

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. KENNEDY III, MICHAEL J. TZIVANIS,
VIKTOR KELLER, WILLIAM M. RISEN JR., MARK L. BINETTE,
and JOHN L. NEALON

Appeal No. 2005-1119
Application No. 10/074,665

ON BRIEF

Before WALTZ, TIMM, and JEFFREY T. SMITH, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 46 through 53. The remaining claims in this application are claims 27 through 45, which stand withdrawn from consideration by the examiner as drawn to a non-elected invention (Brief, page 2, ¶III). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a golf ball comprising a core, an inner cover layer which has a Shore D hardness of at least 60 and is formed from a specified material,

and an outer cover layer formed over the inner cover layer, where the outer cover layer has a Shore D hardness of no more than 55, and the golf ball has a spin factor of at least 5 (Brief, page 3, ¶V). Appellants state that claims 46 to 53 stand or fall together (Brief, page 4, ¶VII).¹ Accordingly, pursuant to the provisions of 37 CFR § 1.192(c)(7)(2003), we select claim 46 as representative of the group of claims and decide the grounds of rejection in this appeal on the basis of this claim alone. Of course, we also consider claim 51 on appeal since it is the subject of a separate rejection. See *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002), Representative independent claim 46 is reproduced below:

46. A golf ball comprising:
a core;
an inner cover layer which has a Shore D hardness of at least 60 as measured on the curved surface thereof and is formed from a composition which includes at least one material selected from the group consisting of polyphenylene ether/ionomer blends, ionomers, polyamides, polyurethanes, polyester elastomers, polyester amides, metallocene catalyzed polyolefins, and blends thereof; and
an outer cover layer formed over the inner cover layer, the outer cover layer having a shore D hardness of no more than 55 as measured on the curved surface thereof, the golf ball having a spin factor of at least 5.

¹The examiner incorrectly finds that appellants state that the claims do not stand or fall together (Answer, page 3, ¶(7), underlining added).

Appeal No. 2005-1119
Application No. 10/074,665

The examiner relies upon the following references as evidence of unpatentability:

Nesbitt	4,431,193	Feb. 14, 1984
Sullivan	5,098,105	Mar. 24, 1992
Sullivan et al. (Sullivan '894)	6,213,894 B1	Apr. 10, 2001
Yabuki (filed Mar. 28, 1997)	6,359,066 B1	Mar. 19, 2002

Claims 46-50, 52 and 53 stand rejected under 35 U.S.C. § 102(b) as anticipated by Nesbitt (Answer, page 3). Claim 51 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Nesbitt in view of Sullivan (Answer, page 4). Claims 46-53 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-42 of Sullivan '894 (Answer, page 4).² We *affirm* all of the rejections on appeal essentially for the reasons stated in the Answer and those reasons set forth below.

OPINION

A. The Obviousness-type Double Patenting Rejection

Appellants do not contest or dispute this rejection but merely state that a terminal disclaimer will be filed once the

²We have considered the decision in Appeal No. 2004-1184, Paper No. 20, in Application No. 10/074,849 (see the Brief, page 2, ¶II).

"other issues" have been resolved (Brief, page 3, ¶VI). Accordingly, we summarily affirm the examiner's rejection of claims 46-53 under the judicially created doctrine of obviousness-type double patenting over claims 1-42 of Sullivan '894.

B. The Rejection under § 102(b)

The examiner finds that Nesbitt discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer, where the inner cover layer is made from a hard, high flexural modulus resinous material such as Surlyn® 1605 (Answer, page 3). The examiner applies Yabuki as evidence that Surlyn® 1605 has a Shore D hardness of 62 (Answer, pages 3 and 5).³ The examiner further finds that Nesbitt discloses an outer cover layer made from a soft, low flexural modulus resinous material such as Surlyn® 1855, which has a Shore D hardness of 55 as taught by Yabuki (Answer, page 3).⁴ Since the examiner also

³It is well known that Surlyn® 1605 is identical or equivalent to hi-milan 1605 (trade name)(see Yabuki, col. 11, ll. 53-57)(see the decision in Appeal No. 2004-1184, Paper No. 20, footnote 1). We note that appellants do not contest or dispute any of the examiner's findings from Yabuki (see the Brief in its entirety).

⁴Again we note that the examiner equates hi-milan 1855 (trade name) with Surlyn® 1855 (see Yabuki, col. 11, ll. 63-67),
(continued...)

finds that the inner cover layer thickness, the outer cover layer thickness, the coefficient of restitution (COR), and the flexural modulus of the inner cover layer of the materials taught by Nesbitt are the same or overlap with these variables of the claimed golf ball, the examiner concludes that the spin factor of the Nesbitt golf ball would inherently be the same as the claimed golf ball spin factor (Answer, pages 3-4). We agree.

Appellants argue that Nesbitt does not disclose or claim the specific Shore D hardness of the inner or outer cover layers (Brief, page 5). Appellants are correct that Nesbitt does not disclose or claim any specific Shore D hardness of the inner or outer cover layers. However, appellants have not disputed the examiner's finding from Yabuki that the exemplified inner cover layer of Nesbitt (Surlyn® 1605) has a Shore D hardness of 62, which is within the scope of claim 46 (which recites an inner cover layer with a Shore D hardness of "at least 60"). Additionally, appellants have not disputed the examiner's finding from Yabuki that the exemplified outer cover layer of Nesbitt (Surlyn® 1855) has a Shore D hardness of 55, which is within the scope of claim 46 (which recites an outer cover layer having a

⁴(...continued)
and appellants do not contest or dispute this finding.

Appeal No. 2005-1119
Application No. 10/074,665

Shore D hardness of "no more than 55"). Therefore appellants' argument is not persuasive since an example of Nesbitt falls within the scope of claim 46 on appeal. See *In re May*, 574 F.2d 1082, 1089, 197 USPQ 601, 607 (CCPA 1978).

Appellants argue that Nesbitt does not disclose or claim a spin factor at all (Brief, page 5). Appellants argue that the burden is on the examiner to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art (*id.*). Finally, appellants argue that in order for a reference to anticipate every element of the claims must be "literally" present in the reference (*id.*).

Appellants' arguments are not persuasive. We note that appellants are incorrect in arguing that every element of the claims must be literally present in a reference to have anticipation. Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. See *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). In this appeal, we note that the "spin factor" is derived from a complex set of measurements and calculations using many different golf clubs (see the specification, pages 45-46). This "spin

factor" is not recognized in any prior art other than some of appellants' own patents. Contrary to appellants' arguments, we determine that the examiner has provided sufficient evidence to establish a reasonable belief that the spin factor of the Nesbitt golf ball would have inherently been the same as the claimed golf ball's spin factor. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990); and *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). As found by the examiner in the Answer (pages 3-4 and 7), the golf ball of Nesbitt has the same range of thicknesses for the inner and outer cover, the same materials for the core, inner and outer cover layers, with the same flex modulus for the inner cover layer, as well as a coefficient of restitution which is the same as the claimed golf ball.⁵ Therefore we determine that the examiner has

⁵We note that the COR taught by Nesbitt of 0.800 or more applies to the core and inner layer, while the COR disclosed and claimed by appellants of at least 0.750 applies to the entire golf ball (e.g., see claim 53 on appeal). However, appellants do not dispute or contest the examiner's finding that the COR of the Nesbitt golf ball falls within the scope of COR values disclosed and claimed by appellants. Furthermore, Nesbitt teaches that the COR of the entire golf ball must be "comparatively high" so that the ball closely approaches the maximum permitted initial velocity specified by the USGA (col. 3, ll. 8-15). Accordingly, for purposes of this appeal, we accept the examiner's finding as fact that the COR of the Nesbitt golf ball falls within the range of COR values of appellants' claimed golf ball.

Appeal No. 2005-1119
Application No. 10/074,665

met the initial burden of proof and shifted this burden to appellants. See *In re Spada, supra*; *In re Best, supra*. We note that appellants have not relied on any evidence to attempt to establish that the golf ball of Nesbitt does not possess the spin factor as recited in claim 46 on appeal.

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a reasonable belief that all of the claimed limitations are described or inherent in Nesbitt. Accordingly, we affirm the rejection of claims 46-50, 52 and 53 under section 102(b) over Nesbitt.

C. The Rejection under § 103(a)

The examiner applies Nesbitt for the findings as discussed above and in the Answer (Answer, pages 3-4). The examiner recognizes that the flex modulus of the exemplified outer cover layer of Nesbitt is above the range recited in claim 51 on appeal (Answer, page 4; see also the specification, page 4, ll. 1-3). The examiner finds that Sullivan teaches an ionomer used for a golf ball cover layer having a flex modulus of 2500 to 3500 psi (Answer, page 4). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this

art to employ the ionomer of Sullivan as the soft, low flex modulus resinous material of the outer cover layer of Nesbitt (*id.*).

Appellants argue that Sullivan is directed to a single layer cover for a golf ball, while Nesbitt is directed to a multi-layer golf ball cover, and the examiner has not provided any motivation for combining these references as proposed (Brief, page 8). Furthermore, appellants argue that the flex modulus taught by Sullivan represents Iotek 7520 resin alone, while the reference only teaches cover layers formed from a blend of Iotek 7520 and another (hard) ionomer (Brief, pages 7-8). Appellants note that the Shore D hardness of the blend taught by Sullivan is greater than the claimed Shore D hardness (Brief, page 8).

These arguments are not persuasive. The examiner has not applied Sullivan for a teaching of a cover layer to replace the cover layer of Nesbitt. The examiner applies Sullivan for its teaching that an ionomer with a flex modulus of 2500-3500 psi was known in this art (Answer, pages 7-8). Since Nesbitt generically teaches that the outer cover layer should be formed of "soft, low flexural modulus resinous material" (col. 1, ll. 52-53), the examiner has applied Sullivan for its teaching that another soft, low flex modulus resinous material was known in the art as useful

Appeal No. 2005-1119
Application No. 10/074,665

in golf ball cover layers. Accordingly, we determine that the examiner has established that it would have been *prima facie* obvious to use an ionomer such as Iotek 7520 to meet the requirements of the outer cover layer of the Nesbitt golf ball.

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence which has not been rebutted by appellants' arguments. Based on the totality of the record, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore we affirm the rejection of claim 51 under section 103(a) over Nesbitt in view of Sullivan.

D. Summary

The rejection of claims 46-53 under the judicially created doctrine of obviousness-type double patenting over claims 1-42 of Sullivan '894 is affirmed.

The rejection of claims 46-50, 52 and 53 under 35 U.S.C. § 102(b) over Nesbitt is affirmed. The rejection of claim 51 under 35 U.S.C. § 103(a) over Nesbitt in view of Sullivan is affirmed.

Appeal No. 2005-1119
Application No. 10/074,665

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

THOMAS A. WALTZ)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CATHERINE TIMM)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY T. SMITH)	
Administrative Patent Judge)	

TAW/jrg

Appeal No. 2005-1119
Application No. 10/074,665

THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED
SUBSIDIARY OF CALLAWAY GOLF COMPANY
2180 RUTHERFORD ROAD
LEGAL DEPT
CARLSBAD, CA 92008-7328