

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ENOCH J. DURBIN

Appeal No. 97-3348
Reexamination No. 90/004,036¹

HEARD: January 12, 1998

Before COHEN, ABRAMS and McQUADE, *Administrative Patent Judges*.
ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 6 and 10 through 12 in this reexamination proceeding. Claims 1 through 5, 7 through 9 and 13 have been indicated by the examiner as being patentable.

¹ Reexamination filed November 22, 1995. This is a reexamination of Application 05/774,677 filed March 7, 1977, now U.S. Patent No. 4,196,901 issued April 8, 1980.

Appeal No. 97-3348
Reexamination No. 90/004,036

The appellant's invention is directed to a tennis racquet in which the percussion center of the racquet is advanced toward the tip end. The subject matter before us on appeal is illustrated by reference to claim 6, which appears in an appendix to the Appeal Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

LaCoste	3,086,777	Apr. 23, 1963
Frolow	4,165,071	Aug. 21, 1979

THE REJECTION

Claims 6 and 10 through 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over LaCoste in view of Frolow.

The rejection is explained in Paper No. 7.

The opposing viewpoints of the appellant are set forth in the Appeal Brief and the Reply Brief.

OPINION

Independent claim 6 stands rejected as being unpatentable over the teachings of LaCoste in view of Frolow. It is the examiner's view that LaCoste discloses the type of tennis racquet set forth in the first portion of claim 6, lacking only the

Appeal No. 97-3348
Reexamination No. 90/004,036

"spacer means weighing less than one ounce," a feature which one of ordinary skill in the art would have found obvious to incorporate into the LaCoste racquet by virtue of the teachings of Frolow (Paper No. 7, pages 2 and 3). The appellant argues in rebuttal that there is no suggestion to combine the references in the manner proposed by the examiner, and that even if the two references were to be combined, the result would not render the claimed subject matter obvious.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5

Appeal No. 97-3348
Reexamination No. 90/004,036

USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).
It is here where the examiner's rejection fails, and we therefore
will not sustain the rejection.

We agree in principle with the arguments in opposition to
the examiner's position which the appellant has set forth on
pages 4 through 9 of the Brief that the combined teachings of
LaCoste and Frolow would not have suggested the invention recited
in claim 6 to one of ordinary skill in the art. The examiner
bases the rejection upon the statements in Frolow that a
reduction in weight in the throat portion of a racquet will
improve performance. However, claim 6 requires more than this in
that the spacer means must weigh less than one ounce, and we
cannot agree with the examiner that there is any teaching in
either of the references which would have suggested this
limitation. In particular, it is our view that the mere fact
that Frolow's frame tubing is disclosed as being 0.16 oz/inch
does not suggest that this be the case in LaCoste, for the Frolow
racquet is of a markedly different construction, in which the
frame, the spacer means, and the handle are separate elements
joined together by rivets and plates, as opposed to the LaCoste
one-piece frame and handle with its welded spacer means. For
this reason, as well as those discussed in detail in the

Appeal No. 97-3348
Reexamination No. 90/004,036

appellant's Brief, it is our view that one of ordinary skill in the art would not have found suggestion in the teachings of these two references to modify the LaCoste spacer means to meet the terms of claim 6, and therefore the combined teachings of the two references fail to establish a *prima facie* case of obviousness with regard to the subject matter of this claim. We therefore will not sustain the rejection. It follows that we also will not sustain the rejection of claims 10 through 12, which depend from claim 6.

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge))	
)	
)	
NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge))	

Appeal No. 97-3348
Reexamination No. 90/004,036

Walter Scott
Law Office of Walter Scott
P.O. Box 121
New York, NY 10025