

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* THOMAS J. DECKER

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Appeal No. 96-1820  
Application 08/189,140<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, *Senior Administrative Patent Judge*, and  
ABRAMS and STAAB, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

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<sup>1</sup> Application for patent filed January 26, 1994.

Appeal No. 96-1820  
Application No. 08/189,140

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 1 through 4, which constitute all of the claims of record in the application.

The appellant's invention is directed to a practice baseball of a size smaller than that of a regulation baseball. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1.

A practice baseball for use in batting practice having dimension and weight proportionally less than that of a regulation baseball, comprising:

a central core with yarn tightly wrapped therearound to form a spherical interior portion, said central core having a diameter in the range of 0.85 inches to 1.18 inches;

an outer cover of two pieces of leather stitched together to form a tightly wrapped outer surface on the practice baseball;

said practice baseball having an outer diameter measured at the outer surface in the range of 1.86 to 2.65 inches and having a total weight in the range of 3.25 to 4.725 ounces.

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#### **THE REFERENCES**

The references relied upon by the examiner to support the final rejection are:

- (1) Worth Catalogue, "Junior Balls," January 9, 1976, page 7
- (2) The appellant's specification, page 4, lines 1 through 4 and 19 through 21<sup>2</sup>

#### **THE REJECTION**

Claims 1 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over the appellant's specification (page 4, lines 1 through 4 and 19 through 21) in view of Junior Balls.

For a complete explanation of the rejection, one must refer to the Examiner's Answer, Paper No. 6 (the final rejection) and Paper No. 3 (the first office action).

The opposing viewpoints of the appellant are set forth in the Brief.

#### **OPINION**

The objective of the appellant's invention is to provide an improved baseball for batting practice. In furtherance of this, the invention comprises a baseball which is dimensionally smaller

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<sup>2</sup>This was not listed as a reference by the examiner, but was cited in the rejection.

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in weight and size than a regulation baseball<sup>3</sup> used in game situations, but which has the same "feel" and "dynamic characteristics" as a regulation baseball. According to the appellant, the inventive baseball is more challenging to hit in batting practice, which results in improving the player's ability to hit a regulation baseball. See specification, page 3.

As we understand the rejection, it is the examiner's position that since the construction and materials of a regulation baseball are known, as acknowledged in the cited portions of the appellant's specification, and since it is known from Junior Balls to make baseballs smaller in size than a regulation baseball, it would have been obvious to one of ordinary skill in the art reduce the size of all of the components of a regulation baseball proportionally, suggestion being found in the desire to permit use by smaller players. The examiner further opines that the appellant has failed to establish that the claimed dimensions are critical. See Answer, pages 4 and 5.

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<sup>3</sup>The examiner and the appellant have agreed that the term "regulation baseball" defines a baseball that meets the requirements of Rule 1.09 of the Official Baseball Rules, which governs amateur and professional baseball in the United States, as has been referenced on page 1 of the appellant's specification and described on page 2 of the Brief.

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The claims in this case stand rejected as being obvious under 35 U.S.C. § 103. Our reviewing court has provided us with the following guidance for evaluating a rejection made under Section 103, which we have applied in arriving at our decision: 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 *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 USC §103, 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). This 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, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

We first reflect upon the fact that the appellant considers it critical that the practice baseball provide the "feel" and the "dynamic characteristics" of a regulation baseball

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(specification, page 3). Explicit consideration of these factors is absent from Junior Balls, which is the only applied reference directed to a baseball of size smaller than that of a regulation baseball. Moreover, there is nothing, in our view, which would have suggested to one of ordinary skill in the art that these factors be present in a baseball of reduced size, especially in view of the fact that the Junior Balls baseball is not made of the same materials as a regulation baseball, as will be discussed below.

With this as prologue, independent claim 1 requires, *inter alia*, that the inventive practice baseball include a central core "having a diameter in the range of 0.85 inches to 1.18 inches," whereas the central core in a regulation baseball has a diameter of "about 1.3125 inches," according to the description provided on page 5 of the appellant's specification. Thus, the core of the regulation baseball does not fall within the range recited in claim 1. While the Junior Balls baseball is smaller in outside circumference than a regulation baseball (8.5 inches vs. 9.25 inches), the diameter of its core is not disclosed nor, in our view, is there any teaching in the reference which would have suggested to one of ordinary skill in the art that the core be of

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the size specified in claim 1. The only information provided about the core is that it is made of "molded wool."

The same situation exists with regard to independent claim 4, wherein the diameter of the core is required to be "in the range of 65% to 90% of the diameter of a regulation baseball." For the reasons expressed above with regard to claim 1, it is our view that the prior art fails to teach this limitation. Claim 4 also requires a central core "formed of the same materials as a regulation baseball core" (emphasis added). As we stated above, the Junior Balls reduced size baseball is disclosed as having a core of molded wool. According to the appellant, however, the core of a regulation baseball must have a central core of cork, rubber or other similar material to comply with Rule 1.09 (specification, page 1). On its face, therefore, the secondary reference also fails to teach this feature of claim 4. Further in this regard, the examiner has not provided evidence to establish that the molded wool core of the Junior Balls baseball is a "similar material" under Rule 1.09.

The examiner's position that the appellant has failed to demonstrate "criticality of the differences" (Answer, page 4) is not well taken. In the disclosure, the appellant states that his invention maintains the feel and the dynamic characteristics of a

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regulation baseball, and in the claims he describes his invention by way of specific dimensions (claims 1 through 3) and dimensional relationships (claim 4), as well as in the material from which the core is made (claim 4). From our perspective, this establishes criticality to the degree necessary to require focus upon the fact that while the prior art discloses baseballs sized smaller than regulation baseballs, this is not the extent of the limitations recited in the appellant's claims. The only suggestion for making the core of the baseball in accordance with the dimensional and material limitations recited in claims 1 and 4 is found via the luxury of the hindsight provided one who first viewed the appellant's disclosure. This, of course, is impermissible as a basis for rejecting the claims. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

It therefore is our conclusion that the teachings of the prior art relied upon fail to establish a *prima facie* case of obviousness with regard to the subject matter of independent claims 1 and 4, and we therefore will not sustain the rejection of these claims or, it follows, of dependent claims 2 and 3.

In view of the fact that a *prima facie* case of obviousness has not been established by the applied prior art, there is no

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need for us to discuss the secondary evidence submitted by the appellant.

The decision of the examiner is reversed.

**REVERSED**

HARRISON E. McCANDLISH, Senior	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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	)	
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	

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