

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* STANLEY BOTTEN and DONNIE MCGUIRE
9

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11 Appeal 2008-1104
12 Application 10/867,541
13 Technology Center 3700
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16 Decided: June 27, 2008
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19 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and MICHAEL
20 W. O'NEILL, *Administrative Patent Judges*.

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22 CRAWFORD, *Administrative Patent Judge*.

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25 DECISION ON APPEAL
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27 STATEMENT OF CASE

28 Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection
29 of claims 1, 2, and 7 to 11. We have jurisdiction under 35 U.S.C. § 6(b)
30 (2002).

31 Appellants invented a baseball bat including a center core and an at
32 least part wood veneer laminate wound from the center core to the outer

1 surface, the wood veneer laminate tapering from the center core to the outer
2 surface (Specification 1).

3 Claim 1 under appeal reads as follows:

4 1. A baseball bat, comprising:
5 a center core;
6 an at least part wood veneer laminate wound from the center
7 core to the outer surface, said at least part wood veneer laminate
8 tapering in length from the center core to the outer surface.
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10 The prior art relied upon by the Examiner in rejecting the claims on
11 appeal is:

12 Johnson	US 2,379,006	Jun. 26, 1945
13 Fenton	US 5,093,162	Mar. 03, 1992
14 Kingston	US 5,906,550	May 25, 1999

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16 The Examiner rejected claims 1, 2, 7, 8, and 10 under
17 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Fenton.

18 The Examiner rejected claims 9 and 11 under 35 U.S.C. § 103(a) as
19 being unpatentable over Johnson in view of Fenton and Kingston.

20 Appellants contend that neither reference discloses a wood veneer
21 laminate that tapers in length from the center core to the outer surface.

22 Appellants also contend that Fenton is non-analogous art.

23 Appellants further contend that there is no suggestion to combine the
24 teachings of Johnson and Fenton.

25 Appellants lastly contend that Kingston does not disclose wood
26 laminates but rather multilayered composite shells.

1 ISSUES

2 The first issue is whether Appellants have shown that the Examiner
3 erred in rejecting the claims 1, 2, 7, and 10 because Fenton is non-analogous
4 art.

5 The second issue is whether Appellants have shown that the Examiner
6 erred in rejecting the claims 1, 2, 7, and 10 because Johnson does not
7 disclose a wood veneer laminate that tapers in length from the center core to
8 the outer surface.

9 The third issue is whether Appellants have shown that the Examiner
10 erred in rejecting the claims 1, 2, 7, and 10 because there is no suggestion to
11 combine the teachings of Johnson and Fenton.

12 The last issue is whether the Appellants have shown that the Examiner
13 erred in rejecting the claims 9 and 11 because Kingston does not disclose
14 wood laminates but rather multilayered composite shells.

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16 FINDINGS OF FACT

17 Johnson discloses a shaft used for sports such as is used for a baseball
18 bat or a golf club including a tapered center metal core 10 and a series of
19 narrow strips of wood veneer laminate 21 wound from the center core 10 to
20 the outer surface (page 2, col. 1, ll. 34 to 38). The margin of the finish end
21 of the veneer strips may be tapered (page 2, col. 2, ll. 35 to 39).

22 Fenton discloses a shaft, used for golf, including a tapered steel center
23 core 11 and a series of tapered graphite plies or strips 15, 17 wound from the
24 center core 11 to the outer surface (col. 2, l. 62 to col. 3, l. 2).

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1 ANALYSIS

2 *Rejection of claims 1, 2, 7, and 10*

3 We are not persuaded by Appellants' argument that the Examiner
4 erred in rejecting claims 1, 2, 7, and 10 because Fenton is non-analogous art.
5 Appellants argue that Fenton is non-analogous art because Fenton relates to
6 golf clubs rather than baseball bats and utilizes graphite rather than wood.

7 The analogous-art test has long been part of the primary *Graham*
8 analysis articulated by the Supreme Court. *See Dann v. Johnston*, 425 U.S.
9 219, 227-29 (1976), *Graham v. John Deere*, 383 U.S. 1, 35 (1966). The
10 analogous-art test requires that a reference is either in the field of the
11 applicant's endeavor or is reasonably pertinent to the problem with which the
12 inventor was concerned in order to rely on that reference as a basis for
13 rejection. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References
14 are selected as being reasonably pertinent to the problem based on the
15 judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary
16 to consider ‘the reality of the circumstances,’-in other words, common
17 sense-in deciding in which fields a person of ordinary skill would reasonably
18 be expected to look for a solution to the problem facing the inventor.”
19 (Quoting *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979))); *In re Kahn*, 441
20 F.3d 977, 986-87 (Fed. Cir. 2006). *See also In re Clay*, 966 F.2d 656, 659
21 (Fed. Cir. 1992) (“[a] reference is reasonably pertinent if, even though it
22 may be in a different field from that of the inventor's endeavor, it is one
23 which, because of the matter with which it deals, logically would have
24 commended itself to an inventor's attention in considering his problem.”).

1 In *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) the Supreme
2 Court held that “*any* need or problem known in the field of endeavor at the
3 time of invention and addressed by the patent can provide a reason for
4 combining the elements in the manner claimed,” 127 S.Ct. at 1742
5 (emphasis added). As such the second part of the analogous art test as stated
6 in *Clay, supra*, must be expanded to require a determination of whether the
7 reference, even though it may be in a different field from that of the
8 inventor's endeavor, is one which, because of the matter with which it deals,
9 logically would have commended itself to an artisan's attention in
10 considering *any* need or problem known in the field of endeavor.

11 In the present case, as Fenton relates to the construction of a shaft
12 used to strike a ball, it is our view that Fenton is within the field of the
13 Appellants' invention. In addition, Fenton is directed to providing a shaft
14 for striking a ball that has sufficient strength. Appellants disclose that one of
15 the problems addressed by the present invention is to provide a sporting
16 shaft that has sufficient strength (Specification 1). Therefore, Fenton relates
17 to the same problem sought to solved by Appellants and would have
18 commended itself to an inventor's attention even if Fenton were in a
19 different field. We additionally note that Johnson's disclosure indicates that
20 the shaft therein disclosed may be applicable to golf clubs as well as baseball
21 bats thereby indicating that the problems addressed by the two striking
22 implements are similar. Therefore, in our view, Fenton is analogous art.

23 We are not persuaded of error on the part of the Examiner by
24 Appellants' argument that Johnson does not disclose a wood veneer laminate
25 that tapers in length from the center core to the outer surface. Firstly, as we

1 found above Johnson does indeed disclose wood veneer laminate that taper
2 in length from the center core to the outer surface as it discloses that the
3 veneer strips may be tapered at the margin. In addition, the Examiner relied
4 on Fenton for this teaching. Fenton discloses a series of tapered strips 15,
5 17 wound from the center core 11 to the outer surface.

6 We are also not persuaded by Appellants' argument that the Examiner
7 erred in rejecting the claims 1, 2, 7, and 10 because there is no suggestion to
8 combine the teachings of Johnson and Fenton. Firstly, as we held above,
9 Johnson alone discloses the subject matter of claim 1. In addition, as the use
10 of tapered strips to form a tapered shaft was known in the art as evidenced
11 by the Fenton reference, the use of such tapered strips on the Johnson shaft
12 is no more than the combination of familiar elements according to known
13 methods to produce a predictable result. As explained in *KSR Int'l*, 127
14 S.Ct. at 1731: "If a person of ordinary skill . . . can implement a predictable
15 variation . . . , § 103 likely bars its patentability."

16 In view of the foregoing, we will sustain the Examiner's rejection of
17 claim 1. We will also sustain the rejection as it is directed to claims 2, 7, 8,
18 and 10 because the Appellants have not argued the separate patentability of
19 these claims.

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21 *Rejection of claims 9 and 11*

22 We are also not persuaded by Appellants' argument that the Examiner
23 erred in rejecting the claims 9 and 11 because Kingston does not disclose
24 wood laminates but rather multilayered composite shells because Kingston is
25 not cited for teaching wood laminates but rather for teaching that it is known

1 to use laminates of different thicknesses. Johnson is cited for teaching wood
2 laminates. An applicant cannot show non-obviousness by attacking
3 references individually where, as here, the rejections are based on a
4 combination of references. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

5 In view of the foregoing, we will sustain this rejection as it is directed
6 to claim 9. We will also sustain this rejection as it is directed to claim
7 11 because the Appellants have not argued the separate patentability of
8 claim 11.

9 The decision of the Examiner is affirmed.

10 No time period for taking any subsequent action in connection with
11 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

12 AFFIRMED

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