

The opinion in support of the decision being entered today  
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* Owen M. Patterson

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Appeal 2007-0052  
Application 10/438,053  
Technology Center 3700

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Decided: August 9, 2007

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Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and  
JENNIFER D. BAHR, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Owen M. Patterson (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-7, 9, 10, 13-15, 17, and 18. Claims 19, 20, 23, and 24 stand allowed and claims 8, 11, 12, and 16 stand

Appeal 2007-0052  
Application 10/438,053

objected to as depending from rejected claims. No other claims are pending. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

Appellant's claimed invention is directed to a device used for improving the putting stroke of a golfer. Claim 1 is illustrative of the claimed invention and reads as follows:

1. A golf putting practice device comprising;
  - a) a disc;
  - b) said disc having an annular top portion and an annular bottom portion;
  - c) said annular top portion having a top edge and said annular bottom portion having a bottom edge;
  - d) said annular top and bottom portion forming an outer annular peripheral edge;
  - e) said disc having a central opening extending through from said top edge to said bottom edge;
  - f) said central opening at said top edge having a diameter substantially greater than said central opening at said bottom edge; and
  - g) said outer annular peripheral edge projecting between said bottom edge and said top edge and spaced a substantial distance from said top and bottom edges.

The Examiner relies upon the following as evidence of unpatentability:

Johnsen                    US 6,279,245 B1                    Aug. 28, 2001

Appellant seeks review of the Examiner's rejections of claims 1-7, 14, 17, and 18 under 35 U.S.C. § 102(b)<sup>1</sup> as anticipated by Johnsen and claims 9, 10, 13, and 15 under 35 U.S.C. § 103(a) as unpatentable over Johnsen.

The Examiner provides reasoning in support of the rejections in the Answer (mailed June 2, 2006). Appellant presents opposing arguments in the Appeal Brief (filed May 10, 2006) and Reply Brief (filed July 19, 2006).

## OPINION

### The anticipation rejection

Appellant argues all the claims rejected under 35 U.S.C. § 102 together as a group. Therefore, in accordance with 37 C.F.R. § 41.37(c)(1)(vii), we have selected claim 1 as the representative claim to decide the appeal of the anticipation rejection, with claims 2-7, 14, 17, and 18 standing or falling with claim 1.

The Examiner (Answer 3) explains where the elements of claim 1 are disclosed in Johnsen by labeling them in the marked-up Figs. 3 and 4 of Johnsen appended to the Examiner's Answer and Appellant does not dispute these findings. Appellant's only argument is that Johnsen, a golf ball measuring device, is not an enabling disclosure of Appellant's claimed invention, a golf putting practice device. According to Appellant (Appeal Br. 7-8), Johnsen enables a hand held measuring device but provides no disclosure of using such as a golf putting practice device and "[n]o evidence is provided that a person of ordinary skill in the art would somehow decide to place the Johnson device on the ground and begin putting golf balls

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<sup>1</sup> Appellant does not dispute that Johnsen is available as prior art against Appellant's claims under 35 U.S.C. § 102(b).

against it.” Therefore, according to Appellant, Johnsen cannot be considered enabling for a golf putting device because “to use it in such a manner would require an undue amount of experimentation” (Appeal Br. 8).

The Examiner asserts that “Johnsen’s device is clearly capable of performing as a target for a golf ball (a fact not disputed by appellant) and absent some claimed structural difference it anticipates the claims” (Answer 4). Indeed, Appellant has not specifically disputed that Johnsen’s device is capable of such use as asserted by the Examiner. Rather, Appellant focuses on the fact that Johnsen does not actually teach such use. The Examiner characterizes the difference between Johnsen and Appellant’s claims as one of intended use only and points out that “[i]f the prior art structure is capable of performing the intended use, then it meets the claim” (Answer 4).

In light of the contentions by Appellant and the Examiner, the issue presented for us to decide is whether Appellant has demonstrated that Johnsen does not provide an enabling disclosure of the subject matter of Appellant’s claim 1 and, thus, does not anticipate the subject matter of claim 1. For the reasons that follow, the Examiner has the better argument.

To be prior art under 35 U.S.C. § 102, a reference must put the anticipating subject matter at issue into the possession of the public through an enabling disclosure. *Chester v. Miller*, 906 F.2d 1574, 1576 n.2, 15 USPQ2d 1333, 1336 n.2 (Fed. Cir. 1990). “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985).

In order to determine whether Johnsen sufficiently describes the claimed subject matter to constitute an anticipatory reference, we must focus our attention on the *claimed* invention. Appellant's claim 1, like all of the claims before us in this appeal, is directed to a golf putting practice *device*, not to a method of using a golf putting practice device. Accordingly, to anticipate claim 1, Johnsen need only provide an enabling disclosure of a golf putting practice device, that is, a device capable of use in golf putting practice. It is not necessary that Johnsen describe a method of using the disclosed ball controller in golf putting practice, much less in the particular manner intended and described by Appellant. It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Appellant's arguments, which, as discussed above, focus on Johnsen's failure to describe use of the ball controller in golf putting practice in the manner described by Appellant and do not challenge the Examiner's findings that Johnsen's ball controller meets all the structural limitations of claim 1 (Answer 3) and is capable of use as a golf putting practice device by performing as a target for a golf ball (Answer 4), are not commensurate with the scope of claim 1, which is directed to a device and not a method, and do not highlight any deficiency in Johnsen as an anticipatory reference of the *claimed* subject matter. The anticipation rejection of claim 1, and claims 2-7, 14, 17, and 18 standing or falling with claim 1, is sustained.

#### The obviousness rejection

Claims 9, 10, and 13 depend directly or indirectly from claim 1 and recite specific dimensions. The Examiner addresses these limitations by

noting that “it is apparent from Johnsen’s figures that his dimensions are approximately those claimed as can be seen by the relative size of the golf ball and asserting that “[a]bsent a showing of unexpected results the claimed dimensions would have been obvious to the ordinarily skilled artisan depending on the compactness desired in the device and the weight desired in the device” (Answer 3).

Appellant argues that Johnsen, in stressing the importance of compactness of the overall device, teaches away from modification regarding the size of Johnsen’s device to arrive at the claimed overall disc diameter recited in claims 9 and 10 (Appeal Br. 9). Appellant’s position is not well taken.

Specifically, the teachings of Johnsen to which Appellant refers are that the measuring tool must be readily available during the golf game and thus must be capable of being readily fetched up from the pocket of the trousers, for example, and must be solid and stable so normal use does not reduce its accuracy (Johnsen, col. 3, ll. 11-18) and that “the ball controller shall be able to be received in a manner requiring little space for example in the user’s pocket, and which in addition is relatively light in weight and relatively simple to produce” (Johnsen, col. 3, ll. 63-67). We understand from these teachings that the ball controller must be relatively light in weight and must be sized so as to be capable of fitting in and being fetched from a user’s pocket. A ball controller having a diameter within the range of about 3 to about 4 inches, as recited in claim 9, or about 3.586 inches, as recited in claim 10, with a maximum thickness (wall thickness c) of 6 mm (0.234 inches) would be capable of fitting in and being fetched from a user’s trouser pocket and thus falls within the teachings of Johnsen.

Johnsen does not specify a value for the overall disc diameter of the ball controller, but does disclose a cavity diameter  $d_3$  of 42.82 mm (1.686 inches). As illustrated in Fig. 3, the overall diameter of Johnsen's ball controller is about 1.75 times the cavity diameter, or about 3 inches, thereby supporting the Examiner's finding that the overall diameter of Johnsen's ball controller is approximately that recited in Appellant's claims. Thus, as Appellant has not alleged, much less proven, that the claimed diameter produces unexpected results, we find no error in the Examiner's determination that an overall disc diameter as recited in claims 9 and 10 for Johnsen's ball controller would have been obvious. *See In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990) (where the difference between the claimed invention and the prior art is some range or other variable within the claims, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range). The rejection of claims 9 and 10 is sustained.

Appellant argues that, since the interior diameter of Johnsen is specifically dimensioned to accurately measure a golf ball, modification of Johnsen to arrive at the central opening height recited in claim 13 would render Johnsen's device inoperative for its intended purpose (Appeal Br. 10). This argument is not well founded.

Johnsen teaches that a wall thickness  $c$  (central opening height) of 6 mm (0.234 inches) and an axial length  $l$  of inner face 14a of 3 mm are shown, but that the length  $l$  can be increased to, for example, 4-5 mm (Johnsen, col. 6, ll. 54-58). Such an increase would seemingly increase the wall thickness  $c$  to 7-8 mm (0.275 inches to 0.314 inches). This appears to

fall within the range of “about from 0.3 inch to about 0.5 inch” recited in claim 13. We thus find no error in the Examiner’s determination that the claimed range would have been obvious. The rejection of claim 13 is sustained.

With respect to claim 15, Appellant argues “[i]t is not understood why one of ordinary skill in the art would modify a golf ball measuring device by constructing it from a material that produces a certain sound when contacted by a golf ball” and the rejection is thus improper (Appeal Br. 9). With respect to this limitation, the Examiner points out that “Appellant states that his preferred density produces an audible sound upon contact with a golf ball. However, inherently Johnsen’s device will also produce a sound and therefore the claimed density cannot be considered to produce the unexpected result of a sound” (Answer 5). Specifically, Appellant’s Specification attributes the creation of a “sound similar to that of a golf ball dropping into a cup on an actual golf course green” to the rolling of the ball up the outer peripheral edge 34 and into opening 42 of the device D in the embodiment of Figs. 7-10 (Specification 9:7-14). In fact, Appellant’s Specification is silent with respect to material and material properties and density is not even mentioned in Appellant’s Specification, though it is recited in original claim 15.<sup>2</sup> Appellant’s description reasonably supports the Examiner’s position that the creation of the sound is dependent on dropping of the ball through the center opening and not on the particular material or density of the material. Accordingly, Appellant’s argument does

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<sup>2</sup> Appellant has not explained the density scale “about from 75D to about 95D” referred to in claim 15. Fiber and fabric densities are often expressed in a denier scale, or 75D, for example, but Appellant’s disc is not disclosed as made from fibers or fabric.

Appeal 2007-0052  
Application 10/438,053

not demonstrate error on the part of the Examiner in rejecting claim 15 as unpatentable over Johnsen. The rejection is sustained.

#### SUMMARY

The decision of the Examiner to reject claims 1-7, 9, 10, 13-15, 17, and 18 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

JRG

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