

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte AHID D. NASHIF  
and GOPICHAND KOGANTI

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Appeal No. 1998-3426  
Application 08/762,204<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 10, which are all of the claims pending in the application.

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<sup>1</sup> Application for patent filed December 9, 1996. According to appellants, the application is a continuation-in-part of Application 08/484,451, filed June 7, 1995.

Appellants' invention relates to a vibration damping device for stringed racquets. In particular, the claimed subject matter on appeal is directed to the embodiment of appellants' invention seen in Figures 7 through 10 of the application. In this embodiment, the body (226) of the damping device (210) is formed of a viscoelastic member (222) that is made from a thin slice of rubber material so that it can be wrapped around at least a pair of strings of the racquet, in the manner seen in Figures 7-9 of the drawings. The damping device further includes a movable member (224) having two enlarged head portions (234) and a connecting portion (236). As can be seen best in Figure 9 of the application, the connecting portion of the movable member (224) extends through the viscoelastic member (222) with the enlarged head portions (234) being disposed on either side of the viscoelastic member. As is specified in each of the independent claims on appeal (i.e., claims 1 and 7), the member (224) is

“movable relative to said viscoelastic member in response to vibrations of the stringed racquet induced by an impact of an object on the strings of the stringed racquet such that said vibration damping device vibrates over the same frequency range but out of phase with the stringed racquet to damp vibrations in the stringed racquet.”

A copy of representative claims 1 and 7 can be found in the Appendix to appellants' brief.

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The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

|      |           |              |
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| Ross | 3,874,666 | Apr. 1, 1975 |
|------|-----------|--------------|

Claims 1 through 10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ross.

The examiner's full statement of this rejection and response to appellants' arguments appears on pages 4 through 7 of the examiner's answer (Paper No. 11, mailed July 7, 1998). Appellants' viewpoints concerning the examiner's rejection of the appealed claims are found in the brief (Paper No. 10, filed June 25, 1998) and in the reply brief (Paper No. 12, filed August 3, 1998).

### OPINION

In arriving at our decision in this appeal, we have carefully considered appellants' specification and claims, the applied Ross patent, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we have made the

determination that the examiner's rejection of claims 1 through 10 under 35 U.S.C. § 102(b) will not be sustained. Our reasons follow.

As noted by appellants, the Ross patent (e.g., Figs. 5 and 6) is directed to a tennis racket having a ball retrieval means affixed to a portion of the racket strings. The ball retrieval means includes first and second interconnectable blocks (31, 32) that are apparently made of plastic material. The blocks are affixed to the strings (35) of the racket by nut and bolt means passing through the blocks and through the interstices (34) between the tensioned strings. The outer surface of each of the blocks is provided with a curvilinear portion (37) that has a radius which corresponds to the radius of a tennis ball. A patch (38) of hooked material is cemented in each of the curvilinear portions and serves to engage with the felted cover normally present on conventional tennis balls so that a ball may be retrieved without the necessity of stooping for such retrieval.

The examiner, on page 4 of the answer, has made the determination that the blocks (31, 32) of Ross are made of plastic, which (according to the examiner) is "[a] group of material to which viscoelastic materials are found." The examiner has further made the determination that the blocks of Figures 5 and 6 in Ross are

“wrapped around at least a pair of strings.” The examiner has additionally characterized the nut and bolt members (33) of Ross Figures 5 and 6 as inherently being movable relative to the blocks (31, 32) “to some degree,” and has concluded that the device seen in Ross has inherent properties of damping vibrations and is capable of vibrating over the same frequency range but out of phase with the stringed racquet so as to damp vibrations in the racquet. Like appellants, we find the examiner’s position that the claimed subject matter as set forth in claims 1 through 10 on appeal is anticipated by Ross to be in error.

In the first place, even assuming that the blocks (31, 32) of Ross are made of plastic, such fact alone provides no disclosure or teaching of a “viscoelastic member” as required in the claims on appeal, and certainly provides no teaching of a viscoelastic member that is “adapted to be wrapped around at least a pair of strings of a stringed racquet” as set forth in independent claim 1 on appeal, and in independent claim 7 in slightly different language. Secondly, we see no basis upon which to conclude that the nut and bolt members of Ross will “inherently” be movable relative to the blocks therein in response to vibrations of the stringed racquet induced by an impact of an object on the strings of the stringed racquet as recited in claim 1, and no reason whatsoever to conclude that the device of Ross will somehow vibrate

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“over the same frequency range but out of phase with the stringed racquet to damp vibrations in the racquet,” as required in the claims before us on appeal.

In our opinion, the examiner’s position is totally without support in the applied reference and is entirely based on speculation and conjecture on the examiner's part. In this regard, we note that it is well settled that inherency may not be established by probabilities or possibilities, but must instead be "the natural result flowing from the operation as taught." See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). In the present case, neither the Ross patent nor the examiner provides an adequate factual basis to establish that the natural result flowing from following the teachings of that patent would be a vibration damping device like that claimed by appellants. Accordingly, since all the limitations of appellants’ claims 1 through 10 are not found in Ross, either expressly or under principles of inherency, it follows that the examiner's rejection of those claims under 35 U.S.C. § 102(b) relying on Ross will not be sustained.

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In accordance with the foregoing, it is clear that the decision of the examiner is reversed.

REVERSED

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| CHARLES E. FRANKFORT        | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) | BOARD OF PATENT |
| JOHN P. McQUADE             | ) |                 |
| Administrative Patent Judge | ) | APPEALS AND     |
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| JEFFREY V. NASE             | ) |                 |
| Administrative Patent Judge | ) |                 |

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