

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte NORIO SUMITOMO and MASAHIDE ONUKI

Appeal No. 2002-1071
Application No. 09/369,312

ON BRIEF

Before ABRAMS, STAAB, 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 to 5, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to an anisotropic golf club shaft (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

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|----------------------------|-----------|----------------|
| Yamamoto et al. (Yamamoto) | 5,326,099 | July 5, 1994 |
| Kawamatsu | 5,421,573 | June 6, 1995 |
| Nishihara | 5,897,447 | April 27, 1999 |

Claims 1 to 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kawamatsu in view of Yamamoto and Nishihara.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No. 7, mailed May 23, 2001) and the answer (Paper No. 14, mailed March 8, 2002) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 13, filed January 8, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of the evidence of obviousness adduced by the examiner (i.e., the applied prior art references), it is our conclusion that the evidence of obviousness is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal.¹ Accordingly, we will not sustain the examiner's rejection of claims 1 to 5 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

¹ Accordingly, there is no need in this case to weigh the evidence of unobviousness submitted by the appellants (i.e., the declaration of Hideaki Kawamatsu dated September 28, 2001). We note that Figures 1 and 2 attached to that declaration and discussed on page 9 thereof may be incorrectly designated. That is, Figure 1 appears to show the shaft of the present invention since the number of plies is constant and Figure 2 appears to show the shaft disclosed in Kawamatsu's patent since the number of plies is not constant. Moreover, neither figure appears to show the two innermost body sheets arranged as shown in Figure 4 of Kawamatsu's patent (i.e., both sheets 6a and 6b start adjacent the mandrel 7).

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 1, the sole independent claim on appeal, reads as follows:

A golf club shaft comprising a laminate of a plurality of fiber reinforced resinous layers having one pair of angle layers consisting of a first angle layer and a second angle layer, or having a plurality of pairs of angle layers consisting of said first and second angle layers, such that a fiber of said first angle layer and that of said second angle layer incline in opposite directions at an angle 20°-35° with respect to an axis of said golf club shaft, wherein:

said first angle layer and said second angle layer are wound by 1.5 turns in a cross-sectional face of said golf club shaft and said 1.5 turns of said first and second angle layers continue along an axis of said shaft;

a winding start point of said first and that of said second angle layers are dislocated at 180° in a circumferential direction of said golf club shaft; and

in a cross-sectional face of said golf club shaft, a part consisting of two first angle layers and one second angle layer layered one upon another and a part consisting of one first angle layer and two second angle layers layered one upon another are formed to differentiate constructions consisting of said first and second angle layers of both of said parts.

The appellants argue (brief, p. 6) that the applied prior art does not teach or suggest a golf shaft in which a first angle layer and a second angle layer are **wound by 1.5 turns** in a cross-sectional face of the golf club shaft and the **1.5 turns** of the first and second angle layers **continue** along an axis of the shaft as recited in claim 1. We agree. The examiner's apparent position (final rejection, pp. 3 & 6; answer, p. 3) that these limitations of claim 1 are met by Kawamatsu is without merit. Kawamatsu clearly discloses in Figure 4 that the first body sheet 6a and the second body sheet 6b (i.e., the

two body sheets in which the angle layers incline in opposite directions) are wound by two turns. The claim clearly requires that the two sheets in which the angle layers incline in opposite directions are wound by 1.5 turns in a cross-sectional face of the golf club shaft and the 1.5 turns of the first and second angle layers continue along an axis of the shaft. The claim does not recite that the two sheets in which the angle layers incline in opposite directions are wound by **at least** 1.5 turns in a cross-sectional face of the golf club shaft and the **at least** 1.5 turns of the first and second angle layers continue along an axis of the shaft. In our view, the phrase "by 1.5 turns in a cross-sectional face of the golf club shaft" excludes other turns such as one turn, two turns, 2.5 turns, etc. Furthermore, the phrase "the 1.5 turns of the first and second angle layers continue along an axis of the shaft" requires that each of the first and second angle layers have 1.5 turns at each position thereof along the axis of the shaft. Accordingly, it is clear to us that the applied prior art does not teach or suggest a golf shaft in which a first angle layer and a second angle layer are **wound by 1.5 turns** in a cross-sectional face of the golf club shaft and the **1.5 turns** of the first and second angle layers **continue** along an axis of the shaft as recited in claim 1.

For the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2 to 5 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 5 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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