

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL BEERS

Appeal No. 2000-0118
Application No. 08/972,640

ON BRIEF

Before COHEN, ABRAMS and CRAWFORD, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-13, 15 and 16.¹ The examiner indicated that dependent claim 14, the only other claim of record, would be allowable if rewritten in independent form (Paper No. 3).

We AFFIRM-IN-PART and REMAND.

¹An amendment after the final rejection was refused entry by the examiner, but a declaration by the appellant under Section 132 was entered (see Papers Nos. 8 and 9).

BACKGROUND

The appellant's invention relates to a swing practicing device for improving a baseball swing. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Griffin	4,176,838	Dec. 4, 1979
Richards	4,268,030	May 19, 1981
Rubin	4,486,016	Dec. 4, 1984
Wolfe	4,770,412	Sep. 13, 1988
Liao	5,035,424	Jul. 30, 1991

Claims 1-5 and 9-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wolfe.

Claims 1, 9, 11-13, 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griffin in view of Liao.

Claims 6, 7, 9 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griffin in view of Rubin.

Claims 1 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Richards.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper

No. 12) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 11) and Reply Brief (Paper No. 13) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The Rejection Under Section 102(b)

The guidance provided by our reviewing court with regard to the matter of anticipation is as follows: Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987), nor does it require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in

the reference. See Kalman v. Kimberly-Clark Corp, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

The appellant's invention is directed to improving a baseball batter's swing by providing a self-righting target to be impacted by a swinging bat. Independent claims 1 and 9 stand rejected as being anticipated by Wolfe, which is directed to a practicing device roughly in the shape of a person, which is intended to be struck with the user's "punch or kick" (Abstract, line 6). It is the examiner's position that the appellant's claim language reads on the Wolfe device, and thus the claims are anticipated thereby. In the course of this rejection, the examiner has considered the head to be the target. As to claim 1, the appellant has advanced several arguments on pages 5 and 6 of the Brief and pages 2 and 3 of the Reply Brief. However, we find none of them to be persuasive.

The first argument is that Wolfe fails to disclose a target for accepting swing impacts from a baseball bat, as required by the claim, because such a functional use is not explicitly taught in the patent. With regard to this, we first point out that claim 1 requires only that there be a "target," and there is no dispute that one of ordinary skill in the art would have recognized that the head in the Wolfe device constitutes a "target," albeit that it is explicitly disclosed only in the context of being capable of accepting impacts from punches and kicks. Insofar as striking the head with a bat is concerned, it is only necessary that the reference include structure capable of performing the recited function in order to meet the

functional limitations of the claim. See In re Mott, 557 F.2d 266, 269, 194 USPQ 305, 307 (CCPA 1977). It is our view that there is no basis from which to conclude that the head in the Wolfe device is not capable of accepting swing impacts from a baseball bat, which is all that is required. The appellant also opines that because the Wolfe device is roughly the same height as the person punching it, the head is too high to be used for baseball swing training. However, the height of the Wolfe device is not specified in the patent, and so it is speculation to conclude that it is too high to be struck by a swinging bat. Moreover, what might be “high” for one person swinging a bat would not be so for a taller person. The final argument focuses on the fact that the Wolfe device has arms disposed in front of the head, which would impede the path of a baseball bat in attempting to impact the head. This conclusion is not supported by the Wolfe disclosure, for it is clear from Figures 1, 2, 5 and 6 that the arms are not so positioned as to preclude direct striking of the head. In fact, it appears that a batter would have a clear route to the front, back, and sides of the head except, perhaps, for a portion of the right side of the head if the swing is low and from the batter’s left. Finally, we point out that the claim requires only that there be a “target,” which is broad enough to encompass the arms as well as the head.

We therefore agree with the examiner that all of the subject matter required by claim 1 is disclosed in Wolfe, and we will sustain the Section 102 rejection against this claim.

Since the appellant has chosen to group dependent claims 2-5 with claim 1 (Brief, page 4), the rejection of the dependent claims also is sustained.

We reach the opposite conclusion, however, with regard to independent claim 9 and dependent claims 10 and 11. The argued difference with regard to claim 9 is that it requires that the target have “a baseball shape,” a feature which we agree is not present in Wolfe. A baseball is spherical in shape, with no protrusions from its surface except for the slightly upstanding stitching at the seams, and that is exactly what the appellant discloses, except for that portion of the bottom where the sphere appears in the Figure 2 representation to meld into the apex of the target support. From our perspective, the head of the Wolfe device is not spherical, that is, “a baseball shape.” As shown from the side in Figure 1, the head appears to be elongated and to include a chin portion. A protruding nose is quite evident in Figure 3. Wolfe describes the head as being “sculptured” and including a “projecting nose” to make it more life-like (column 3, lines 26-28).

Wolfe thus fails to disclose or teach the target shape recited in independent claim 9, and we will not sustain the Section 102 rejection of claim 9 or dependent claims 10 and 11.

The Rejections Under Section 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413,

425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The first of these rejections is that independent claims 1, 9 and 15, and dependent claims 11-13 and 16 are unpatentable over the combined teachings of Griffin and Liao. Griffin discloses a baseball batting tee comprising a self-righting target support having a rounded bottom and terminating at its upper end in a helical coil spring upon which a ball is placed. The purpose of the device is to allow young children to learn to hit a ball without having it pitched to them, and the ball flies off of the tee after being struck by a bat and can be provided with a tether to facilitate returning it to the tee (column 1, lines 6-39). The self-righting capability is provided "especially" for "a bad batting hit" (column 1, lines 44-52), which would imply a hit wholly or partially upon the tee spring (16) or post (14) rather than the ball. The intended "target" in Griffin clearly is the baseball on the tee, and thus the

target is not “coupled to” the support so it can accept swing impacts “without separating from the target support,” as is required by the three independent claims.

Liao discloses a batting practice device whose objectives have much in common with the appellant’s invention, however, the target support structure is quite different. The target is coupled to the support, but the base of the support is flat and the impact of the bat striking the ball is absorbed by a flexing mechanism on the upper end of the support, rather than by pivotal movement of the support, as is the case in the appellant’s invention. It is the examiner’s position that one of ordinary skill in the art would have found it obvious to modify Griffin by replacing the removable ball with a ball fixed to the upper end of the support “so as not [to] have to chase batted balls” (Answer, page 4). However, it is basic to the Griffin invention to bat the ball off of the tee in order to provide an element of realism to the game. To modify the Griffin device by replacing the free ball with one fixed to the top of the target support would destroy the Griffin invention by causing the device not to be operable for the intended purpose. This, in our view, would operate as a disincentive to the artisan to make the modification proposed by the examiner.

The combined teachings of Griffin and Liao thus fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claims 1, 9 and 15, and we therefore will not sustain the rejection of these claims or, it follows, of claims 11-13 and 16, which depend therefrom.

Claims 6, 7, 9 and 12 stand rejected as being unpatentable over Griffin and Rubin, which discloses a punching bag attached to a flexible support that is mounted on a flat base filled with water or sand. This reference was cited by the examiner only for its teachings of using sand or water in the base and a mechanism for adjusting the height of the target (Answer, page 5), which teachings do not overcome the fact that Griffin's target is not secured to the support. In this regard, we further point out that while the target in Rubin is fixed to the support, it suffers from the same lack of suggestion problem as Liao when considering combining this feature with the Griffin device, wherein the ball is not coupled to the target support. In any event, we will not sustain this rejection.

The last of the Section 103 rejections is that claims 1 and 8 are unpatentable over Richards. This reference discloses a one-piece elongated inflatable toy in the nature of a free-standing and self-righting punching bag that is essentially in the shape of an elongated cylinder with rounded ends. We do not agree with the examiner that this device comprises a "target support" having a terminal end with a "target" coupled thereto and, in our view, no suggestion exists that would have motivated one of ordinary skill in the art to modify it so that those components were present. Thus, Richards fails to establish a prima facie case of obviousness with regard to independent claim 1 or dependent claim 8, and we will not sustain this rejection.

Since we have not sustained any of the examiner's Section 103 rejections on their face, we need not comment upon the information presented in the inventor's declaration, which is directed to the secondary considerations of long-felt need and unexpected results.

Remand to the Examiner

This application is remanded to the examiner for the purpose of considering Liao taken in view of Griffin as a basis for rejecting the appellant's claims, noting that Liao discloses a device for batting practice in which the target ball is fixedly coupled to the terminal end of the target support but lacks the curved bottom required by the claims, and Griffin teaches providing a curved support base bottom in order to provide self-righting "on a bad batting hit," which is explained as being a hit wholly or partially upon the support, rather than wholly upon the target ball.

SUMMARY

The rejection of claims 1-5 under 35 U.S.C. § 102(b) as being anticipated by Wolfe is sustained.

The rejection of claims 9-11 under 35 U.S.C. § 102(b) as being anticipated by Wolfe is not sustained.

The rejection of claims 1, 9, 11-13, 15 and 16 under 35 U.S.C. § 103 as being unpatentable over Griffin in view of Liao is not sustained.

The rejection of claims 6, 7, 9 and 12 under 35 U.S.C. § 103 as being unpatentable over Griffin in view of Rubin is not sustained.

The rejection of claims 1 and 8 under 35 U.S.C. § 103 as being unpatentable over Richards is not sustained.

A rejection of claims 1-5 having been sustained, the decision of the examiner is affirmed-in-part.

The application is remanded to the examiner for action in accordance with the above instructions.

This application, by virtue of its "special" status, requires an immediate action, M.P.E.P 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

In addition to affirming the examiner's rejection of one of more claims, this decision contains a remand. 37 CFR § 1.196(e) provides that

[w]henver a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART AND REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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NEAL E. ABRAMS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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MURRIEL E. CRAWFORD)	
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NEA:lbg

Appeal No. 2000-0852
Application No. 09/061,314

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APPEAL NO. 2000-0852 - JUDGE ABRAMS
APPLICATION NO. 09/061,314

APJ ABRAMS

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APJ CRAWFORD

DECISION: **AFFIRMED-IN-PART**
AND REMANDED

Prepared By:

DRAFT TYPED: 23 Oct 02

FINAL TYPED: