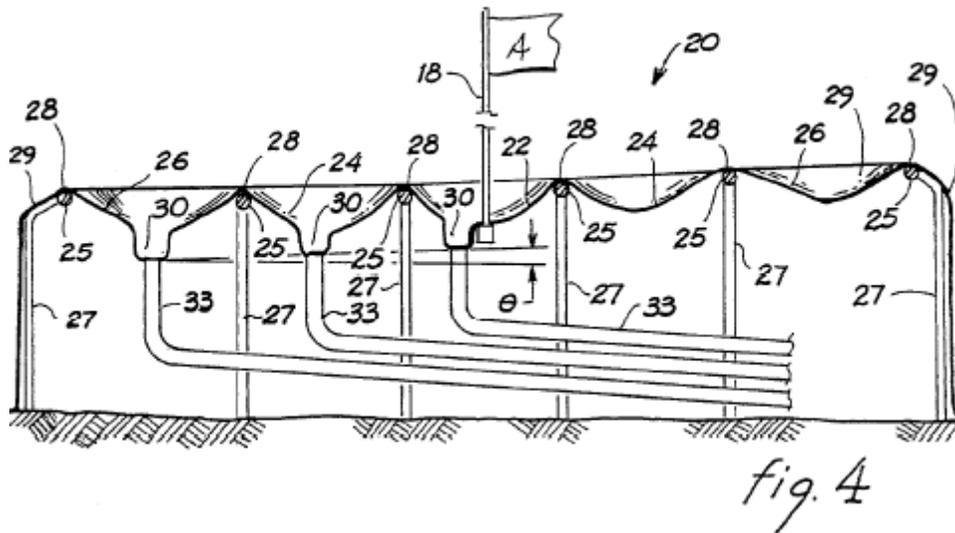


Figure 4 of Bertoncino shows a cross-sectional view of the sloped circular target shown in Figure 3, reproduced above. *Id.* at 4:8–9. Bertoncino teaches that the inner section 22 preferably comprises a concave structure, and a receiving cup 30 is located at the lowest spot in the section, which ensures that any ball that is hit into the section will roll into the cup 30 by the force of gravity. *Id.* at 5:54–60. In addition, Bertoncino teaches that “the target 20 may comprise a single section 22 with a single cup 30 connected to the lowest point in its surface.” *Id.* at 6:62–65.

Figure 5 of Bertoncino is reproduced below:

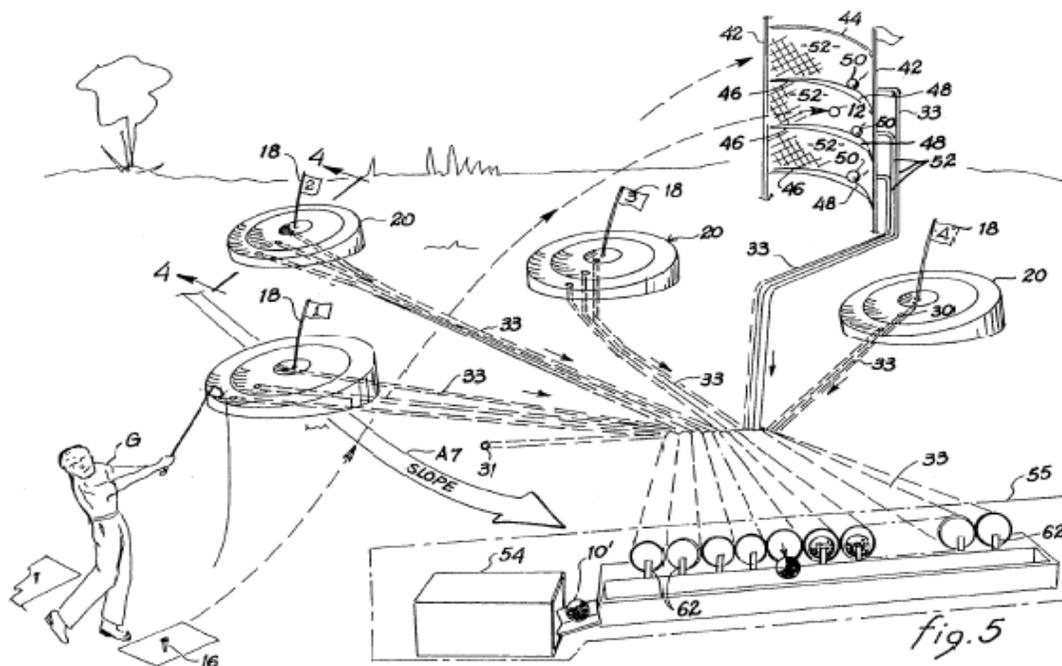


Figure 5 is “a schematic perspective of a sloped driving range” according to Bertoncino. *Id.* at 4:12–13.

ii. *Overview of Foley (Ex. 1006)*

Foley is drawn to a “golf driving-range for driving golf balls from any of a series of tee-points grouped together to a single common golf driving fairway having a plurality of spaced-apart greens each with a flagged hole.” Ex. 1006, Abstract. Foley teaches that on one or more of the golf greens there are golf ball percussion devices, such as an infra-red ray detector that detects balls that strike or roll across the green. *Id.* at 4:62–68. A signal is then sent through a computer and digitizer and fed to the booth from which a ball was most recently struck. *Id.* at 4:68–5:4. According to Foley, higher values or scores are assigned to particular greens depending on the distance or difficulty to hit the green from the teeing area. *Id.* at 5:6–21.

*iii. Analysis*

Petitioner relies on Bertoncino for teaching every element of claim 1, except that Bertoncino shows receiving the score card at the club house, rather than a scoring device located at each tee. Pet. 21–22. According to Petitioner, such scoring devices were well known in the art at the time of invention, as exemplified by Foley. *Id.* Each element of claim 1 is addressed below.

*a. “A method for playing a point-scoring game at a golfing range comprising the steps of”*

According to Petitioner, both Bertoncino and Foley “disclose ‘a method for playing a point-scoring game at a golfing range.’” Pet. 23. For example, Petitioner asserts that Bertoncino teaches a golf range in which players hit balls from a tee, wherein each hole on a target green is associated with a particular number of points, and the player receives a scoring card showing the points they have obtained. *Id.* (citing Ex. 1004, Abstract, 4:21–23, 8:55–63, 9:11–22, 10:5–13, 10:18–51, 10:52–11:3, Figs. 5, 8; Ex. 1003 ¶ 60). In addition, Petitioner asserts that Foley “discloses a ‘golf driving-range for driving golf balls from any of a series of tee-points grouped-together to a single common golf driving fairway having a plurality of spaced-apart greens each with a flagged hole,’ where each green has a particular score, and the system assigns a player that score when one of his or her balls passes through the hole.” *Id.* at 23–24 (citing Ex. 1006, Abstract, 5:6–30, Fig. 1; Ex. 1003 ¶ 61).

*b. “(a) providing a plurality of golfing tees, each of which has an associated scoring device and a plurality of golf balls”*

Petitioner asserts that the combination of Bertoncino and Foley teaches that limitation. *Id.* at 24 (citing Ex. 1003 ¶¶ 62–68; Ex. 1004, 3:19–

32, 5:17–29, 8:32:63, 9:32–54, Figs. 2, 8; Ex. 1006, 4:12–19, 6:26–52, Figs. 1, 3).

Specifically, Petitioner asserts that Bertoncino teaches a plurality of golf tees, each having a bucket of golf balls, as well as an associated scoring device. *Id.* According to Petitioner, “the balls at each tee stand are associated with a unique name, numbers, or other identifying code or symbol unique to a particular player, which is used to calculate the score for the player at that tee,” wherein the system automatically calculates a score for a player at a given tee. *Id.* at 24 (quoting Ex. 1004, 5:17–24; citing Ex. 1003 ¶¶ 63–64; Ex. 1004, 9:45–54, 9:63–10:17, Fig. 2).

Petitioner notes that Bertoncino teaches that the players obtain their scorecard that is automatically generated at the clubhouse at the end of the round, and not at the tee. *Id.* (citing Ex. 1004, 10:52–59, 9:55–10:5). Petitioner contends, however, that “[p]roviding a plurality of tees each with its own associated scoring device[] was well-known in the prior art.” *Id.* at 26. In that regard, Petitioner cites Foley as an example of a golf-driving range wherein each tee has an associated scoring device. *Id.* Foley, Petitioner asserts, teaches that each tee booth has an associated monitor, 35, as shown in Figure 1. *Id.* (citing Ex. 1006, Figs. 1, 4, 4:16–19, 5:6–21, 6:32–53; Ex. 1003 ¶ 65). In particular, Foley teaches that the score on the monitor is updated each time the golfer hits a target. *Id.* at 27.

Petitioner contends that the ordinary artisan would have had a reason to “incorporate Foley’s concept of having an individual scoring device” to provide each golfer’s score as taught by Bertoncino in order to provide a real-time score during play of the game. *Id.* at 28–29 (citing Ex. 1003 ¶¶ 64, 67, 68, 100). Petitioner asserts further that the ordinary artisan would have

had a reasonable expectation of success of having an individual scoring device at the tees of Bertoncino because Bertoncino teaches an automated system that tracks each golfer's scores and stores those scores in a centralized computer, and it would have been well within the level of skill of the ordinary artisan to include individual scoring devices at each tee as taught by Foley. *Id.* at 30 (citing Ex. 1004, 9:55–10:17; Ex. 1003 ¶¶ 68, 102). According to Petitioner, such a substitution is a simple “substitution of one known element for another to obtain a predictable and improved result.” *Id.* (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007)).

*c. “(b) providing each golf ball with an identifying characteristic which makes it possible to determine from which tee the golf ball originated”*

Petitioner contends that Bertoncino teaches this limitation, teaching specifically that each golfer is given a bucket of balls with a unique bar code to allow the system to determine from which tee the ball was hit. *Id.* at 30–33 (citing Ex. 1004, 1:66–2:10, 3:26–28; 4:30–63, 5:4–9, 5:17–23, 9:1–11, 9:63–10:5; Ex. 1003 ¶ 69).

*d. “(c) striking one of said golf balls at one of the plurality of golfing tees”*

Petitioner points to Figure 5 of Bertoncino, which shows a golfer striking a ball from a tee. *Id.* at 33–34.

*e. “(d) providing a plurality of target greens which are remotely located from the plurality of golfing tees”*

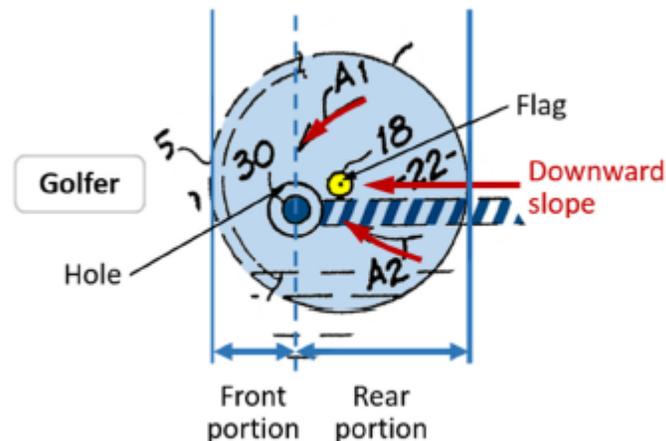
Petitioner notes that Bertoncino teaches a plurality of target greens, as shown in Figures 2 and 5. *Id.* at 34. Petitioner notes further that Foley also teaches a plurality of target greens. *Id.* (citing Ex. 1006, 2:4–12, 5:6–21; Ex. 1003 ¶ 72).

*f. “each target green having a front portion and a rear*

*portion, providing each target green with a receptacle hole and sloping the surface of each target green in a manner to cause said golf ball, once it lands upon the target green, to roll into said receptacle hole”*

Petitioner asserts that “Bertoncino discloses that each target green has a front portion, a rear portion, and a hole, and it discloses that each target green’s surface is sloped to cause a golf ball that lands on the green to roll into the hole.” *Id.* at 34–35 (citing Ex. 1004, 5:37–39, 5:53–60, 6:3–11, Figs. 3, 4, 5; Ex. 1003 ¶¶ 73–74). Citing Figure 3 of Bertoncino, Petitioner asserts that Bertoncino teaches a target green that includes three different sections (22, 24, and 26), each of which has a hole 30, noting that Bertoncino teaches also that the target green may be a single section 22 with a cup 30 at its lowest point. *Id.* at 35 (citing Ex. 1004, 5:44–66, 6:61–65).

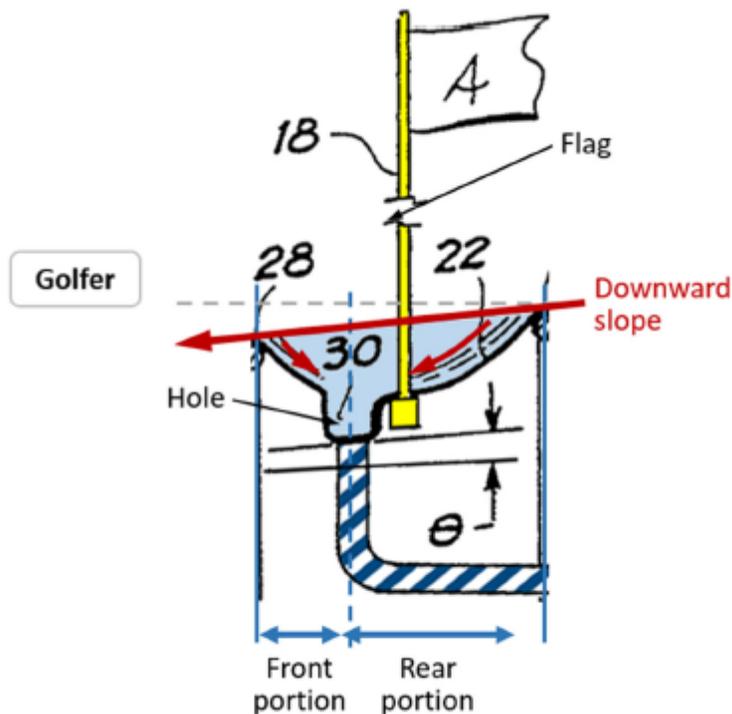
Petitioner provides the following annotated figure (hereinafter, “annotated Figure 3”):



Pet. 36 (citing Ex. 1003 ¶ 76; Ex. 1004, Fig. 3). Figure 3 of Bertoncino, from which the annotated figure above was adapted, shows a plan view of a sloped, circular target. Ex. 1004, 4:6. According to Petitioner, the ordinary artisan would understand the above annotated figure to be consistent with

Figure 3 of Bertoncino and its disclosure that the target green may include a single section 22. Pet. 35–36. Petitioner asserts further Bertoncino discloses also that the surface of the green 22 is sloped such that any ball that lands on it will roll into the hole 30 by force of gravity. *Id.* at 36–37 (citing Ex. 1004, 5:52–60, 6:3–11, 6:16–23).

Citing Figures 4 and 5 of Bertoncino, as well as Bertoncino’s disclosure that the target green may include a single section 22 (*id.* at 37–39, 42–43), Petitioner provides the following annotated Figure based on Figures 4 and 5 (hereinafter, “annotated Figure 4”):



Pet. 39 (citing Ex. 1003 ¶ 78). Figure 4 of Bertoncino is a cross-sectional view of the sloped circular target of Figure 3. Ex. 1004, 4:8–9. Figure 5 of Bertoncino, discussed above, shows a perspective view of the sloped driving range disclosed by that reference. *Id.* at 4:12–13. According to Petitioner, the ordinary artisan would understand that annotated Figure 4 represents the

single section 22 having the slope profile of Figure 5, which shows that each of the target greens is sloped such that the rearmost end is greatest in elevation. Pet. 38, 42. The above annotated figure, Petitioner asserts, further illustrates that the target green is sloped so that the ball will roll into the hole by force of gravity if hit anywhere into the target green 22. *Id.* at 39.

g. *“said sloped surface forming an asymmetrical concave shape, said sloped surface having said receptacle hole located at its lowest point, said sloped surface having a profile, as viewed from the side of said target green, which is greatest in elevation at its rearmost end located at the rear portion of the target green furthest from said golfing tees”*

Petitioner asserts that as Bertoncino teaches that the target green may be a single section 22, as discussed above, and shown in annotated Figure 4, Bertoncino teaches this limitation. *Id.* at 40 (citing Ex. 1004, 6:61–65).

Thus, Petitioner argues, Bertoncino expressly teaches that inner section 22 preferably comprises a concave structure with an upper rim 28 defining its perimeter and boundary with the intermediate section 24. A receiving cup 30 is located next to the flag 18 at the lowest spot in the section, thus ensuring that any ball lying on the inner section 22 would roll into the cup by the force of gravity. *Id.* at 40–41 (quoting Ex. 1004, 5:53–60). Petitioner contends, as discussed above in the discussion of annotated Figure 4, as shown in Figure 5 and as discussed by Bertoncino, the target green is sloped such that the rearmost end is greatest in elevation. *Id.* at 42–43 (citing Ex. 1004, Fig. 5, 5:37–39; Ex. 1003 ¶¶ 74, 81–83).

Petitioner argues further that “[t]o the extent Bertoncino does not disclose a stand-alone target having an asymmetric concave shape that meets

the claim limitations, such a green would be obvious to a skilled artisan based on Bertoncino's disclosures and the skilled artisan's general knowledge." *Id.* at 43 (citing Ex. 1003 ¶ 84). As Bertoncino teaches that the target green may only have section 22, the ordinary artisan would have a reason "to follow Bertoncino's teachings and use the shape in section 22 for the slope of the entire target green to help the golfer better visualize the green and see where his shot landed, while also ensuring that the ball rolls into the hole so it can be collected, sensed, and scored." *Id.* at 43–44 (citing Ex. 1003 ¶ 84; Ex. 1004, 1:26–30).

*h. "said profile continuously sloping downward toward the front portion of the target green nearest to said golfing tees, until arriving at said receptacle hole, said downward slope travelling substantially more than one-half the distance between the front and rear portions of the target green"*

According to Petitioner, as already noted, Bertoncino teaches that the target green may only have section 22. Pet. 44. In particular, Petitioner relies on Figure 4 as well as annotated Figure 4 as showing that the hole 30 is closer to the front portion than the rear portion, and that the "downward slope travels substantially more than half the distance from the front to the rear portions of the target green." *Id.* at 45–46 (citing Ex. 1004, Fig. 4, 5:37–39, 5:64–6:1; Ex. 1003 ¶ 87).

Petitioner argues further that to the extent that Bertoncino does not explicitly teach this limitation, it would have been obvious over the teachings of Bertoncino to use the shape in Figure 22 for the slope of the entire green to help the golfer better visualize the green and see where his shot had landed. *Id.* at 46–47 (citing Ex. 1003 ¶ 90).

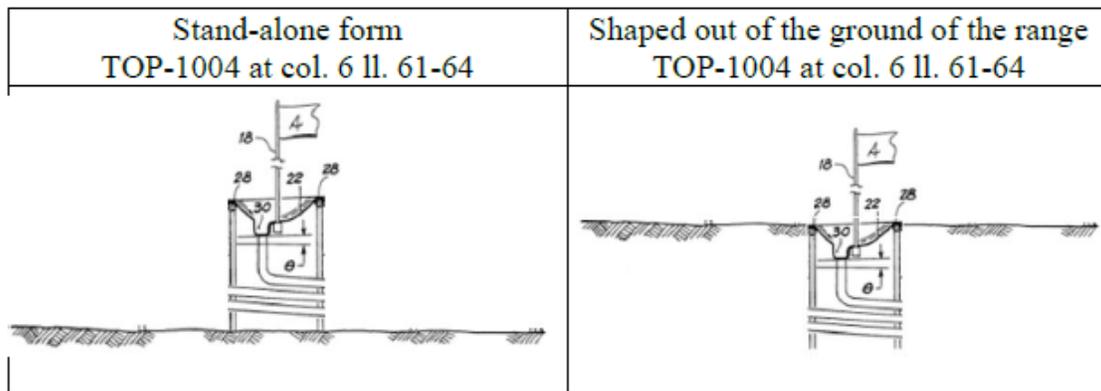
*i. "said profile, as it continues forward from said receptacle hole, continuously sloping upward toward the*

*front portion of the target green, said profile's forward most end located at the forward portion of the target green having an elevation that is significantly lower than at its rearmost end, said upward slope travelling substantially less than one-half the distance between the front and rear portions of the target green”*

As discussed above, Petitioner again notes that Bertoncino teaches that the target green may only have section 22. *Id.* at 47. Petitioner argues that Figure 5 of Bertoncino shows that the target green has a rear portion that is significantly higher than the front, which allows the golfer to easily see where his ball lands on the green. *Id.* at 49–50 (citing Ex. 1004, Fig. 5, 1:26–30, 5:37–39, 5:53–60, 6:21–32; Ex. 1003 ¶¶ 43, 91, 90, 93).

Petitioner asserts further that to the extent that Bertoncino does not expressly teach this limitation, it renders it obvious. In particular, Petitioner argues that Petitioner would have a reason to use the shape in Figure 22 for the slope of the entire green to help the golfer better visualize the green and see where his shot had landed, and also allow the ball to roll into the hole, where it can be sensed, selected, and scored. *Id.* at 50 (citing Ex. 1004, Figs. 4, 5, 5:47–6:15, 6:61–65; Ex. 1003 ¶ 94).

Patent Owner argues that the “prior art lacks the ‘significantly lower’ limitation.” Prelim. Resp. Patent Owner asserts that Petitioner “distorts Fig. 4 and labels parts of Fig. 5 matching far ends of multi-target green Fig. 4.” *Id.* (citing Pet. 49). Patent Owner provides the following annotated figure:



*Id.* Thus, Patent Owner contends that merely using section 22 for the entire target green does not achieve the “significantly lower” limitation. *Id.*

We have carefully considered both Patent Owner’s and Petitioner’s arguments and evidence, and conclude that Petitioner has shown a reasonable likelihood that this claim limitation is rendered obvious by Bertoncino. In particular, Figure 5 of Bertoncino clearly shows that the front ends of the target green on the driving range are substantially lower than the back ends. Ex. 1004, Fig. 5. In addition, we determine that to the extent they are not, Petitioner has reasonably demonstrated that Bertoncino makes such a green obvious by teaching that the ability to see the lie of the ball is dependent on the ability to visually follow the path of the ball (*id.* at 1:26–29), as well as teaching a “sloped driving range” (*id.* at 4:12–13; *see also id.* at 5:37–39 (“Each target . . . preferably comprises a surface generally sloped towards the tee stands area)).

*j.* “(e) sensing said identifying characteristic of the golf ball, and identifying from which of said plurality of golfing tees the golf ball originated”

Petitioner argues that Bertoncino expressly teaches this limitation. Pet. 50–52 (citing Ex. 1004, 3:36–28, 5:4–9, 5:17–23, 9:1–11, 9:63–10:5, Figs. 1a–1c, 2, 6, 7; Ex. 1003 ¶¶ 95–96).

k. “(f) indexing the score of the scoring device which is located at the golfing tee corresponding to the identifying characteristic of said golf ball”

Petitioner contends that the combination of Bertoncino and Foley renders this limitation obvious. Pet. 52–58. In particular, Petitioner asserts that Bertoncino teaches that each target has an associated scanner, and that the scanner is associated with a central computer that records the score associated with a particular ball and tee. *Id.* at 53 (citing Ex. 1004, 8:55–63, 5:17–23, Fig. 8). The central computer indexes the scores, adds them to the total for the round, and generates a score card unique to the player and sends it to the clubhouse. *Id.* at 54 (citing Ex. 1004, 9:45–10:5, 10:43–49, 10:5–11:3, Fig. 8; Ex. 1003 ¶¶ 49, 60, 97, 99). Petitioner argues further that Foley shows a driving range wherein each tee has an associated scoring device. *Id.* at 55 (citing Ex. 1006, 2:7–12, 4:16–19, 4:34–43, 4:62–5:21, 6:26–7:2, Figs. 1, 3; Ex. 1003 ¶¶ 65, 101).

Thus, according to Petitioner, the ordinary artisan would have had a reason to “incorporate Foley’s concept of having an individual scoring device” to provide each golfer’s score as taught by Bertoncino in order to provide a real-time score during play of the game. *Id.* at 55–56 (citing Ex. 1003 ¶¶ 64, 67, 68, 100).

*l. Conclusion as to claim 1*

We have reviewed Petitioner’s and Patent Owner’s arguments and evidence, as discussed above, and conclude that Petitioner has demonstrated a reasonable likelihood that independent claim 1 is rendered obvious by the combination of Bertoncino and Foley.

*m. Claim 6*

As to dependent claim 6, Petitioner argues that claim only adds the limitation of “the step of indexing the score of said scoring device provides a different score value of said target greens.” Pet. 58. Petitioner asserts, however, that Bertoncino teaches that limitation by teaching that each of the target greens is located a different distance from the tee, and also discloses a scoring formula where a player’s shot is “assigned a particular number of points based on the target’s size and distance from the tee to the target.” *Id.* at 58 (citing Ex. 1004, 1:67–2:3, 9:55–10:5, 9:49–54, 10:5–51, 9:16–22, Figs. 2, 5, 8; Ex. 1003 ¶ 103). Petitioner notes also that Foley discloses further the assignment of a score based on the distance of the targets from the green. *Id.* at 59 (citing Ex. 1006, 5:6–21).

After considering Petitioner’s arguments and evidence, we conclude that Petitioner has demonstrated a reasonable likelihood that claim 6 is rendered obvious by the combination of Bertoncino and Foley.

III. CONCLUSION

For the foregoing reasons, we are persuaded that the Petition establishes a reasonable likelihood that Petitioner would prevail in showing that claims 1 and 6 of the ’389 patent are unpatentable as obvious under 35 U.S.C. § 103.

Our determinations at this stage of the proceeding are based on the evidentiary record currently before us. This decision to institute trial is not a final decision as to patentability of the claim for which *inter partes* review is instituted. Our final decision will be based on the full record developed during trial.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that pursuant to 35 U.S.C. §314(a), an *inter partes* review is hereby instituted on the following ground:

Claims 1 and 6 as rendered obvious by the combination of Bertoncino and Foley.

FURTHER ORDERED that no other proposed grounds of unpatentability are authorized; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this Decision.

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