

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HISASHI YAMAGISHI,
HIROSHI HIGUCHI,
JUNI HAYASHI and AKIRA KAWATA

Appeal No. 2002-0080
Application No. 09/170,216

ON BRIEF

Before PAK, KRATZ, and JEFFRY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-6 as amended after final rejection. No other claims are pending in this application.

OPINION

We refer to the appellants' brief and reply brief and to the answer for the opposing viewpoints expressed by appellants and the examiner concerning the above noted rejection.¹ For the reasons which follow, we will sustain the examiner's § 102(e) rejection.

Initially, we note that appellants have indicated that the claims "can be considered as a group" (brief, page 4). We therefore limit our discussion to one claim, i.e., claim 1. See In re Ochiai, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c)(7) (1999).

Furthermore, we observe that anticipation by a prior art reference does not require that reference to recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim

¹ In Paper No. 16, the examiner noted that the reply brief was considered. The additional comments concerning the reply brief set forth in that paper have not been considered since such comments are inappropriate absent express authorization by a panel of this Board pursuant to 37 CFR § 1.193(b)(1).

when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)). However, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Anticipation under this section is a factual determination. See In re Baxter Travenol Labs., 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)). In the case before us, the examiner has determined that Yamagishi discloses, either expressly or inherently, a golf ball meeting every limitation of the invention set forth in representative claim 1.

Appellants' arguments with respect to the examiner's determination as to the correspondence of the applied reference to the subject matter of representative claim 1 are essentially limited to the contention that "the artisan would not construe

the prior art as comprising a golf ball having a single solid core" (brief, page 5).² In this regard, appellants (brief, page 5) contend that the golf ball "core is defined as a single layer" in appellants' claims by the claim language requiring a three piece solid golf ball and "[a] single solid core and a cover of two-layer structure consisting of an inner layer and an outer layer."

The examiner, on the other hand, has found that the claim language does not exclude a golf ball having a two layer core together with inner and outer cover layers as described in Yamagishi.

Therefore, we must analyze the claim language to determine the scope and meaning of each contested limitation. See Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). During examination proceedings, claim language is given its broadest reasonable interpretation consistent with the specification as it would have been interpreted by one of ordinary skill in the art. See In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995).

² We consider the propriety of the examiner's rejection in light of the arguments made by appellants in the brief. See 37 CFR § 192(a).

Here, we observe that the claims on appeal require a three piece golf ball comprising a single solid core with a specified deflection property, a cover inner layer and a cover outer layer, with each such cover layer having a specified hardness and thickness. See the sole independent claim 1.³ We determine that the ordinary meaning of the term "three piece" and "single" as used in appellants' claims requires that the golf ball be made of three pieces, including a single solid core and two cover layers.⁴ However, the single solid core is not limited to a single **layer** core as urged by appellants but rather a single solid core that may comprise either a single layer or a multi layer core. See page 4, lines 10-14 and 19-21, page 5, lines 16-29, page 6, lines 4-7, and page 8, lines 31-34 of appellants' specification. Consequently, our claim construction is

³ We note that dependent claim 2 appears to recite a broader range for the hardness of the cover outer layer than provided for in independent claim 1 raising an issue with respect to the proper dependent status thereof which should be addressed by appellants and the examiner in the event of further prosecution of this application.

⁴ Appellants do not argue with the examiner's determination that Yamagishi discloses, either expressly or inherently, a golf ball meeting every limitation of the invention set forth in representative claim 1 including the core deflection property and inner and outer cover layer hardness and thickness parameters but for the "three piece" and "single core" limitations.

consistent with the requirement that the claims of the application be given the broadest reasonable interpretation consistent with the specification as they would be construed by one of ordinary skill in the art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). We further observe that the above-noted description in appellants' specification is not inconsistent with the solid core described at column 5, lines 20-27 of Yamagishi. Also, see the golf ball described in Table 1, Example 6 of Yamagishi.

It follows that, on this record, we shall sustain the examiner's anticipation rejection.

CONCLUSION

The decision of the examiner to reject claims 1-6 under 35 U.S.C. § 102(e) as being anticipated by Yamagishi is affirmed.

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

AFFIRMED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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APPEAL NO. - JUDGE KRATZ
APPLICATION NO.

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DECISION: **ED**

Prepared By:

DRAFT TYPED: 25 Aug 04

FINAL TYPED: