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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK M. SIMONUTTI,
PETER R. TOLLEY, WILLIAM E. DILLON
and
JERRY MATHENY

Appeal No. 1998-3371
Application 08/614,383[1]

ON BRIEF

Before MEISTER, ABRAMS and GARRIS, ***Administrative Patent Judges***.

ABRAMS, ***Administrative Patent Judge***.

DECISION ON APPEAL

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[1] Application for patent filed March 12, 1996.

This is an appeal from the decision of the examiner finally rejecting claims 1-9, which constitute all of the claims of record in the application.

The appellants' invention is directed to an improved tennis ball (claims 1-7) and to a method of decreasing the deformation and increasing the rebound of a tennis ball (claims 8 and 9). The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Wood	1,991,534	Feb. 19, 1935
Hazelton et al. (Hazelton)	4,978,717	Dec. 18, 1990

THE REJECTION

Claims 1-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wood in view of Hazelton.

The rejection is explained in the Examiner's Answer.

OPINION

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and the appellants with regard thereto, we make reference to the Examiner's Answer (Paper No. 13) and to the Appellants' Brief (Paper No. 11) and Reply Brief (Paper No. 14).

The 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 disclo-

sure. ***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).

The appellants explain in the opening pages of their specification that the cores of tennis balls conventionally are pressurized to 10-15 psig in order to provide the required rebound, but the pressure decreases over time because the gas leaks through the core. The result is a tennis ball of diminished performance. Pressureless balls have been developed to overcome this problem, but according to the appellants they require increased stiffness to compensate for the lack of internal gas pressure, and suffer from a decrease in resilience and rebound which also adversely affects performance. The objective of the appellants' invention is to provide a pressureless tennis ball that meets the specifications required by the United States Lawn Tennis Association while providing the increased stiffness needed in a pressureless ball, with little or no decrease in resilience and rebound.

The appellants have discovered that these goals can be achieved by adding a plastomer to the rubber that is used for the core in a conventional tennis ball. As manifested in claim 1, the tennis ball comprises a hollow core and a cover, with the core being formed “from a composition including rubber and a plastomer defined as a copolymer of ethylene and one or more
alkenes containing 4 to 10 carbon atoms.” The claim goes on to require that the ball have a “rebound” and a “forward deformation” of stated values as measured by the United States Lawn Tennis Association.

This claim stands rejected as being unpatentable over Wood in view of Hazelton. Wood discloses a conventional pressurized tennis ball having a hollow rubber core. The thrust of the Wood invention is to improve upon the cover. Hazelton is directed to a “thermoelastic” composition of ethylene-1-olefin copolymer and rubber. The characteristics of the composition are described in the Abstract as “heat-

shrinkable . . . of exceptionally low hardness, and great flexibility and elasticity." It is the examiner's position that one of ordinary skill in the art would have found it obvious to add the plastomer disclosed in Hazelton to the rubber of the core of Wood "in order to improve the flexibility and elasticity of the rubber composition," with "the particular statistics for the rebound and forward deformation . . . being obvious results" (Answer, page 3).

However, the mere 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. ***See In re*** **Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, we fail to perceive any teaching, suggestion or incentive in either Wood or Hazelton which would have led one of ordinary skill in the art to replace the rubber core of the

pressurized Wood tennis ball with a core of rubber and the plastomer defined in the appellants' claims. We arrive at this conclusion because there appears to be no problem in the

Wood ball that would be solved by such a modification to the core, and there is no hint in Hazelton that the plastomer described therein would increase the stiffness of a composition to which it was added, much less that it would improve the core of tennis balls or the like. From our perspective, the only suggestion for making the modification to Wood proposed by the examiner is found in the hindsight accorded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for an obviousness rejection. ***See In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The combined teachings of Wood and Hazelton thus fail to establish a ***prima facie*** case of obviousness with regard to the subject matter recited in claim 1. This being the case, we will not sustain the rejection of independent claim 1 or, it follows, of claims 2-7, which depend therefrom.

The same conclusion, based upon the same rationale, applies also to independent claim 8, which sets forth a method of decreasing deformation and increasing rebound of a tennis ball by

adding to the ingredients of the rubber core the same plastomer that was recited in claim 1. The rejection of claim 8 and dependent claim 9 also will not be sustained.

SUMMARY

The rejection of claims 1-9 is not sustained.

The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER Administrative Patent Judge	)	BOARD OF PATENT
NEAL E. ABRAMS Administrative Patent Judge	)	APPEALS AND INTERFERENCES
BRADLEY R. GARRIS Administrative Patent Judge	)	

NEA:psb

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