

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOPGOLF INTERNATIONAL, INC.,
Petitioner,

v.

AMIT AGARWAL,
Patent Owner.

Case IPR2017-00928
Patent 5,370,389

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

GREEN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION

Determining That Claims 1 and 6 Have Been Shown to Be Unpatentable
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

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). We determined that the information presented in the Petition and the Preliminary Response demonstrated that there was a reasonable likelihood that Petitioner would prevail in challenging claims 1 and 6 as unpatentable under 35 U.S.C. § 103(a). Pursuant to 35 U.S.C. § 314, the Board instituted trial on July 19, 2017, as to all of the challenged claims of the ’389 patent. Paper 8 (“Institution Decision” or “Dec. Inst.”).

Patent Owner filed a Response¹ (Paper 23, “PO Resp.”), and Petitioner filed a Reply (Paper 27). Oral hearing was held on April 17, 2018, and a transcript of that hearing has been entered into the record. Paper 37 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. Petitioner bears the burden of proving unpatentability of the challenged claims, and that burden never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must establish

¹ Patent Owner originally filed a Patent Owner Response at Paper 22, which was not in compliance with the word count required by 37 C.F.R. § 42.24(b). Patent Owner then filed a redacted copy of the Patent Owner Response that was in compliance with the required word count as Paper 23. After oral hearing, in which we inquired whether either party had any objections to our expunging the non-compliant Patent Owner Response, and both parties stated that they did not, we expunged Paper 22. Tr. 4.

facts supporting its challenge by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Based on the record before us, we conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 1 and 6 of the '389 patent are unpatentable.

A. Related Proceeding

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 (M.D. Fl.). 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. In particular, the '389 patent teaches that the "invention will be specifically disclosed in connection with such a range in which the target

greens are sloped so that a golf ball landing on each green will roll into a hole containing a sensor that can identify from which tee the ball was hit.” *Id.* at 1:11–15.

The ’389 patent teaches that “[e]xisting driving ranges often have small greens that include target flags at which to aim.” *Id.* at 1:48–49. According to the ’389 patent, the greens may be located from as little as 100 to more than 250 yards from the tee. *Id.* at 1:49–52. Such ranges, however, “do not . . . include any type of automatic scoring capabilities.” *Id.* at 1:55–56.

The ’389 patent teaches further that available golfing games that provide an automatic score are designed for putting or short distance chipping. *Id.* at 1:61–64. Moreover, in such games, the ’389 patent notes, “the targets are so small and at such a distance that it would be very difficult to obtain any score whatsoever.” *Id.* at 1:64–67. In addition, the ’389 patent states that “each of the games available at the present time requires construction of a special facility and could not be easily retrofitted into an existing driving range.” *Id.* at 1:67–2:2. The ’389 patent teaches also that “[n]one of the prior art games are intended for use as a driving range to practice driving skills at realistic distances.” *Id.* at 2:2–4. Thus, a primary object of the invention of the ’389 patent is “to provide a golfing game which can be retrofitted into an existing driving range in which the golfer attempts to place his ball upon one of several target greens,” wherein “a score is indexed at a distance near the golfer’s location.” *Id.* at 2:7–12.

Figure 3 of the '389 patent is reproduced below:

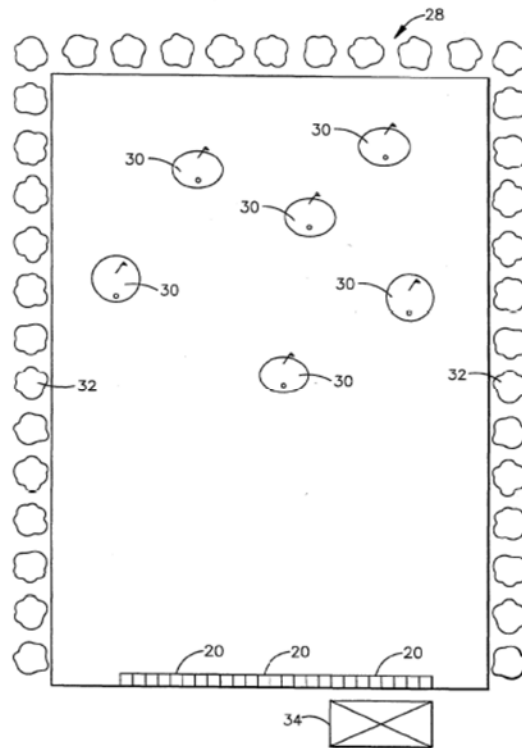


FIG. 3

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. *Id.* at 4:13–18. According to the '389 patent, “[e]ach 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.” *Id.* at 2:51–53.

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