

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte HOWARD B. SOSIN

Appeal 2007-2315
Application 10/095,265
Technology Center 3700

Decided: July 31, 2007

Before DONALD E. ADAMS, LORA M. GREEN, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.
LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 8, 9, 15, 26, and 27. We have jurisdiction of this appeal under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF CASE

The claimed invention is drawn to iron or wood type clubs with a grip “being greater than 15 inches along the golf club shaft.” Claims 8, 9, 15, 26, and 27 are pending and stand rejected over prior art. The Examiner relies on the following evidence of unpatentability:

Curry	US 2,221,421	Nov. 12, 1940
Herber	US 5,865,684	Feb. 2, 1999
Gedeon	US 6,048,275	Apr. 11, 2000

There is only one rejection on appeal. Claims 8, 9, 15, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as obvious over Curry in view of Herber and Gedeon (Answer 4). The claims stand or fall together because Appellant has not provided separate reason for their patentability. We select claim 8 as representative for deciding this appeal. *See* 37 C.F.R. § 41.37(c)(1)(vii). Claim 8 reads as follows:

8. An iron or wood type golf club, comprising:
 - a golf club head;
 - a golf club shaft attached to said golf club head; and
 - an elongated grip attached to said shaft, wherein said elongated grip is an integral part of the iron or wood type golf club and has an extended length, said extended length being greater than 15 inches along the golf club shaft.

FINDINGS OF FACT

Curry

1. Curry describes a method of constructing the grip portion of a golf club (Curry at 1, col. 1, ll. 1-10).
2. The grip is adhered to the golf club shaft (Curry at 1, col. 2, ll. 12-35 and Fig. 5; Answer 4).
3. “[L]eather hides, which preferably are the material employed, are cut into strips the width of which is equal to the length of the grip desired, say 12, 13, 14 or 15 inches” (Curry at 2, col. 1, ll. 37-41; Answer 4).

Herber

4. Herber describes a golf club which combines the characteristics of two separately numbered golf clubs, “reducing the amount of equipment necessary to properly play a round of golf, and increasing the number of shot options

. . . while remaining within the required rule limiting the number of golf clubs used during the play of golf” (Herber, col. 2, ll. 55-65).

5. This object is achieved with a golf club having a club head, a shaft, and handgrip (Herber, col. 3, ll. 17-19).

6. “The handgrip . . . has at least two hand grip position designations located thereon, both designations are preferably positioned within 2 to 4 inches from one another” (Herber, col. 3, ll. 22-25; Answer 4).

7. The two hand grip designations permit the club to be used for different shots. “[O]ne of the designations may be defined as a ‘short shot’ hand grip designation 18a and may be located on the hand grip [at] a given distance from the top end of the shaft. Another designation may [be] defined as a ‘long shot’ hand grip designation 18b and may be located a distance which is closer to the top end of the shaft than the other ‘short shot’ designation” (Herber, col. 5, ll. 2-8, Fig. 1; Answer 4).

8. Thus, the “multi-use golf club . . . allows a user to select a long or short shot without changing the dynamics of the user’s golf swing” (Herber, Abstract; Answer 4).

9. Fig. 6 shows a club with an additional marking on the handgrip to accommodate different swings (Herber, col. 5, ll. 53-65; Answer 4).

10. “Club head 20 may be any type or size of standard golf club head, such as a wood or an iron, and may be formed from a variety of well known materials such as metal, wood, or graphite” (Herber, col. 5, ll. 10-13).

Gedeon

11. Gedeon describes a golf putter with a long grip 18 which extends “over substantially the entire length of the straight portion 17 of the shaft” which allows a golfer to grip the club at different locations along the shaft (Gedeon, col. 3, ll. 37-52; Answer 4).

12. “The lower part of the grip 18 is only used when the golfer crouches close to the ground or bends low over the ball in using the club. This can happen when the golfer putts by facing toward the hole holding the club with one hand close to head 11 and the other midway or higher along the shaft. . . . Still another position is taken when the golfer stands facing perpendicular to the line of the putt, and bends over the ball and the club until the top of the shaft touches the golfer’s chest with one hand low on the grip 18 and the other hand at the top of grip 18” (Gedeon, col. 3, ll. 39-49).

DISCUSSION

The issue in this appeal is whether the Examiner erred in determining that it would have been obvious to persons of ordinary skill in the art at the time the invention was made to have modified Curry’s golf club grip by extending it to a “length being greater than 15 inches along the golf club shaft” on an “iron or wood type golf club” as recited in claim 1.

Curry describes a golf club grip of “say 12, 13, 14 or 15 inches” (Curry at 2, col. 1, ll. 37-41; Findings of Fact 3), but does not explicitly disclose that it be “greater than 15 inches along the golf club shaft” as

recited in claim 8. Curry also does not specify the type of club for which its grips are intended; thus, Curry does not teach the iron or wood type golf club of claim 8.

The Examiner contends that persons of ordinary skill in the art would have had reason to extend the length of the grip to permit golfers to use the club for different types of swings and when standing in different positions. The Examiner relies on Herber and Gedeon as evidence of this.

Herber describes a golf club with multiple markings along the length of its grip to designate different hand grip positions (Herber, col. 3, ll. 22-25; col. 5, ll. 53-65; Answer 4; Findings of Fact 6, 9). By placing the grip at different locations along the shaft length, Heber teaches that a single wood or iron club can be used “to select a long or short shot without changing the dynamics of the user’s golf swing” (Herber, Abstract; Answer 4; Findings of Fact 7, 8).

Gedeon describes a golf putter with a long grip which extends “over substantially the entire length of the straight portion 17 of the shaft[,]” allowing a golfer to grip the club at different locations along the shaft (Gedeon, col. 3, ll. 37-52; Answer 4; Findings of Fact 11). Gedeon states that, by extending the grip, a golfer can hold the grip at a lower part close to the club head or higher along the shaft depending on the golfer’s body position when using the club (Gedeon, col. 3, ll. 39-48; Answer 14; Findings of Fact 12).

The Examiner concludes that teachings of Heber and Gedeon provide the motivation to have extended the length of Curry’s golf club grip “greater than 15 inches along the golf club shaft” as required by claim 8 (Answer 5).

Prima facie obviousness requires a teaching that all elements of the claimed invention are found in the prior art and a reason that would have prompted a person of ordinary skill in the relevant field to modify the prior art to arrive at the claimed invention. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). In our opinion, the Examiner has set forth sufficient evidence to establish prima facie obviousness of claim 8. The Examiner identifies where all elements of the claimed invention can be found in the prior art and provides a logical reason to have modified the prior art. “The prima facie case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. . . . If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Appellant contends there would have been no motivation to have extended Curry’s grip. “There is nothing in the teachings of Herber or Curry that would reasonably suggest *extending* the Curry grip beyond 15 inches, when the 15 inch grip of Curry without extension would easily accommodate the markings of Herber” (Suppl. Br. 10-11). We do not agree. First, as stated by the Examiner:

Curry states that the grip length should be based on what is desired. Curry gives examples of 12, 13, 14, or 15 inches [Curry at 2, col. 1, ll. 37-41; Findings of Fact 3]. However by using the word “desired” and “say” prior to the lengths reveals that these lengths or range of lengths are not critical and there might be other lengths desired and obvious to have.

(Answer 5.)

Secondly, both Herber and Gedeon teach that the grip length of a golf club can be increased to accommodate hand positions used in different stances and swings. Gedeon explicitly refers to a grip that extends over the entire length of the shaft for gripping “with one hand close to head 11” of the putter (Gedeon, col. 3, ll. 43; Findings of Fact 12). Moreover, in addition to Herber’s and Gedeon’s teachings about integral golf club grips, Appellant admits in the Specification that methods of “extending golf grips” using “a covering or sleeve applied over the grip after manufacture” were known (Spec. 6: 7-8). Thus, grip length was not considered by persons of skill in the art to be a fixed constant for all golf clubs. In our opinion, it was not inventive at the time the invention was made to lengthen a grip beyond the explicit 15 inches¹ disclosed because it was well known to persons of ordinary skill in the art that golf club grips could be lengthened for the purpose of accommodating different golfing demands (Findings of Fact 6-8, 11, 12; Spec. 6: 7-8; Answer 12 (e.g., “Players come in all sizes”)).

Appellant argues that Gedeon’s teaching about a putter is not applicable to a wood or iron type-club.

[T]he disclosure of structure with respect to a putter does not teach or fairly suggest structure with respect to iron and wood type golf clubs. In particular, as expressly documented and discussed herein, manufacturers of iron and wood type golf clubs, unlike those of putters, would not extend grip lengths because of a variety of potentially negative effects to such

¹ We agree with the Examiner that “15 inches” is not a magic number. In Appellant’s own Specification, it is stated that the grip can be extended “anywhere from 11 to 24 inches” (Spec. 6: 28-30). While “15 to 16 inches” is described as most preferable (Spec. 6: 30), there is no statement in the Specification that the preferred length confers any benefit or advantage different from the broader range.

characteristics as shaft weight and flexibility. In support of this contention, Appellant's refer to the Loesch 132 Declaration in the Evidence Appendix that confirms the negative effects of extending grip lengths (see paragraphs 4 and 5).

(Suppl. Br. 11).

We are not persuaded by this argument. It is well settled that an obviousness analyses involving potential modifications of the prior art entails weighing the relative trade-offs of the various alternatives. *See Medichem S.A. v. Rolabo S.L.*, 437 F.3d 1157, 1165, 77 USPQ2d 1865, 1870 (Fed. Cir. 2006) (“The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.”) (quoting *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8, 53 USPQ2d 1580, 1587 n.8 (Fed. Cir. 2000)). In this case, the prior art quite clearly describes the advantage of extending the length of the length of the handgrip for an iron or wood club (*see Heber*), despite the “concern” by club makers of “the effect of the grip on the overall weight of the club, the balance of the club and the flex of the shaft” (Declaration of Loesch 2: ¶ 5).

Moreover, we see no reason why the teaching of Gedeon for a putter is not applicable to an iron or wood club. Curry teaches a grip of “say” 15 inches, without limiting it to a particular club type. Evidence Appendix 2 does not distinguish between putters and iron/wood clubs in its discussion of grips (Evidence Appendix 2 at p. 2). Thus, we find no evidence for the assertion that the skilled worker would not have considered Gideon's teaching applicable to an iron or wood club. To the contrary, there is a preponderance of evidence that grip lengthening was used for both putters

(Gedeon) and wood/iron clubs (Herber), supporting the Examiner's position that lengthening the grip is applicable to any club.

Appellant in his own application admits that golfers choke down on wood and/or clubs and that the existing grip length is inadequate: "Because wood and iron grips are approximately 10 ½ inches long, the latter choking down method often requires the golfer to grip the club partially on the grip and partially on the exposed shaft thereby altering feel and potentially accuracy" (Spec. 3: 6-8). The common sense solution to this problem is to extend the grip length, which indeed is suggested in Heber and Gedeon. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007). Obviousness is viewed through the lens of a person of ordinary skill in the art with consideration of common knowledge and common sense. *Dystar Textilfarben GMBH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1367, 80 USPQ2d 1641, 1650 (Fed. Cir. 2006). "A court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, at 1741, 82 USPQ2d at 1389. Thus, we are not convinced by Appellant's assertion that because "putters have entirely different swing characteristics than iron or wood type golf clubs" (Suppl. Br. 13), there would have been no reason to have extended a grip past 15 inches on an iron or wood type club. While a golfer may not assume the same stance in swinging a putter (Reply Br. 4), their own Specification admits that golfers choke down on iron and wood type clubs (Spec. 3: 6-8). As the Examiner notes: "Players come in all sizes and are custom fitted with all sort of different clubs resulting in a variety of hand locations along a grip of a club" (Answer 12).

We also do not find it persuasive that Mr. Loesch has “not seen an iron or wood type golf club having an elongated grip of greater than 15 inches” (Declaration of Loesch 2: § 5). The prior art constitutes all that was available prior to the effective date of the application, not just what was commercially offered. There may be many reasons for not bringing a product to market, unrelated to its effectiveness or value. Our task is to determine what is obvious from the prior art – not to determine why a particular item which is suggested by the prior art is not commercially sold. As pointed out by the Examiner (Answer 12-13), lengthening the grip of the club is the same strategy utilized by Herber with the same expected result.

Appellant also appears to suggest that USGA rules teaches away from combining Curry with Heber and Gedeon (Declaration of Loesch 3: ¶ 8). We are in complete agreement with the Examiner’s succinct and proper response:

[P]atentability is not limited at all by the USGA rules of golf. There are many clubs being invented and used on golf courses which do not meet the USGA rules of golf or designed as such. As such[,] patentability of inventions of golf clubs are not evaluated based on the USGA rules of golf.

(Answer 14).

For the foregoing reasons, we affirm the rejection of claim 8. Claims 9, 15, 26, and 27 fall with claim 8 because they were not separately argued.

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TIME PERIOD

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

AFFIRMED

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CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON MA 02110