

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LESLIE G. DUTCHBURN

Appeal No. 95-4994
Application No. 08/133,294¹

ON BRIEF

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 8. Claims 3 through 7 and 9 through 13 have been allowed.

We AFFIRM.

¹ Application for patent filed October 8, 1993.

BACKGROUND

The appellant's invention relates to a play-head for a hockey stick. Claim 1 is representative of the subject matter on appeal and a copy of claim 1 is attached to this decision.

The prior art reference of record relied upon by the examiner as evidence of anticipation under 35 U.S.C. § 102(b) is:

White, Sr. (White)	3,529,825	Sept. 22, 1970
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Claims 1, 2 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by White.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 102(b) rejection, we make reference to the examiner's answer (Paper No. 10, mailed February 13, 1995) and the examiner's response to the reply brief (Paper No. 12, mailed June 29, 1995) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 9, filed October 12, 1994) and reply brief (Paper No. 11, filed March 13, 1995) for the appellant's arguments thereagainst.

Appeal No. 95-4994
Application No. 08/133,294

Page 3

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 reference, and to the respective positions articulated by the appellant and the examiner.

Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is sufficient to establish a case of anticipation with respect to claim 1. Accordingly, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b). Our reasoning for this determination follows.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ

781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 1 is anticipated by White. Claim 1 reads on the hockey stick clearly disclosed in Figure 8 of White. Claim 1 reads on White's hockey stick as follows: A play-head for a hockey stick comprising, a generally rectangular body portion having one end adapted to be mounted to a hockey stick handle (White's body portion shown in Figure 8 is generally rectangular), a middle portion having a front surface operative for playing and impacting with a hockey puck (White's middle portion of the body portion as shown in Figure 8 has a front surface which is operative for playing and impacting with a hockey puck), said middle portion having an elongated lower edge operative to contact with a play surface of a hockey ring (White's front surface shown in Figure 8 has an elongated lower edge which is capable of contacting a play surface of a hockey ring), said lower edge having an elongated recess formed therein (White's front surface shown in Figure 8 has elongated recesses, i.e., notched out portions 14), said recess having an elongated

inner edge (as shown in Figure 8, White's elongated recesses 14 have an elongated inner edge), and said recess operatively forming an elongated gap between said elongated inner edge and said play surface when said lower edge is pushed against said play surface (as shown in Figure 8, the elongated inner edges of White's elongated recesses 14 are spaced from the lower edge to form elongated gaps between the elongated inner edges and the play surface when the lower edge is pushed against the play surface).

The argument presented by the appellant that claim 1 is not anticipated by White is unpersuasive for the following reasons. First, the appellant's argument regarding the hazards of using White's hockey stick and the inability of White's hockey stick to comply with the standards of the National Hockey League Association is not commensurate in scope with the claims under appeal. Second, the claims on appeal do not define over White's hockey stick shown in Figure 8 prior to fixedly attaching the attachment member 1 to the hockey stick. In that regard, claim 1 is drafted utilizing the transitional phrase "comprising." Therefore, claim 1 is open-ended and does not exclude additional, unrecited elements such as White's attachment member.

Since each and every element as set forth in claim 1 is found, either expressly or inherently described, in White, we sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b).

Claims 2 and 8 have not been separately argued by the appellant. Accordingly, we have determined that these claims must be treated as falling with claim 1. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and 37 CFR §§ 1.192(c)(7) and 1.192(c)(8)(iv). Thus, it follows that the examiner's rejection of claims 2 and 8 under 35 U.S.C. § 102(b) as being anticipated by White is also sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2 and 8 under 35 U.S.C. § 102(b) is affirmed.

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

AFFIRMED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 95-4994
Application No. 08/133,294

Page 9

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APPENDIX

1. A play-head for a hockey stick comprising,
a generally rectangular body portion having one end adapted to be mounted to a hockey stick handle, a middle portion having a front surface operative for playing and impacting with a hockey puck, said middle portion having an elongated lower edge operative to contact with a play surface of a hockey ring, said lower edge having an elongated recess formed therein, said recess having an elongated inner edge, and said recess operatively forming an elongated gap between said elongated inner edge and said play surface when said lower edge is pushed against said play surface.

APPEAL NO. 95-4994 - JUDGE NASE
APPLICATION NO. 08/133,294

APJ NASE

APJ McQUADE

APJ ABRAMS

DECISION: **AFFIRMED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 10 Dec 98

FINAL TYPED: