

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte CHRISTOPHER CAVALLARO, RYAN B. BOSANKO
and EDMUND A. HEBERT

Appeal No. 2004-0189
Application No. 09/782,782

ON BRIEF

Before STAAB, McQUADE, 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 16 and 18 to 28, which are all of the claims pending in this application.

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellants' invention relates generally to golf balls, and more specifically, to multilayer golf balls. In particular, this invention relates to a golf ball having a core comprising a center and an outer core layer, and a cover comprising an inner cover layer and a thin outer cover layer (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellants' brief. Claims 1 and 18, the independent claims on appeal, read as follows:

1. A golf ball comprising a core and a cover disposed about the core, wherein the core comprises a center and at least one outer core layer adjacent the center, and the cover comprises at least one inner cover layer and an outer cover layer;
 - (a) wherein the center has an outer diameter from about 0.375 in to about 1.4 in and deflection of greater than about 4.5 mm under a load of 100 Kg;
 - (b) the outer core layer has an outer diameter of from about 1.4 in to about 1.62 in;
 - (c) the inner cover layer has an outer diameter of greater than about 1.58 in and a material hardness of less than about 72 Shore D; and
 - (d) the outer cover layer has a hardness of greater than about 56 Shore D.

18. A golf ball comprising a core and a cover disposed about the core, wherein the core comprises a solid center and an outer core layer adjacent the center, and the cover comprises an inner cover layer and an outer cover layer;
 - (a) wherein the center has an outer diameter from about 0.375 in to about 1.4 in and deflection of greater than about 4.5 mm under a load of 100 Kg;
 - (b) the outer core layer has an outer diameter of from about 1.4 in to about 1.62
 - (c) the inner cover layer has an outer diameter of greater than about 1.58 in and a material hardness of less than about 72 Shore D; and
 - (d) the outer cover layer has a hardness of greater than about 56 Shore D.

Claims 1 to 16 and 18 to 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,248,027¹ to Hayashi et al. (Hayashi).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 9, mailed April 16, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 8, filed February 5, 2003) and reply brief (Paper No. 10, filed June 16, 2003) 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 Hayashi patent, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The appellants argue (brief, pp. 5-10) that the limitation that the "outer cover layer has a hardness of greater than about 56 Shore D" is not taught or suggested by Hayashi since that patent discloses an outer cover having a Shore D hardness in the range of 35-53. In response to this argument in the answer (pp. 4-9), the examiner has

¹ Issued June 19, 2001.

(1) stated that the claim term "about" has not been defined at all by the appellants;
(2) stated that the appellants have given no indication as to the scope of the term "about;" (3) determined that this limitation is met by Hayashi's outer cover having a Shore D hardness of 53 since one skilled in the art would consider the claimed Shore D hardness of greater than "about" 56 to be readable on a Shore D hardness of 53; and
(4) concluded that the claimed Shore D hardness of greater than "about" 56 to be prima facie obvious² from Hayashi's teaching of a Shore D hardness of 53. Thus, this appeal requires us to fully understand³ the scope of the terminology "about" as used in the claims under appeal.

Our review of independent claims 1 and 18 reveals that we are unable to derive a proper understanding of the scope and content thereof. Specifically, the terminology

² The Federal Circuit stated in In re Peterson, 315 F.3d 1325, 1329, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003) that a prima facie case of obviousness exists when the claimed range and the prior art range do not overlap but are close enough such that one skilled in the art would have expected them to have the same properties (citing to Titanium Metals Corp. v. Banner, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985) (concluding that a claim directed to an alloy containing "0.8% nickel, 0.3% molybdenum, up to 0.1% maximum iron, balance titanium" would have been prima facie obvious in view of a reference disclosing alloys containing 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium).

³ Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988).

"about" in independent claims 1 and 18 raises a definiteness issue under 35 U.S.C. § 112, second paragraph.

The term "about" is a term of degree. When a word of degree is used, such as the term "about" in claims 1 and 18, it is necessary to determine whether the specification provides some standard for measuring that degree. See Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

Admittedly, the fact that some claim language, such as the term of degree mentioned supra, may not be precise, does not automatically render the claim indefinite under the second paragraph of § 112. Seattle Box, supra. Nevertheless, the need to cover what might constitute insignificant variations of an invention does not amount to a license to resort to the unbridled use of such terms without appropriate constraints to guard against the potential use of such terms as the proverbial nose of wax.⁴

In Seattle Box, the court set forth the following requirements for terms of degree:

When a word of degree is used the district court must determine whether the patent's specification provides some standard for measuring that

⁴ See White v. Dunbar, 119 U.S. 47, 51-52 (1886) and Townsend Engineering Co. v. HiTec Co. Ltd., 829 F.2d 1086, 1089-91, 4 USPQ2d 1136, 1139-40 (Fed. Cir. 1987).

degree. The trial court must decide, that is, whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification.

In Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225

USPQ 634, 641 (Fed. Cir. 1985), the court added:

If the claims, read in light of the specifications [sic], reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.

Indeed, the fundamental purpose of a patent claim is to define the scope of protection⁵ and hence what the claim precludes others from doing. All things considered, because a patentee has the right to exclude others from making, using and selling the invention covered by a United States letters patent, the public must be apprised of what the patent covers, so that those who approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection in evaluating the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

⁵ See In re Vamco Machine & Tool, Inc., 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985).

In the present case, we have reviewed the appellants' disclosure to help us determine the meaning of the above-noted terminology from claims 1 and 18. That review has revealed that the appellants' specification provides at page 9 that the term "about," as used herein in connection with one or more numbers or numerical ranges, should be understood to refer to all such numbers, including all numbers in a range.

However, this definition does not provide a sufficient guideline defining the terminology "about" as used in the claims under appeal. For example, if this definition connotes that "greater than about 56" refers only to numbers greater than 56 then the term "about" becomes meaningless. If this definition is meant to indicate that "greater than about 56" refers to all numbers greater than 56 and some numbers less than 56 then the definition does not clearly set forth the lower limit. Furthermore, there are no guidelines that would be implicit to one skilled in the art defining the term "about" as used in the terminology "greater than about 56 Shore D" that would enable one skilled in the art to ascertain what is meant by "about." For example, one cannot ascertain if a Shore D hardness of 53 is "greater than about 56." This is especially true since (1) dependent claim 2 further requires the outer cover layer to have a material hardness

less than about 55 shore D, and (2) dependent claims 3 and 19 further require the outer cover layer to have a material hardness less than about 50 shore D.⁶

Absent guidelines that would enable one skilled in the art to ascertain what is meant by "about" as used in the claims under appeal, we are of the opinion that a skilled person would not be able to determine the metes and bounds of the claimed invention with the precision required by the second paragraph of 35 U.S.C. § 112. See In re Hammack, supra.

Since the appellants' disclosure fails to set forth an adequate definition as to what is meant by the terminology "about" as used in the claims under appeal, the appellants has failed to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112.

NEW GROUND OF REJECTION

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

⁶ These dependent claims would seem to indicate that the appellants may have intended the terminology "greater than about 56 Shore D" to encompass both a Shore D hardness less than 55 and a Shore D hardness less than 50. However, such is not clear from the record before us in this appeal.

Claims 1 to 16 and 18 to 28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention, for the reasons explained above.

As set forth previously, our review of the specification leads us to conclude that one of ordinary skill in the art would not be able to understand the metes and bounds of the terminology "about" as used in the claims under appeal.

THE OBVIOUSNESS REJECTION

Considering now the rejections of claims 1 to 16 and 18 to 28 under 35 U.S.C. § 103, we have carefully considered the subject matter defined by these claims. However, for reasons stated supra in our new rejection under the second paragraph of 35 U.S.C. § 112 entered under the provisions of 37 CFR 1.196(b), no reasonably definite meaning can be ascribed to certain language appearing in the claims. As the court in In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) stated:

[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious --the claim becomes indefinite.

In comparing the claimed subject matter with the applied Hayashi patent, it is apparent to us that considerable speculations and assumptions are necessary in order

to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and assumptions, see In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962), we are constrained to reverse, pro forma, the examiner's rejections of claims 1 to 16 and 18 to 28 under 35 U.S.C. § 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the section 103 rejection.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 16 and 18 to 28 under 35 U.S.C. § 103 is reversed and a new rejection of claims 1 to 16 and 18 to 28 under 35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 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. . . .

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)

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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Appeal No. 2004-0189
Application No. 09/782,782

Page 12

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