

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER HASKELL

Appeal No. 97-0394
Application 08/353,083¹

ON BRIEF

Before FRANKFORT, McQUADE and CRAWFORD, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1 through 8, all of the claims pending in the application.

The invention relates to a "bowling ball fingertip positioner for positioning a pad of a fingertip against an interior wall of a finger hole in a bowling ball" (specification,

¹ Application for patent filed December 9, 1994.

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medial knuckle 24 and a proximal thumb joint 26 which attaches the thumb to a bowler's hand. Thumb pad 10 includes a thin, distal portion 28 and a slightly thicker foam pad portion 30. The distal end 32 of foam pad portion 30 is located longitudinally behind medial knuckle 24 of thumb 18. Further, foam pad portion 30 is positioned laterally intermediate medial knuckle 24 and proximal thumb joint 26. . . .

It is known that the medial knuckle of some bowler's [sic] develop calluses due to rubbing of the knuckle on the interior side of a bowling ball thumb hole. These calluses and the friction developed between the back side of the thumb and the interior surface of the thumb hole distracts the bowler and affects the bowler's ability to control the bowling ball during the swing and release of the ball down the alley. The placement of a cushioning pad in a thumb insert intermediate the medial knuckle and the proximal thumb joint enables the bowler to better grip the bowling ball, reduces the friction between the bowler's thumb and the thumb hole, and further reduces and sometimes eliminates the callus formed on the medial knuckle of the bowler's thumb [column 2, line 57 through column 3, line 21].

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

In the present case, independent claim 1 recites a bowling ball comprising, inter alia, "a finger tip positioner protruding

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into said finger hole and adapted to position a finger to grip said bowling ball with the pad portion of said finger pressed against said interior wall of the finger hole . . . [and] with the fingernail of the finger in contacting relationship with the fingertip positioner." Independent claim 5 recites an insert for providing a fingertip positioner in a bowling ball "wherein said insert is positioned in a finger hole of a bowling ball . . . such that . . . said fingernail is in contacting relationship with the insert to position the finger for pressing against a portion of the interior wall of the finger hole." Independent claim 8 recites a fingertip positioner for use in a finger hole of a bowling ball comprising "a protrusion positioned in the interior wall toward the bottom wall in said finger hole, said protrusion adapted to bear against a fingernail of a finger and thereby press an opposite pad portion of the finger against an opposite portion of the interior wall of the finger hole."

Although the foregoing limitations contain functional language, there is nothing intrinsically wrong with defining something in a claim by what it does rather than by what it is (In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971)). Taken as a whole, these limitations set forth positive

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structural relationships between the fingertip positioner (claims 1 and 8) or insert (claim 5) and the bowling ball.² Thus, the examiner's position that the functional language is entitled to little, if any, weight (see pages 3 through 7 in the answer) is not well taken.

Clearly, Rowland's disclosure of a thumb pad in combination with a bowling ball does not expressly meet the above limitations in claims 1, 5 and 8. Moreover, the illustration of the bowling ball portion 16 and thumb pad 10 in Rowland's Figure 1 renders unduly speculative, and indeed seems to refute, the examiner's apparent determination that these elements meet the limitations in question under principles of inherency. This being the case, the examiner's finding that the subject matter recited in independent claims 1, 5 and 8, and in dependent claims 2 through 4, 6 and 7, is anticipated by Rowland cannot stand. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of these claims.

² The recitation of these positive structural relationships belie the examiner's determination that "Claims 5-8 are drawn to merely an insert . . . and do not require the particulars of a bowling ball" (answer, Paper No. 10, page 4).

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The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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