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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(2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICOLAS MIMEUR
AND JEAN-MARC GUIBAUD

Appeal No. 96-0987
Application 08/226,467¹

ON BRIEF

Before McCandlish, Senior Administrative Patent Judge, and
LYDDANE and MEISTER, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final
rejection of claims 8 through 14, which are all of the claims
remaining in the application.

The subject matter on appeal is directed to an iron-
type golf club head. Claim 8 is exemplary of the invention and
reads as follows:

¹ Application for patent filed April 12, 1994.

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8. Iron-type golf club head comprising a hollow metal body incorporating an internal cavity delimited by a plurality of walls, including an impact wall attached peripherally at all points to other walls, wherein said impact wall has an internal surface coated with a thin layer of a viscoelastic resin having damping properties, said resin layer only partially filling said internal cavity and having a specific gravity between 1 and 2, said layer being adapted for molding under low pressure or by gravity using a reaction injection molding process (RIM).

The references of record relied upon by the examiner in rejections of the claims under 35 U.S.C. § 103 are:

Yoneyama	4,635,941	Jan. 13, 1987
Molitor et al. (Molitor)	4,762,322	Aug. 9, 1988
Fenton et al. (Fenton)	5,290,036	Mar. 1, 1994
Hutin et al. (Hutin)	5,316,298	May 31, 1994 (Filed Apr. 14, 1993)
Desbiolles et al. (Desbiolles)(Great Britain)	2,238,251	May 29, 1991

Claims 8 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Desbiolles in view of Fenton and Molitor.

Claims 9, 10 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Desbiolles in view of Fenton, Molitor and Hutin.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Desbiolles in view of Fenton, Molitor and Yoneyama.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the

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examiner and the appellants, we refer to pages 3 through 9 of the examiner's answer and to pages 3 through 6 of the appellants' brief for the full exposition thereof.

OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art, and to the respective positions advanced by the appellants and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to all claims on appeal. Our reasoning for this determination follows.

Initially, we observe that prior to an analysis of whether the claims on appeal are patentable under 35 U.S.C. § 103, similar to the situation in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), "the claims must be analyzed first in order to determine exactly what subject matter they encompass," and the first inquiry is thus to "determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity." In re Moore, supra. This analysis of the claims must be made, not

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in a vacuum, but in light of the specification disclosure and the teachings of the prior art.

With this in mind, we first analyze independent claim 8, which recites, inter alia, an

Iron-type golf club head comprising a hollow metal body incorporating an internal cavity...an impact wall... wherein said impact wall has an internal surface coated with a thin layer of a viscoelastic resin having damping properties...said layer being adapted for molding under low pressure or by gravity using a reaction injection molding process (RIM) [emphasis added].

Thus, the golf club head is recited as an article of manufacture having a thin layer of viscoelastic resin coated on an internal surface of the impact wall, which layer is subsequently recited as being "adapted for molding...using a reaction injection molding process (RIM)." Therefore, as claimed, it appears that appellants intended the "layer" recited in appealed claim 8 to be "adapted for molding" by the RIM process subsequent to the formation of the golf club head. Consequently, it is our opinion that the metes and bounds of appealed claim 8 cannot be accurately determined and that claim 8, along with claims 9 through 14 dependent thereon, fail to comply with the provisions of 35 U.S.C. § 112, second paragraph.

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Turning to the examiner's rejections of the claims on appeal under 35 U.S.C. § 103, we note that normally when substantial confusion exists as to the interpretation of the claims and no reasonably definite meaning can be ascribed to terms in the claim, a determination as to the issue of obviousness is not made. See In re Steele, 305 F.2d 859, 863, 134 USPQ 292, 295 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). However, in this instance, we consider it to be desirable to address this issue in order to avoid the inefficiency of piecemeal appellate review. See Ex parte Ionescu, 222 USPQ 537, 540 (Bd. App. 1984). Therefore, we have reached the determination below with respect to the issue of obviousness of the claims on appeal in the interest of judicial economy. In order to reach the question of obviousness with respect to the claims on appeal, we have necessarily applied the interpretation to appealed claim 8 that it is a product-by-process claim reciting the layer of viscoelastic resin coated on the internal surface of the impact wall by molding using a reaction molding process which necessarily requires the viscoelastic resin be capable of being molded in a reaction injection molding process. We believe this interpretation to be

consistent with appellants' originally filed disclosure in the paragraph spanning pages 5 and 6 thereof.

With this as background, we first address the examiner's rejection of claims 8 and 12 under 35 U.S.C. § 103 as being unpatentable over Desbiolles in view of Fenton and Molitor. In view of the fact that the patent to Fenton discloses an iron-type golf club head comprising a hollow metal body incorporating an internal cavity 17 and including an impact wall 21 (Figure 3) as claimed, with the impact wall having an internal surface coated with a thin layer 23 of a viscoelastic resin having damping properties (note column 2, lines 30-39) and which layer only partially fills the internal cavity, the only issue to be resolved is whether or not the disclosed viscoelastic resin is capable of being molded by a reaction injection molding (RIM) process or that it would have been obvious to form the viscoelastic resin of a suitable resin usable in a RIM process.

It is known that reaction injection molding normally is "utilized for the production of partially foamed polyurethane moldings by rapid injection of metered liquid streams of polyol and isocyanate into a mold,"² which is consistent with

²KIRK-OTHMER Encyclopedia of Chemical Technology, Third Edition, Volume 18, 1982, page 203.

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appellants' example on page 6 of the specification as originally filed of "PU-type elastomer resins" as well as with the disclosure in the patent to Molitor of the formation of golf club heads from "low density, high strength material such as reaction injection molded (RIM) polyurethane" (column 2, lines 29-30). Thus, since Fenton discloses the thin layer of viscoelastic resin 23 to be "comprised of silicone rubber or a PVC plastisol or any synthetic or natural rubber" (column 2, lines 33-34), we reach the conclusion that the viscoelastic material of Fenton is not one capable of being molded by the RIM process.

We next turn to the disclosure of Molitor which the examiner has relied upon for the teaching of the use of materials suitable for use with the RIM process as being well known in the art of making golf clubs. However, it is clear from the disclosure of Molitor that the use of RIM polyurethane is in a second embodiment of the invention wherein the entire club head is formed of "low density, high strength material such as reaction injection molded (RIM) polyurethane" (column 2, lines 28-30) with "insert weights molded into and encapsulated by the polyurethane material" (column 2, lines 32-33). The first embodiment is directed to club heads fabricated "as a hollow metal shell" (column 2, line 23), and there is no disclosure in

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Molitor of the use of polyurethane material in combination with the club heads formed as a hollow metal shell. In fact, the two types of club heads are disclosed as alternatives. Note the second paragraph of the "ABSTRACT," column 2, lines 22 through 36 and column 6, lines 47 through 52. Accordingly, we find no factual basis from the evidence applied by the examiner in the rejection of appealed claims 8 and 12 sufficient to conclude that it would have been obvious to one having ordinary skill in the art to form the viscoelastic material of Fenton from a material suitable for molding in a RIM process.

Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re GPAC Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995) and In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has also repeatedly cautioned against employing hindsight by using the applicant's disclosure

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as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

Furthermore, as stated in W.L. Gore & Assocs. Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is our conclusion that the only reason to combine the teachings of Fenton and Molitor (even considering Desbiolles, which is surplusage) in the manner proposed by the examiner results from a review of appellants' disclosure and the application of impermissible hindsight. Thus, we cannot sustain the examiner's rejection of appealed claims 8 and 12 under 35 U.S.C. § 103. We have also carefully considered the teachings Hutin and Yoneyama applied in the rejections of claims 9 through 11 and Yoneyama applied in the rejection of claims 13 and 14, but we find nothing therein to cure the deficiencies in the factual

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basis in the rejection of appealed independent claim 8 from which they depend. Therefore, we also cannot sustain the examiner's rejections of these claims under 35 U.S.C. § 103.

We make the following new rejection pursuant to the provisions of 37 CFR § 1.196(b).

Claims 8 through 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. Claim 8 is indefinite for the reasons set forth above, and claims 9 through 14 are indefinite in that they depend from indefinite base claim 8.

Accordingly, the decision of the examiner rejecting claims 8 through 14 under 35 U.S.C. 103 is reversed, and a new rejection of claims 8 through 14 under 35 U.S.C. § 112, second paragraph, has been made pursuant to the provisions of 37 CFR § 196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision. 37 CFR § 1.197. Should appellants elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or

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showing of facts, or both, not previously of record a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

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

REVERSED, 37 CFR § 196(b)

Harrison E. McCandlish, Senior)	
Administrative Patent Judge)	
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William E. Lyddane)	BOARD OF PATENT
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