

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN FITE

Appeal No. 1999-1979
Application No. 08/758,788

HEARD: February 07, 2000

Before COHEN, MCQUADE, and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1, 6, 20, 26, 28 and 29, as amended subsequent to the final rejection.¹ Claims 10, 11, 13, 25 and 27 have been

¹ See the amendment filed August 26, 1998 (Paper No. 11).

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allowed. Claims 2 through 5, 7 through 9, 12, 14 through 19 and 21 through 24 have been canceled.

We AFFIRM.

The appellant's invention relates to a golf putter with adjustable characteristics. A more complete understanding of the invention can be derived from a reading of exemplary claim 1, which appears on page 14 of the brief (Paper No. 15).

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

Kenon 1974	3,848,737	Nov. 19,
Ebbing 1978	4,121,832	Oct. 24,
Huggins et al. 29, 1979 (Huggins)	4,156,526	May
Tucker, Sr. 1994 (Tucker)	5,332,214	Jul. 26,
Fisher 1995	5,458,332	Oct. 17,
Sturm 1997	5,690,562	Nov. 25,
		(filed Sep. 3, 1996)

The following rejections are before us for review:

(I) claims 1 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fisher;

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(II) claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fisher;

(III) claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fisher in view of Kenon;

(IV) claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fisher in view of Ebbing, Huggins, Tucker and Sturm; and

(V) claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Huggins in view of Fisher.²

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. 16) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15) 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

² Fisher was included in the answer as evidence to support the § 103 rejection of claim 29 in response to the language inserted into the claim by Paper No. 11 (answer, pages 3 and 4).

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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 determination which follows.

Rejection (I)

Initially, we note that appellant has indicated that claims 1 and 20 stand or fall together (brief, page 5). Accordingly, with respect to Rejection (I), we select independent claim 1 for

review and claim 20 will stand or fall with claim 1. 37 CFR § 1.192(c)(7).

Fisher discloses a golf putter 10 having a head 12, a shaft 14 received in a recess 18 formed in the upper surface 20 of putter head 12 (Fig. 2). Head 12 includes a forward face 24 having a rectangular recess 22. A flexible polyurethane pad or insert 26 having a golf ball impacting forward surface 28 is mounted or installed in recess 22. Pad 26 is constructed from solid polyurethane having a hardness that is selected according to a golfer's preference. To

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adjust for different putting distances, different pads of the same hardness provide a decrease in rebound by energy absorption between club head 12 and ball 50 of substantially less than 100% of an ideally "live" standard, and preferably in the range of 12.5% to 50.0% of the ideal. For example, a rebound factor of about 12.5% may be provided for a short putt, a rebound factor of about 25% may be provided for a medium putt, and a rebound factor of about 50% may be provided for a long putt.

At col. 5, lines 6 through 13, Fisher teaches that

[d]epending upon the distance of the golf ball from the cup (not shown) and the degree of control and feel required to sink the putt, the golfer can preselect a pad 26 from a set of pads to be inserted in a putter 10, (or, from a multi-putter set of putters embodying

the present invention, may select a putter) for, say, a 12.5%, 25%, 37.5%, or 50.0% rebound factor. In either case, the pads 26 may be color coded for ease of identifying the pad to the distance.
(Emphasis added)

Claim 1 calls for a golf club for putting comprising a putter body having a shaft connection region and a ball

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striking surface with a recess, a shaft secured to the putter body, and

a ball striking insert fabricated from a material selected from the group consisting of titanium, graphite, PTFE, copper, brass, nylon, resinous plastic material, polycarbonate resin, aluminum and steel, said ball striking insert detachably mounted in said recess, said insert having length, width and depth dimensions closely matching said recess so as to form a ball striking face substantially coplanar with said ball striking surface, whereby the putting characteristics of said golf club can be varied by using ball striking inserts of different weight, texture and hardness.

It is the examiner's position that the polyurethane pad disclosed by Fisher is "a ball striking insert fabricated from . . . resinous plastic material" (answer, page 3). As to the "whereby" clause of claim 1, the examiner has determined that the putting characteristics of the golf club disclosed by Fisher can also be varied by using inserts of different weight, texture and hardness. The examiner points out that claim 1 does not require a plurality of inserts having different weight, texture and

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hardness, only that if such inserts are used, the putting characteristics of the golf club can be varied (id. at 7).

Anticipation is established only if each and every element 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."

Appellant does not argue that polyurethane is not a resinous plastic material. Rather, appellant argues that since Fisher discloses a putter in which all of the pads are constructed from polyurethane, Fisher fails to disclose: (1) a

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golf club in which the insert is constructed from one of a group of materials having varying hardness; (2) pads constructed from titanium, graphite, PTFE, copper, brass, nylon, resinous plastic

material, polycarbonate resin, aluminum or steel; and (3) pads having different weights or textures (brief, pages 6 and 7).

Like the examiner, we are not persuaded by appellant's arguments. Claim 1 does not require a plurality of pads fabricated from different materials or having different weight, texture or varying hardness. Rather, claim 1 requires a ball striking insert fabricated from a material selected from a group of materials which includes resinous plastic material. Appellant would have us read into claim 1 limitations which are contrary to the plain words of the claim, something that we simply cannot do. See In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Thus, we will not read claim 1 as requiring a plurality of ball striking inserts fabricated from different materials having different weight, texture and hardness.

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Appellant has not explained, nor is it evident, why the putting characteristics of the golf club disclosed by Fisher would not be varied, if the club were used with inserts of different weight, texture and hardness. Thus, the examiner's determination that Fisher discloses, expressly or under principles of inherency, each and every element of the invention recited in claim 1 is well taken.

Therefore, we will sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Fisher. It follows, based on appellant's grouping of claims 1 and 20, supra, that the standing 35 U.S.C. § 102(b) rejection of claim 20 will also be sustained.

Rejection (II)

Claim 6 is dependent on claim 1 and further requires that the recess and the ball striking insert both have chamfered corner portions.

Appellant does not contest the examiner's determination that putting chamfered corner portions on the insert taught by Fisher would have been an obvious matter of design choice.

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Rather, appellant argues that Fisher does not teach, suggest or disclose a golf club in which the insert is constructed from one of a group of materials having varying hardness or pads constructed from a group of materials having different weights or textures (brief, pages 7 and 8). For the reasons set forth, above, in our discussion of the rejection of claim 1, we find appellant's arguments equally unpersuasive with respect to the rejection of claim 6.

Therefore, we will sustain the rejection of claim 6 under 35 U.S.C. § 103 as being unpatentable over Fisher.

Rejections (III), (IV) and (V)

With respect to each of the standing 35 U.S.C. § 103 rejections of claim 26 over Fisher in view of Kenon, claim 28 over Fisher in view of Ebbing, Huggins, Tucker and Sturm, and claim 29 over Huggins in view of Fisher, appellant again argues that Fisher does not teach, suggest or disclose a golf club in which the insert is constructed from one of a group of

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materials having varying hardness or pads constructed from a group of materials having different weights or textures (brief, pages 8 and 9).

Claim 26 does call for "a plurality of ball striking inserts," but does not require that the inserts be constructed from different materials or have different hardness, weight or texture as appellant seems to suggest. Rather, claim 26 requires that each insert be "fabricated from a material selected from the group consisting of titanium, graphite, PTFE, copper, brass, nylon, resinous plastic material, polycarbonate resin, aluminum and steel."

Fisher teaches a set of golf putter inserts with each insert being constructed of polyurethane, a resinous plastic material, and having the same hardness and a different rebound factor. Thus, the limitation of claim 26 that each insert is "fabricated from a material selected from the group consisting of titanium, graphite, PTFE, copper, brass, nylon, resinous plastic material, polycarbonate resin, aluminum and steel" can

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be read literally on the set of inserts taught by Fisher.

Claim 28, like claim 1, calls for

a ball striking insert fabricated from a material selected from the group consisting of titanium, graphite, PTFE, copper, brass, nylon, resinous plastic material, polycarbonate resin, aluminum and steel, said ball striking insert detachably mounted in said recess, said insert having length, width and depth dimensions closely matching said recess so as to form a ball striking face substantially coplanar with said ball striking surface, whereby the putting characteristics of said golf club can be varied by using ball striking inserts of different weight, texture and hardness.

Claim 29 calls for a ball striking insert having a ball striking face fabricated from a material selected from the group consisting of titanium, graphite, PTFE, copper, brass, nylon, resinous plastic material, polycarbonate resin, aluminum and steel.

Thus, the features which appellant argues are lacking in Fisher are not found in either of claims 28 or 29. Accordingly, we are constrained to sustain the standing 35 U.S.C. § 103 rejections of claims 26, 28 and 29.

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The examiner's decision rejecting appealed claims 1, 6, 20, 26, 28 and 29 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

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. MCQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN F. GONZALES)	
Administrative Patent Judge)	

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Thomas F. Smegal, Jr.
Knobbe, Martens, Olson & Bear, L.L.P.
620 Newport Center Drive
16th Floor
Newport Beach, CA 92660