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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JONATHAN DWIGHT SCHULTZ

Appeal 2015-005690
Application 12/760,817
Technology Center 2100

Before JUSTIN BUSCH, CATHERINE SHIANG, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

BUSCH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the rejection of claims 1–46. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

CLAIMED SUBJECT MATTER

Claims 1, 18, and 34 are independent claims. The claims relate generally to selecting locations for a hole on a golf green and, more specifically, to selecting a location for a golf hole from a plurality of predefined potential locations based upon attributes of each potential location. Spec., Abstract, ¶¶ 33–34. Claim 1 is reproduced below:

1. A system for management of a physical golf green through selection of a location for a physical golf hole on said green, the system comprising:
 - a processor;
 - a memory; and
 - a determination component stored in the memory, wherein said determination component is executed by said processor to:
 - a) access a database, wherein said database comprises a plurality of potential locations for said physical golf hole on said green
 - b) determine an available set of potential locations for said physical golf hole on said green, wherein said available set of potential locations for said physical golf hole on said green is determined by analyzing an attribute associated with each of said potential locations for said physical golf hole on said green and removing a subset of potential locations for said physical golf hole on said green from said plurality of potential locations for said physical golf hole on said green based upon said analysis;
 - c) select said location for said physical golf hole on said green from said available set of potential locations for said physical golf hole on said green; and
 - d) output a presentation of said location for said physical golf hole on said green.

REJECTIONS

Claims 1–8, 11–16, 18–25, 28–40, and 42–46¹ stand rejected under 35 U.S.C. § 112 ¶ 1 for failing to comply with the written description requirement. Final Act. 2–3; Ans. 2.

Claims 1–46 stand rejected under 35 U.S.C. § 103(a) as unpatentable in view of Cohodas (US 6,171,199 B1; Jan. 9, 2001) and Aronchick (US 2007/0184910 A1; Aug. 9, 2007). Final Act. 3–27.

ANALYSIS

REJECTION UNDER 35 U.S.C. § 112

The Examiner rejected claims 1–8, 11–16, 18–25, 28–40, and 42–46 under 35 U.S.C. § 112 ¶ 1 for failing to comply with the written description requirement. Final Act. 2–3. In the Advisory Action, mailed on July 9, 2014, the Examiner withdrew the rejection under § 112. Adv. Act. 2. However, in the Answer, the Examiner appears to have reintroduced the rejection. Ans. 2.

Appellants did not respond to the rejection under § 112 because it was withdrawn in the Advisory Action. App. Br. 8 (explaining that “[t]he only remaining ground for rejection in the Final Office Action dated March 24, 2014 (as modified by the Advisory Action dated July 9, 2014) is the Examiner’s rejection of all pending claims as obvious based upon the

¹ Claims 9, 10, 17, 26, 27, and 41 depend directly from one of independent claims 1, 18, and 34, and incorporate each of the limitations of the respective claim from which they depend. Accordingly, it is unclear why the Examiner did not reject claims 9, 10, 17, 26, 27, and 41 under 35 U.S.C. § 112 ¶ 2. Nevertheless, because we find the Examiner erred in rejecting the claims for failing to comply with the written description requirement for the reasons discussed herein, we need not address the issue further.

combination of Cohodas and Aronchick.”). Appellants contend the rejection under § 112 is improper because it was previously withdrawn in view of Appellants’ arguments that overcame the rejection. Reply Br. 2 (quoting Adv. Act. 2; citing MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 1205.02).

To the extent Appellants contend the rejection under 35 U.S.C. § 112 reintroduced in the Answer should have been designated as a new ground of rejection, such an argument is a petitionable matter, which we do not address on appeal. 37 C.F.R. § 41.40; *see* MPEP § 1207.03(b) (explaining that “37 CFR 41.40 sets forth the exclusive procedure for an appellant to request review of the primary examiner’s failure to designate a rejection as a new ground of rejection via a petition to the Director under 37 CFR 1.181.”).

Nevertheless, we determine the rejection of claims 1–8, 11–16, 18–25, 28–40, and 42–46 for failing to comply with the written description requirement under 35 U.S.C. § 112 ¶ 1 is improper. Whether a specification complies with the written description requirement of 35 U.S.C. § 112 ¶ 1 is a question of fact. *Regents of Univ. of Cal. v. Eli Lilly and Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). The Examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976). Notwithstanding the numerous references in Appellants’ Specification to a “golf hole,” the Examiner finds the recited “physical golf hole” is unsupported. Ans. 2. The Examiner merely states “‘physical golf hole’ was not described in the specification,” but provides no explanation. Ans. 2.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See, e.g., Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003); *Vas-Cath*, 935 F.2d at 1563. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. Amer. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

Notably, Appellants' originally-filed Specification included claims that recited "[a] system for selecting a *golf hole* location *on a green*," and descriptions including, for example: "selecting golf hole locations on a golf green," "[c]onventional methods for selecting golf hole locations on a golf green typically involve a greens superintendent . . . choosing a hole location," "rotating the position of the cup or golf hole location," "selecting where to cut the golf hole location and placement of the cup," "FIG. 1 is a depiction of a green with multiple golf hole locations," "golf hole location 110 should be cut on green 100 seven yards from front edge 112," and disclosed processes "may be applied serially, in parallel, or a combination thereof to reach an output of a golf hole location for each of the eighteen greens of the exemplary golf course." Spec. 17 (claim 1), ¶¶ 1, 3, 5, 20, 50, 55 (emphases added). In addition to the description, Appellants' Figure 1 depicts golf holes at various positions on a golf green.

Although Appellants' Specification never uses the term "physical," the written description requirement does not require the Specification to

disclose the claim terms in the same words. *Martin v. Johnson*, 454 F.2d 746, 751 (CCPA 1972) (stating “the description need not be in *ipsis verbis* to be sufficient”). Moreover, it is unclear how the term “physical” modifies the recitation of a “golf hole.” Appellants assert the term “physical” was added by amendment at the suggestion of a Supervisory Examiner during an interview on August 21, 2013.² In light of Appellants’ Specification, including the portions quoted above, a person of ordinary skill in the art would have understood the recited “golf hole” is a physical entity. Accordingly, because the term “physical” is superfluous, it cannot present new matter that was not sufficiently disclosed in the originally-filed Specification.

Furthermore, “[t]he ‘written description’ requirement must be applied in the context of the particular invention and the state of the knowledge.” *Capon v. Eshhar*, 418 F.3d 1349, 1358 (Fed. Cir. 2005). If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. *See, e.g., Vas-Cath*, 935 F.2d at 1563. We fail to see, and the Examiner provides no explanation regarding, why a person of ordinary skill in the art would not have understood Appellant’s Specification to disclose a “physical golf hole.”

² It is unusual, to say the least, for an Examiner to suggest an amendment to the claims that is not supported by Appellants’ Specification only to then reject Appellants’ amended claim under 35 U.S.C. § 112 ¶ 1.

For the above reasons, we reverse the Examiner's rejection of claims 1–8, 11–16, 18–25, 28–40, and 42–46 for failing to comply with the written description requirement under 35 U.S.C. § 112 ¶ 1.

REJECTION UNDER 35 U.S.C. § 103

The Examiner rejects claims 1–46 as obvious in view of the combined teachings of Cohodas and Aronchick. Final Act. 3–27. With respect to claim 1, the Examiner finds Cohodas teaches many of the limitations but finds Aronchick teaches “determin[ing] an available set of potential golf hole locations for said physical golf hole on said green wherein said available set of potential golf hole locations on said green is determined by analyzing an attribute associated with each of said potential golf hole locations on said green” and “select[ing] said location for said physical golf hole on said green from said available set of potential golf hole locations on said green.” Final Act. 5–6 (quoting Aronchick ¶¶ 78, 116, 124, 192); Ans. 8–9. The Examiner makes no findings relating to the proper construction of the recited phrase “physical golf hole on said green” and provides no explicit construction of that phrase.

Appellants argue the broadest reasonable interpretation, consistent with Appellants' Specification, of “physical golf hole on said green” is “a shallow cylindrical hole in the putting green of a golf course into which the ball is played.” App. Br. 10–13 (citing Appellants' claims, Specification, and various dictionaries). We agree with Appellants' arguments and adopt Appellant's proposed construction for the reasons asserted. In particular, we agree with Appellants because the claims recite the hole is *on* the green, which supports Appellants' proffered construction.

Appellants argue the rejection is improper for various reasons, including that the proposed combination of Cohodas and Aronchick fails to teach or suggest the determining and selecting steps. In particular, Appellants assert Aronchick is directed to designing a “compact golf course” by identifying and selecting sets of tee boxes and greens to create a number of golf holes comprising a course, which is not related to identifying and selecting the location of a golf hole on a green. App. Br. 16–19. Appellants further contend Aronchick’s “hole possibilities” are potential pairings of tees and greens, which is not related to Appellants’ recitations of a golf hole on a green. *Id.* at 18–19. Based on Aronchick’s focus on tee box and green pairings, Appellants argue Aronchick does not teach or suggest the determining or selecting steps because Aronchick does not teach determining or selecting locations for a golf hole on a green, as recited in the claims. *Id.* at 19.

Although we agree with the Examiner that Cohodas discloses a “modification program [that] determines the next position for each” of a tee area and a pin³ moving the location of a golf hole on a green based on certain characteristics, such as “slope and other key parameters of the putting green,” Cohodas 6:35–43, the Examiner has not explained how the disclosures of Aronchick relate to determining or selecting a golf hole on a green, as properly construed.

³ In the context of Appellants’ application and Cohodas, we consider determining the location of the pin to at least suggest determining the location of a golf hole on a green because a person of ordinary skill in the art would have understood the location of a pin marks the location of a golf hole on a green.

The Examiner merely block quotes sections of Aronchick relating to designing a compact golf course, which includes pairing tees and greens. *See* Aronchick ¶¶ 78, 83, 116, 124, 192. The Examiner provides no explanation in the Final Action or the Answer how these portions of Aronchick teach determining or selecting golf hole locations on a green. The Examiner finds it would have been obvious to a person of ordinary skill in the art to combine Cohodas's teachings with Aronchick's teachings, and the Examiner states in the Answer that the combination of Cohodas and Aronchick teaches the determining and selecting steps "in order to provide the maximum hole possibilities and shot opportunities." Final Act. 6–7; Ans. 9–10 (quoting Aronchick ¶¶ 78, 116, 124, 192). However, the Examiner provides no explanation of how Aronchick's compact golf course design would be combined in a way that would result in a teaching or suggestion of the determining or selecting steps.

Given Aronchick's failure to teach or suggest potential golf hole locations on a green, the Examiner's proposed combination of Cohodas and Aronchick does not teach or suggest the determining or selecting steps as recited in claim 1 and commensurately recited in claims 18 and 34. Claims 2–17, 19–33, and 35–46 ultimately depend from one of claims 1, 18, and 34. Accordingly, on this record, we are persuaded the Examiner erred in rejecting claims 1–46 under 35 U.S.C. § 103(a). Because this issue is dispositive of the Appeal, we do not address Appellants' other arguments.

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DECISION

For the reasons discussed above, we reverse the Examiner's decision to reject claims 1–46.

REVERSED