

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

M & P GOLF, LLC d/b/a COOL CLUBS, ROGER DUNN INC.,
GOLFSMITH INTERNATIONAL, INC., and GOLFTEC
ENTERPRISES, LLC,
Petitioner,

v.

MAX OUT GOLF, LLC,
Patent Owner.

Case IPR2016-00784
Patent 7,967,695 B2

Before JOSIAH C. COCKS, HYUN J. JUNG, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

JUDGMENT AND FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

M & P Golf, LLC d/b/a Cool Clubs, Roger Dunn Inc., Golfsmith International, Inc., and GolfTEC Enterprises, LLC (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–6 of U.S. Patent No. 7,967,695 B2 (“the ’695 patent”). Pet. 1. We issued a Decision to Institute an *inter partes* review of claims 1–6 of the ’695 patent as unpatentable under 35 U.S.C. § 103 over (1) Gobush¹ and Maltby² and (2) Gobush, Maltby, and Erlichson.³ Paper 13, 20–21.

After institution of trial, Max Out Golf, LLC (“Patent Owner”) filed a Response (Paper 17), to which Petitioner replied (Paper 35). Oral argument was conducted on May 25, 2017, and a transcript of the hearing is entered in the record. Paper 42, “Tr.”

II. ANALYSIS

Ex Parte Reexamination Control Number 90/013,617 of the ’695 patent (“Reexamination”) was granted on November 25, 2015, and a rejection of claims 1–6 as unpatentable over Gobush and Erlichson was made on February 9, 2016. Ex. 1015, 340–49, 355–64. On December 21, 2016, Patent Owner filed a response amending independent claims 1 and 4 “to include subject matter that was indicated as being allowable over the prior art.” *Id.* at 675–717; *see id.* at 716 (arguing that independent claims 1

¹ US Pat. No. 6,241,622 B1, iss. June 5, 2001 (Ex. 1012).

² Ralph Maltby, *Golf Club Design, Fitting, Alteration & Repair* (Ralph Maltby Enterprises, Inc., 4th ed., 1995) (Ex. 1010).

³ Herman Erlichson, *Maximum projectile range with drag and lift, with particular application to golf*, Am. J. Phys. 357 (1983) (Ex. 1011).

and 4 have “been amended herein to include the subject matter that was indicated as being allowable over the prior art”).

On February 6, 2017, Petitioner filed a Motion to Stay the Reexamination (“Motion,” Paper 21), to which Patent Owner opposed (“Opposition,” Paper 26). In its Opposition, Patent Owner argued that the claims pending in the Reexamination “are substantially different from the claims for which this proceeding was instituted” and that “the patentability of the independent claims 1 and 4 in the . . . Reexamination hinges on features . . . not at all involved in this proceeding.” Paper 26, 8–9.

On March 10, 2017, we denied Petitioner’s Motion, in part because the claims pending in the Reexamination were of narrower scope than original claims 1–6 pending in this proceeding. Paper 33, 4.

On April 14, 2017, an *Ex Parte* Reexamination Certificate issued amending independent claims 1 and 4. Ex. 3002, 1:15–2:29. As claims 2 and 3 depend from claim 1, and claims 5 and 6 depend from claim 4, every claim subject to this *inter partes* review has been amended, and original claims 1–6 no longer exist. See Ex. 1001, 14:35–16:16. Furthermore, Patent Owner acknowledges that the amended claims are narrower in scope and patentably distinct from the original claims. Paper 26, 8–9; Tr. 41–42.⁴

⁴ Prior to rebuttal argument from Petitioner, the following exchange occurred between the panel and Patent Owner:

JUDGE COCKS: Okay, so the claims that have emerged from the re-exam in connection with the ’695 patent, are you representing to us that they are patentably indistinct from the claims as the appeared before?

MR. GILLESPIE: I’m not representing that. They clearly were narrowed.

Accordingly, any decision as to the patentability of original claims 1–6 that are at issue in this proceeding seemingly would be moot and purely advisory.

As set forth in 37 C.F.R. § 42.73:

(b) *Request for adverse judgment.* A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include:

. . . .

(3) Concession of unpatentability or derivation of the contested subject matter; and

(4) Abandonment of the contest.

Pursuant to 37 C.F.R. § 42.73(b), we find Patent Owner’s amendment—which results in claims that are patentably distinct from those that are before us—to be an abandonment of contest and a concession of unpatentability. Accordingly, we construe Patent Owner’s claim amendment as a request for adverse judgment.

Accordingly, we enter judgment against Patent Owner under 37 C.F.R. § 42.73.

III. ORDER

Accordingly, it is

ORDERED that judgment is entered under 37 C.F.R. § 42.73 against Patent Owner with respect to original claims 1–6 of the ’695 patent; and

FURTHER ORDERED that this Order constitutes a Final Written Decision under 35 U.S.C. § 318(a).

JUDGE COCKS: So they’re –
Mr. GILLESPIE: They are patently distinct claims.

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