

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was not written for publication and is not binding  
precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte Mark L. Binette et al.

---

Appeal No. 2004-1399  
Application No. 09/777,595

---

ON BRIEF

---

Before WINTERS, GRON, and LORIN, Administrative Patent Judges.  
GRON, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

This is an appeal under 35 U.S.C. § 134 from an examiner's  
final rejection of Claims 1-27, which are all the claims pending  
in U.S. Application No. 09/777,595, filed February 6, 2001.

Appeal No. 2004-1399  
Application No. 09/777,595

Introduction

Claims 1-27 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Saito, U.S. Patent No. 4,919,434, patented April 24, 1990; Cavallaro et al. (Cavallaro I), U.S. Patent No. 5,810,678, patented September 22, 1998; and Cavallaro et al. (Cavallaro II), U.S. Patent No. 5,947,842, patented September 7, 1999. Appellant stated that Claims 1-9 stand or fall together, Claims 10-17 stand or fall together, and Claims 18-27 stand or fall together. (Appeal Brief, Paper No. 16, pages 3-4). Independent Claims 1, 10, and 18 read as follows:

1. A golf ball comprising: a core; and a cover enclosing said core, wherein said cover includes at least one layer comprising an outermost layer having a thermoplastic material, a thickness of less than 0.040 inches, a Shore D hardness of at least about 56 and a Shore D hardness at least as hard as a layer disposed between said outermost layer and said core.

10. A golf ball comprising: a core; and a cover comprising an inner layer and an outermost layer disposed about said inner layer comprising a thermoplastic material, a thickness of less than about 0.040 inches, a Shore D hardness of at least about 56 and a Shore D hardness at least as hard as said inner layer.

18. A golf ball comprising: a core; a wound layer; wherein said cover includes an outermost layer that comprises a thermoplastic material, said outermost layer having a thickness less than about 0.040 inches, a Shore D hardness at least about 56 and a Shore D hardness at least as hard as a layer disposed between said outermost layer and said core.

Appeal No. 2004-1399  
Application No. 09/777,595

We have considered the appellant's specification and claims, the applied prior art, and the positions of the examiner and the appellant. We conclude that the prior art teaching is sufficient to establish a prima facie case of obviousness under 35 U.S.C. § 103(a) for the invention defined by Claims 1-27. Appellant has presented no objective evidence of nonobviousness. Accordingly, we affirm the examiner's final rejection.

#### Discussion

"The PTO has the burden under section 103 to establish a prima facie case of obviousness." In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Claims 1 and 10 are directed to a golf ball comprising a core and a cover. The cover has an outermost layer with a thickness of less than .040 inches and a minimum Shore D hardness of "about 56." The outermost layer is at least as hard as a layer between the core and outermost layer.

Saito, Cavallaro I, and Cavallaro II have been cited as evidence that appellant's claimed invention would have been obvious to one of ordinary skill in the art at the time the application was filed. Saito would have taught persons skilled in the art to make and use a golf ball comprising (1) a core and (2) a thermoplastic cover that includes at least one layer with

Appeal No. 2004-1399  
Application No. 09/777,595

the hard outermost layer having a thickness of less than .040 inches. (Saito, column 9, lines 36-46). Saito does not specify hardness parameters for the outermost layer, however Cavallaro II shows the degree of hardness required for golf ball covers. Cavallaro II discloses a cover with a Shore D hardness of at least 65. (Cavallaro II, column 16, line 4). Additionally, Cavallaro II teaches an outermost layer harder than the layer beneath. (Cavallaro II, column 4, line 44). In our view, Cavallaro I adds nothing significant to the teaching of Cavallaro II.

The appellant argues that Saito does not disclose a Shore D hardness of at least 56, and there was no motivation to combine the teachings of Saito and Cavallaro. (Appeal Brief, page 9, second full paragraph). Appellant's claimed limitation of an outermost layer with a minimum Shore D hardness of "about 56" encompasses Cavallaro's limitation of an outermost layer with a minimum Shore D hardness of 65. (Cavallaro II, column 16, line 4). Cavallaro II teaches a thermoplastic cover with a minimum Shore D hardness of 65 and is directed to golf balls having the characteristics described below (Cavallaro II, column 4, lines 36-38, 60-62):

a softer feel, while also providing superior distance, low spin, durability, and ease of manufacturing.

Appeal No. 2004-1399  
Application No. 09/777,595

Saito discloses a golf ball with a thin cover that is durable and controllable. (Saito, column 1, lines 14-18). It would have been obvious in view of Cavallaro II to fabricate the golf ball cover of Saito with a Shore D hardness of Cavallaro to receive the durability of the Cavallaro II ball while maintaining the controllability of Saito's ball.

Moreover, Cavallaro II describes a durable golf ball with a good feel comprising a core and a cover with a Shore D hardness of at least 65. (Cavallaro II, column 4, lines 36-37, 61). Saito's golf ball is described as providing the following characteristics (Saito, column 1, lines 16-18):

a long overall distance, improved controllability,  
extended durability, and a good shot feeling.

In view of Saito, it would have been obvious at the time the invention was made to make a Cavallaro II ball with a cover made of the thickness and composition that Saito discloses for the benefit of having a soft feel ball with Cavallaro's durable hard cover.

The golf ball of appellant's Claim 18 also requires a core and a hard cover. However, the core of the golf ball has an outer wound layer. The wound layer around the core of the golf ball of Claim 18, although not required or even preferred by Cavallaro or Saito, is described in Cavallaro II as well known in

Appeal No. 2004-1399  
Application No. 09/777,595

the art and preferred ball for controllability. (Cavallaro II, column 1, lines 52-54, 59-61). Cavallaro II describes a wound ball with a hard SURLYN® cover like applicant's claimed invention. (Cavallaro II, column 1, lines 57-58).

Saito also describes a conventional golf ball comprising a core with an outer wound layer and a SURLYN® cover. (Saito, column 7, lines 28-32). In light of Saito and Cavallaro II, it would have been prima facie obvious to persons having ordinary skill in the art to make a ball of Saito or Cavallaro comprising a core with a wound layer for improved controllability. Again, appellant has provided no objective evidence or nonobviousness for our consideration.

#### Conclusion

For the reasons stated above, we sustain the examiner's final rejection of Claims 1-27 of Application No. 09/777,595 under 35 U.S.C. § 103(a) over the combined teachings of Saito and Cavallaro II.

The examiner's decision is affirmed.

Appeal No. 2004-1399  
Application No. 09/777,595

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

AFFIRMED

SHERMAN D. WINTERS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
TEDDY S. GRON	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
HUBERT LORIN	)	
Administrative Patent Judge	)	

Appeal No. 2004-1399  
Application No. 09/777,595

THE TOP-FLIGHT GOLF COMPANY  
425 MEADOW STREET  
P.O. BOX 901  
CHICOPEE, MA 01021-0901