

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEFFRY A. PEGG

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Appeal No. 2002-1163  
Application 09/393,374

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HEARD: March 4, 2003

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Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.  
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 14, all of the claims pending in this application.

Appellant's invention relates to a putter used in the game of golf which may be placed in striking position on a golf green

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adjacent the golf ball to be struck and remain standing in striking position without external support so that the user may view alignment of the putter face with respect to the cup, the ball and topography of the green from positions removed from the location of the putter. Claims 1 and 6 are representative of the subject matter on appeal and a copy of those claims, as they appear in the Appendix to appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness of the claimed subject matter are:

Richilano	4,173,343	Nov. 6, 1979
Evans	5,282,622	Feb. 1, 1994
Hannon et al. (Hannon)	5,290,035	Mar. 1, 1994
Turner	5,855,525	Jan. 5, 1999

Claims 1 through 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Turner, Richilano and Hannon. According to the examiner (answer, pages 4-5), Evans addresses a self standing putter substantially as claimed except that this patent does not show or disclose the specific limitations for putter head weight, shaft weight, and grip

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weight, as well as height, length, and width of the putter head elements, namely the striking face and bottom face set forth in the claims on appeal. To address the above-noted differences, the examiner looks to Turner (col. 2) for a teaching of putter heads in the weight range of 10-14 ounces and a putter shaft weight of 4.1 ounces; Richilano (col. 2) for a teaching of a putter weighing between 10½ to 18 ounces; and Hannon (col. 3) for disclosure of a putter head having a weight of approximately 10 ounces (308 grams) and a shaft weight typically of about 3.5 ounces. The examiner then provides the following commentary:

[c]onsidering the collective teachings of Turner, Richilano and Hannon, it is clear that the appellant's claimed dimensions for the putter are not novel. Given the secondary teachings, it is clear that any number of weight combinations for the shaft, grip and head are available to the skilled artisan. The claimed structure of a free-standing putter having either a generally flat foot surface or concave foot surface that is wide enough to stabilize the putter in a free standing configuration is also not novel, as shown by the primary reference to Evans. To have modified the Evans device to simply make use of dimensions that are convenient and well-known for putters would have been obvious to the skilled artisan at the time of the invention, the motivation being to simply arrange the weight of the putter in a manner that not only satisfies the requirement that the Evans device be self-standing, but also enables the putter to be balanced, a feature shown many times over again to be desirable in the art. (See answer pages 4-5)

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Reference is made to the examiner's answer (Paper No. 9, re-mailed September 6, 2001) for the full reasoning in support of the above-noted rejection and to appellant's brief (Paper No. 8, filed August 6, 2001) and reply brief (Paper No. 11, filed October 1, 2001) for the arguments thereagainst.

#### OPINION

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art, and the respective positions advanced by appellant and the examiner. As a consequence of our review, we have reached the conclusions which follow.

Before addressing the examiner's rejection based on prior art, we note that it is an essential prerequisite that the claimed subject matter be fully understood. Accordingly, we initially direct our attention to appellant's independent claims 1 and 6 to derive an understanding of the scope and content thereof.

Independent claim 1 is directed to a putter comprising, *inter alia*, a putter head having a mass of "about fourteen ounces" and a shaft extending from the top surface of the putter head. Claim 1 further defines the putter shaft as extending from the top surface of the putter head at an angle of from "about 10° to about 25°" from vertical and sets forth that the shaft and grip thereon have "a combined mass of less than about three (3) ounces." Claim 6 is likewise directed to a putter comprising, *inter alia*, a putter head having a mass of "about fourteen ounces" and a shaft extending from the top surface of the putter head. Claim 6 includes the added limitations that the putter head defines a bottom face, a top face and a striking face, with the striking face extending "about four inches in a substantially horizontal plane to define a horizontal axis" and that the foot surface of the putter lies in a plane substantially normal to the vertical plane of the striking face and "defines an area of at least about eight square inches." It is significant to note that neither of appellant's independent claims before us on appeal specifically sets forth that the putter is free standing or has any such capability.

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As our reviewing Court has indicated in Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826 221 USPQ 568, 574 (Fed. Cir. 1984), when words of degree are used in the claims we must determine whether the specification provides some standard for measuring the degree and whether one of ordinary skill in the art would understand what is claimed when read in light of the specification. Thus, in attempting to discern what constitutes a putter head having a mass of "about fourteen ounces," a striking face which "extends about four inches," a foot surface that defines an area of "at least about eight square inches," and a shaft extending from the top face of the putter head at an angle of from "about 10° to about 25°," wherein the shaft and grip thereon have a combined mass of "less than about three (3) ounces," we have turned to appellant's specification to see if a standard for measuring the various stated matters of degree are provided therein. However, after a careful review, we find nothing in the specification to give us guidance in clearly understanding the language in question.

While the specification, e.g., at pages 2 and 3, indicates that the putter of the present invention is weighted, balanced and aligned to provide a balanced pendulum motion and to permit

the putter to remain free standing when the bottom face of the putter is placed on the green in the striking position, the remainder of the specification, e.g., at pages 4 through 7, provides no clear indication of exactly how these results are to be achieved, since the specification merely uses the same type of open-ended language as appears in the claims presently on appeal. For example, page 5 of the specification indicates that the putter head (10) of Fig. 2 will remain free standing so long as the mass of the head is "at least about fourteen (14) ounces and the combined mass of the shaft and grip is less than about three (3) ounces." Page 6 indicates that in the preferred embodiment the bottom face is flat and defines a foot surface that is "about four (4) inches long" and of "about eight (8) square inches."

At this point, we again note that the claims on appeal do not require that the claimed putter be free standing or have that capability. Thus, it is clear that a claimed putter having a head weight of "about fourteen ounces," a shaft and grip weight of "less than about three (3) ounces," a shaft extending from the top surface of the head at an angle of "about 10° to about 25°" from vertical, and having a foot surface area of "at least about eight square inches" need not necessarily be free standing.

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Thus, given the open-ended nature of the claims on appeal and the multiple terms of degree or ambiguous ranges set forth in each of those claims, we have no basis for precisely determining the metes and bounds of the claimed subject matter.

As examples of our difficulty in understanding the scope of the presently claimed subject matter, we note that Turner (col. 2, lines 4-6) discloses a putter head having a weight of 12 ounces (i.e.,  $18 \times \frac{2}{3}$ ), while Hannon discloses (col. 3, lines 35-38) a typical shaft weight for a putter of about 3.5 ounces. When questioned at the oral hearing held on March 4, 2003, appellant's counsel was unable to say with any degree of certainty whether these parameters associated with putters in the prior art fell within the metes and bounds of the claims on appeal. Given the ambiguity of the multiple ranges in the claims on appeal and lack of any precise guidance in the specification, we conclude that the scope and content of claims 1 and 6 are indefinite. Since claims 2 through 5 on appeal depend from claim 1 and claims 7 through 14 depend from claim 6, they too suffer from the same indefiniteness.

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Under the provisions of 37 CFR 1.196(b), we enter the following new ground of rejection against appellant's claims 1 through 14:

Claims 1 through 14 are rejected under 35 U.S.C. § 112, second paragraph, for the reasons explained above, as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as the invention.

Turning to the examiner's rejection of the appealed claims under 35 U.S.C. 103(a) based on Evans in view of Turner, Richilano and Hannon, we again point out that the claims before us contain unclear language which renders the subject matter thereof indefinite for reasons stated supra as part of our new rejection under 35 U.S.C. § 112, second paragraph. Accordingly, we find that it is not possible to apply this prior art to these claims in deciding the question of obviousness under 35 U.S.C. § 103 without resorting to considerable speculation and conjecture as to the meaning of the questioned limitations in the claims. This being the case, we are constrained to reverse the examiner's rejection of claims 1 through 14 under 35 U.S.C. 103(a) in light of the holding in In re Steele, 305 F.2d 859,

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862, 134 USPQ 292, 295 (CCPA 1962). We hasten to add that this reversal of the examiner's rejection is not based on the merits of the rejection, but only on technical grounds relating to the above-noted indefiniteness of the appealed claims.<sup>1</sup>

Based on the foregoing, the examiner's rejection under 35 U.S.C. § 103(a) of the appealed claims has been reversed for technical reasons. A new ground of rejection of claims 1 through 14 under 35 U.S.C. § 112, second paragraph, has been added pursuant to 37 CFR § 1.196(b).

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<sup>1</sup>As mere guidance to the examiner and appellant, we note that it would appear that if the ambiguity of the multiple ranges set forth in the claims on appeal were to be eliminated, i.e., by reciting in claim 1 a self standing putter having a putter head having "a mass of fourteen ounces" and a shaft and grip having a combined mass of "less than three ounces," and in claim 6 a self standing putter having a putter head having "a mass of fourteen ounces," a striking face which "extends four inches in a substantially horizontal plane," and a foot surface on the putter head which defines an area of "at least eight square inches," then the claims would define over the prior art currently applied by the examiner, since that prior art provides no teaching or suggestion for selecting the specific multiple parameters of claims so amended. Further in that regard, it does not appear to us that the examiner has even attempted to specifically address the angle of the putter shaft in appellant's claims in the rejection set forth on appeal. As an additional point, we note that the examiner's apparent attempt to introduce a new ground of rejection in the examiner's answer (page 7) is entirely improper.

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This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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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 § 1.196(b)

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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Appendix

1. A putter comprising:

(a) a putter head having a mass of about fourteen ounces defining a bottom face, a top face and a striking face which extends in a substantially vertical plane from said bottom face toward said top face and defines a horizontal axis; and

(b) a shaft extending from the top face of said putter head at an angle of from about  $10^{\circ}$  to about  $25^{\circ}$  from vertical with respect to said horizontal axis having a grip adjacent the end opposite said putter head, said shaft and said grip having a combined mass of less than about three (3) ounces.

6. A putter comprising:

(a) a putter head having a mass of about fourteen ounces defining a bottom face, a top face and a striking face which extends in a substantially vertical plane from said bottom face toward said top face and extends about four inches in a substantially horizontal plane to define a horizontal axis;

(b) a foot surface on said putter head which lies in a plane substantially normal to the vertical plane of said striking face and defines an area of at least about eight square inches; and

(c) a shaft extending from the top face of said putter head.