

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte REGIS T. KEELAN

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Appeal No. 2001-1400  
Application No. 08/989,320

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ON BRIEF

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Before CALVERT, ABRAMS, and FRANKFORT, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 10, 12, 22 to 24 and 26, all the claims remaining in the application.

The subject matter in issue is defined by claim 10, the only independent claim on appeal, as:

10. A putter head with a striking face, comprising:

a body made from a uniform composition of a plastic base with a metal filler, with the metal filler being between fifty and ninety-five percent by weight of the composition and the



In Fig. 3, Bulla shows a set of clubs, the faces of each varying from a 9° slope to a 45° slope. According to the patentee (col. 2, lines 25 to 29 and 45 to 50):

As the slope of the heads increases, the volume of the plastic material **19** decreases and the lengths of the shafts decrease. The heads must be increased in weight so as to have all of the clubs of the set provide a like weight of swing to each of the clubs.

\* \* \* \* \*

By increasing the amount of metal filler within the material of a head which has decreased mass and a face of greater slope in the series, the heads become increasingly heavy, and as the shafts decrease in length, the weight of swing of the clubs will be uniform throughout the set.

Concerning the amount of metal filler to be used, Bulla states at col. 3, lines 12 to 20:

In general, it has been found that at least 25% by weight of the total weight of plastic composition should comprise metal filaments in order to appreciably improve the thermal conductivity, strength, impact resistance and other desired properties. Except in special circumstances it has been found that the range of the metal filler in the binder may vary throughout the series of clubs from 25% to as much as 75%.

Bulla then discloses at col. 3, lines 45 to 49 concerning the putter:

It is also within the purview of the invention to form a putter out of the same plastic material with a face which slopes at an angle of substantially 5° to provide a "feel" to the putter that will correspond to that of the other clubs of the set.

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Appellant, noting Bulla's disclosure, quoted above, to the effect that as the slope of the club face increases, the amount of metal filler increases, argues that Bulla's putter, having a face which slopes only 5°, would have the least amount of metal filler (presumably 25%). He also asserts that since Bulla wishes to have a traveling shock wave which returns to the face as the ball leaves the club, and metal fillers impede the movement of a shock wave through the material, one of ordinary skill would tend to use less metal filler in the Bulla clubs, rather than more.

After fully considering the record in light of the arguments presented in appellant's brief and reply brief, as well as in the examiner's answer, we conclude that claim 1 is prima facie obvious over Bulla.

We do not find appellant's arguments concerning Bulla to be persuasive, because one of ordinary skill would have known that the design considerations for a putter would be different from those applicable to the other clubs in a set. A putter is a specialized club, which unlike the other clubs in a set is not used to drive the ball. Therefore, it would have been obvious to one of ordinary skill that Bulla's disclosure concerning application of a shock wave to the ball for maximum striking force (col. 1, lines 50 to 56) would not be a consideration

where the putter was concerned. Likewise, we do not believe that one of ordinary skill would necessarily regard Bulla's disclosure concerning the relationship of the amount of metal filler to the slope (angle) of the club face as being applicable to the putter. In this connection, we note that Bulla does not include the putter when discussing the set of clubs with different face angles shown in Fig. 3, but rather refers to the putter subsequently, as a separate item.

Bulla does not disclose the shape of the head of the putter.<sup>2</sup> If the Bulla putter head were the shape of a conventional blade putter, as shown by appellant in Fig. 2a (specification, page 4, lines 16 to 19), the volume of its head would evidently be smaller than the volume of the heads of the other clubs in the set, so that in order to provide a "feel" for the putter (i.e., a weight of swing) corresponding to that of the other clubs, as taught by Bulla at col. 3, lines 45 to 49, supra, one of ordinary skill would have to use a larger proportion of metal filler than was used with the other clubs. Thus, Bulla's disclosure concerning increasing the proportion of metal filler

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<sup>2</sup> Appellant states at page 5, line 16, of the brief that Bulla teaches that his putter should be spherical in shape, but we find no such disclosure in the patent.

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with increasing club face angle would not apply to the putter.

As for claims 12, 22 to 24 and 26, which recite that the metal filler is a powder, appellant argues at pages 5 to 7 of the reply brief that Bulla teaches that a metal powder is undesirable. We do not agree, since Bulla specifically discloses at col. 1, line 64, and col. 4, line 18, that the metal filler may be a powder. Moreover, all disclosures of the prior art, including unpreferred embodiments, must be considered in determining obviousness. In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979).

In In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), the Court stated:

The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range.

In the present case, appellant filed a declaration on Feb. 25, 2000 (Paper No. 17) which he contends provides "objective evidence of unexpected superior results found in the putter of the present invention" (reply brief, page 8). We will consider the declaration to determine whether it is sufficient to rebut

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the prima facie case of obviousness.<sup>3</sup> See In re Geisler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997). See also In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (after a prima facie case of obviousness has been established, the evidence in support thereof must be evaluated along with appellant's rebuttal evidence to reach a final conclusion of obviousness or non-obviousness).

In the declaration appellant refers to articles from the magazines Golf Today (Oct. 1998) and GolfNews (Jan. 2000) in which a putter having a head as defined in claim 1 was evaluated. These articles praise the putter (formerly called the TruPutt, now the Marquee) as giving straighter putts, with more feel and control (Golf Today), and superb feel and roll off the clubhead (GolfNews). However, we do not regard them as establishing that the results obtained from the putter were unexpected, because "when unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared with the closest prior art." In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991). Here, it might be

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<sup>3</sup> Appellant also submitted copies of two e-mails (Exhibits A and B) with his reply brief, but these will be given no consideration since they were not accompanied by a showing under 37 CFR § 1.195.

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said that, at the most, the Golf Today and GolfNews evaluators found the claimed putter head to be superior to putters in general; they did not, however, compare it to the Bulla putter, which would be the closest prior art. The declaration therefore does not establish that the claimed 50% to 95% range of metal filler achieves unexpected results relative to the closest prior art (Bulla).

Appellant also states in paragraph 14 of the declaration that the putter is experiencing commercial success, but this is simply a conclusory statement which is not supported by any evidence. Cf. In re Huang, 100 F.3d 135, 139, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996).

Accordingly, after considering all the evidence, we conclude that the putter defined in claims 10 and 12 would have been obvious over Bulla, and the rejection will be sustained.<sup>4</sup>

#### Conclusion

The examiner's decision to reject claims 10, 12, 22 to 24 and 26 is affirmed.

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<sup>4</sup> Claims 12, 22 to 24 and 26 fall together, having been designated by appellant on page 1 of the reply brief as a single group.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
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NEAL E. ABRAMS	)	APPEALS AND
Administrative Patent Judge	)	
	)	INTERFERENCES
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CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	

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