

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLAST MOTION, INC, and
TAYLORMADE GOLF COMPANY, INC.
Petitioner,

v.

NEWSPIN SPORTS LLC,
Patent Owner.

Case IPR2019-00538
Patent 8,589,114 B2

Before FRANCES L. IPPOLITO, CHRISTOPHER M. KAISER, and
JOHN R. KENNY, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing of Decision
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Blast Motion, Inc. and TaylorMade Golf Company, Inc. (“collectively, Petitioner”) filed a Petition (Paper 1, “Pet.”), requesting an *inter partes* review of claims 1–24 (“challenged claims”) of U.S. Patent No. 8,589,114 B2 (Ex. 1003, “the ’114 patent”). Newspin Sports, LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). We denied the Petition and did not institute *inter partes* review. Paper 9 (“Dec.”). Petitioner now requests rehearing of our decision not to institute review. Paper 10 (“Request for Rehearing,” “Req. Reh’g”).

For the reasons below, the Request for Rehearing is *denied*.

II. ANALYSIS

A request for rehearing must identify specifically all matters the requesting party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). When rehearing a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

A. *Hackman*

Petitioner argues that we erred in determining that “Hackman does not teach an externally mounted device that avoids any interference with the golfer’s swing; it merely teaches a device that permits use outside an artificial environment in which the golfer is less likely to make a normal swing.” Dec. 17; Req. Reh’g 9. Petitioner argues that, in making this determination, we overlooked Hackman’s disclosure that “a need exists for an apparatus which can be used during normal golf activities so as to encourage the golfer to swing in the normal playing manner.” Ex. 1012, 4:26–30; Req. Reh’g 9. We, however, cited this disclosure in Hackman when we explained “although the cited portion of Hackman recognizes the benefit of ‘encourag[ing] the golfer to swing in the normal playing manner,’ ”

it does not contrast this with a swing that is encumbered by externally mounted devices that cause the ‘weight, drag, or other swing-related issues’ to which Dr. Paradiso refers. Ex. 1012, 4:7–30.” Dec. 17 (referring also to our discussion of paragraphs 97–98 of Dr. Paradiso’s Declaration). The Request for Rehearing does not cite any disclosure in which Hackman contrasts the swing it permits with one that is encumbered by externally mounted devices that cause weight, drag, or other swing-related issues. Req. Reh’g 9–10. Further, we are not persuaded that we misapprehended Dr. Paradiso’s testimony in this regard. Rather, we were unpersuaded that Dr. Paradiso’s citation to portions of Hackman’s disclosure (and Exhibit 1017) supported Dr. Paradiso’s own statements in his Declaration. See Dec. 17 (“[A]lthough the cited portion of Hackman in Dr. Paradiso’s Declaration recognizes the benefit of ‘encourag[ing] the golfer to swing in the normal playing manner,’ it does not contrast this with a swing that is encumbered by externally mounted devices that cause the “‘weight, drag, or other swing-related issues’ to which Dr. Paradiso refers. Ex. 1012, 4:7–30.”).

Accordingly, we are not persuaded that we erred in determining that Hackman does not teach an externally mounted device that avoids interference with a golfer’s swing.

B. Exhibit 1017

Petitioner argues that we erred in determining that Exhibit 1017 did not support Dr. Paradiso’s testimony that the weight, drag, and other swing-related issues caused by shaft-mounted devices identified by Farrington were readily overcome. Dec. 17–18; Req. Reh’g 10. Petitioner argues that Exhibit 1017 supports that testimony by Dr. Paradiso because Dr. Paradiso testified that the teachings in wearable systems were applicable to non-wearable systems. *Id.* We, however, are not persuaded by that argument

because even if we were to credit that latter testimony, Petitioner has not shown that Exhibit 1017 describes or even suggests any device (wearable or non-wearable) that would be sized so as to avoid the weight, drag, and swing-related issues that Farrington attributes to externally mounted swing analysis devices. *Id.*

C. Kirby

Petitioner argues that we erred in determining that the evidence of record did not sufficiently show that Kirby includes an optional accelerometer or other analog device for swing analysis. Req. Reh’g 11. In making this argument, however, Petitioner does not address our reasons for concluding that the evidence of record did not provide a sufficient showing: Kirby describes another device as being useful as an analog sensor that does not appear capable of being used for swing analysis, and Kirby expressly teaches that accelerometers, gyroscopes, and angular rate sensors are impractical for swing analysis. Dec. 26–29 (citing Ex. 1013 ¶¶ 15, 105). Accordingly, we are not persuaded that we erred in determining that the evidence of record did not sufficiently show that Kirby includes an optional accelerometer or other analog device for swing analysis.

Petitioner also argues that Kirby only indicates that accelerometers are too slow for detecting the precise moment of contact and, consistent with Kirby’s teachings, accelerometers would be useful for other aspects of swing analysis. Req. Reh’g 11–12. Petitioner, however, cites nothing in Kirby that suggests that the accelerometers would have sufficient speed for other aspects of swing analysis. *Id.* To the contrary, Kirby teaches that accelerometers, gyroscopes, and angular rate sensors all require a slow latching and conversion process, whereas golf involves club head speeds that can reach 250 km/hr. Ex. 1013 ¶ 15. Further, even if speed were not an

issue, as we noted, Kirby disparages the use of externally mounted systems due to alignment problems, which Petitioner has not addressed in its Request for Rehearing. Dec. 27; Ex. 1013 ¶ 14; Req. Reh’g 15. Accordingly, we are not persuaded that we erred in not instituting an *inter partes* review on this basis.

D. Farrington’s Disparagement and the Level of Skill in the Art, Background Art, and Reasonable Expectation of Success

Petitioner argues that we overlooked evidence regarding the general knowledge of an ordinarily skilled artisan, background art, and reasonable expectation of success when we determined, for Ground 1 (based on Farrington and Hackman), that Petitioner made an insufficient showing to overcome Farrington’s disparagement of using a swing analysis device mounted on the outside of its golf club. Req. Reh’g 2–5. More specifically, Petitioner contends that “[t]he Decision first accords little or no weight to ¶¶93-94 of Dr. Paradiso’s declaration because it purportedly lacks ‘any citation to the record’” and “[t]he only other portions of Dr. Paradiso’s testimony addressed in the Decision are ¶¶97-98, which cite Hackman and EX1017.” *Id.* at 2 (citing Dec. 14–20). We address each of Petitioner’s contentions below.

Petitioner argues first that we have overlooked section VIII of the Petition (Pet. 7–8) that cites to section VI of Dr. Paradiso’s declaration (Ex. 1009 ¶¶ 41–72, which, according to Petitioner, describes the person of ordinary skill in the art’s (POSA) knowledge and skill with support from 16 exhibits. Req. Reh’g 3. Petitioner adds that in relation to these sections, Dr. Paradiso discusses the POSA’s knowledge of sensor types, sensor locations, and explains that POSAs understood the tradeoffs of internally vs. externally mounted systems—e.g., security, configurability, costs, and user preference.

Id. (citing Pet. 8; Ex. 1009 ¶¶ 6, 9, 41, 43–60).

Petitioner’s arguments are not persuasive. To start, we note that on page 39 of the Petition, Petitioner refers to section VIII to argue that POSA would have had a *reasonable expectation of success* in implementing Petitioner’s proposed modification of Farrington with Hackman’s removable device. Pet. 39 (“The POSA also would have had a reasonable expectation of success in implementing a shaft-mounted approach like Hackman’s. *Id.*, ¶102. As explained above in section VIII, sensors, like accelerometers and gyroscopes, and their functions were well-understood prior to August 19, 2008.”). The Petition, separately, and specifically addresses the Farrington’s disparagement of the shaft-mounted systems on pages 38–39 of the Petition. There Petitioner argues that

[a]lthough Farrington notes certain concerns with shaft-mounted systems, such as swing effects, aesthetics, and the attachment mechanism’s gripping capability, it was known in the art, and within the POSA’s ability, how to adequately address and alleviate those concerns. See EX1011, ¶5; EX1009, ¶¶95-96. For instance, Hackman teaches providing a shaft-mounted system that does not interfere with the golfer’s swing, see EX1012, 4:7-30 (acknowledging need for golfer to “swing in a normal manner”), and the POSA would have been aware of readily-available accelerometers, gyroscopes, and other sensors, that were sufficiently light and compact so that any impact on a swing would be negligible. EX1009, ¶¶97-98. In addition, for aesthetics, the POSA would have been aware of the wide variety of choices known in the art and would have understood how to design the removable unit for a certain “look and feel”. *Id.*, ¶99. As for grip concerns, Hackman demonstrates the numerous mechanical options available to the POSA that would allow IMU attachment to the club’s shaft without loosening or moving during a swing. See, e.g., EX1012, 10:10-18 (teaching frictional engagement that “is sufficient to hold the analyzer 10 in place during swinging”), FIGS. 1, 4, 7-10; EX1009, ¶¶100-01.

Accordingly, even in view of Farrington's concerns, the POSA would have had reason to implement an IMU, like that taught by Farrington, as a removable device, like that taught by Hackman, based on, for example, costs, convenience, and flexibility benefits conferred by such a system. EX1009, ¶¶93-94.

Pet. 38-39. Nowhere in this discussion does the Petition reference section VIII of the Petition (Pet. 7-8) or other testimony from Dr. Paradiso to support these arguments.

Further, as our Decision noted, the only support Dr. Paradiso cited for these propositions are portions of Hackman and Exhibit 1017. Ex. 1009 ¶¶ 93-101; Dec. 14-15 (discussing Dr. Paradiso's testimony in paragraphs 93-94 of his Declaration and Petitioner's arguments on pages 37-38 of the Petition), *id.* at 15 (discussing Farrington's disclosure and Petitioner's arguments on pages 37-40 of the Petition), *id.* at 16 (discussing Petitioner's arguments on page 38 of the Petition, cited portions of Hackman, and paragraphs 97-98 of Dr. Paradiso's Declaration), *id.* at 19 (discussing paragraph 99 of Dr. Paradiso's Declaration). As such, our Decision addressed the arguments and evidence presented by Petitioner in the Petition for overcoming the "concerns" and disparagement that Farrington explicitly teaches go against Petitioner's arguments for why the proposed modification would have been obvious.

Petitioner identifies nothing from its evidence of the general knowledge of an ordinarily skilled artisan, background art, or reasonable expectation of success that provides any further support for these propositions. Req. Reh'g 2-5. Instead, Petitioner merely argues that an ordinarily skilled artisan would have recognized some benefits to using a shaft mounted system with a golf club and would have had a reasonable

expectation of success for adding such a system to Farrington’s golf club.

Id. None of that evidence, however, suffices to overcome Farrington’s disparagement. The mere fact that, for general purposes, externally mounted systems may have benefits or could be added to Farrington’s golf club does not demonstrate that, as Dr. Paradiso testified, the weight, drag or other swing-related issues highlighted by Farrington associated with such a system would be readily overcome. Indeed, “obviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015).

Accordingly, we are not persuaded that we overlooked evidence that would overcome Farrington’s disparagement of using a swing analysis device mounted on the outside of its golf club.

F. Kirby’s and Kimber’s Disparagements and the Level of Skill in the Art, Background Art, and Reasonable Expectation of Success

Petitioner argues that we overlooked evidence regarding the general knowledge of an ordinarily skilled artisan, background art, and reasonable expectation of success when we determined, for Ground 3 (based on Kirby and Kimber), that Petitioner made an insufficient showing to overcome Kirby’s disparagement of using accelerometers, gyroscopes and angular sensors for swing analysis and to overcome Kimber’s disparagement of placing a swing measurement device near the grip. Req. Reh’g 5–9.

Initially, we are not persuaded that we overlooked any evidence, e.g., Dr. Paradiso’s testimony. *See id.* at 5 (“the Decision overlooks critical testimony cited at pp. 72–73 of the Petition.”). For example, page 28 of the Decision notes:

Petitioner relies on the Dr. Paradiso’s testimony to overcome this evidence of disparagement. *Pet. 71–73 (citing Ex. 1009 ¶¶ 203–219)*. Neither Petitioner nor Dr. Paradiso explains persuasively, however, why a person of ordinary skill in the art would have been persuaded to ignore Kirby’s disparagement of the use of accelerometers for swing measurement. *Id.*

Dec. 28 (emphasis added); *see id.* at 25 (noting that “Petitioner argues that a person of ordinary skill in the art would have had reason to use an accelerometer-based device like that taught by Kimber and optionally by Kirby, located adjacent to the grip of a golf club, as taught by Kirby, rather than adjacent to the head of the golf club, as taught by Kimber. *Pet. 71–73.*”) (emphasis added). Thus, as indicated in the Decision, the panel considered all of the arguments and evidence presented by Petitioner in the Petition. However, the panel determined that these arguments and evidence did not establish a reasonable likelihood that Petitioner would prevail in showing the unpatentability of the challenged claims.

Additionally, none of the evidence cited by Petitioner regarding the level of skill in the art, background art, or a reasonable expectation of success would overcome Kirby’s and Kimber’s disparagements. *Id.* As discussed extensively in the Decision, even considering all the arguments presented on pages 71–73 of the Petition and Dr. Paradiso’s testimony (Ex. 1009 ¶¶ 203–19), we determined that neither the Petitioner nor Dr. Paradiso explains persuasively why a POSA would ignore Kirby’s disparagement for using accelerometers for swing measurement. Dec. 28. Further, we determined given “Kirby’s express teaching that ‘accelerometers, gyroscopes, and/or angular rate sensors’ are too slow to be used for swing analysis . . . we are not persuaded that the evidence of record sufficiently shows that the purpose for which Kirby includes an optional accelerometer

or other analog device is, as Petitioner argues, ‘for swing analysis.’” Dec. 29. Thus, the mere fact that, for general purposes, accelerometers may have some benefits or that there would be a reasonable expectation that they could be added to Kirby’s golf club does not mean that such a modification would avoid the speed and cost issues noted by Kirby or outweigh them. See Ex. 1009 ¶¶ 44–50.

We have also previously considered all the arguments and evidence Petitioner presented and referenced on pages 72–73 of the Petition regarding Kimber’s teachings. We determined in the Decision that

Kimber also disparages Petitioner’s proposed combination. *Petitioner argues that a person of ordinary skill in the art would have located the swing-measurement device adjacent to the grip of the golf club, as taught by Kirby, rather than adjacent to the club head, as taught by Kimber. Pet. 72–73. But, Kimber characterizes its device placement near the club head as crucial to successful measurement of a swing, stating that “if the device is not attached close to the club head, then accurate measurement will not be possible.” Ex. 1014, 2:7–10. . . . Petitioner relies on the Dr. Paradiso’s testimony to overcome this evidence of disparagement. Pet. 71–73 (citing Ex. 1009 ¶¶ 203–219).*

Dec. 28 (emphases added). Thus, we are not persuaded that we have overlooked any of Petitioner’s arguments or evidence. Further, we are not persuaded that the advantages, i.e., tradeoffs, to placing an accelerometer near a grip and reasonable expectation of success for the modification overcomes Kimber’s disparagement of placing a swing measurement device near the grip or outweigh that concern. See Ex. 1009 ¶¶ 51–57. As we noted in the Decision, “Kimber characterizes its device placement near the club head as crucial to successful measurement of a swing, stating that ‘if the device is not attached close to the club head, then accurate measurement will not be possible.’” Dec. 28 (citing Ex. 1014, 2:7–10). We reiterate our

determination in the Decision that the express disparagement by Kimber (and Kirby) is not overcome by Petitioner's arguments and proffered evidence. *See* Dec. 28.

Accordingly, we are not persuaded that we overlooked or misapprehended arguments or evidence that would overcome Kirby's disparagement of using accelerometers, gyroscopes and angular sensors for swing analysis and Kimber's disparagement of placing a swing measurement device near the grip.

III. CONCLUSION

In view of the foregoing, we are not persuaded that we erred in not instituting an *inter partes* review with respect to Petitioner's obviousness grounds. Thus, Petitioner's request for rehearing is *denied*.

Outcome of Decision on Rehearing:

Claims	35 U.S.C. §	Basis	Granted	Denied
1–13 and 15–24	§ 103	Farrington and Hackman		1–13 and 15–24
14	§ 103	Farrington, Hackman, and Nusbaum		14
1–13 and 15–24	§ 103	Kirby and Kimber		1–13 and 15–24
14	§ 103	Kirby, Kimber, Nusbaum		14

IV. ORDER

It is

ORDERED that the Request for Rehearing is denied.

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