UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DECA INTERNATIONAL CORP.,
Requester and Respondent,

v.

SKYHAWKE TECHNOLOGIES, LLC,
Patent Owner and Appellant.

Appeal 2015-004932
Reexamination Control 95/001,750
Patent No. US 7,118,498
Technology Center 3900

Before JOHN A. JEFFERY, MARC S. HOFF, and ERIC B. CHEN, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Third Party Requester DECA International Corp. appeals under 35 U.S.C. §§ 134(b) and 315(a) (2002) from the Examiner's decision not to

reject claims 5–8[1] as set forth in the Right of Appeal Notice (RAN) mailed April 15, 2014. Requester filed a brief ("Req. App. Br.") on July 15, 2014 and a rebuttal brief ("Req. Reb. Br.") on December 15, 2014. Patent Owner SkyHawke Technologies, LLC filed a Respondent's Brief on August 15, 2014. The Examiner mailed an Examiner's Answer ("Ans.") on November 13, 2014 which incorporated the RAN by reference. We have jurisdiction under 35 U.S.C. §§ 134 and 315.

We affirm.

The '498 Patent issued to Meadows on October 10, 2006, and is assigned to SkyHawke Technologies, LLC. The '498 Patent concerns a handheld personal golfing assistant system that includes a GPS receiver. The system can be used during the course of playing golf to mark a ball location automatically, determine the distance to golf course targets or objects, analyze golf related data and generate statistics (Abstract).

Claim 5 is exemplary of the claims on appeal:

An integrated handheld apparatus for measuring and displaying distances between a golfer and an object on a golf course comprising:

a computing device;

a GPS device connected to said computing device;

an apparatus display connected to said computing device;

said GPS device adapted to produce measured location information corresponding to a location of said GPS device independent of golf course infrastructure;

[1] Claims 1–4 are not subject to reexamination.

means, within said handheld apparatus, for determining a distance, independent of said golf course infrastructure, between said GPS device and said object by using said measured location information and previously stored information concerning the location of said object; and

wherein a representation of said object is displayed on said apparatus display, as viewed from above said object, and said representation automatically rotates to orient said representation to coincide with said golfer's line of sight to said object and said integrated handheld computing device is adapted to selectively display said distance on said apparatus display.

The Examiner relies upon the following prior art in rejecting the claims on appeal:

Rudow et al.	US 6,236,940	May 22, 2001
Johnson	US 6,366,856	April 2, 2002
Barnard	US 6,456,938	September 24, 2002
Reeves	US 7,121,962	October 17, 2006

The claims stand rejected over various combinations of prior art references (*see* Req. App. Br. 12-14):

References	**Claims**	**Basis (§)**
Reeves and Johnson	5 and 6	103(a)
Reeves, Johnson, and Barnard	5 and 6	103(a)
Rudow and Johnson	5 and 6	103(a)
Rudow, Johnson, and Barnard	5 and 6	103(a)
Barnard and Johnson	5-8	103(a)

ISSUE

Requester argues that the '498 Patent does not disclose sufficient structure corresponding to the "means for determining a distance" limitation of claim 5, such that the limitation cannot be properly construed (Req. App. Br. 14). Requester argues that Patentee should be required to remedy claim 5. In the alternative, Requester contends that a broad construction of "hardware and software that can perform the recited function" be applied, and the claims should be rejected in accordance with the first Action Closing Prosecution (Req. App. Br. 14).

The arguments made by Patent Owner and Requester present us with the following issue:

1. Does the '498 Patent disclose sufficient structure, material, or acts such that the claims of the '498 Patent are amenable to construction?

2. Did the Examiner err in withdrawing the rejections of claims 5–8 entered in the first ACP?

PRINCIPLES OF LAW

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claims shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.
>
> 35 U.S.C. § 112 (2003).

A determination by the Director under subsection (a) shall be final and non-appealable. 35 U.S.C. § 312(c) (2003).

> [A]n inter partes reexamination is a two-step process. First, the Director must make a determination "whether a substantial new question of patentability affecting any claim of the patent is raised by the request . . . with or without consideration of other patents or printed publications . . . . Second, after the director has determined that there is a substantial new question of patentability affecting a claim with respect to prior art, an inter partes reexamination is ordered "for resolution of the question." The question to be resolved is the substantial new question of patentability determined by the Director.

Belkin Int'l Inc. v. Kappos, 696 F.3d 1379, 1382 (Fed. Cir. 2012).

ANALYSIS

In order to evaluate whether the Examiner erred in deciding to withdraw the proposed rejections that were initially found to raise a substantial new question of patentability, we must construe the means-plus-function limitation found in independent claim 5:

"Means, within said handheld apparatus, for determining a distance, independent of said golf course infrastructure, between said GPS device and said object by using said measured location information and previously stored information concerning the location of said object."

Requester argues that the specification does not clearly link or associate tangible structure with the recited function, and does not disclose a complete algorithm for performing the function. Requester states that the '498 Patent's Specification requires that

> [t]he golfer can also load course object data previously surveyed by the golfer or others and adjust the distance processing to correct for differences between current environmental conditions and the environmental conditions when the course was originally surveyed. This process combined with real time tunable GPS parameters that can be adjusted for the dynamics of an individual mobile golfer on a specific course enables relative distances to be computed with sufficient accuracy for golf without requiring the use of DGPS equipment or any equipment mounted on a golf cart or infrastructure on the golf course.

'498 Patent, col. 8, ll. 26–36.

Requester concludes from this disclosure that the process for performing the claimed function (i.e., "determining a distance") requires

> (1) loading previously surveyed course-object data; (2) adjusting the distance processing to correct for differences between current environmental conditions and the environmental conditions when the course was originally surveyed; and (3) using real time tunable GPS parameters that can be adjusted for the dynamics of an individual mobile golfer on a specific course.

Req. App. Br. 6.

Requester goes on to argue that the '498 Patent "fails to provide a complete step-by-step procedure for fully performing the first and third requirements" (Req. App. Br. 6–7).

We agree with Requester that the claimed "means . . . for determining a distance . . . between said GPS device and said object" must include adjusting distance processing (i.e., "environmental error correction") and using real time tunable GPS parameters. Even though the patent claims do not recite environmental correction or tunable GPS parameters, claim 5 does

recite "independent of said golf course infrastructure." Column 8 of the '498 Patent makes clear that in order to determine relative distances, e.g. between the GPS device and an object such as a green, "with sufficient accuracy for golf . . . *without* requiring the use of DGPS equipment or any equipment mounted on a golf cart *or infrastructure on the golf course*" (col. 8, ll. 34-36; emphasis added), one must perform the process of correcting for environmental condition differences, and use real time tunable GPS parameters.

Figure 8 of the '498 Patent, a flowchart of the main program, is reproduced below:

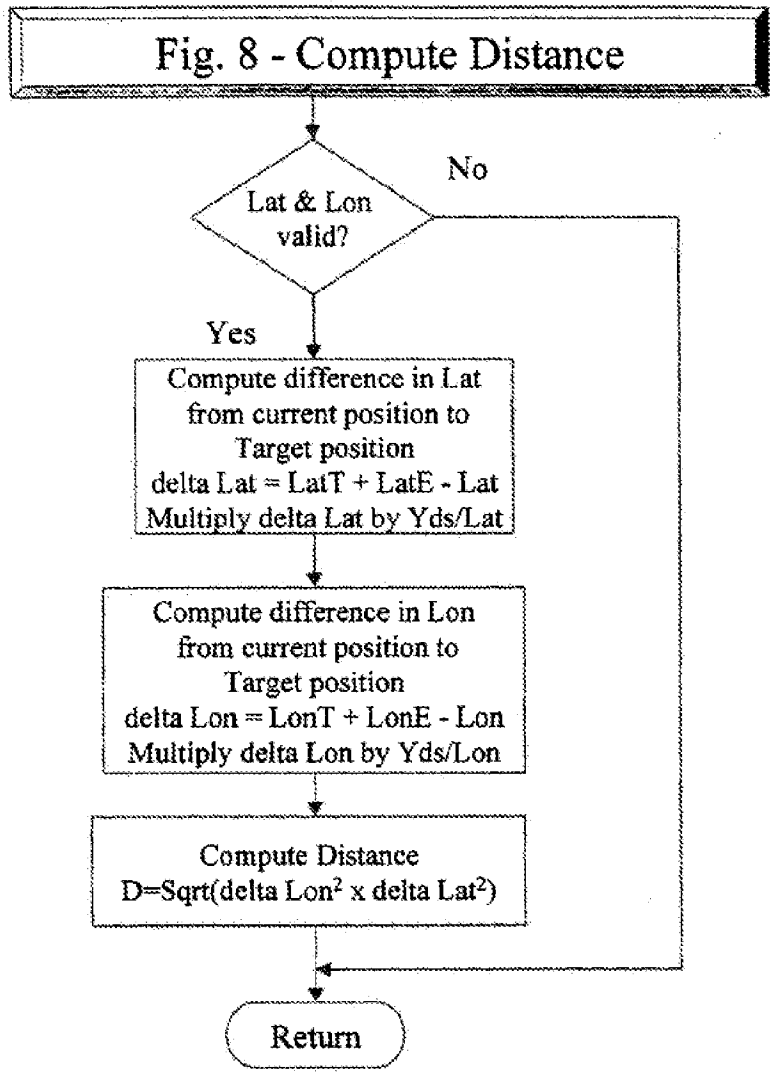

Figure 8 not only discloses the formula for computing the distance between a current position and a target object, but it includes "LatE" and "LonE" as terms in the algorithm. "LatE" is the "eFilter Lat [latitude] correction value," and "LonE is the "eFilter Lon [longitude] correction value" (col. 11, ll. 36-37). Figure 8 therefore further suggests that eFilter environmental error correction forms part of the distance determining process.

We do not, however, agree with Requester's contention that the '498 Patent fails to provide a complete algorithm for loading previously surveyed course-object data, and using real time tunable GPS parameters (Req. App. Br. 6–7). The loading of previously surveyed course-object data is illustrated at Figure 12, and disclosed at column 20, lines 1–53, of the '498 Patent. We agree with Patent Owner that the '498 Patent also discloses structure and algorithms corresponding to the disclosed environmental error correction and tunable GPS parameters. As the Examiner points out, eFilter adjustment for environmental conditions is disclosed at Figure 9 (Action Closing Prosecution mailed Dec. 13, 2013, p. 14) as well as column 11, line 5 through column 16, line 57 of the '498 Patent. The use of real time tunable GPS parameters is illustrated at Figure 11, and described at column 19, line 11 to column 20, line 53, of the '498 Patent.

Patent Owner argues that the structure corresponding to the "determining a distance" function recited in the claims "is the claimed computing device, including the algorithmic structure of Figures 8, 26B, and 26C (steps A, E1a, E1b, E2, and E3)" (PO Resp. Br. 6). We agree with Patent Owner's position that the recited portions of Figures 26B and 26C, as well as Figure 8 already discussed, would be recognized by one of ordinary skill in the art as linked to the recited function (*Id.*).

Figures 26B and 26C, which illustrate a flow chart for determining crosshair distances from the golfer's perspective, are reproduced below:

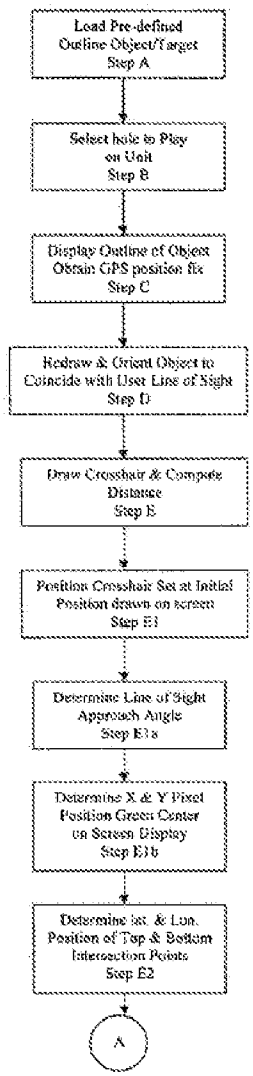
Load Pre-defined Outline Object/Target Step A
Select hole to Play on Unit Step B
Display Outline of Object Obtain GPS position fix Step C
Redraw & Orient Object to Coincide with User Line of Sight Step D
Draw Crosshair & Compute Distance Step E
Position Crosshair Set at Initial Position drawn on screen Step E1
Determine Line of Sight Approach Angle Step E1a
Determine X & Y Pixel Position Green Center on Screen Display Step E1b
Determine lat. & Lon. Position of Top & Bottom Intersection Points Step E2
A

FIG. 26B

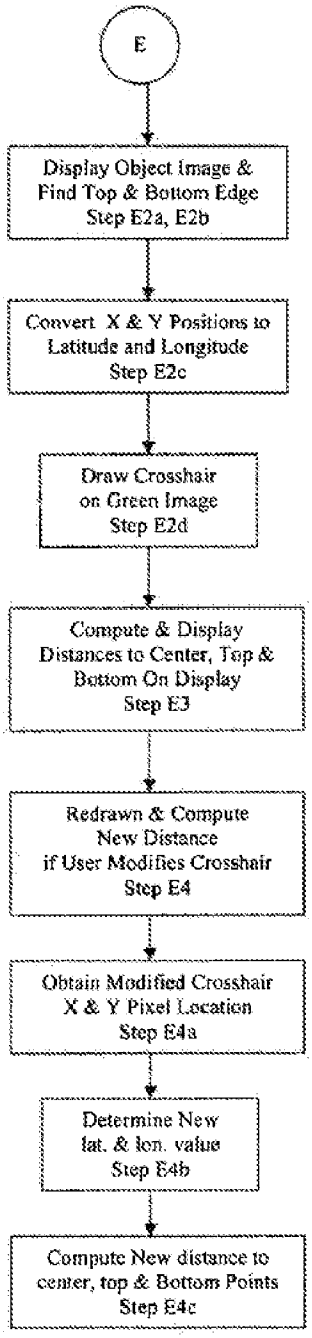

FIG. 26C

Figures 26B-26C show an embodiment of one preferred method to determine the crosshair distances from user's perspective (col. 6, ll. 32-34). In Step A, the Golfer loads the unit's memory with a pre-defined green outline and/or outline of other objects and the center location of the green

(col. 23, ll. 42–44). In Step E1a, a golfer's line of sight angle of approach is determined (col. 24, ll. 9–10). Step E1b is used to determine the X & Y pixel position of the center of green from the center of screen (col. 24, ll. 32–33). In Step E2, the latitude and longitude of the top and bottom intersection points is determined (col. 24, ll. 56–57). In Step E3, the distances to the center, top and bottom points on the green are computed and displayed on the screen (col. 25, ll. 28–30).

Taken together, we find that the claimed "means . . . for determining a distance" recited in claim 5 finds support in Figures 8, 9, and 11, and portions of Figures 26B and 26C, as well as associated sections of the '498 Patent specification. Necessarily, then, we do not agree with Requester's suggested construction of this limitation as merely "hardware and software that can perform the recited function" (Req. App. Br. 15).

REJECTIONS WITHDRAWN BY EXAMINER

Requester's entire argument urging that the withdrawn prior art rejections[2] be adopted is that, "[s]hould the Board determine the correct construction of this limitation for purpose of this reexamination is hardware and software that can perform the recited function, the Board should reverse the decision to withdraw the proposed rejections" (Req. App. Br. 15).

Such a construction is unreasonably broad in light of our finding that Figures 8, 9, 11, and portions of Figures 26B and 26C disclose the algorithmic structure corresponding to the claimed function of "determining a distance, independent of said golf course infrastructure, between said GPS

[2] Identified as Issues 3a, 4a, 11a, 12a, and 13 (Req. Reb. Br. 8).

device and said object by using said measured location information and previously stored information concerning the location of said object." As a result, we are unpersuaded by Requester's remarks.

Using the claim construction we adopt today, we agree with the Examiner that the Request and the prior art cited therein fails to disclose the corresponding structure and algorithms illustrated in Figures 8, 9, 11, and portions of Figures 26B and 26C of the '498 Patent, and associated disclosure in the patent's specification (*see* ACP mailed December 13, 2013, p. 15). We sustain the Examiner's decision to withdraw the prior art rejections of claims 5–8.

REVIEW OF PROPOSED REJECTIONS FOUND NOT TO RAISE A SUBSTANTIAL NEW QUESTION OF PATENTABILITY

Requester asks that the Board review of grounds of rejection[3] based on prior art references "that were found to raise substantial new questions of patentability" (Req. Reb. Br. 9). In Requester's view, because Reeves, Rudow, Johnson, and Barnard "were found to raise a substantial new question of patentability . . . those references are properly considered in their entirety on appeal," and rejections premised on combinations of those references are reviewable, even if the Examiner declined to find a substantial new question of patentability based on a particular combination complained of (Req. Reb. Br. 9).

[3] Identified as Issues 1a, 1b, 2, 3b, 4b, 5, 6, 7, 8, 9, 10, 11b, and 12b (Req. Reb. Br. 8).

We do not agree that the Board has jurisdiction to review these proposed rejections. The language of 35 U.S.C. § 312(c) is unequivocal. "A determination by the Director under subsection (a) [i.e., whether a substantial new question of patentability affecting a claim of the patent concerned is raised by the request for inter partes reexamination] shall be final and non-appealable." 35 U.S.C. § 312(c) (2003).

Nevertheless, Requester cites *Belkin Int'l Inc. v. Kappos*, 696 F.3d 1379 (Fed. Cir. 2012) in an attempt to assert that the non-adopted proposed rejections are reviewable by the Board (Req. Reb. Br. 8). We disagree with Requester that *Belkin* can be factually distinguished from the present appeal. *Belkin* makes clear that the Director finds *issues*, not merely individual patents, to raise substantial new questions of patentability. *Belkin*, 696 F.3d at 1350. "The Board was correct not to consider the previously raised and rejected *issues based on* the other three references," *id.*(emphasis added). If the court were in agreement with Requester that individual *references* are what give rise to substantial new questions of patentability, there would be no need to discuss *issues* based on those references. This is not what the court does, however. As in *Belkin*, Requester's only option was to petition the Director to review the Examiner's determination that the proposed grounds of rejection did not raise a substantial new question of patentability. When Requester did not do so, the Examiner's determination became final and non-appealable, rendering those issues beyond the scope of the reexamination. *See id.*

CONCLUSION

1. The '498 Patent discloses sufficient structure, material, or acts such that the claims of the '498 Patent are amenable to construction.

2. The Examiner did not err in withdrawing the rejections of claims 5-8 entered in the first ACP.

ORDER

The Examiner's decision to withdraw the rejection of claims 5–8 is affirmed.

Pursuant to 37 C.F.R. § 41.79(d), this decision is final for the purpose of judicial review. A party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

AFFIRMED

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