

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. BERNHARDT

Appeal No. 2002-0095
Application No. 09/378,051

HEARD: MAY 7, 2002¹

Before COHEN, FRANKFORT, and McQUADE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 7 through 18. These claims constitute all of the claims remaining in the application.

Appellant's invention pertains to a bowling ball insert and a bowling ball assembly. A basic understanding of the invention can be derived from a reading of exemplary claims 7 and 9,

¹ At the request of appellant, a telephonic hearing took place on the specified hearing date.

Appeal No. 2002-0095
Application No. 09/378,051

respective copies of which are appended to the main brief (Paper No. 11).

As evidence of anticipation, the examiner has applied the document specified below:

Bernhardt

5,308,061

May 3, 1994

The following rejection is before us for review.

Claims 7 through 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bernhardt.²

The full text of the examiner's rejection and response to the argument presented by appellant appears in the answer (Paper No. 12), while the complete statement of appellant's argument can be found in the main and reply briefs (Paper Nos. 11 and 13).

² In error, both the final rejection (Paper No. 7, page 2) and the answer (Paper No. 12, page 2) indicate claims 1 through 18 as being under rejection when the application file reveals that claims 1 through 6 were canceled (Paper No. 6) prior to the final rejection and the cover sheet of the final rejection correctly indicates that claims 7 through 18 are rejected.

Appeal No. 2002-0095
Application No. 09/378,051

In the main brief (page 3), appellant sets forth that claims 7 through 12 stand or fall together, and that claims 13 through 18 stand or fall together. Pursuant to 37 CFR 1.192(c)(7), we select claims 7 and 13 for review, infra, with the remaining dependent claims of each claim grouping standing or falling with their respective independent claim.

OPINION

In reaching our conclusion on the anticipation issue raised in this appeal, this panel of the Board has carefully considered appellant's specification and claims 7 and 13,³ the applied patent, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

³ As noted below, claims 7 and 13 include informalities therein. However, reading these claims in light of the underlying disclosure allows us to comprehend the metes and bounds thereof and assess the claimed subject matter relative to the applied prior art.

Appeal No. 2002-0095
Application No. 09/378,051

We sustain the rejection of claims 7 and 13 under 35 U.S.C. § 102(b). It follows that the rejection of dependent claims 8 through 12 and 14 through 18 is also sustained since these claims stand or fall with claims 7 and 13, respectively, as earlier indicated.

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims 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).

Claim 7 is drawn to a bowling ball insert comprising, inter alia, a tubular body defining first and second finger openings at opposite terminal ends, a first finger gripping member adjacent the first finger opening, a second finger gripping member adjacent the first finger opening and directly opposing and being different than the first finger gripping member, a third finger gripping member adjacent the second finger opening, a fourth finger gripping member adjacent the second finger opening and directly opposing and being different than the first (sic, third) finger gripping member.⁴

Claim 13 recites a bowling ball assembly, comprising, inter alia, a bowling ball, a resilient insert defining first and second finger openings at opposite terminal ends of said body (sic, insert),⁵ a first finger gripping member adjacent the first

⁴ The language in the penultimate paragraph of claim 7 is informal, when read in light of the specification (page 2, lines 1 through 10), in referencing said "third" finger gripping member (rather than said --fourth-- finger gripping member) directly opposing said third gripping member, and in setting forth said "first" finger gripping member rather than said --third-- finger gripping member.

⁵ In lines 5 through 8 of claim 13, the phrases "said outer wall surface" and "said body" (two occurrences) are informal in that they have no explicit antecedent basis in the claim.

Appeal No. 2002-0095
Application No. 09/378,051

finger opening, a second finger gripping member adjacent the first finger opening and directly opposing and being different than the first finger gripping member, a third finger gripping member adjacent the second finger opening, a fourth finger gripping member adjacent the second finger opening and directly opposing and being different than the third finger gripping member.

The examiner's position is that claims 7 and 13 are anticipated by the Bernhardt reference (the '061 patent). In particular, the examiner points out that the reference shows a tubular body (insert) 96 (Figs. 14 through 18) and teaches, starting at column 7, line 27, that inserts can be "configured differently than the symmetrical arrangement disclosed." Appellant argues (main brief, page 5) that, with the present invention, opposing gripping members of each pair are different and that "[t]his is not explicitly illustrated in the '061 patent." In the reply brief (page 2), it is asserted that appellant (Bernhardt), the inventor of the applied Bernhardt reference, did not consider having "four different gripping surfaces" and designed the opposing gripping surfaces as the same "as is shown in the '061 patent."

Appeal No. 2002-0095
Application No. 09/378,051

In our opinion, claims 7 and 13, read in light of the underlying disclosure, clearly require that respective directly opposed finger gripping members be "different" (i.e., not be identical). A difficulty we have with appellant's argument, regarding the above claim limitation, is that it addresses what is depicted in the Bernhardt patent, and not the explicit disclosure of the reference (column 7, lines 22 through 28) as to (opposed finger gripping) configurations that are different rather than symmetrical. The referenced portion of Bernhardt makes it quite apparent to this panel of the Board that, for example, each opposed arcuate wall surface 108 (Fig. 18) would have a different second radius R_2 . Accordingly, we conclude that the Bernhardt document expressly teaches different opposed surfaces at opposite terminal ends of the insert, i.e., different opposed first and second finger gripping members at a first finger opening of an insert and different opposed third and fourth finger gripping members at a second finger opening of the insert, as required by claims 7 and 13. Therefore, claims 7 and 13 are anticipated by the Bernhardt patent.

Appeal No. 2002-0095
Application No. 09/378,051

For the reasons which we have articulated, supra, the argument advanced by appellant simply does not convince us that claims 7 and 13 are patentable under 35 U.S.C. § 102(b). More specifically, these claims do not require four different gripping surfaces, as argued.

In summary, this panel of the board has sustained the rejection of the claims on appeal.

The decision of the examiner is affirmed.

Appeal No. 2002-0095
Application No. 09/378,051

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)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

ICC:pgg

Appeal No. 2002-0095
Application No. 09/378,051

Harness Dickey & Pierce PLC
P.O. Box 828
Bloomfield Hills, MI 48303