

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  
Denying Patent Owner's Request for Rehearing  
37 C.F.R. § 42.71

Patent Owner filed a Request for Rehearing (Paper 10, “Reh’g Req.”) of our Decision instituting *inter partes* review (Paper 8, “Decision” or “Dec.”) of claims 1 and 6 of U.S. Patent No. 5,370,389 (Ex. 1001, “the ’389 patent”). We deny Petitioner’s Request for Rehearing for the reasons set forth below.

### STANDARD OF REVIEW

When reconsidering a decision on institution, the Board reviews the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion occurs if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). “The burden of showing that a decision should be modified lies with the party challenging the decision.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In its request for rehearing, the dissatisfied party must, in relevant part, “specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768. We address Petitioner’s arguments with these principles in mind.

### ANALYSIS

Challenged independent claim 1 is directed to (focusing on the limitation at issue in Patent Owner Rehearing Request) “a method for playing a point-scoring game at a golfing range,” wherein each target green

has a front portion and a rear portion, wherein the target green has a profile whose “forward most end located at the forward portion of the target green ha[s] an elevation that is *significantly lower* than at its rearmost end.”

Ex. 1001, 9:24–68 (Claim 1) (emphasis added).

In our Decision on Institution, we determined that Petitioner had established sufficiently a reasonable likelihood that the challenged claims were rendered obvious by the combination of Bertoncino and Foley.

Dec. 22. In particular, as to the limitation that the target green has a profile whose “forward most end located at the forward portion of the target green ha[s] an elevation that is *significantly lower* than at its rearmost end,” for purposes of institution, we determined:

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)).

*Id.* at 19.

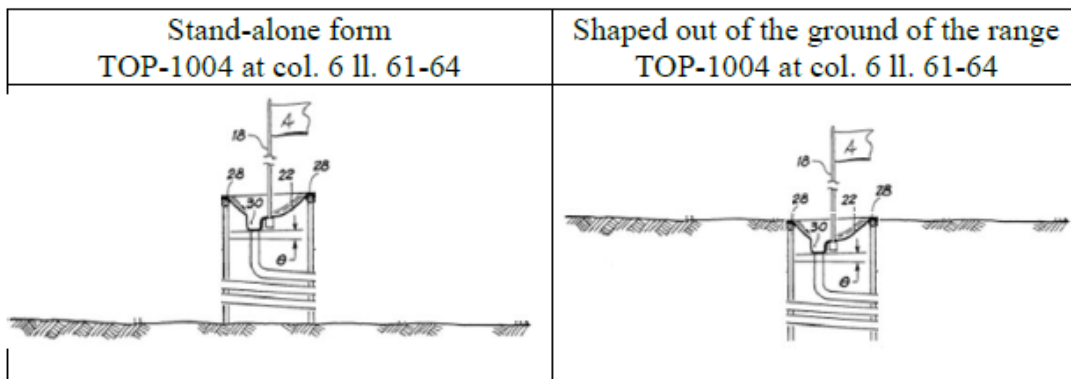
Before we address the merits of Patent Owner’s Rehearing Request, we note that Patent Owner, Amit Agarwal, who is proceeding *pro se*, initially filed of Waiver of his Preliminary Response. Paper 4. In a conference call on April 24, 2017, requested by Patent Owner, Patent Owner sought authorization to file a motion for sanctions against Petitioner,

alleging that Petitioner misrepresented the teachings of the prior art in its Petition. Paper 7, 2. We declined to authorize a motion for sanctions, but did authorize Patent Owner to file a patent owner Preliminary Response by the date at which such a response would have been due if Mr. Agarwal had not waived its filing, i.e., May 28, 2017. *Id.* at 3. We also counseled Patent Owner that he should seek the services of a registered patent attorney who is familiar with the *inter partes* review process. *Id.* at 2.

Patent Owner filed a one page Preliminary Response on April 25, 2017. Paper 6. In that Response, Patent Owner stated in full:

The prior art lacks the “significantly lower” limitation. TOP-1001 at col. 9 ll. 58-59. Topgolf distorts Fig. 4 and labels parts of Fig. 5 matching far ends of multi-target-green Fig. 4. Pet. at 49. Topgolf’s sole proposed prior art modification, “follow[ing] Bertoncino’s teachings and us[ing] the shape in section 22 for the slope of the entire target green,” Pet. at 50, does not achieve the missing “significantly lower” limitation (illustrated below) and thus cannot suffice to “obtain the claimed invention,” *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1335 (Fed. Cir. 2016), meriting non-institution.

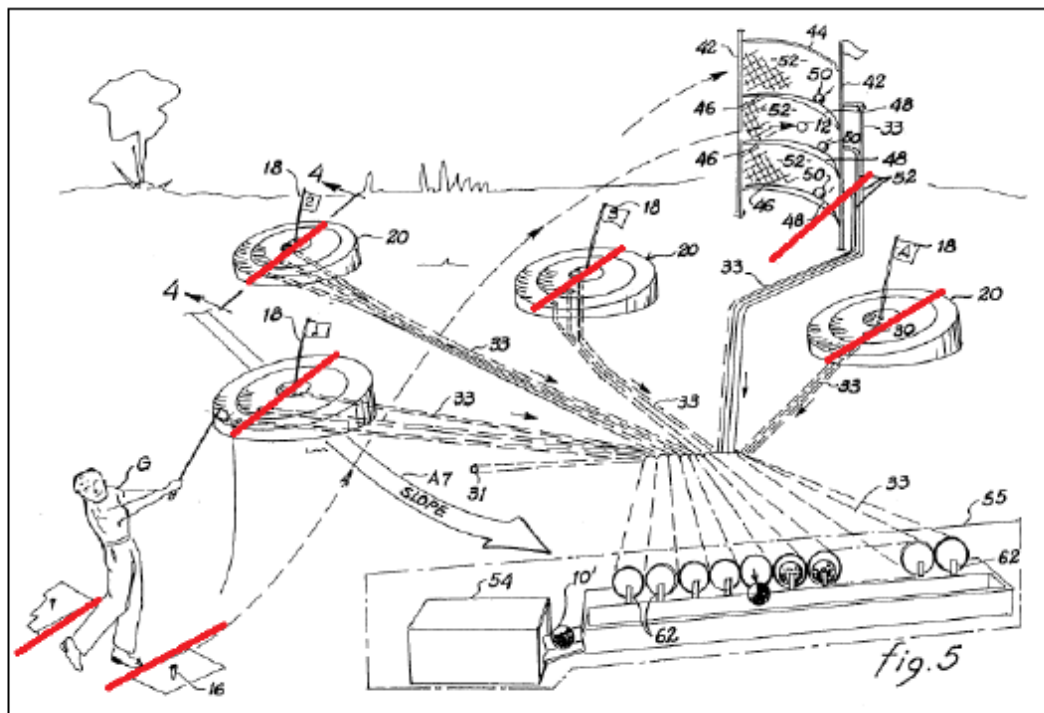
*Id.* Patent Owner also provided the following figure:



*Id.*

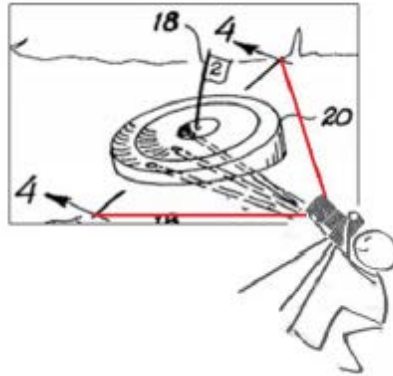
Patent Owner now contends in a fifteen page Request for Rehearing that we erred by misapprehending or overlooking various teachings of Bertoncino, as well as the case law regarding reliance on drawings. We address Patent Owner's arguments below.

Patent Owner argues that we overlooked the vantage point of Figure 5, which, Patent Owner asserts, portrays the objects diagonally from a height. Reh'g Req. 1. In particular, Patent Owner provides the following annotated Figure 5 of Bertoncino:



*Id.* (annotations in red). Figure 5 is “a schematic perspective of a sloped driving range” according to Bertoncino. Ex. 1004, 4:12–13.

According to Patent Owner, we overlooked that Figures 4 and 5 of Bertoncino depict the same structure, as Figure 4 is along line 4-4 from the vantage point of Figure 5. Reh'g Req. 2. That is, as illustrated by Patent Owner, line 4-4 is:



*Id.* The above Figure is an illustration of line 4-4 shown in Figure 5 from the vantage point of Figure 5. *Id.* Thus, Figure 4, reproduced below, is from that vantage point:

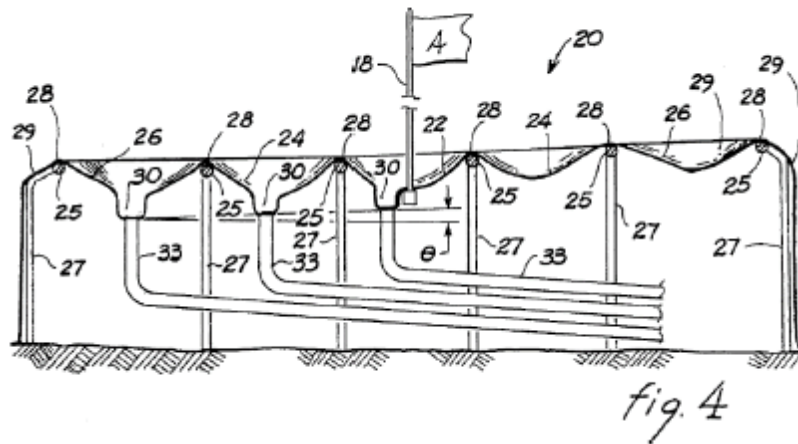


Figure 4 of Bertoncino, reproduced above, shows a cross-sectional view of the sloped circular target shown in Figure 3. Ex. 1004, 4:8–9. According to Patent Owner, “[n]o reasonable artisan would independently render an already-rendered drawing to ascertain the difference between the prior art and the claimed target green—one of the key steps of the obviousness analysis.” Reh’g Req. 3

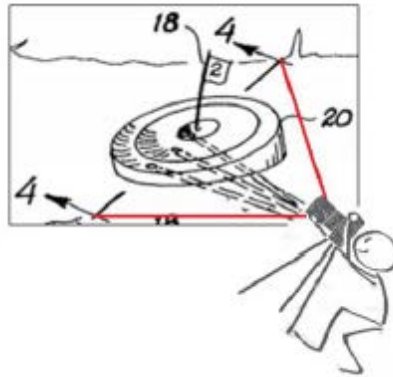
Patent Owner argues further that forty-eight hours before instituting trial in this proceeding, another panel of the Board declined to institute trial

in a different proceeding, noting that “dimensions purportedly reflected in patent drawings are unpersuasive, absent a discussion of those dimensions in the written description of the patent’s specification.” *Id.* (quoting *Yitzhak v. Uni-Charm Corp.*, IPR2017-00694 Paper 11, 10 (July 17, 2017)). Patent Owner further notes that in that decision, the Board relied on *Hockerson-Halberstadt, Inc. v. Avia Grp. Int’l, Inc.*, 222 F.3d 951, 956 (Fed. Cir. 2000) and *Nystrom v. TREX Co.*, 424 F.3d 1136, 1149 (Fed. Cir. 2005) for the proposition that “patent drawings do not define the precise proportions of the elements and may not be relied upon to show particular sizes if the specification is completely silent on the issue.” Reh’g Req. 3 (quoting *Yitzhak v. Uni-Charm Corp.*, Case IPR2017-00694, slip. op. at 10 (PTAB July 17, 2017) (Paper 11)). Thus, Patent Owner contends, we “overlooked that Bertoncino’s drawing are not explicitly made to scale and therefore arguments based on those drawing are unavailing.” Reh’g Req. 3.

We did not rely on the drawings for the dimension of the target green, but for what they would reasonably teach or suggest to the ordinary artisan. *See, e.g., In re Meng*, 492 F.2d 843, 847 (CCPA 1974) (noting that “a drawing is available as a reference for all that it teaches a person of ordinary skill in the art.”). As can be seen in Figure 5 of Bertoncino, even if the perspective is from the side, the Figure shows that the driving range slopes up from the golfer to the target green. And that is not just shown in Figure 5, but is supported also by the Specification of Bertoncino. Thus, Bertoncino teaches 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” (Ex. 1004, Abstract); Figure 5 of Bertoncino is described as “a schematic perspective of a sloped driving range according to

th[e] invention” (*id.* at 4:12–13); and “[e]ach target comprises a surface generally toward the tee stands area” (*id.* at 5:37–39).

Moreover, as noted by Patent Owner, Figure 4 of Bertoncino is taken at a line 4-4 in Figure 5 of Bertoncino, which, as annotated by Patent Owner, is again reproduced below:



Reh’g Req. 2. The above Figure is an illustration of line 4-4 shown in Figure 5 from the vantage point of Figure 5. *Id.* Patent Owner fails to discuss, however, that even from the perspective added by Patent Owner, line 4-4 follows the slope of the green. Thus, in Figure 5, it can be seen that the front area of each target green is lower than the back end of each green, which is also seen in Figure 4. Figure 4, however, does not take into account the slope of the driving range shown in Figure 5.

Thus, Patent Owner’s reliance on *Yitzhak v. Uni-Charm Corp.*, Case IPR2017-00694, slip. op. at 10 (PTAB July 17, 2017) (Paper 11) is unavailing. In that case, the independent claims required exact ratios, that is, a “ratio of a radius to an axial length of the outer curved face of the applicator is at most 0.8, and that a ratio of valve length to width is 1.0 to 2.0.” *Id.* Petitioner’s expert stated in that case that the figures depicted that ratio based on measurements of the figures using a ruler. *Id.* In that

proceeding, the panel concluded the case-law, including that relied upon by Patent Owner here, supported the proposition that “*specific dimensions inferred from patent drawings* are unpersuasive if the specification is silent on the issue.” *Id.* at 11 (emphasis added). Here, Figure 5 of Bertoncino is relied upon to show the general slope of the driving range. In addition, as discussed above, the slope of that range is also supported by the statements made in the Specification of Bertoncino. In that regard, we note that as discussed below, Patent Owner has not persuaded us at this stage of the proceeding that “significantly lower” is a “specific” dimension.

Patent Owner argues further that even though the Petition and the Preliminary Response relied on Figure 4, we did not discuss whether that figure discloses the “significantly lower” limitation. Reh’g Req. 5. According to Patent Owner, we “misapprehended an analytical mandate to assess Fig. 4 to the exclusion of Fig. 5, a mandate that naturally flows from the (i) the existence of the vantage point claim limitation; and (ii) the fact that Fig. 4 is explicitly defined in Bertoncino as a rendering of Fig. 5’s target from the claimed vantage point and not a depiction of some alternative embodiment.” *Id.*

Patent Owner asserts that we inappropriately instituted trial based on an “‘express disclosures of Bertoncino’ section [that] is limited to an observation that Fig. 5 ‘clearly’ depicts something—with no account of the vantage point claim limitation, no requisite correlation of Fig. 5 to Fig. 4, and an effective reading out of the recited vantage point claim limitation” of that profile as viewed from the target green. *Id.* Moreover, Patent Owner contends, Petitioner nowhere addresses whether Figure 4, in its undoctored form, discloses that limitation. *Id.*

Patent Owner is focusing on the limitation of wherein the “forward most end located at the forward portion of the target green ha[s] an elevation that is *significantly lower* than at its rearmost end.” We note that the term “significantly lower” is a relative term, and Patent Owner does not offer a construction of that term.<sup>1</sup> Nor does Patent Owner point us to anything in the prosecution history as providing a construction for that term. In addition, we note further that the Specification of the ’389 patent also does not define the relative term “significantly lower.” The Specification of the ’389 patent, however, teaches that each target green includes a target flag and a receptacle hole that is located near the front section of the green. Ex. 1001, 4:29–32. According to the Specification of the ’389 patent, the target green is sloped downhill and has the general shape of a concave surface so that the receptacle hole is at the lowest portion of the green. *Id.* at 4:32–35. Figure 4C of the ’389 patent is reproduced below:

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<sup>1</sup> We acknowledge that the ’389 patent expired as of September 2012, and we are, thus, 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). But, “[i]n 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).

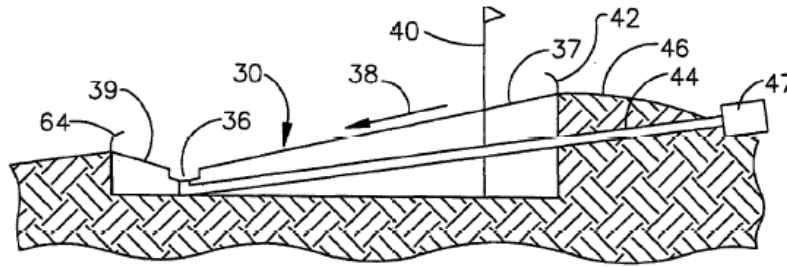
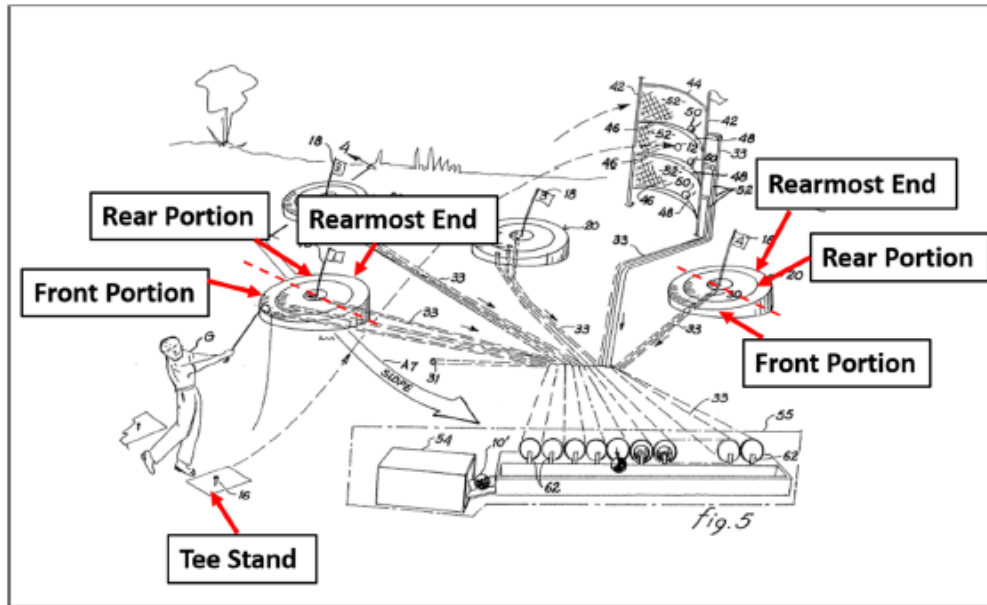


Figure 4C shows a cross-sectional view of a target green. *Id.* at 3:28–29. As taught by the '389 patent, “[t]arget green 30 would appear to the golfer at the teeing area to have a sudden drop off near the front portion of the green, and then a gradual slope upwardly toward the back of the green.” *Id.* at 4:37–40. Thus, at best, the Specification of the '389 patent appears to support a construction of the claim limitation of a target green profile whose “forward most end located at the forward portion of the target green ha[s] an elevation that is *significantly lower* than at its rearmost end” as a green that has a sudden drop off near the front portion of the green and then a gradual slope upward toward the back of the green.

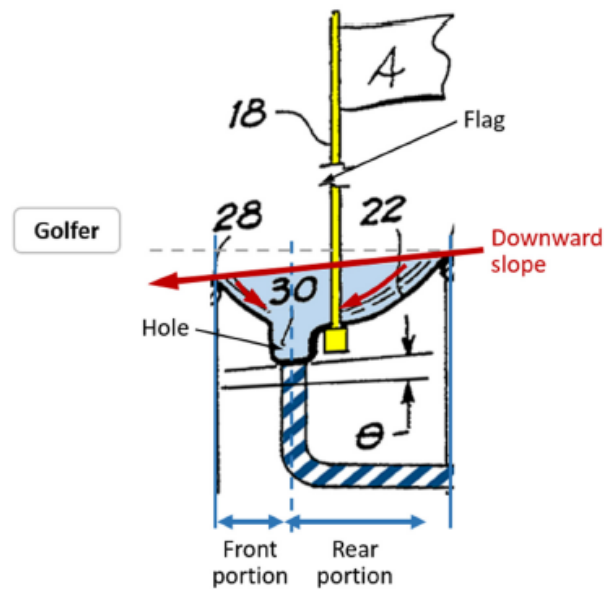
As discussed in the Decision on Institution (Dec. 8), Bertoncino teaches a target green that has “a surface generally sloped toward the tee stands area.” Ex. 1004, 5:37–30. Figure 4 of Bertoncino shows such a target green, taken along line 4-4 of Figure 5. As can be seen in Figure 5 of Bertoncino, line 4-4 follows the slope of the green of the driving range shown in Figure 5. Thus, in Figure 4 the target green is shown as being on a flat surface, but it is related to Figure 5, and Figure 5 shows the target green on a sloped surface, and that is reiterated in the Specification of Bertoncino, which teaches that Figure 5 of Bertoncino shows “a schematic perspective of a sloped driving range” (Ex. 1004, 4:12–13), and teaches also that “[e]ach

target comprises a surface generally toward the tee stands area” (*id.* at 5:37–39).

Petitioner relied on Figure 5 of Bertoncino to address that the target green is significantly lower in the front and the back, presenting annotated Figure 5 of Bertoncino, reproduced below:



Pet. 49. Figure 5 of Bertoncino, as addressed above, is a schematic perspective of a sloped driving range of Bertoncino. Petitioner also relied on its version of Figure 4 of Bertoncino, which was altered in line with the teaching of that reference that the target green may have only the inner section 22 (Ex. 1004, 6:61–65), and including the slope of the driving range shown in Figure 5 of Bertoncino, reproduced below:



Pet. 49 (citing Ex. 1003 ¶ 92). Figure 4 of Bertoncino is a cross-sectional view of the sloped circular target of Figure 3. Ex. 1004, 4:8–9. That is supported by Petitioner’s expert, Mr. Robbins, who declares that “[a] person of skill in the art would interpret Bertoncino to disclose a range with a plurality of target greens, each of which is composed of a single section with the slope profile of inner section 22” as depicted above. Ex. 1003 ¶ 92. Thus, as we concluded in the Decision on Institution (Dec. 17–18), Petitioner in its Petition has established reasonably that Bertoncino teaches a target green having a profile wherein the “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.” That is, Petitioner has established reasonably for purposes of institution that the target green of Bertoncino meets the “significantly lower” limitation as construed above, as it has as a green that has a sudden drop off near the front portion of the green due to the concave shape of the target green and then a gradual slope upward toward the back of the green. See Ex. 1004, 6:3–11, 12:6–12, Figure 4.

As to the obviousness analysis in the Decision on Institution, Patent Owner argues that we relied on evidence and argument that Petitioner did not make. Reh’g Req. 6. In that regard, we note that the Court of Appeals for the Federal Circuit, our reviewing court, has held that an IPR is not strictly limited to the grounds asserted in the petition. *In re Cuozzo Speed Technologies, LLC*, 793 F.3d 1268, 1273–74 (Fed. Cir. 2015).

Patent Owner argues further that to the extent that we relied on Bertoncino’s teaching that a golfer needs to see where the ball lands, Patent Owner argues that Bertoncino’s description addresses why Bertoncino slopes its green the way it does, but is not a reason to modify the target green. Reh’g Req. 7 (citing Pet. 50). Patent Owner argues that, as was argued above, Bertoncino does not slope his green such that it meets the “significantly lower” claim limitation. *Id.* As also discussed above, however, we determine that Petitioner has established sufficiently for purposes of institution that Bertoncino does slope the green such as to meet the “significantly lower” claim limitation.

Petitioner argues further that we misapprehended the proper meaning of the claimed method if we “believe[ ] a sloped driving range has any bearing—whatsoever—on the claim limitation ‘significantly lower’ which compares two points on a profile of a target green viewed from the side. This has nothing to do with the general slope of a driving range.” Reh’g Req. 9. In addition, Patent Owner asserts, “[P]etitioner nowhere recited ‘4:12–13’ or ‘sloped driving range’ in its petition.” *Id.* (emphasis omitted).

Although Petitioner does not specifically mention a sloped driving range, it specifically argues that the prior art taught sloped target greens, which is what is required by the claims. Pet. 13–17. And as discussed

above, the slope of the driving range of Bertoncino as shown in Figure 5 of that reference is relevant to the slope of the target green shown in Figure 4 of that reference, as line 4-4 in Figure 5, of which the cross-section is shown in Figure 4, follows the slope of the driving range shown in Figure 5.

Patent Owner asserts further that we relied upon Bertoncino's teaching that the target comprises a surface generally sloped towards the tee stands area in the obviousness analysis, which was not relied upon by Petitioner in its Petition. Reh'g Req. 9–10. That evidence, Patent Owner asserts, "was cited by the Petitioner as evidence for the proposition that the Bertoncino reference confirms that Bertoncino **actually discloses** that the forward most end of the target green is significantly lower in elevation than the rearmost end." *Id.* at 10. But, even if we were to agree that argument was not necessarily made by Petitioner in the Petition, as held by the Federal Circuit in *Cuozzo*, we are not necessarily limited to the grounds as set forth in the Petition.

### CONCLUSION

We have considered Patent Owner's request for rehearing, but are not persuaded that we abused our discretion in instituting an *inter partes* review.

### ORDER

It is

ORDERED that Patent Owner's request for rehearing of the Decision instituting an *inter partes* review of claims 1 and 6 of U.S. Patent No. 5,370,389 is *denied*.

IPR2017-00928  
Patent 5,370,389

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