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precedent of the Board

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK L. BINETTE, MICHAEL J. SULLIVAN,
THOMAS J. KENNEDY, III, MICHAEL J. TZIVANIS,
VIKTOR KELLER and WILLIAM M. RISEN, JR.

Appeal No. 2004-1225
Application 09/840,312

ON BRIEF

Before GARRIS, WALTZ, and PAWLIKOWSKI, Administrative Patent
Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the
examiner's final rejection of claims 1-39.

On pages 3-4 of the brief, appellants group the claims as
set forth therein. In view of the groupings set forth by
appellants, we consider claims 1, 14 and 27 in this appeal. We
also consider any claim separately argued by appellants, e.g.,
claim 4, in regard to PGA compression values of the core. See
37 CFR § 1.192(c)(7) and (8) (2003). Claims 1, 14, and 27 are
appended to this opinion.

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The examiner relies upon the following references as evidence of unpatentability:

Isaac	4,770,422	Sep. 13, 1988
Wu	6,392,002	May 21, 2002

Claims 1-3, 6-16, 19-29 and 32-39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Wu.

Claims 4, 5, 17, 18, 30, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu in view of Isaac.

OPINION

I. The 35 U.S.C. §102(e) Rejection¹

In this rejection, we consider claims 1, 14, and 27.

On page 6 of the brief, appellants argue that Wu does not disclose a golf ball comprising a core, and a multiple layer cover wherein both cover layers comprise a polyurethane and have a Shore D hardness of less than 60. Claim 1 requires that the first cover layer exhibits a Shore D hardness of less than 60 and that the second outermost cover layer exhibits a Shore D hardness of less than 60. Claim 14 also requires a Shore hardness of less than 60 for the first cover layer and second outermost cover layer. Claim 27 also requires that each of the layers exhibits a Shore D hardness of less than 60.

Appellants state that Wu teaches " . . . at least one of the layers is formed from a polyurethane composition . . . ". Brief,

¹ Wu has a U.S. filing date of Dec. 3, 1999. Appellants have not contested Wu on the issue of qualifying prior art under §102(e). Hence, we treat Wu as qualifying prior art.

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page 5. Appellants argue that Wu does not teach that each layer has a Shore D hardness of less than 60. Brief, page 6.

Beginning on page 5 of the answer, the examiner finds that Wu discloses that the intermediate layer and/or cover layers of the golf ball of Wu is formed of a polyurethane composition. The examiner refers to column 6, lines 54-58. Appellants do not dispute that Wu discloses that the intermediate and cover layers are formed of a polyurethane composition. Brief, page 5. In fact, as pointed out by the examiner, Wu discloses example cover layers as having Shore D hardness values of 52, 54, and 55 (Table 2 of Wu). Answer, pages 3-4.

We note that it is well settled that the Patent and Trademark Office can require appellants to prove that a function or property relied upon for novelty is not possessed by prior art compounds otherwise meeting the limitations of the claims. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Here, each of claims 1, 14, and 27 recite that the first cover layer comprises a majority portion by weight of a composition selected from the group consisting of polyurethane, polyureas and blends thereof. Claim 1 additionally requires that the second outermost layer comprises a majority proportion by weight of a polyurethane. Claim 27 requires that the second outermost cover layer comprises a majority proportion by weight of a composition selected from the group consisting of polyurethane, polyureas and blends thereof. Hence, the claims do not differ from Wu's disclosed polyurethane composition. Thus, it is appellants' burden to show that the property of Shore D hardness of less than 60 is not possessed by Wu. Id. We need not evaluate Wu's examples or tables in making this determination. In this context, we note that a reference is not limited to its examples, but is available for all that it fairly discloses and suggests. See In re Widmer, 353 F.2d 752, 757,

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147 USPQ 518, 523 (CCPA 1965). Because appellants do not provide such evidence showing that the polyurethane layers of Wu do not each possess a Shore D hardness of less than 60, we agree with the examiner's conclusion in this rejection.

In view of the above, we therefore affirm the 35 U.S.C. §102(e) rejection.

II. The 35 U.S.C. § 103 Rejection

On pages 7-8 of the brief, appellants do argue the limitations of the dependent claims with regard to the PGA compression values of the core. Hence, to the extent the patentability of these claims are argued, we do consider them.

We refer to our determinations made with regard to Wu, discussed above, and add the following additional comments.

Appellants argue that Isaac discloses a golf ball having a core and a cover, and the golf balls, not the cores, have a PGA compression of 50-110. Appellants also argue that Isaac does not specifically disclose a golf ball core having a PGA compression of no more than 85, nor does Isaac recognize the benefit of a golf ball having a core PGA compression of no more than 85. Appellants additionally argue that there is no motivation to combine Wu and Isaac. Appellants state that one skilled in the art would not be motivated to combine a two-piece solid golf ball with a golf ball comprising a center, a cover, an optionally an intermediate layer, wherein the golf ball disclosed is a wound golf ball. Brief, pages 6-8.

On page 7 of the answer, the examiner's rebuttal is that one of ordinary skill in the art would know that many golf ball cores are made from soft materials, while the outer layers are made from harder materials that increase the PGA compression for the entire golf ball to the recommended range. The examiner states that since the recommended PGA compression for a complete golf

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ball is from 80-100, the PGA compression for the cores would inherently be less than the recommended range for the complete golf ball. Appellants do not dispute this statement made by the examiner.

We find, in column 10 at lines 1-19 of Wu, that the cores of the golf balls of Wu can be solid, hollow, fluid filled, or semi-solid filled, one-piece or multicomponent cores or wound. Therefore, appellants' statement that the golf ball of Wu is restricted to a wound golf ball is incorrect. We again note that a reference is not limited to its examples, but is available for all that it fairly discloses and suggests. See In re Widmer, supra. Hence, we are unpersuaded by appellants' argument in this regard.

We reiterate the examiner's statement that it is known that the recommended PGA compression for a complete golf ball is from 80-100. We also observe on page 2, beginning at line 13 of appellants' specification, it is disclosed that when a multi-layer cover is employed, it is known that each cover layer traditionally has a significantly different Shore D hardness than an adjacent cover layer, in order to impart to the golf ball a particular desired combination of spin and distance characteristics. Hence, it is known to choose particular properties to achieve particular results, and therefore, absent evidence to the contrary, we determine that the skilled artisan would have known to select the claimed PGA compression values of the core (result effective variables) for achieving certain PGA compression requirements. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Furthermore, we also observe, in Isaac, that Example 2 shows cores having a PGA compression of 68 in which no cracking occurred. See column 3, lines 50-55. Hence, Isaac teaches appellants' claimed PGA compression value of a core.

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In view of the above, we determine the examiner has presented a prima facie case of obviousness.

III. Other Issues

Upon return of the application to the jurisdiction of the examiner, review of the record of U.S. Application S.N. 10/074,849 and Appeal No. 2004-1184 is in order, along with review of the following references:

Nesbitt	4,431,193	Feb. 14, 1984
Sullivan	6,667,001 B2	Dec. 23, 2003
Sullivan	5,803,831	Sep. 8, 1998
Kennedy, III	6,648,777 B2	Nov. 18, 20003
Kennedy III	6,290614 B1	Sep. 18, 2001
Yabuki	6,359,066 B1	Mar. 19, 2002
Sullivan	5,098,105	Mar. 24, 1992
Sullivan	6,213,894 B1	Apr. 10, 2001

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IV. Conclusion

Each of the rejections 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

Bradley R. Garris)	
Administrative Patent Judge)	
)	
)	
)	
Thomas A. Waltz)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
)	
Beverly A. Pawlikowski)	
Administrative Patent Judge)	

BAP/cam

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The Top-Flite Golf Co.
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APPENDIX

1. A golf ball comprising:

a core;

a first cover layer disposed about said core, said first cover layer comprising a majority proportion by weight of a composition selected from the group consisting of polyurethane, polyureas and blends thereof, said first cover layer exhibiting a Shore D hardness of less than 60; and

a second outermost cover layer disposed on said first cover layer, said second cover layer comprising a majority proportion by weight of a polyurethane, said second cover layer exhibiting a Shore D hardness of less than 60.

14. A golf ball comprising:

a core;

a first cover layer disposed about said core, said first cover layer comprising a majority proportion by weight of a composition selected from the group consisting of polyurethane, polyureas and blends thereof, said first cover layer exhibiting a Shore D hardness less than 60; and

a second outermost cover layer disposed on said first cover layer, said second cover layer exhibiting a Shore D hardness of less than 60.

27. A golf ball comprising:

a core;

a first cover layer disposed on said core, said first cover layer exhibiting a Shore D hardness of less than 60; and

a second outermost cover layer disposed on said first cover layer, said second cover layer comprising a majority proportion by weight of a composition selected from the group consisting of polyurethane, polyureas and blends thereof, said second cover layer exhibiting a Shore D hardness of less than 60.