UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte
HAI MINH NGUYEN

Appeal 2008-1976
Application 10/919,852
Technology Center 3700

DECIDED: July 22, 2008

Before TONI R. SCHEINER, DONALD E. ADAMS, and LORA M. GREEN, Administrative *Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1, 3, and 5-10, the only claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

The present invention is directed to a swing exercising device which eliminates the need to retrieve struck balls, and allows a user, for example a golfer or baseball player, to practice his or her swing in a confined area (Spec. 1: 4-11; 5: 5-13).

The claims stand rejected as follows.

I. Claims 1, 5, and 10 under 35 U.S.C. § 102(b), as anticipated by Di Re (U.S. Patent 6,551,204 B1, issued April 22, 2003).

II. Claims 1, 3, 6, 8, and 9 under 35 U.S.C. § 103(a) as unpatentable over Wang (U.S. Patent 4,932,660, issued June 12, 1990) in view of Chou (U.S. Patent 6,425,830 B1, issued July 30, 2002).

III. Claims 1, 3, and 9 under 35 U.S.C. § 103(a) as unpatentable over Hornig (U.S. Patent 2,606,025, issued August 5, 1952) in view of Chou.

IV. Claims 1 and 6-8 under 35 U.S.C. § 103(a) as unpatentable over Smith (U.S. Patent 5,454,561, issued October 3, 1995) in view of Chou.

Claims 1, 3, 5, and 6 are representative, and read as follows:

1. A swing exercising device, comprising:
a base;
a handle coupled to the base;
means for attaching a ball to the base.

3. The device of claim 1, wherein said base includes an opening and wherein said means for attaching a ball comprises a pivotable arm inserted into said opening, wherein when the ball is struck, the arm allows the ball to orbit around said opening above said base.

5. The device of claim 1, comprising a tube mounted on top of the base and adapted to receive said string therethrough.

6. The device of claim 1, wherein said means for attaching a ball comprises:

a stand projecting above the base;
an arm projecting from the stand; and
a ring rotatably coupled to the arm.

FINDINGS OF FACT (FF)

1. The swing exercising device of claim 1 requires 3 elements: a base; a handle coupled to the base; and means for attaching a ball to the base.

2. The third element of claim 1 is expressed in "means-plus-function" language. According to Appellant, the structures corresponding to the "means for attaching a ball to the base" language are disclosed in the Specification as follows: "(Fig. 1, item 16; Fig. 2, item 24[;] Fig. 4, item 47[;] Fig. 5, item[s] 54, 57, 59; Fig. 6, item 65; Fig. 7, items 76-77; Fig. 8, item 84; and Fig. 9[,] item 93; page 6 line 7 - page 10 line 20)" (App. Br. 2).

3. Appellant does not specifically identify any structural elements in Figure 3 of the Specification corresponding to the "means for attaching a ball to the base" language of claim 1.

4. Figure 3 of the Specification is reproduced immediately below:

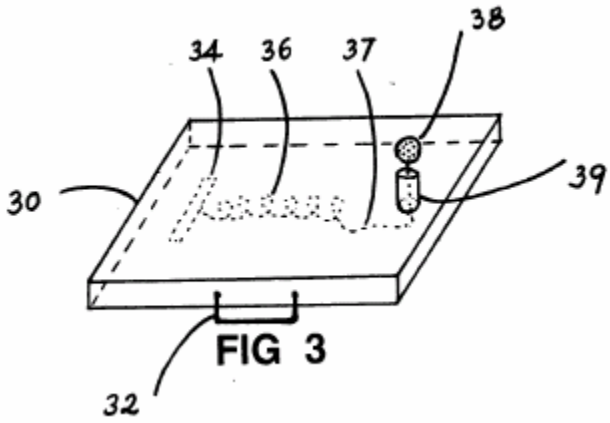

FIG 3

Figure 3 shows an embodiment of the device "with an enclosure 30 having . . . a pipe 39 on a top side of the enclosure 30. Projecting through the pipe 39 is a spring 36. At one end of the spring 36 is a ball 38, and the other end of the spring is attached to a retainer 34 to secure the spring to the enclosure" (Spec. 7: 3-6). When the ball is struck, it "flies off, but is restrained by the spring 36 and spins around the pipe 39 until the . . . ball returns to its original rest position" (Spec. 7: 9-11).

5. Spring 36 and pipe 39, shown in Figure 3, correspond to the "means for attaching a ball to the base" language of claim 1.

6. In addition, according to claim 3, another structure corresponding to a "means for attaching a ball to the base" is "a pivotable arm inserted into said opening [in the base]" (Claim 3). Yet another structure corresponding to "means for attaching a ball to the base" is "a stand projecting above the base; an arm projecting from the stand; and a ring rotatable coupled to the arm" (Claim 6). Finally, "[t]he means for attaching a ball can include a coiled spring fastened to one side of the base" (Spec. 4: 5-6); "a pivotable arm" (Spec. 4: 8); or a retainer secured in the base with a coiled spring fastened to the retainer, and a string coupled to the coiled spring (Spec. 4: 10-11). "The means for attaching a ball can also include a first hollow [rectangular or cylindrical] tube . . . [with] a second [hollow] tube rotatably coupled to and slideably engaging the first hollow tube . . . [a]n arm can be connected to the second tube . . . [and] [t]he ball can be mounted on one end of the arm . . . [or] [a] spring can be connected to the arm and the ball" (Spec. 4: 18-24).

Di Re

7. Di Re describes "a baseball batting practice system allowing a baseball player to practice their swing without having to retrieve the ball" (Di Re, col. 1, ll. 6-8).

8. Figure 1, reproduced below, illustrates Di Re's batting practice system:

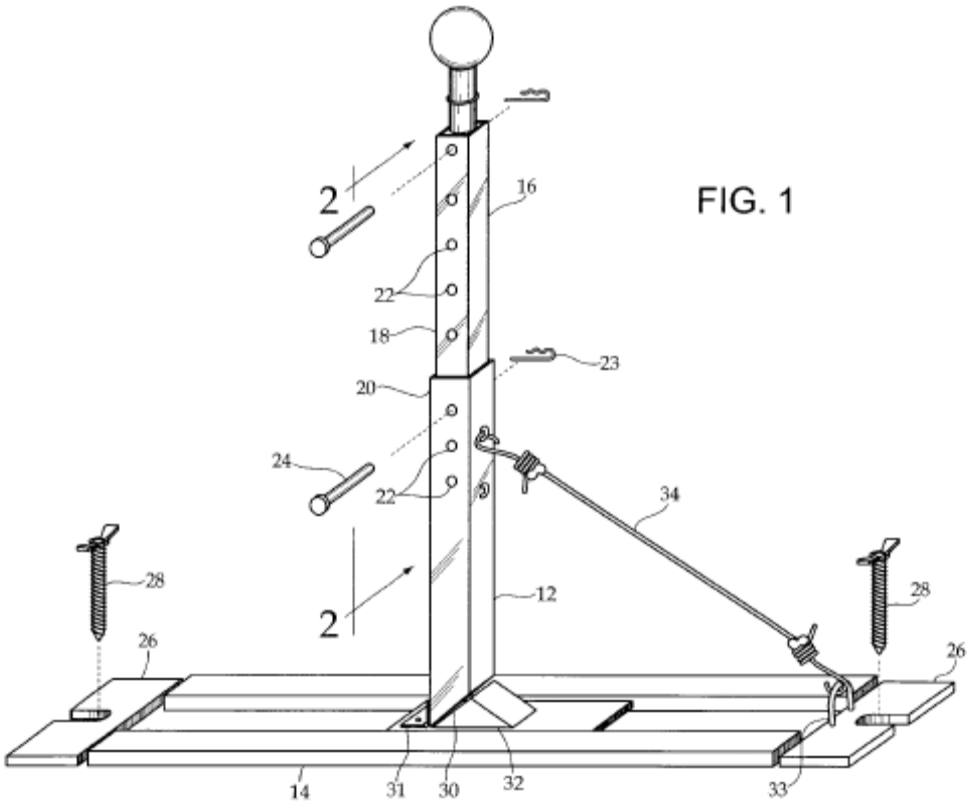

Figure 1 is a perspective view of Di Re's system, and shows an "inverted T-shaped stand **12** [which] includes a lower horizontal base **14** and an upper vertical support **16**" (Di Re, col. 2, ll. 31-34).

9. "[H]orizontal base **14** is provided with additional end portions **26** that are capable of receiving anchoring screws **28** to secure the stand **12** to a recipient ground surface" (Di Re, col. 2, ll. 31-34). "U-hook **33** is provided

at one of the additional end portions **26** to provide direct anchoring to the ground surface" (Di Re, col. 2, ll. 54-55).

10. Ball **38** is secured to upper vertical support **16** with "interior elastic cord **44** [which] has a free end securable interiorly of the upper vertical support **16**" (Di Re, col. 3, ll. 20-21).

11. When "the ball **38** has been struck, pulling the ball **38** somewhat upward and away from the ball support cup **36**[,] [t]he interior elastic cord **44** stretches but keeps the ball **38** tethered to the upper vertical support **16**" (Di Re, col. 3, ll. 31-35).

Chou

12. Chou describes a golf swing practicing device as shown in Figure 3, reproduced below:

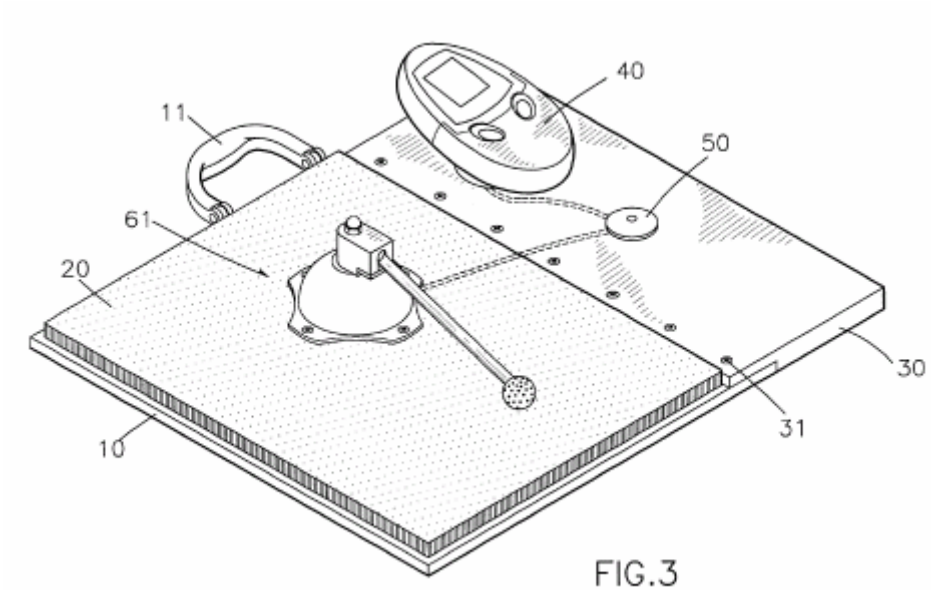

FIG.3

Figure 3 is a perspective view of the golf swing practice device, which comprises a board **10**, and a handle **11** connected to board **10** (Chou, col. 2, ll. 30-33). Flexible rod **79** is rotatably mounted on the board through tube

67 which extends from a skirt portion mounted to the board, and shaft **82**, which extends through hole **75** in the board **10** (Chou, col. 2, ll. 42-52). A golf ball is mounted to the distal end of flexible rod **79** (Chou, col. 2, ll. 63-64).

13. Chou's "device can be easily carried by the handle **11**" (Chou, col. 3, ll. 4-5).

Wang

14. Wang describes a golf practice device, as shown in Figure 3, reproduced immediately below:

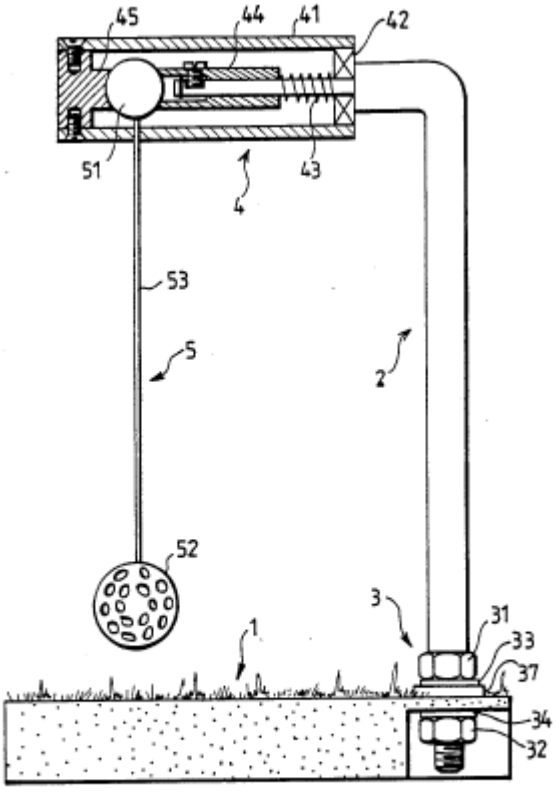

FIG. 3

Figure 3 is a side elevational view of Wang's practice device. The device "consists of an elongate base **1**, an inverted L-shaped support **2** secured to the elongate base **1** . . . a rotatable member **4** mounted on the upper end of the L-shaped support **2**, and a ball body **5** mounted loosely on the rotatable member **4**" (Wang, col. 3, l. 67 to col. 4, l. 5).

15. Elongate base **1** is "a flat rectangular section covered with artificial grass. The base part **1** is constructed of high strength rubber matting on which the L-shaped support . . . [is] mounted" (Wang, col. 4, ll. 6-10).

Hornig

16. Hornig describes a ball game apparatus "wherein a captive ball may be struck by the hand or a bat or racquet to cause it to encircle its support" (Hornig, col. 1, ll. 1-4). Figure 1 of Hornig is reproduced below:

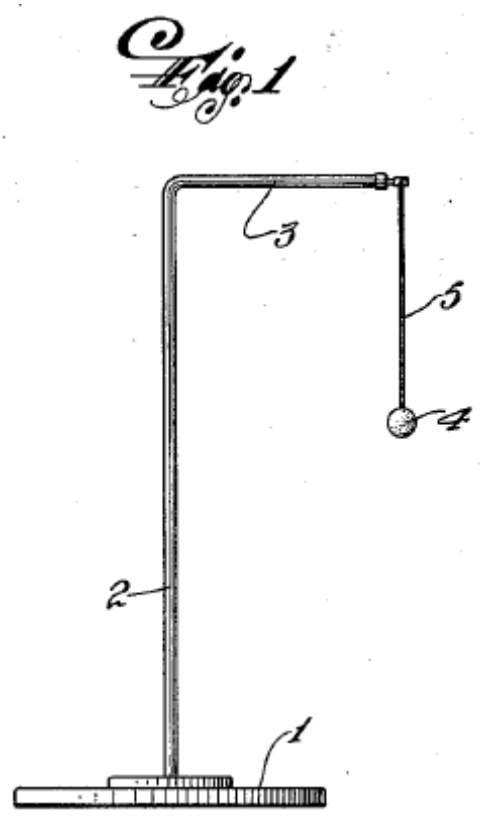

Figure 1 is a side elevational view of Hornig's device. "Base **1** is of such weight, size and material as will furnish a substantial support during the use of the apparatus. Mounted in such base is vertical post **2** from which at the top extends horizontally arm **3** which . . . is tubular" (Hornig, col. 1, ll. 28-32). "Within arm **3** . . . is coil spring **6** which is secured at one end to rotatable disc **8** and at the other end is anchored at **10** to closure **9**" (Hornig, col. 1, ll. 43-46).

17. "When ball **4** is struck it will revolve about the end of arm **3** carrying with it wire **5** and turning the axle to which the wire is secured" (Hornig, col. 1, ll. 56-58). The spring "may be placed outside of arm **3**" (Hornig, col. 2, ll. 7-8).

Smith

18. Smith describes "an apparatus permitting players to practice batting a ball" (Smith, col. 1, ll. 8-9).

19. "The device comprises a base **22** having an upwardly open socket **24** centrally supporting, a preferably tubular, standard having laterally projecting arm **28** in[ ]turn supporting a tethered ball **30** at its end remote from the standard" (Smith, col. 1, ll. 59-62). "[A]ngularly rotatable hub means **40**, at the end of the arm **28** remote from the standard **26**, secures one end of a flexible strand **42** secured at its other end portion to the ball **30**" (Smith, col. 2, ll. 9-12).

20. "When the ball **30** is struck by a bat . . . the ball rotates in a circular direction in a substantially vertical plane" (Smith, col. 2, ll. 34-35).

21. Smith's apparatus is shown in Figure 1, reproduced immediately below:

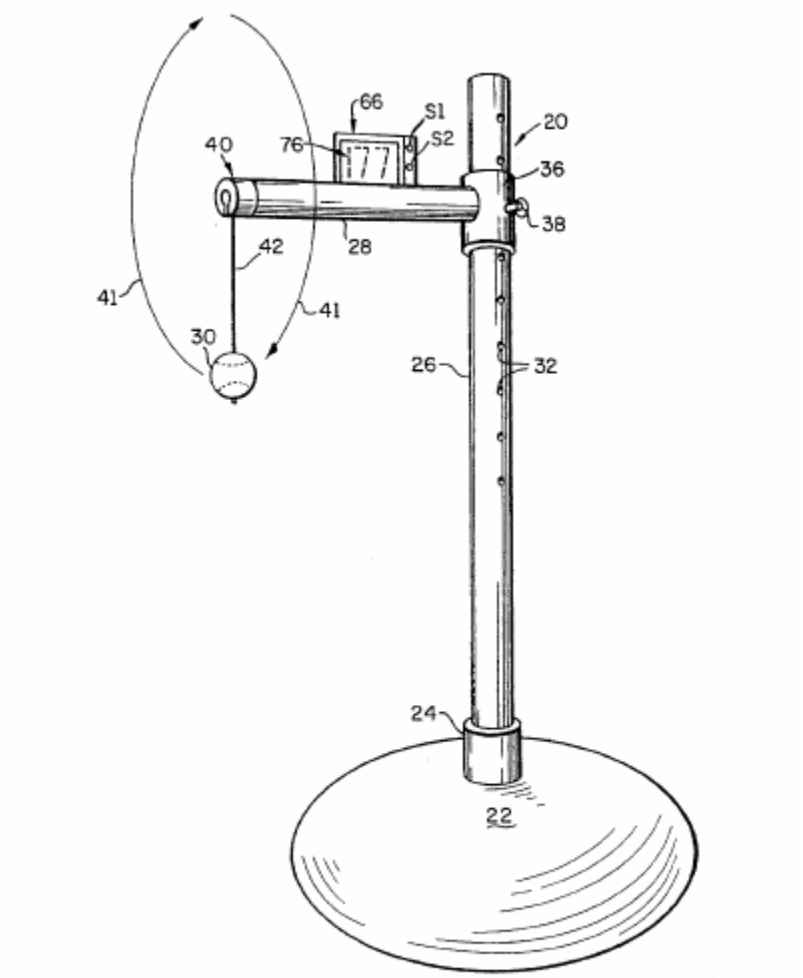

FIG. 1

Figure 1 is a perspective view of Smith apparatus, showing, among other things, LED indicia **76** displaying units of distance measurement (Smith col. 3, ll. 65-66).

DISCUSSION

In this decision we consider only those arguments actually made by Appellant in the Brief. Arguments that Appellant could have made but chose not to make in the Brief have not been considered and are deemed to have been waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Anticipation by Di Re

The Examiner rejected claims 1, 5, and 10 under 35 U.S.C. § 102(b) as anticipated by Di Re. The exercising device of claim 1 requires: a base; a handle coupled to the base; and means for attaching a ball to the base. Claim 5 requires a tube mounted on top of the base adapted for receiving a string. Claim 10 requires that the base is rectangular.

The issues raised by this rejection on appeal are essentially: whether Di Re describes a device with a handle; whether Di Re describes "means for attaching a ball to the base" as interpreted under 35 U.S.C. § 112, sixth paragraph; and, with respect to claim 5, whether Di Re describes a device with a tube mounted on top of the base adapted for receiving a string.

The Examiner contends that Di Re discloses a rectangular base **14**, a handle **33** coupled to the base, and a means for attaching a ball to the base (Ans. 3).

With respect to claim 5 in particular, the Examiner contends that Di Re discloses a tube **16** mounted on the base and adapted to receive a string (Ans. 3).

Appellant contends that "Di Re fails to show the handle, and the word handle is no-where mentioned in Di Re" (App. Br. 3).

This argument is not persuasive. The Examiner has identified Di Re's U-bolt **33** as a structure capable of functioning as a handle, and Appellant has not explained why it could not function in that manner.

Appellant further contends "under Section 112, [sixth paragraph] Di Re fails to show the structure [of the means for attaching a ball to the base] recited in Fig. 5" of the present Specification (App. Br. 3), and therefore "cannot anticipate claim 1 as well as claims dependent therefrom" (App. Br. 4). In particular, Appellant argues

> Under Section 112, the structure corresponding to the means for attaching the ball to the base includes an arm 55 projecting horizontally from the stand 54. A ring 56 is rotatably mounted on the arm 55. A pipe 57 is connected to the ring 56, and a string 59 is attached to the other end of the pipe 57. A ball 58 is attached to the remaining end of the string 59.

(App. Br. 3.)

This argument is not persuasive. As pointed out by the Examiner, "[t]he instant invention has 9 mechanically different embodiments (Fig. 1-9)" (Ans. 5) corresponding to the "means for attaching a ball to the base" language in claim 1. In other words, the structure shown in Figure 5 of the present Specification is not the only structure corresponding to the means-plus-function language of claim 1 (Spec. 6: 8 to 10: 20; Figs.1-9).

According to Appellant, structures that correspond to the "means for attaching a ball to the base" are as follows: : "(Fig. 1, item 16; Fig. 2, item 24[;] Fig. 4, item 47[;] Fig. 5, item[s] 54, 57, 59; Fig. 6, item 65; Fig. 7, items 76-77; Fig. 8, item 84; and Fig. 9[,] item 93; page 6 line 7 - page 10 line 20)" (App. Br. 2; FF 2). In addition, spring **36** and pipe **39**, shown in

Figure 3 of the present Specification, correspond to the "means for attaching a ball to the base" language of claim 1 (FF 4, 5).

As discussed above, Di Re describes a T-shaped stand **12** which includes a lower horizontal base **14** and an upper vertical support **16** (Di Re, col. 2, ll. 31-34; FF 8). Vertical support **16** is attached to base **14** (FF 8). Elastic cord **44**, attached to ball **38,** runs through vertical support **16** and stretches to allow ball **38** to move away from the base, but still remain tethered to the base when hit by a practice swing (FF 10, 11).

It may be that Di Re does not describe the structure shown in Figure 5 of the present Specification, but Appellant has not explained why Di Re's vertical support **16** and elastic cord **44** are not equivalent to at least one of the present Specification's other structures corresponding to the "means for attaching a ball to the base" of claim 1.

For example, Appellant has not explained why spring **37** and pipe **39** of Appellant's device (shown in Figure 3 of the Specification), and Di Re's elastic cord **44** and vertical support **16**, are not equivalent means of attaching a ball to the base. According to the Specification, when the ball is struck, it "flies off, but is restrained by the spring 36 and spins around the pipe 39 until the . . . ball returns to its original rest position" (Spec. 7: 9-11; FF 4). Likewise, according to Di Re, when "the ball **38** has been struck, pulling the ball **38** somewhat upward and away from the ball support cup **36**[,] [t]he interior elastic cord **44** stretches but keeps the ball **38** tethered to the upper vertical support **16**" (Di Re, col. 3, ll. 31-35; FF 11). Thus, these structures perform the identical function, in substantially the same way, and produce substantially the same result (FF 4, 11). *See Kemco Sales, Inc. v. Control*

Papers Co., 208 F.3d 1352, 1364 (Fed. Cir. 2000) ("[T]wo structures may be 'equivalent' for purposes of section 112, paragraph 6, if they perform the identical function, in substantially the same way, with substantially the same result.").

As for claim 5, we note that the strictures of the sixth paragraph of 35 U.S.C. § 112 do not apply because claim 5 explicitly recites a structure comprising "a tube mounted on top of the base and adapted to receive . . . [a] string therethrough." *See Rodime PLC v. Seagate Technology, Inc.*, 174 F.3d 1294, 1303-04 (Fed. Cir. 1999) ("[D]etailed recitation of structure for performing the . . . [claimed] function takes this claim element out of the scope of § 112, ¶ 6").

Appellant argues "with respect to claim 5, Di Re fails to show a tube mounted on top of the base and adapted to receive a string therethrough. Fig. 1 shows a ball, but not the string" (App. Br. 4).

This argument is not persuasive. Di Re clearly shows a tube (vertical support **16**) mounted on top of the base (horizontal base **14**), with an elastic cord running through the vertical support (FF 8, 10). The fact that Di Re shows an elastic cord **44** rather than a string is irrelevant, as claim 5 merely requires a tube "adapted" to receive (i.e., capable of receiving) a string. Clearly, Di Re's vertical support is capable of receiving a string.

The rejection of claims 1, 5, and 10 under 35 U.S.C. § 102(b) as anticipated by Di Re is affirmed.

Obviousness over Wang and Chou

Claims 1, 3, 6, 8, and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Wang in view of Chou.

Appellant has not argued the rejected claims separately. Therefore, we select claim 1 as representative of the claimed subject matter for the purpose of deciding this rejection on appeal, and claims 3, 6, 8, and 9 will stand or fall accordingly. 37 C.F.R. § 41.37(c)(1)(vii).

Again, the exercising device of claim 1 requires: a base; a handle coupled to the base; and means for attaching a ball to the base.

The Examiner contends that Wang discloses a base, a means for attaching a ball to the base, a ring rotatably coupled to the means for attaching a ball to the base, and a string (items **1**, **2**, **4**, **44**, **53**), while Chou discloses the use of a handle on a golf swing exercise device (Ans. 3). The Examiner contends "[i]t would have been obvious to one of ordinary skill in the art . . . to have employed the handle of Chou with the apparatus of Wang in order to more easily adjust and move the device" (*id.*).

Appellant contends that "Wang fails to show the structure corresponding to the means for attaching a ball to the base" (App. Br. 4), where that structure includes

> an arm 55 projecting horizontally from the stand 54. A ring 56 is rotatably mounted on the arm 55. A pipe 57 is connected to the ring 56, and a string 59 is attached to the other end of the pipe 57. A ball 58 is attached to the remaining end of the string 59. Similarly, Chou fails to show the attaching means structure.

(App. Br. 4.)

Appellant further contends that "Wang does not show the base and is not designed to be movable" (App. Br. 4), and "[o]ne skilled in the art would not be motivated to combine Chou with Wang as attaching the handle to the ground serving as the base for Wang would be non-functional" (*id.*).

Thus, the issues raised by this rejection on appeal are essentially: whether Wang describes "means for attaching a ball to the base" as interpreted under 35 U.S.C. § 112, sixth paragraph, and whether the combined teachings of Wang and Chou would have suggested a swing exercise device with a handle.

Appellant's arguments do not persuade us that the Examiner's conclusion that the rejected claims are unpatentable over Wang and Chou is in error. Appellant is again arguing that the cited references do not disclose the structure shown in Figure 5 of the present invention. However, as discussed above, the structure shown in Figure 5 of the present Specification is not the only structure corresponding to the means-plus-function language of claim 1 (FF 2, 4, 5, 6).

Again, Appellant has not explained why Wang's rotatable member **4**, and L-shaped support **2**, secured to base **1**, are not equivalent to at least one of the present Specification's other structures corresponding to the "means for attaching a ball to the base" of claim 1 (for example, where "said means for attaching a ball comprises: a stand projecting above the base; an arm projecting from the stand; and a ring rotatably coupled to the arm" (Claim 6, FF 6)).

Moreover, contrary to Appellant's argument (and as pointed out by the Examiner on page 6 of the Answer), Wang discloses elongate base **1**,

"a flat rectangular section covered with artificial grass. The base part **1** is constructed of high strength rubber matting on which the L-shaped support . . . [is] mounted" (Wang, col. 4, ll. 6-10; FF 15). Therefore, we are not persuaded by Appellant's argument that "attaching the handle to the ground serving as the base for Wang would be non-functional" (App. Br. 4).

The rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Wang and Chou is affirmed, and claims 3, 6, 8, and 9 fall accordingly.

Obviousness over Hornig and Chou

Claims 1, 3, and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hornig in view of Chou.

The Examiner contends that Hornig discloses a base (item **1**) and a means for attaching a ball to a base (item **2**) as required by claim 1, but does not disclose a handle attached to the base (Ans. 4). The Examiner contends "[i]t would have been obvious to one of ordinary skill in the art . . . to have employed the handle of Chou with the apparatus of [Hornig] in order to more easily adjust and move the device" (*id.*).

Appellant contends that Hornig "fails to show the structure corresponding to the means for attaching the ball to the base" (App. Br. 5), where that structure includes

> an arm 55 projecting horizontally from the stand 54. A ring 56 is rotatably mounted on the arm 55. A pipe 57 is connected to the ring 56, and a string 59 is attached to the other end of the pipe 57. A ball 58 is attached to the remaining end of the string 59. Similarly, Chou fails to show the attaching means structure.

(App. Br. 5.)

Once again, Appellant argues that the cited references do not disclose the structure shown in Figure 5 of the present invention. However, as discussed above, the structure shown in Figure 5 of the present Specification is not the only structure corresponding to the means-plus-function language of claim 1 (FF 2, 4, 5, 6).

In addition, Appellant further contends that Hornig's device is "for bats or hands" and "[is] not useful for golf" (App. Br. 5).

Appellant's arguments do not persuade us that the Examiner's conclusion that claims 1 and 3 are unpatentable over Hornig and Chou is in error. Again, Appellant has not explained why Hornig's vertical post **2**, horizontally extending tubular arm **3**, and axel **7** are not equivalent to at least one of the present Specification's other structures corresponding to the "means for attaching a ball to the base." (Claim 1).

However, with respect to claim 9, which requires that the ball is a golf ball, we disagree with the Examiner's interpretation of the reference. Contrary to the Examiners assertion, ball **4** is not a golf ball, but is instead a ball hit with a bat (e.g., a baseball), or a racquet (FF 16).

The rejection of claims 1, 3, and 9 under 35 U.S.C. § 103(a) as unpatentable over Horning and Chou is affirmed with respect to claims 1 and 3, but reversed with respect to claim 9.

Obviousness over Smith and Chou

Claims 1 and 6-8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Smith and Chou.

The Examiner contends that Smith discloses a base (item **22**) and a means for attaching a ball to a base (items **26**, **44**, and **42**) as required by

claim 1, but does not disclose a handle attached to the base (Ans. 4). The Examiner contends "[i]t would have been obvious to one of ordinary skill in the art . . . to have employed the handle of Chou with the apparatus of Smith in order to more easily adjust and move the device" (*id.*). In addition, the Examiner contends that Smith discloses a distance indicator (item **66**) (*id.*).

Appellant contends "[a]gain, Smith fails to show the structure corresponding to the means for attaching the ball to the base" (App. Br. 5), where that structure includes

> an arm 55 projecting horizontally from the stand 54. A ring 56 is rotatably mounted on the arm 55. A pipe 57 is connected to the ring 56, and a string 59 is attached to the other end of the pipe 57. A ball 58 is attached to the remaining end of the string 59. Similarly, Chou fails to show the attaching means structure.

(App. Br. 5.)

Once again, Appellant argues that the cited references do not disclose the structure shown in Figure 5 of the present invention. However, as discussed above, the structure shown in Figure 5 of the present Specification is not the only structure corresponding to the means-plus-function language of claim 1 (FF 2, 4, 5, 6).

Appellant's arguments do not persuade us that the Examiner's conclusion that claims 1 and 6-8 are unpatentable over Smith and Chou is in error. Appellant has not explained why Smith's standard **26** (attached to base **22**), projecting arm **28**, and circular cylinder **44** (FF 19, 20, 21) are not equivalent to at least one of the present Specification's other structures corresponding to the "means for attaching a ball to the base" required by claim 1, for example, the means for attaching a ball to the base recited in

claim 6: "a stand projecting above the base; an arm projecting from the stand; and a ring rotatably coupled to the arm" (Claim 6).

Appellant further contends that combining Chou with Smith would "result in a game device for bats and not for golf. Hence, Smith and Chou cannot render claim 1 and any of the dependent claims obvious" (App. Br. 6). This argument is not persuasive, as none of the claims rejected over Smith and Chou is limited to a golf swing exercise device.

The rejection of claims 1 and 6-8 under 35 U.S.C. § 103(a) as unpatentable over Smith and Chou is affirmed.

SUMMARY

The rejection of claims 1, 5, and 10 under 35 U.S.C. § 102(b) as anticipated by Di Re is affirmed.

The rejection of claims 1, 3, 6, 8, and 9 under 35 U.S.C. § 103(a) as unpatentable over Wang and Chou is affirmed.

The rejection of claims 1, 3, and 9 under 35 U.S.C. § 103(a) as unpatentable over Horning and Chou is affirmed with respect to claims 1 and 3, but reversed with respect to claim 9.

The rejection of claims 1 and 6-8 under 35 U.S.C. § 103(a) as unpatentable over Smith and Chou 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)(1)(iv)(2006).

AFFIRMED

Ssc:

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