

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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

Ex parte MICHEAL E. FRANSSSEN

Appeal No. 2005-0297
Application No. 09/772,689

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 and 11. Claims 1-9, the only other claims pending in this application, stand allowed, the examiner having withdrawn the rejection thereof on page 3 of the answer (Paper No. 13).

We REVERSE.

BACKGROUND

The appellant's invention relates to training bats with adjustable weight and balance for use in improving hitting accuracy and for improving the transition from aluminum bats used in collegiate games to wood bats used in professional games and to a method for helping a player accustomed to an aluminum bat to adapt to a wood bat using such training bat.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Fujii	3,963,239	Jun. 15, 1976
Pomilia	4,682,773	Jul. 28, 1987
DiSieno	4,720,104	Jan. 19, 1988

Claims 10 and 11 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Pomilia in view of DiSieno and Fujii.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 13) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 12 and 14) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The basis of the examiner's rejection of claims 10 and 11 is that,

since no boundaries have been set or established in this application as originally filed as to what weight a wood or aluminum bat should or could have, and since it is well known that the wood and the aluminum bat can have the same weight, then it is unclear how one would compare the weights in order to establish an "intermediate" weight? In the instant when the wood and aluminum bat do not have the same weight, it is unclear what weight range appellant's training bat should be compared to? Therefore, it is impossible to compare the present training bat to other bats [answer, page 3].

The basic flaw in the examiner's reasoning is that the examiner appears to have improperly read out of the claim the language "method for helping a baseball player who is accustomed to an aluminum bat to adapt to a wood bat." A person of ordinary skill in the field of baseball seeking to help a player transition from an aluminum bat to which he or she is accustomed to a wood bat would of course know the identities of the are between the total weights and balances of said aluminum and wood bats. We thus conclude that the references to aluminum bat weight and balance, wood bat weight and

balance, and intermediate weight and balance do not render claims 10 and 11 indefinite. The rejection under 35 U.S.C. § 112, second paragraph, is reversed.

The examiner's rejection of claim 10 under 35 U.S.C. § 103 as being unpatentable over Pomilia in view of DiSieno and Fujii suffers from the same flaw evident in the indefiniteness rejection, namely, reading out the language "method for helping a baseball player who is accustomed to an aluminum bat to adapt to a wood bat."¹ Pomilia discloses a baseball training bat comprising a tubular member 12 of constant diameter and weight to length ratio along its length and having a shaft or hitting portion 16 which is substantially thinner than that of a conventional bat as well as a weight which is heavier than that of a conventional bat for use in practice to develop batting strength, bat speed and hand-eye coordination. Pomilia provides no teaching or suggestion of helping a player who is accustomed to an aluminum bat to adapt to a wood bat, or providing an intermediate total weight and intermediate balance in the training bat which are between said aluminum bat and said wood bat, as called for in claim 10. DiSieno and Fujii likewise lack such teaching or suggestion. We thus conclude that, even if the references were combined as proposed by the examiner, appellant's claimed invention would not result. The rejection is reversed.

CONCLUSION

¹ It is elementary that to support an obviousness rejection, all of the claim limitations must be taught or suggested by the prior art applied (see In re Royka, 490 F.2d 981, 984-85, 180 USPQ 580, 582-83 (CCPA 1974)) and that all words in a claim must be considered in judging the patentability of that claim against the prior art (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

To summarize, the decision of the examiner to reject claims 10 and 11 under 35 U.S.C. § 112, second paragraph, and claim 10 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 2005-0297
Application No. 09/772,689

Page 6

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