

PTAB Agrees To Review Golf Club Patent Challenges

By **Suzanne Monyak**

Law360 (August 31, 2018, 7:19 PM EDT) -- The Patent Trial and Appeal Board has agreed to take up two patent challenges levied by a California-based golf equipment manufacturer against rival Parsons Xtreme Golf LLC, finding that TaylorMade Golf Co. Inc. had shown it would likely win its bid to nix the two patents over obviousness.

The PTAB found in its decisions Thursday instituting inter partes review of Parsons' two patents, both related to golf club heads, that TaylorMade had shown a "reasonable likelihood" that it could convince the board during IPR that at least one claim in each patent is too obvious in light of prior art to be patented.

"We find petitioner has made a sufficient showing at this stage of the proceeding that one of ordinary skill in the art would have had reason to combine the teachings ... in the manner set forth in the petition," the decisions both say.

Parsons accused TaylorMade in September 2017 in an Arizona federal court of selling golf clubs that infringe multiple of Parsons' patents, including the new patents before the PTAB this week — U.S. Patent Numbers 9,199,143 and 8,961,336 — which both cover a method of manufacturing the head of a golf club. That litigation is currently pending.

TaylorMade asked the PTAB to review the two patents in February, claiming that all 20 claims in each patent were invalid as obvious.

Parsons argued back that TaylorMade had "oversimplified" the Arizona-based company's patented golf club design and had relied on hindsight bias.

"TMG cobbles together incompatible prior art club designs and then extensively modifies them to arrive at the [patent's] claimed invention — all based on hindsight bias," Parsons' preliminary responses to both petitions say.

Parsons had nearly lost that early chance to respond, after the golf company filed those preliminary responses to the two petitions shortly after the midnight deadline in June. According to court documents, Parsons did not begin uploading the documents until 11:36 P.M., 24 minutes before the deadline. As a result, some of its supporting exhibits were not filed until after 12:30 A.M., and one of its preliminary responses was filed at 12:01 A.M.

In a Thursday order, the PTAB granted Parsons' motion to excuse the late filing, holding that while Parsons could not establish "good cause" to justify turning the documents in late, as the company had three months to craft its responses, it was in the "interest of justice" to allow the late filings since they were all filed within an hour of the deadline.

But despite allowing Parsons to file its preliminary responses, the board was unpersuaded by the golf company's arguments in those responses that its patented golf club design was too complex to be obvious.

"On this record, it appears that the alleged complexities of golf club design would have motivated one of ordinary skill in the art to look to known ways of improving [center of gravity] and [moment of inertia] ... rather than starting from scratch," the decisions say. "We are not persuaded that the alleged complexities identified by patent owner would have dissuaded a skilled artisan from attempting to combine the [prior art's] teachings."

The two patent disputes instituted on Thursday are two of numerous challenges the golf companies have lobbed at each other at the PTAB this year.

TaylorMade has filed nine petitions against Parsons, including these two, since January, the other seven of which are currently pending. Parsons has also hit TaylorMade with six IPR petitions of its own. The board has agreed to review two of those petitions, denied three, and one is still pending.

"Parsons Xtreme Golf is confident that once the PTAB hears the full merits of these IPR proceedings, it will confirm the validity of the PXG patents and the company's position as innovators in the golf industry," Parsons said in a statement through its attorney.

An attorney for TaylorMade declined to comment.

TaylorMade is represented by Richard D. Collier III, David K.S. Cornwell and Jason A. Fitzsimmons of Sterne, Kessler, Goldstein & Fox PLLC.

Parsons is represented by Brian W. LaCorte, Richard W. Miller, Jonathon A. Talcott and Joseph P. Anderson III of Ballard Spahr LLP.

The patents at issue are U.S. Patent Numbers 9,199,143 and 8,961,336.

The cases are Taylor Made Golf Company Inc. v. Parsons Xtreme Golf LLC, case numbers IPR2018-00675 and IPR2018-00702, in the Patent Trial and Appeal Board.

--Editing by Kelly Duncan.