

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BRENDA ERDOES and JEFF ERDOES

Appeal No. 2002-1062
Application No. 09/285,607

HEARD: September 17, 2002

Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4. Claims 5 and 6 have been withdrawn by the examiner as being directed to a non-elected invention.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a mat for simulated golf putting. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Anderson <u>et al.</u> (Anderson)	3,595,581	Jul. 27, 1971
Lorraine	3,601,407	Aug. 24, 1971
Trigg <u>et al.</u> (Trigg)	4,273,329	Jun. 16, 1981

Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lorraine in view of Anderson.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lorraine in view of Anderson and Trigg.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 10) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 8) and Reply Brief (Paper No. 11) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Claims 1, 3 and 4 stand rejected as being obvious¹ in view of the combined teachings of Lorrance and Anderson. It is the examiner's view that all of the subject matter recited in these claims is disclosed by Lorrance except for the requirement for forming a protrusion on the top surface of the mat. However, the examiner has taken the position that it would have been obvious to one of ordinary skill in the art to modify the Lorrance structure in such a manner as to provide this feature, in view of the teachings of Anderson.

¹A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references, rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see, for example, Cable Elec. Prods. v. Genmark, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see In re Bozak, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see In re Sovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom (see In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

With regard to claim 1, we first point out that this claim is directed to a golf mat, and not to the combination of a golf mat and a peg. The Lorraine mat comprises a fabric layer 17 backed by flexible panels 14 and a cushioning layer 18. While the mechanism for altering the surface of the Lorraine mat has the stated objective of causing depressions in the surface of the mat and differs from that disclosed by the appellants, the mat nevertheless has a plurality of holes (unnumbered, but through which link rods 25 extend) in the bottom surface that in our view are “suitable to receive” a peg of solid material, which is all that the claim requires. Since the upper fabric surface and its supporting panels are flexible, the Lorraine mat is capable of having a protrusion created therein.

It therefore is our conclusion that all of the subject matter recited in claim 1 is disclosed by Lorraine. Anticipation being the epitome of obviousness (see In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982)), we will sustain the rejection of claim 1, considering Anderson merely to be confirmatory that it was known in the art at the time of the appellants’ invention to provide simulated golf putting mats with protrusions as well as depressions.

Claim 3 is directed to the combination of a mat of construction essentially the same as that of claim 1 and a peg inserted into a hole in the bottom of the mat in such a manner that the upper surface of the mat adjacent the hole is deformed upwardly so as to create a protrusion on the top surface of the mat. The comments we made above

regarding the structure disclosed by Lorrance in claim 1 also are applicable to claim 3. In addition, notwithstanding the appellants' arguments to the contrary, it is our view that Lorrance's link rods 25 fall within the definition of a "peg" provided by the appellants on page 5 of the Brief in that they are "fitted into something," namely, the hole through which they extend. It is not necessary, in our view, for a "peg" to be press (friction) fit into the hole in which it is installed, which appears to be the thrust of the appellants' argument on this issue, considering that the common applicable definition of "fit" or "fitted" includes "suitable for," "conform to," and "to be accommodated,"² none of which require a press fit. In this regard, we point out that there is no language in claim 3 that requires the peg to be pressed or even closely fitted into the hole.

As is the case in the claimed invention, the holes in the Lorrance mat do not penetrate the top surface. We acknowledge that, as disclosed, the rods on the Lorrance invention are operated in such a manner as to create depressions in the upper surface of the mat adjacent the holes. Thus, the reference fails to disclose or teach that the rods operate in such a manner that the upper surface of the mat is deformed upwardly in the area adjacent the holes so as to create a protrusion.

The objects of the Lorrance invention include providing a game device having "a variable elevation playing surface" (column 1, lines 56-57) and a game device and "means for adjusting the elevation and curvature of its playing surface at any one or

²See, for example, Webster's New Collegiate Dictionary, 1973, page 434.

more of a plurality of locations” (column 1, lines 61-62). Anderson, which also is directed to a green for use in a golf game, has an analogous objective, stating “wherein the contour of the golf green may be selectively altered to provide the contour of each of several differing natural greens on a golf course” (column 1, lines 35-38). Anderson accomplishes this by suitable adjustment of a plurality of jacks which support the playing surface from below and may be extended to varying distances (column 3, lines 32-45). As can clearly be appreciated from Figure 3, adjustment of the jacks can cause depressions to be created in the surface in the area adjacent to the jacks, such as is shown on the right side of the drawing, as well as protrusions in the surface, as illustrated on the left side.

It is our conclusion that it would have been obvious to one of ordinary skill in the art to modify the surface adjustment mechanism of the Lorraine putting green so that it in addition to deforming the surface downwardly to create depressions, as disclosed, it can deform the surface upwardly to create protrusions, suggestion being found in the explicit teaching of Anderson that both can be provided on the same mat. This being the case, the combined teachings of Lorraine and Anderson establish a prima facie case of obviousness with regard to the subject matter of claim 3, and we will sustain the rejection.

Claim 4 adds to claim 3 the requirement that “the peg depends upwardly toward the top surface of the mat from an enlarged base³ which does not penetrate into the mat.” In Lorraine the rods depend upwardly from bars 22, which in our opinion constitute “an enlarged base which does not penetrate into the mat.” It should be recognized that claim 4 does not require that the peg itself comprise an “enlarged base,” but only that the peg “depends upwardly” from an enlarged base. We will sustain the rejection of claim 4.

Claim 2 depends from claim 1, and recites “wherein an elongate measuring cord is affixed within the hole suitable to receive a golf ball” (emphasis added). Trigg discloses a multi-use golf tool having an elongate measuring cord. To utilize the measuring feature, the Trigg tool is temporarily attached by means of a clip (50) to the flag stick (64) that extends upwardly out of the hole. As such, the Trigg measuring cord is not “affixed within” the hole, as required by this claim. A prima facie case of obviousness therefore has not been established with regard to claim 2, and we will not sustain the rejection.

We have carefully considered all of the appellants’ arguments. However, they have not convinced us that the examiner’s rejections of claims 1, 3 and 4 were in error. While we appreciate that the golf putting greens disclosed in Lorraine and Anderson

³The recitation of the claim in the appendix to the Brief erroneously recites “from and enlarged base.” See page 10 of the specification.

are more complex than that of the appellants' invention as disclosed, we share the examiner's opinion that the combined teachings of the two references establish that the invention as claimed would have been obvious to one of ordinary skill in the art. In this regard, it also should be recognized that the claims are presented in "comprising" format, and it is well settled that the use of the term "comprising" in a claim opens the claim to inclusion of elements or steps other than those recited in the claim. In re Hunter, 288 F.2d 930, 932, 129 USPQ 225, 226 (CCPA 1961).

SUMMARY

The rejection of claims 1, 3 and 4 is sustained.

The rejection of claim 2 is not sustained.

The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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Appeal No. 2002-1062
Application No. 09/285,607

Page 10

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