



1 We AFFIRM-IN-PART.

2 The claims on appeal relate to golf clubs of a type which may include  
3 damping elements for reducing the amplitudes of vibrations in the shafts of  
4 the clubs. (Spec. 3, ¶ 06, ll. 1-2). Independent claim 36 is typical of the  
5 appealed claims and reads as follows:

6  
7 36. A golf club comprising:  
8 an elongate shaft that defines an interior  
9 void extending along at least a portion of a length  
10 of the shaft;  
11 a head secured to the shaft; and  
12 a chamber located within the void, the  
13 chamber having a valveless and sealed  
14 configuration that encloses a pressurized fluid.  
15

16 Claims 36, 37 and 40-42 stand rejected under 35 U.S.C. § 103(a)  
17 (2002) as being unpatentable over MacKay (U.S. Patent 5, 904,628)  
18 [“MacKay golf club reference”] in view of either MacKay (U.S. Patent  
19 6,053,827) [“MacKay baseball bat reference”] or Tawney (U.S. Patent  
20 6,402,879). Claim 38 stands rejected under section 103(a) as being  
21 unpatentable over MacKay golf club reference in view of either MacKay  
22 baseball bat reference or Tawney and further in view of Patitsas (U.S. Patent  
23 6,015,525). Claim 39 stands rejected under section 103(a) as being  
24 unpatentable over MacKay golf club reference in view of either MacKay  
25 baseball bat reference or Tawney and further in view of Patitsas and  
26 Richwine (U.S. Patent 5,779,968). Claims 43 and 44 stand rejected under  
27 section 103(a) as being unpatentable over MacKay golf club reference in  
28 view of either MacKay baseball bat reference or Tawney and further in view  
29 of Horwood (U.S. Patent 5,944,616) and Hogan (U.S. Patent 5,308,062).



1           2) whether the Examiner erred in concluding that a golf club  
2 including a fluid-filled chamber located entirely between an area for  
3 gripping the golf club and an area for securing a head to the shaft or a shaft  
4 protrusion located entirely between the same bounds would have been  
5 obvious from the teachings of MacKay golf club reference, Horwood and  
6 Hogan; and

7           3) whether the Examiner erred in concluding that a golf club in which  
8 substantially all of a fluid-filled and pressurized chamber is located within a  
9 protrusion in the shaft would have been obvious from MacKay golf club  
10 reference in view of Tawney or MacKay baseball bat reference and further  
11 in view of Horwood and Hogan.

12

13

#### FINDINGS OF FACT

14

The record supports the following findings of fact (“FF”) by a  
15 preponderance of the evidence.

16

1.       MacKay golf club reference teaches a golf club including an  
17 inflated and pressurized bladder inserted into a hollow metal golf club shaft  
18 of conventional shape and configuration. (MacKay golf club reference, col.  
19 2, ll. 4-7 and 18-25).

20

2.       MacKay golf club reference teaches assembling the golf club  
21 by inserting a preinflated bladder into the hand grip end of the hollow shaft  
22 and then mounting the grip on the shaft in a conventional manner. (*Id.*, col.  
23 4, ll. 50-54).

24

3.       The reference also teaches MacKay’s golf clubs can be “tuned  
25 to the player by adjusting the gas pressure within certain limits in the  
26 inflated bladder or bladders and provide a signature sound and/or feel to be

1 produced upon ball impact to distinguish the golf clubs incorporating the  
2 present invention from other existing clubs.” (MacKay golf club reference,  
3 col. 2, ll. 61-67).

4 4. MacKay golf club reference teaches that “it is possible to adjust  
5 the stiffness distribution in the shaft *14* by selecting the location of the  
6 bladder *20* and adjusting the pressure to which the bladder is inflated and  
7 pressurized.” (*Id.*, col. 4, ll. 33-36).

8 5. The shaft of MacKay’s golf club includes an outermost section  
9 of constant diameter, an innermost section of constant diameter and a  
10 tapered central section which appears to be located entirely between the  
11 constant diameter sections of the shaft. (MacKay golf club reference, Fig. 1  
12 and col. 4, ll. 18-27). The golf club has a hand grip at the outermost end of  
13 the shaft and a club head at the innermost end of the shaft. (*Id.*, Fig. 1; *see*  
14 *also id.*, col. 4, ll. 8-10).

15 6. MacKay golf club reference teaches providing the interior of  
16 the peripheral wall of the hollow golf club shaft and the exterior of the  
17 peripheral wall of the shaft with spiral grooves so as to form a spiral rib and  
18 groove arrangement on both the internal and external surfaces of the shaft.  
19 (MacKay golf club reference, col. 7, l. 66 – col. 8, l. 6). The spiral rib and  
20 groove arrangement reduces the weight of the hollow shaft and also  
21 increases the rigidity of the shaft. (MacKay golf club reference, col. 2, ll.  
22 26-31).

23 7. The reference teaches that the bladder:

24  
25 reinforces and [rigidifies] the peripheral wall *102*,  
26 thus permitting the shaft to be made of thinner  
27 metal to reduce the weight of the shaft. Rather

1 than thinning the wall thickness, the shaft material  
2 can be removed from the peripheral wall *102* by  
3 providing the internal spiral groove *104* or external  
4 spiral groove *106* to thus remove the requisite  
5 material. The thinning or grooving of the wall  
6 thickness is preferably throughout the length of the  
7 shaft, but can be confined to a certain area, such as  
8 the tapered section or one or both of the cylindrical  
9 sections of the club shaft or in the area of the shaft  
10 where the peripheral wall of the bladder engages  
11 the shaft wall.  
12

13 (MacKay golf club reference, col. 8, ll. 17-29).

14 8. MacKay baseball bat reference teaches a tubular metal baseball  
15 bat having an inflatable bladder inserted into an open distal end of the bat  
16 barrel in the area of the hitting zone. (MacKay baseball bat reference, col. 1,  
17 ll. 51-54).

18 9. Each embodiment illustrated in MacKay baseball bat reference  
19 appears to include a self-sealing valve through which the bladder is  
20 pressurized. (*E.g.*, MacKay baseball bat reference, col. 6, ll. 6-18; col. 7, ll.  
21 58-62; col. 8, ll. 41-47; col. 8, ll. 58-61; col. 9, ll. 34-38; col. 10, ll. 56-60;  
22 col. 11, ll. 28-33; and col. 11, l. 62 – col. 12, l. 1; *cf.* App. Br. 7-9  
23 [summarizing the embodiments described in the reference]).

24 10. Tawney teaches inflating or pressurizing valveless  
25 thermoplastic cushioning bladders by filling the bladders with fluid through  
26 a stem and then welding the stem closed after the bladder is filled. The stem  
27 is removed from the finished bladder while leaving the weld location intact  
28 to prevent loss of fluid. (Tawney, col. 11, ll. 17-21; *see also id.*, col. 24, ll.  
29 58-59).



ANALYSIS

A. *The Rejection of Claims 36, 37 and 40-42 Under Section 103(a) as Being Unpatentable Over MacKay Golf Club Reference in view of Tawney*

Claim 36 recites a golf club comprising an elongate shaft that defines an interior void and a chamber having a valveless and sealed configuration located within the void. The Appellants contend that MacKay golf club reference teaches away from a modification of MacKay's golf club to include a chamber or bladder having a valveless and sealed configuration. They contend that such a modification would prevent the gas pressure within the bladder from being adjusted so as to tune the club to the player to provide a signature sound and feel upon ball impact. (App. Br. 9-11). The Appellants further contend that such a modification would render MacKay's golf club unsatisfactory for its intended purpose. (App. Br. 11).

MacKay golf club reference does not teach away from modifying a golf club to include a bladder having a valveless and sealed configuration. The reference teaches that the stiffness distribution in the shaft may be adjusted so as to tune the sound and feel of the club by selecting the location of the bladder and adjusting the pressure to which the bladder is inflated. (FF 4). The reference further teaches inserting a pre-inflated bladder into the hand grip end of the shaft. (FF 2). From these teachings, one of ordinary skill in the art could have predicted that a valveless bladder pre-inflated to an appropriate pressure according to the teachings of Tawney (FF 10) and inserted into an appropriate location in the shaft would satisfy the intended purpose of tuning the sound and feel of the club to the player. Hence, the teachings of MacKay golf club reference are not inconsistent with the simple

1 substitution of a bladder of valveless and sealed configuration for the valved  
2 bladders expressly disclosed by the reference.

3 On the record before us, the Appellants have not shown that the  
4 Examiner erred in rejecting claim 36 under section 103(a) as being  
5 unpatentable over MacKay golf club reference and Tawney. The Appellants  
6 have not presented any arguments suggesting that dependent claims 37 and  
7 40-42 might be patentable if claim 36 were not. Therefore, the Appellants  
8 also have not shown that the Examiner erred in rejecting dependent claims  
9 37 and 40-42 as being unpatentable over MacKay golf club reference and  
10 Tawney.

11

12 *B. The Rejection of Claims 36, 37 and 40-42 Under Section*  
13 *103(a) as Being Unpatentable Over MacKay Golf Club*  
14 *Reference in view of MacKay Baseball Bat Reference*

15 We agree with the Appellants (App. Br. 7) that MacKay golf club  
16 reference does not disclose a golf club including a chamber having a  
17 valveless and sealed configuration. We also agree with the Appellants (App.  
18 Br. 7-9) that MacKay baseball bat reference does not teach the use of  
19 valveless bladders. We agree with the Examiner (*see* Ans. 5) that claim 1 of  
20 MacKay baseball reference does not recite a valve. (MacKay baseball bat  
21 reference, col. 15, ll. 13-23). Since each embodiment described in MacKay  
22 baseball bat reference includes a bladder having a valve (FF 9), however, we  
23 do not believe that the omission of such a valve from claim 1 would have  
24 provided one of ordinary skill in the art reason to substitute a valveless  
25 bladder for a valved bladder such as those expressly disclosed in MacKay  
26 golf club reference. We agree with the Appellants (Reply Br. 2) that the  
27 configuration of the bladder in the embodiment of Figs. 19-21 of MacKay

1 baseball bat reference is not “valveless” even if the bladder’s valve lies in a  
2 tube sealed during the manufacturing process.

3 On the record before us, the Appellants have shown that the Examiner  
4 erred in rejecting claims 36, 37 and 40-42 under section 103(a) as being  
5 unpatentable over MacKay golf club and baseball bat references.

6

7 *C. The Rejection of Claim 38 Under Section 103(a) as Being*  
8 *Unpatentable Over MacKay Golf Club Reference in View*  
9 *of Tawney and Patitsas*

10 The Appellants do not present any argument suggesting that  
11 dependent claim 38 might be patentable if independent claim 36 were found  
12 to be unpatentable. (App. Br. 6 n.1). Since the Appellants have not shown  
13 that the Examiner erred in rejecting claim 36 as being unpatentable under  
14 section 103(a) over MacKay golf club reference in view of Tawney, the  
15 Appellants also have not shown that the Examiner erred in rejecting claim  
16 38 as being unpatentable under section 103(a) over MacKay golf club  
17 reference in view of Tawney and Patitsas.

18

19 *D. The Rejection of Claim 38 Under Section 103(a) as Being*  
20 *Unpatentable Over MacKay Golf Club Reference in View*  
21 *of MacKay Baseball Bat Reference and Patitsas*

22 We agree with the Appellants (App. Br. 7) that MacKay golf club  
23 reference does not disclose a golf club including a chamber having a  
24 valveless and sealed configuration. We also agree with the Appellants (App.  
25 Br. 7-9) that MacKay baseball bat reference does not teach the use of  
26 valveless bladders. The Examiner does not identify any teaching in Patitsas  
27 sufficient to overcome this deficiency. On the record before us, the  
28 Appellants have shown that the Examiner erred in rejecting claim 38 as

1 being unpatentable under section 103(a) over MacKay golf club reference in  
2 view of MacKay baseball bat reference and Patitsas.

3

4 *E. The Rejection of Claim 39 Under Section 103(a) as Being*  
5 *Unpatentable Over MacKay Golf Club Reference in View*  
6 *of Tawney, Patitsas and Richwine*

7 The Appellants do not present any argument suggesting that  
8 dependent claim 39 might be patentable if independent claim 36 and  
9 dependent claim 38 were found to be unpatentable. (App. Br. 6 n.1). Since  
10 the Appellants have not shown that the Examiner erred in rejecting claims  
11 36 and 38 as being unpatentable under section 103(a) over MacKay golf  
12 club reference in view of Tawney, the Appellants also have not shown that  
13 the Examiner erred in rejecting claim 39 as being unpatentable under section  
14 103(a) over MacKay golf club reference in view of Tawney, Patitsas and  
15 Richwine.

16

17 *F. The Rejection of Claim 39 Under Section 103(a) as Being*  
18 *Unpatentable Over MacKay Golf Club Reference in View*  
19 *of MacKay Baseball Bat Reference, Patitsas and Richwine*

20 We agree with the Appellants (App. Br. 7) that MacKay golf club  
21 reference does not disclose a golf club including a chamber having a  
22 valveless and sealed configuration. We also agree with the Appellants (App.  
23 Br. 7-9) that MacKay baseball bat reference does not teach the use of  
24 valveless bladders. The Examiner does not identify any teaching in Patitsas  
25 or Richwine sufficient to overcome this deficiency. On the record before us,  
26 the Appellants have shown that the Examiner erred in rejecting claim 39 as  
27 being unpatentable under section 103(a) over MacKay golf club reference in  
28 view of MacKay baseball bat reference, Patitsas and Richwine.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

*G. The Rejection of Claims 43 and 44 Under Section 103(a) as Being Unpatentable Over MacKay Golf Club Reference In View of Tawney, Horwood and Hogan*

The Appellants do not present any argument suggesting that dependent claims 43 and 44 might be patentable if independent claim 36 and dependent claim 42 were found to be unpatentable. Since the Appellants have not shown that the Examiner erred in rejecting claims 36 and 42 as being unpatentable under section 103(a) over MacKay golf club reference in view of Tawney, the Appellants also have not shown that the Examiner erred in rejecting claims 43 and 44 as being unpatentable under section 103(a) over MacKay golf club reference in view of Tawney, Horwood and Hogan.

*H. The Rejection of Claims 43 and 44 Under Section 103(a) as Being Unpatentable Over MacKay Golf Club Reference In View of MacKay Baseball Bat Reference, Horwood and Hogan*

We agree with the Appellants (App. Br. 7) that MacKay golf club reference does not disclose a golf club including a chamber having a valveless and sealed configuration. We also agree with the Appellants (App. Br. 7-9) that MacKay baseball bat reference does not teach the use of valveless bladders. The Examiner does not identify any teaching in Horwood and Hogan sufficient to overcome this deficiency. On the record before us, the Appellants have shown that the Examiner erred in rejecting claims 43 and 44 as being unpatentable under section 103(a) over MacKay golf club reference in view of MacKay baseball bat reference, Horwood and Hogan.

1           I.       *The Rejection of Claims 45-49 Under Section*  
2                    *103(a) as Being Unpatentable Over MacKay Golf Club*  
3                    *Reference in view of Horwood and Hogan*

4           Claim 45 recites a golf club comprising an elongate shaft that defines  
5           an interior void and a fluid-filled chamber located within the void entirely  
6           between an area for gripping the golf club and an area for securing a head to  
7           the shaft. The Appellants contend that MacKay golf club reference does not  
8           teach a golf club with a bladder located entirely between the area for  
9           gripping the golf club and the area for securing the head to the shaft. (App.  
10          Br. 13). We disagree.

11          MacKay golf club reference teaches forming a spiral rib and groove  
12          arrangement on the internal and external surface of the hollow shaft and  
13          using the bladder to reinforce and rigidify the grooved portion of the  
14          peripheral wall of the shaft so as to reduce the shaft weight. (FF 6). The  
15          shaft of MacKay's golf club includes an outermost section of constant  
16          diameter on which a hand grip is mounted and an innermost section of  
17          constant diameter to which a club head is secured. (FF 5). MacKay golf  
18          club reference teaches confining the spiral rib and groove arrangement to a  
19          tapered central section located entirely between the constant diameter  
20          sections of the shaft. (*Id.*; FF 7).

21          The reference teaches positioning the grooves where the peripheral  
22          wall of the bladder engages the shaft wall. (FF 7). In light of the teaching to  
23          use the bladder to reinforce and rigidify the grooved portion of the shaft,  
24          MacKay golf club reference would have suggested the converse to one of  
25          ordinary skill in the art: that is, positioning the bladder within the portion of  
26          the peripheral wall of the shaft on which the rib and groove arrangements are  
27          formed. Where the spiral rib and groove arrangement is confined to the

1 tapered central section, one skilled in the art would have reason to locate the  
2 bladder entirely between the constant diameter sections of the shaft where  
3 the hand grip and the club head are secured.

4         The Appellants contend that the area for gripping the golf club as  
5 recited in claim 45 is not limited to the outermost section of constant  
6 diameter. Instead, they contend that “a bladder within the tapered section  
7 (or even confined to the tapered section) may still be in the gripping area of  
8 the shaft.” (App. Br. 13). We interpret the phrase “area for gripping the golf  
9 club” as referring to the area of the shaft covered by the grip. (*See, e.g.*,  
10 Spec. 5, ¶ 23 (“A grip 23 may extend over first end 21 to provide a  
11 comfortable and slip-resistant area for grasping golf club 10.”))

12         Horwood teaches securing a tubular grip or sleeve to the handle end of  
13 the shaft. (FF 12). The similarity between the shapes of the golf clubs  
14 taught by Horwood and MacKay golf club reference (*compare* FF 5 *with* FF  
15 11) would have provided one of ordinary skill in the art reason to apply a  
16 conventional tubular grip to the shaft of MacKay’s golf club. The common  
17 sense of those of ordinary skill would have suggested confining the tubular  
18 grip to the outermost constant diameter section of MacKay’s golf club as  
19 suggested by Fig. 1 of Horwood so as to secure a snug fit between the grip  
20 and the shaft without tapering the proximal end of the grip in a manner  
21 which might increase the difficulty of pressing the grip over the handle end  
22 of the shaft. When MacKay’s golf club is modified to confine the grip to the  
23 constant diameter section at the handle end of the shaft, a bladder confined  
24 to the tapered central section of the shaft would be located entirely between  
25 the area for gripping the golf club and the area for securing the head to the  
26 shaft.

1           On the record before us, the Appellants have not shown that the  
2 Examiner erred in rejecting claim 45 under section 103(a) as being  
3 unpatentable over MacKay golf club reference, Horwood and Hogan. The  
4 Appellants have not presented any arguments suggesting that dependent  
5 claims 46-49 might be patentable if claim 45 were not. Therefore, the  
6 Appellants also have not shown that the Examiner erred in rejecting  
7 dependent claims 46-49 as being unpatentable over MacKay golf club  
8 reference, Horwood and Hogan.

9

10           *J.       The Rejection of Claims 50, 51, 54 and 55 Under Section*  
11                     *103(a) as Being Unpatentable Over MacKay Golf Club*  
12                     *Reference in view of Horwood and Hogan*

13           Claim 50 recites a golf club comprising an elongate shaft that defines  
14 an interior void having an outwardly-projecting area that forms a protrusion  
15 entirely located between the area for gripping the golf club and the area for  
16 securing the head to the shaft. We agree with the Examiner (Ans. 8) that the  
17 rib and groove arrangement formed in the peripheral wall of the shaft of  
18 MacKay's golf club constitutes a protrusion in the shaft. As discussed in  
19 connection with the affirmance of the rejection of claims 45-49, MacKay  
20 golf club reference would have provided one of ordinary skill in the art  
21 reason to confine the rib and groove arrangement to the central tapered  
22 section of the shaft of MacKay's golf club. The teachings of MacKay golf  
23 club reference and Horwood would have provided one of ordinary skill in  
24 the art reason to modify MacKay's golf club so as to confine the grip to the  
25 constant diameter section at the handle end of the shaft. When the handle of  
26 MacKay's golf is modified in this manner, a rib and groove arrangement  
27 confined to the tapered central section of the shaft is located entirely

1 between the area for gripping the golf club and the area for securing the head  
2 to the shaft.

3 On the record before us, the Appellants have not shown that the  
4 Examiner erred in rejecting claim 50 under section 103(a) as being  
5 unpatentable over MacKay golf club reference, Horwood and Hogan. The  
6 Appellants have not presented any arguments suggesting that dependent  
7 claims 51, 54 and 55 might be patentable if claim 50 were not. Therefore,  
8 the Appellants also have not shown that the Examiner erred in rejecting  
9 dependent claims 51, 54 and 55 as being unpatentable over MacKay golf  
10 club reference, Horwood and Hogan.

11

12 *K. The Rejection of Claim 52 Under Section 103(a) as Being*  
13 *Unpatentable Over MacKay Golf Club Reference in View*  
14 *of Horwood, Hogan and Patitsas*

15 The Appellants do not present any argument suggesting that  
16 dependent claim 52 might be patentable if independent claim 36 were found  
17 to be unpatentable. (App. Br. 6 n.2). Since the Appellants have not shown  
18 that the Examiner erred in rejecting claim 50 as being unpatentable under  
19 section 103(a) over MacKay golf club reference in view of Horwood and  
20 Hogan, the Appellants also have not shown that the Examiner erred in  
21 rejecting claim 52 as being unpatentable under section 103(a) over MacKay  
22 golf club reference in view of Horwood, Hogan and Patitsas.

1           *L. The Rejection of Claim 53 Under Section 103(a) as Being*  
2                                   *Unpatentable Over MacKay Golf Club Reference in View*  
3                                   *of Horwood, Hogan, Patitsas and Richwine*

4           The Appellants do not present any argument suggesting that  
5 dependent claim 53 might be patentable if independent claim 50 and  
6 dependent claim 52 were found to be unpatentable. (App. Br. 6 n.2). Since  
7 the Appellants have not shown that the Examiner erred in rejecting claims  
8 50 and 52 as being unpatentable under section 103(a) over MacKay golf  
9 club reference in view of Horwood and Hogan, the Appellants also have not  
10 shown that the Examiner erred in rejecting claim 53 as being unpatentable  
11 under section 103(a) over MacKay golf club reference in view of Horwood,  
12 Hogan, Patitsas and Richwine.

13

14           *M. The Rejection of Claims 57, 58, 61 and 62 Under Section*  
15                                   *103(a) as Being Obvious Over MacKay Golf Club*  
16                                   *Reference in View of Tawney, Horwood and Hogan*

17           Independent claim 57 recites a golf club in which substantially all of a  
18 fluid-filled and pressurized chamber is located within a protrusion in the  
19 shaft. The Appellants contend that the teachings of MacKay golf club  
20 reference, Tawney, Horwood and Hogan would not have provided one of  
21 ordinary skill in the art reason to modify MacKay's golf club so as to locate  
22 substantially all of a fluid-filled chamber within a protrusion in the shaft.  
23 The only protrusion identified by the Examiner in the teachings of MacKay  
24 golf club reference is the rib and groove arrangement on the internal and  
25 external surfaces of the hollow shaft. (See Ans. 16-17)..

26           The Appellants contend that MacKay does not teach a golf club in  
27 which "substantially all" of the chamber or bladder is located within the

1 protrusion. (App. Br. 16-17). The Appellants provide no guidance in  
2 construing the phrase “substantially all” and there is little in the present  
3 specification that one may rely on to determine how substantial  
4 “substantially all” must be. An argument could be framed by observing that  
5 the present specification teaches the use of the protrusion to retain the  
6 position of the chamber or bladder with respect to the length of the shaft  
7 (Spec. 8, ¶ 28, ll. 15-18) and that the peripheral wall of the bladder of the  
8 MacKay golf club reference engages the grooves of the interior peripheral  
9 wall of the shaft sufficiently to retain the bladder in position (*Cf.* MacKay  
10 golf club reference, col. 8, ll. 14-17). MacKay golf club reference does not  
11 teach that the engagement of the peripheral wall of the bladder with the  
12 grooves retains the bladder in position, however. Given how little of the  
13 bladder would likely extend into the grooves, we do not believe that this  
14 MacKay golf club reference suggests that substantially all of a fluid-filled  
15 and pressurized chamber be located within a protrusion in the shaft.

16       The Examiner has not identified any teachings of Tawney, Horwood  
17 and Hogan which might supply this deficiency in the teachings of MacKay  
18 golf club reference. On the record before us, the Appellants have shown that  
19 the Examiner erred in rejecting independent claim 57 and dependent claims  
20 58, 61 and 62 under section 103(a) over MacKay golf club reference in view  
21 of Tawney, Horwood and Hogan.

1           N.     *The Rejection of Claims 57, 58, 61 and 62 Under Section*  
2                     *103(a) as Being Obvious Over MacKay Golf Club*  
3                     *Reference in View of MacKay Baseball Bat Reference,*  
4                     *Horwood and Hogan*

5           As discussed in connection with the reversal of the rejection of claims  
6 57, 58, 61 and 62 under section 103(a) in view of MacKay golf club  
7 reference, Tawney, Horwood and Hogan, MacKay golf club reference does  
8 not teach a golf club in which substantially all of a fluid-filled and  
9 pressurized chamber is located within a protrusion in the shaft. The  
10 Examiner has not identified any teachings of MacKay baseball bat reference,  
11 Horwood and Hogan which might supply this deficiency in the teachings of  
12 MacKay golf club reference. On the record before us, the Appellants have  
13 shown that the Examiner erred in rejecting independent claim 57 and  
14 dependent claims 58, 61 and 62 under section 103(a).

15

16           O.     *The Rejection of Claim 59 Under Section 103(a) as Being*  
17                     *Unpatentable Over MacKay Golf Club Reference in View*  
18                     *of Tawney, Horwood, Hogan and Patitsas*

19           MacKay golf club reference does not teach a golf club in which  
20 substantially all of a fluid-filled and pressurized chamber is located within a  
21 protrusion in the shaft. The Examiner has not identified any teachings of  
22 Tawney, Horwood, Hogan and Patitsas which might supply this deficiency  
23 in the teachings of MacKay golf club reference. On the record before us, the  
24 Appellants have shown that the Examiner erred in rejecting claim 59 under  
25 103(a) as being unpatentable over MacKay golf club reference in view of  
26 Tawney, Horwood, Hogan and Patitsas.

1           *P.     The Rejection of Claim 59 Under Section 103(a) as Being*  
2                     *Unpatentable Over MacKay Golf Club Reference in View*  
3                     *of MacKay Baseball Bat Reference, Horwood, Hogan and*  
4                     *Patitsas*

5           MacKay golf club reference does not teach a golf club in which  
6 substantially all of a fluid-filled and pressurized chamber is located within a  
7 protrusion in the shaft. The Examiner has not identified any teachings of  
8 MacKay baseball bat reference, Horwood, Hogan and Patitsas which might  
9 supply this deficiency in the teachings of MacKay golf club reference. On  
10 the record before us, the Appellants have shown that the Examiner erred in  
11 rejecting claim 59 under 103(a).

12

13           *Q.     The Rejection of Claim 60 Under Section 103(a) as Being*  
14                     *Unpatentable Over MacKay Golf Club Reference in View*  
15                     *of Tawney, Horwood, Hogan, Patitsas and Richwine*

16           MacKay golf club reference does not teach a golf club in which  
17 substantially all of a fluid-filled and pressurized chamber is located within a  
18 protrusion in the shaft. The Examiner has not identified any teachings of  
19 Tawney, Horwood, Hogan, Patitsas and Richwine which might supply this  
20 deficiency in the teachings of MacKay golf club reference. On the record  
21 before us, the Appellants have shown that the Examiner erred in rejecting  
22 claim 60 under 103(a) as being unpatentable over MacKay golf club  
23 reference in view of Tawney, Horwood, Hogan, Patitsas and Richwine.

1           R.     *The Rejection of Claim 60 Under Section 103(a) as Being*  
2                    *Unpatentable Over MacKay Golf Club Reference in View*  
3                    *of MacKay Baseball Bat Reference, Horwood, Hogan, Patitsas*  
4                    *and Richwine*

5           MacKay golf club reference does not teach a golf club in which  
6 substantially all of a fluid-filled and pressurized chamber is located within a  
7 protrusion in the shaft. The Examiner has not identified any teachings of  
8 MacKay baseball bat reference, Horwood, Hogan, Patitsas and Richwine  
9 which might supply this deficiency in the teachings of MacKay golf club  
10 reference. On the record before us, the Appellants have shown that the  
11 Examiner erred in rejecting claim 60 under 103(a).

12

13

#### CONCLUSIONS OF LAW

14

15           On the record before us, the Appellants have not shown that the  
16 Examiner erred in rejecting claims 36, 37 and 40-42 under section 103(a) as  
17 being unpatentable over MacKay golf club reference in view of either  
18 MacKay baseball bat reference or Tawney. The Appellants also have not  
19 shown that the Examiner erred in rejecting claim 38 under section 103(a) as  
20 being unpatentable over MacKay golf club reference in view of either  
21 MacKay baseball bat reference or Tawney and further in view of Patitsas or  
22 in rejecting claim 39 under section 103(a) as being unpatentable over  
23 MacKay golf club reference in view of either MacKay baseball bat reference  
24 or Tawney and further in view of Patitsas and Richwine. The Appellants  
25 have not shown that the Examiner erred in rejecting claims 43 and 44 under  
26 section 103(a) as being unpatentable over MacKay golf club reference in  
27 view of either MacKay baseball bat reference or Tawney and further in view  
of Horwood and Hogan.

1           On the record before us, the Appellants have not shown that the  
2 Examiner erred in rejecting claims 45-51, 54 and 55 under section 103(a) as  
3 being unpatentable over MacKay golf club reference in view of Horwood  
4 and Hogan. The Appellants also have not shown that the Examiner erred in  
5 rejecting claim 52 under section 103(a) as being unpatentable over MacKay  
6 golf club reference in view of Horwood, Hogan and Patitsas or in rejecting  
7 claim 53 under section 103(a) as being unpatentable over MacKay golf club  
8 reference in view of Horwood, Hogan, Patitsas and Richwine.

9           On the record before us, the Appellants have shown that the Examiner  
10 erred in rejecting claims 57, 58, 61 and 62 under section 103(a) as being  
11 unpatentable over MacKay golf club reference in view of either MacKay  
12 baseball bat reference or Tawney and further in view of Horwood and  
13 Hogan. The Appellants also have shown that the Examiner erred in rejecting  
14 claim 59 under section 103(a) as being unpatentable over MacKay golf club  
15 reference in view of either MacKay baseball bat reference or Tawney and  
16 further in view of Horwood, Hogan and Patitsas. The Appellants also have  
17 shown that the Examiner erred in rejecting claim 60 under section 103(a) as  
18 being unpatentable over MacKay golf club reference in view of either  
19 MacKay baseball bat reference or Tawney and further in view of Horwood,  
20 Hogan, Patitsas and Richwine.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16

DECISION

We affirm the Examiner's rejection of claims 36-55. We reverse the Examiner's rejection of claims 57-62.

AFFIRMED-IN-PART

vsh

BANNER & WITCOFF, LTD.  
1100 13TH STREET, N.W.  
SUITE 1200  
WASHINGTON, D.C. 20005-4051