

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(2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM P. CARNEY

Appeal No. 1998-2657
Application 08/659,359

ON BRIEF

Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3
to 5 and 11 to 13. The other claims remaining in the

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application, claims 14 to 19, have been allowed.¹

The claims on appeal are drawn to an aiming device for practicing putting, and, with some errors noted by the examiner on pages 2 and 3 of the answer, are reproduced in the appendix of appellant's brief.

The references applied in the final rejection are:

Brandell	4,078,806	Mar. 14,
1978		
Terry, III et al.	5,527,041	Jun. 18,
1996		
(Terry)	(filed Apr. 21, 1995)	

A reference of record, applied herein in a rejection pursuant to 37 CFR 1.196(b), is:

Mick	5,452,897
Sept. 26, 1995	

Claims 1, 3 to 5 and 11 to 13 stand finally rejected on the following grounds:

(1) Claims 11 to 13, anticipated by Terry, under 35 U.S.C.

¹ Claim 19 was added by an amendment after final rejection, filed on February 10, 1997 (Paper No. 5½), "for the purpose of placing claim 2 in independent form." Although the amendment did not specifically cancel claim 2, the examiner appears to have treated it as if it were cancelled.

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§ 102(e);²

(2) Claims 1 and 3 to 5, unpatentable over Brandell in view of Terry, under 35 U.S.C. § 103(a).

Rejection (1)- Under U.S.C. § 102(e)

Claim 11 reads:

A device providing means for practicing proper alignment of a face of a putter with respect to an optimum path of a properly impacted golf ball, said apparatus [sic: device] comprising:

a target placed on a surface for putting thereon, said target simulating a golf hole for putting thereto;

a laser emitter positioned adjacent said target projecting a laser beam forwardly thereof defining an illuminated reference line for aligning said putter with respect thereto; and

said golf ball to be putt being placed on said path, said face being positioned adjacent said golf ball and said face being aligned perpendicularly to said reference line such that a properly aimed putt rolls along said reference line toward said target.

In order to constitute an anticipation of a claim, a reference must disclose every claimed limitation, either

² The examiner designated this as a new ground of rejection in the answer because in the final rejection he had designated the statutory basis as § 102(b), rather than § 102(e).

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explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The examiner asserts that the apparatus disclosed by Terry could be used by putting a golf ball towards the device (10), in which case the structure recited in claims 11 to 13 would be anticipated, notwithstanding that this would be a different use of the apparatus from that disclosed by Terry (as stated in In re Schreiber, supra, "It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable").

Appellant states that he does not dispute that a reference need not disclose the intended use in order to anticipate, but argues that Terry does not disclose the structural limitation "a target . . . simulating a golf hole for putting thereto," as recited in claim 11 (reply brief, page 2).

After fully considering the record in light of the arguments presented in appellant's brief, reply brief and reply, and in the examiner's answer and supplemental answer, we conclude that claims 11 to 13 are not anticipated by Terry.

Assuming arguendo that Terry's apparatus 10 constitutes a

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target, we do not consider that it meets the claimed limitation of "simulating a golf hole for putting thereto." In general, terms in a claim are to be given their ordinary and accustomed meaning, K-2 Corp. v. Salomon S.A., 191 F.3d 1356, 1362, 52 USPQ2d 1001, 1004 (Fed. Cir. 1999), and the ordinary meaning of "simulate", as defined in Webster's Third New International Dictionary (1971), is "to give the appearance or effect of" or "to have the characteristics of." The Terry device 10 does not meet any of these definitions, since it does not give the appearance of, give the effect of, or have the characteristics of a golf hole. The examiner argues that "Terry's device is designed to receive a golf ball, and thus meets the limitations of a target which simulates a golf hole for putting thereto" (answer, page 5), but we do not agree. Simply because a golf ball 26 may be placed on the Terry apparatus does not mean that the apparatus simulates a golf hole, but rather, if anything it would simulate a putting green.

Accordingly, we will not sustain the § 102(e) rejection of claim 11, nor of claims 12 and 13 dependent thereon.

Rejections Pursuant to 37 CFR 1.196(b)

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Pursuant to 37 CFR 1.196(b), we enter the following new rejections:

(A) Claims 1 and 3 to 5 are rejected for failure to comply with the second paragraph of 35 U.S.C. § 112.

Claim 1 reads:

A laser aiming device comprising:

a housing simulating a generally circular golf hole defining an axially extending diameter;

said housing being positioned on an adjacent floor, said floor providing a surface for putting a golf ball thereon, said golf hole providing a target for putting thereto;

said housing including a bore, the axis of said bore lying in the vertical plane parallel to and passing through said diameter;

a laser module mounted in said bore adapted to emit a laser beam coincident with said axis thereof; and

said laser beam projecting an illuminated mark on said surface forwardly of said target thereby providing a reference means defining an optimum path of a successful putt aimed at said target.

The expression "the axis of said bore lying in the vertical plane parallel to and passing through said diameter" in lines 7 to 9 of claim 1 is inconsistent and causes the claim to be indefinite. If a plane is parallel to a line, by definition the plane and line do not intersect; therefore, the

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vertical plane cannot be both parallel to the diameter and also pass through the diameter, as recited. Considering the apparatus disclosed by appellant in, e.g., Figs. 1 and 8 and in the sentence bridging pages 16 and 17, it appears that, rather than "parallel to and passing through," the term "containing" would more accurately define what appellant discloses and intended to claim.³

(B) Claim 11 is rejected under 35 U.S.C. § 102(e) as anticipated by Mick, which discloses a target 40 simulating a golf hole

(col. 3, lines 8 to 10), a laser emitter 70 adjacent the target, and a golf ball 30 on the optimum path with the face of putter 20 adjacent thereto. The beam 72 emitted by the laser constitutes "an illuminated reference line" as claimed, it being noted that the claim does not require that the line be on the surface.

³ If appellant amends claim 1 in response to this rejection, page 6, lines 10 to 12, and page 7, lines 3 to 5, should be correspondingly amended. We also note that on page 15, line 23, and page 16, lines 16, 17 and 26, "90" or "92" should be --98--.

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Rejection (2) - Under 35 U.S.C. § 103

We have rejected claims 1 and 3 to 5 above as failing to comply with § 112, second paragraph. Generally, if claims are rejected on that basis, a rejection under § 103 is inappropriate.

See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). However, in order to avoid piecemeal appellate review, we will interpret the expression "parallel to and passing through" in claim 1 as if it were "containing," and proceed to consider the § 103 rejection on that basis. Cf. Ex parte Ionescu, 222 USPQ 537, 540 (Bd. Apps. 1984).

The basis of this rejection, as stated by the examiner on pages 6 and 7 of the answer, is:

In the instant application, the art (Terry) teaches the use of a laser with a putting practice device to help the golfer line up a putt. It is the examiner's opinion that one of ordinary skill in the art would have found the use of a laser for the purpose of lining up a putt valuable on other putting practice devices such as Brandell's. The motivation to combine comes from the recognized advantage in the prior art as typified by Terry of using a laser to line up a putt.

We do not disagree with the broad proposition that it would have been obvious to use the Terry device in conjunction with

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a target such as disclosed by Brandell. However, we do not consider that, in combining the teachings of these two references, one of ordinary skill would have been motivated to locate the laser beam emitter (module) on the target, as called for by claim 1. Our conclusion is based on the fact that in the Terry apparatus the laser beam is directed from the golfer's position toward the target. In our view, the opposite arrangement of locating the laser on the target and directing it back toward the golfer would be the result of improper hindsight, based on appellant's own disclosure, rather than the result of a teaching or suggestion coming from the applied prior art.

Rejection (2) of claim 1, and of dependent claims 3 to 5, will therefore not be sustained.

Conclusion

The examiner's decision to reject claims 1, 3 to 5 and 11 to 13 is reversed. Claims 1, 3 to 5 and 11 are rejected pursuant to 37 CFR 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997)), 1203

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Off. Gaz. Pat. and Trademark Office 63,122 (Oct. 21, 1997)).
37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED 37 CFR § 1.196(b)

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	Administrative Patent Judge))
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)	
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