

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID B. HUEBER

Appeal No. 2004-0099
Application No. 09/388,663

ON BRIEF

Before ABRAMS, FRANKFORT, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 16-28, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a golf club metal wood (claims 22 and 25-28), and to sets of golf club metal woods (claims 16-21). An understanding of the invention can be derived from a reading of exemplary claim 22, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:¹

Davis	5,228,688	Jul. 20, 1993
Muldoon	5,421,098	Jun. 6, 1995
Kobayashi	5,421,577	Jun. 6, 1995
Cheng	5,643,108	Jul. 1, 1997
Eberle	5,779,559	Jul. 14, 1998
Cook <u>et al.</u> (Cook)	5,879,241	Mar. 9, 1999

Claims 16-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Davis in view of Kobayashi, Muldoon, Cheng, Cook and Eberle.²

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 21) and the final rejection (Paper No. 16) for the examiner's complete

¹In the Answer the examiner listed ten patents which were "not relied upon but cited to develop what is known in the art by one skilled in the art at the time of the invention" (Answer, page 3). Since these references were not applied against the claims in the statement of the rejection but merely were mentioned as a group in the examiner's response to the appellant's argument (Answer, page 23), we have not considered them.

²Cheng, Cook and Eberle actually were applied only against claim 16.

reasoning in support of the rejection, and to the Brief (Paper No. 20) and Reply Brief (Paper No. 22) for the appellant's arguments thereagainst.

OPINION

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

The appellant's invention is directed to golf clubs of the type known as "metal woods," that is, clubs that have the shape of conventional woods but are made of metal. The object of the invention is to provide individual golf clubs, or sets of golf clubs, equivalent to the standard 2, 3, 4, 5 and 6 irons with regard to distance of travel, but which incorporate the desirable features of a metal wood on a short shafted club. According to the appellant, the shorter shaft provides for increased control and consistency of shots, the greater club head mass and weight provide for easier penetration of the club head through grass or sand than a club of the same weight that is of the conventional length, and the combination of the features recited in the invention provides a set of clubs with the same swing weight as the equivalent standard irons while having the aforesaid advantages over the standard irons. See specification, pages 1-5.

Claim 22, which is directed to a single club, recites the invention in the following manner:

A golf club metal wood having a shaft approximately 38.5 inches in length, a club head weight of approximately 259 to 279 grams, a loft of approximately 17 degrees and a lie of approximately 60 degrees.³

Claim 22 stands rejected as being obvious⁴ in view of the combined teachings of Davis, Kobayashi and Muldoon. In arriving at this conclusion and with particular reference to Table I, the examiner has found that Davis discloses all of the subject matter recited in the claim except for the metal wood head and the specified amount of loft and lie. The examiner relies upon the teachings of Kobayashi as the basis for concluding it would have been obvious to one of ordinary skill in the art to modify the Davis irons by replacing the blade heads with iron wood heads, and upon those of Muldoon for concluding it would have been obvious to further modify the Davis irons by

³"Loft" is the angle made by the face of the club head when grounded and "lie" is the angle of the shaft relative to the ground when the club head is grounded (specification, pages 1 and 2).

⁴The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, 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 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

decreasing the angle of loft by 7 degrees and increasing the angle of lie by 3 degrees in order to meet the terms of the claim. The appellant argues in rebuttal that there is no suggestion to modify the Davis club in the manner proposed by the examiner.

Even assuming, arguendo, that it would have been obvious to one of ordinary skill in the art to modify the Davis irons by replacing the blade heads with metal wood heads in view of the teachings set forth in column 1 of Kobayashi, we cannot agree with the examiner that it would have been obvious in view of Muldoon to further modify the Davis clubs by changing the loft and lie angles to those specified in claim 22. Muldoon is directed to an apparatus for adjusting the loft and lie of a golf club by manipulating the club shaft with respect to the head, that is, bending the shaft to change the loft and lie angles. The purpose of the Muldoon methods and apparatus is “personalizing” the club for a particular golfer by measuring the optimum loft and lie of a club for that golfer, and then adjusting the shaft with respect to the head to meet these personalized needs (column 2). There is no mention in Muldoon of the loft and lie angles recited in the appellant’s claim 22, nor in our opinion is there any teaching that would have directed one of ordinary skill in the art to decrease the loft in the Davis 3 iron from 24 degrees to the “approximately 17 degrees” recited in claim 22, or to increase the lie from 58 degrees to “approximately 60 degrees.” If it is the examiner’s contention that the obviousness is vested on the fact that this might possibly occur in practicing the Muldoon invention with regard to a particular golfer, such a conclusion is mere

speculation. The fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive in the applied references which would have led one of ordinary skill in the art to modify the Davis 3 iron in the manner proposed by the examiner, other than the hindsight afforded one who first viewed the appellant's disclosure. That, of course, is not a proper basis for a rejection. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

It therefore is our conclusion that the combined teachings of Davis, Kobayashi and Muldoon fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 22, and we will not sustain the rejection.

Independent claims 25, 26, 27 and 28 also are directed to single clubs. In rejecting each of these claims, the examiner has referred to an iron in Davis' Table I, has admitted that Davis fails to disclose or teach the claimed metal wood head and the specified loft and lie, and has looked to Kobayashi for the suggestion to substitute a metal wood head and to Muldoon for the teaching of changing the loft and lie to those specified in the claim in order to customize clubs for a particular golfer. For the reasons expressed above in our refusal to sustain the rejection of claim 22, we do not agree with the examiner that one of ordinary skill in the art would have been motivated to modify

the loft and lie of the Davis clubs in such a manner as to meet the terms of each of claims 25, 26, 27 and 28. The rejection of claims 25-28 is not sustained.

Independent claim 17 is directed to a set of at least two correlated golf club metal woods, the first club recited being the one to which claim 22 is directed and the second the one set forth in claim 25. Dependent claims 19 and 20 add to claim 17, seriatim, the clubs singularly recited in claims 26, 27 and 28. Independent claim 21 is directed to a set of three correlated golf club metal woods, the first being the same as that set out in claim 22, and the other two being described in terms of differences in shaft length, loft, and lie from the club of claim 22 and from one another. Dependent claims 23 and 24 add more clubs to the set of claim 21, also described in terms of differences between the previously described clubs. The rejection of all of these claims is on the basis of Davis, Kobayashi and Muldoon, and it cannot be sustained for the reasons expressed above with regard to the other similarly rejected claims.

Independent claim 16 recites a set of five clubs comprising the clubs individually described in claims 22 and 25-28. Claim 16 stands rejected as being unpatentable over Davis, Kobayashi and Muldoon, applied as against the other claims, taken further with Cheng, Cook and Eberle. Cheng is cited for teaching that a heavier club has more impact energy but is more difficult to swing, Cook for disclosing a set of irons whose shaft lengths differ by 0.5 inches, and Eberle for teaching that the length of a club shaft is dependent upon the height of a golfer. Be that as it may, the latter three references

do not overcome the problem in combining Davis, Kobayashi and Muldoon to meet the
loft and lie requirements recited in the claim for each club of a particular length. We
therefore will not sustain this rejection.

CONCLUSION

The rejection is not sustained.

The decision of the examiner is reversed.

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

NEA/lbg

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