

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ATSUKI KASASHIMA

Appeal 2007-3527
Application 10/684,688
Technology Center 3700

Decided: May 29, 2008

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) from the final rejection of claims 1-21. A hearing was held on May 20, 2008.

Representative claim 1 reads as follows:

1. A golf ball having an outermost spherical surface wherein a plurality of flat surface regions are formed on said outermost spherical surface, where areas of said outermost spherical surface which are not formed of said

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flat regions are land areas on said outermost surface, and a dimple is disposed within said plurality of the flat surface regions.

The references set forth below are relied upon as evidence of unpatentability:

Boehm	5,566,943	Oct. 22, 1996
Sullivan	6,884,183	Apr. 26, 2005

Claims 1, 8, 13, 14, and 17 are the sole independent claims from which all dependent appealed claims depend. Claims 1, 8, 14, and 17 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Sullivan. Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sullivan.

Claims 1, 8, 13, 14, and 17 each require a golf ball with flat surface regions formed on the outermost spherical surface.

Appellant asserts that Sullivan fails to disclose either explicitly or inherently, a golf ball with flat surface regions formed on the outermost spherical surface (Appeal Br. 10).

The Examiner however maintains that Sullivan inherently discloses a golf ball with flat surface regions formed on the outermost spherical surface because “the contour lines of the dimples inside of the polygonal shapes would indicate that the polygonal shape is planar.” (Answer 8) In addition, in an Advisory Action dated July 31, 2006, the Examiner illustrates his position using a tangent line drawn juxtaposed to a dimple top surface of Figure 3A in Sullivan to evidence that in Sullivan “the dimples comprise flat regions”. *Id.*

However, under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). We are not persuaded from the disclosure in Sullivan that one of ordinary skill in the art reading Sullivan would be clear that the flat surfaces are formed on the outer surfaces of the ball for the following reasons.

First, we find that the dimple contour lines which the Examiner references as evidence of a departure from a flat surface would also occur from a curved outer surface because the curvature of the ball at these segmented areas is so slight relative to the more aggressive sloped or curved depression surface that the departure from the otherwise more gradually sloped curved outer surface at the start of the depression would be marked by the same type of contour lines marking the change in curvature at the depression.

Second, the Examiner's attempt to show parallel straight surfaces between the tangent line drawn in the Advisory Action and the outer surface of the dimples, likewise fails to provide the disclosure of flat surface regions formed on the outermost spherical surface of the ball. While the drawing is a reasonable attempt to provide technical reasoning to support the determination that the allegedly inherent characteristic is shown in the drawings, it fails for two reasons. First, the portions of the drawing under scrutiny in Figure 3A in Sullivan are at the corners of the triangles demarking each dimple. These portions of the triangular dimples

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are so small relative to the overall scale of the drawing, as to make determining the slope of these surfaces impossible.

Furthermore, the lines defining the triangular sections in Sullivan are defined by inter-dimple spacings 20 and inter-sectional spacings 22 (Sullivan, col.5, lines 16-19). At least with respect to the inter-sectional spacings 22, the spacings 22 are disclosed as forming “great circles around the ball” (Sullivan, col.5 lines 27-28), which means that the lines defining the triangular section must be curved in order to allow the arc of the great circle to be formed. This is in keeping with the Summary of Invention in Sullivan, which discloses that the golf ball has a “substantially spherical outer surface” (Sullivan col. 3, ll. 3-4).

Accordingly, we do not find that Sullivan discloses a golf ball with flat surface regions formed on said outermost spherical and hence no prima facie case of anticipation of the claimed invention over Sullivan has been established with respect to the rejection of claims 1-4, 6-8, 11, 12, 14, 17, 18, and 19 under 35 U.S.C. § 102(e).

Claims 5, 9, 10, 13, stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan, and claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) over Sullivan in view of Boehm. As the rejections of claims 5, 9, 10, and

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13¹, and claims 20 and 21 fail to cure the deficiency of the rejection of claims 1, 8, 14, and 17, we also cannot sustain the rejection of these claims.

The decision of the Examiner to reject claims 1-21 is REVERSED.

REVERSED

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¹ The Final Office action does not group claims 15 and 16 in any one rejection but addresses these claims as rejected in the Office Action Summary; hence we assume that the Examiner meant to group claims 15 and 16 with claims 5, 9, 10, and 13 given that the subject matter of these claims are similar.