

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte  
R. DENNIS NESBITT

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Appeal No. 2003-1293  
Application No. 09/675,739

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**ON BRIEF**

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Before PAK, OWENS and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 15. Claims 16 through 23 have been withdrawn from consideration pursuant to a requirement for restriction. These are all the claims pending in

this application.

### **THE INVENTION**

The invention is directed to a hollow game ball having a core comprising a cross-linked thermoset elastomeric material having a specific range of Shore hardness. A cover overlies the core. Additional limitations are described in the following illustrative claim.

### **THE CLAIM**

Claim 1 is illustrative of appellant's invention and is reproduced below.

1. A hollow game ball comprising:

a substantially spherical core defining a substantially spherical internal cavity, said core comprised of a cross-linked thermoset elastomeric material having a Shore C hardness within the range of 40 to 70; and

a cover overlying said core.

### **THE REFERENCES OF RECORD**

As evidence of obviousness, the examiner relies upon the following references:

Tomar	4,498,667	Feb. 12, 1985
Miller	4,653,752	Mar. 31, 1987
McClure et al. (McClure)	5,665,188	Sep. 9, 1997
Yang	5,704,858	Jan. 6, 1998

### **THE REJECTIONS**

Claims 1 through 3, 5, 10 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Miller in view of McClure.

Claims 4, 6 through 9 and 11 through 13 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Miller in view of McClure and Yang.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of McClure and Tomar.

### **OPINION**

We have carefully considered all of the arguments advanced by the appellant and the examiner and agree with the appellant that the rejections of the claims under § 103(a) are not well founded. Accordingly, we reverse each of the rejections.

#### *The Rejections under § 103(a)*

It is the examiner's position that inasmuch as McClure discloses cores of rubber, thermoplastic, thermoset or polyurethane materials, "[i]t would have been obvious to one of ordinary skill in the art to form the core of Miller from a thermoset material in order to take advantage of the material's well known physical characteristics." See Final rejection, mailed March 29, 2002, page 2. We disagree.

Miller is directed to a game ball which may be a baseball or softball having a plastic sphere and a cover. See column 1, lines 11-14. The game ball is formed from a single sphere of thermoplastic material. See column 1, lines 64-65. We find that the interior of the ball is a hollow sphere which is optionally filled with cellular material. See column 2, lines 7-12. The specific thermoplastic polymers which may be utilized in the polymers include Surlyn, ethylene vinyl acetate and mixtures thereof. See column 2, line 62 to

column 3, line 13. Significantly however, the preferred embodiment of Miller's invention is directed to mixtures of the two thermoplastic polymers, i.e., Surlyn and ethylene vinyl acetate. See column 3, lines 14 to 31 and claims 1 to 4.

McClure is likewise directed to the preparation of baseballs and softballs. The patentee discloses that, "the core can be molded from a variety of products, depending upon the type of ball being manufactured, including rubber, thermoplastic, thermoset or polyurethane." See column 3, lines 19-22. As we noted above the examiner combined Miller with McClure and stated the obviousness of using a thermoset material in place of the thermoplastic materials of Miller.

Even if the examiner's assertion had been correct, the claimed subject matter before us requires that the core be comprised of, "a cross-linked thermoset elastomeric material." See claim 1. Miller, as we found above is directed exclusively to thermoplastic materials. In contrast, the materials described by McClure include both rubber and thermoset materials. A thermoset material neither teaches nor suggests that the material is elastomeric, or necessarily crosslinked. It merely requires that a substance such as a plastic becomes permanently rigid usually by application of heat. As for rubber, it is customarily elastomeric. There is however, no requirement that rubber is either cross-linked or thermoset.

Based upon the above considerations, even if the examiner was correct in combining Miller and McClure in the manner described supra, the requisite article would

not be taught and the article created would, in any event fall short of the invention defined by the claimed subject matter, as the aforesaid claimed subject matter requires features that cannot be achieved by combining the two references. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Accordingly, the examiner has not established a prima facie case of obviousness.

The references to Yang and Tomar are directed to limitations found in the dependent claims and fail to account for the deficiencies in the combination of Miller and McClure.

### **DECISION**

The rejection of claims 1 through 3, 5, 10 and 14 under 35 U.S.C. §103(a) as being unpatentable over Miller in view of McClure is reversed.

The rejection of claims 4, 6 through 9, and 11 through 13 under 35 U.S.C. §103(a) as being unpatentable over Miller in view of McClure and Yang is reversed.

The rejection of claim 15 under 35 U.S.C. §103(a) as being unpatentable over Miller in view of McClure and Tomar is reversed.

The decision of the examiner is reversed.

**REVERSED**

CHUNG K. PAK  
Administrative Patent Judge

TERRY J. OWENS  
Administrative Patent Judge

PAUL LIEBERMAN  
Administrative Patent Judge

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