

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JEAN-MARC GUIBAUD and JEAN-PIERRE RIGAL

Appeal No. 1999-2033
Application No. 08/737,928

HEARD: FEBRUARY 19, 2002

Before STAAB, McQUADE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 7) of claims 12-31. Claims 12-14, 17, 18, 26, 28 and 30 were amended after the final rejection (see Paper No. 9). As a result of this amendment, in an advisory action mailed June 26, 1998 (Paper No. 10), the examiner subsequently indicated that claims 14, 16, 18 and 20 are allowable. The answer (Paper No. 15) is replete with inconsistencies as to which claims stand allowed and which claims stand rejected. For example, the answer does not

set forth a 35 U.S.C. § 112 rejection of claims 14, 16, 20 and 21 and states on page 2 that claims 14, 16, 18 and 20 “have been allowed as set forth in the advisory action.” The answer, however, indicates on page 5 that claims 14, 16 and 20 would be allowable if rewritten to overcome the 35 U.S.C. § 112 rejections set forth in the answer and to include all the limitations of the base claim and any intervening claims and that claim 21 would be allowable if amended to overcome the 35 U.S.C. § 112 rejection set forth in the answer. While such inconsistencies in the answer are clearly improper, in the interest of efficiency, we have decided this appeal by treating as rejected all claims which are expressly rejected in the answer and treating as allowed or objected to all claims which are not expressly rejected in the answer.¹ As the answer sets forth a rejection of claims 17 and 18 under the second paragraph of 35 U.S.C. § 112, a rejection of claims 12, 13 and 22-24 under 35 U.S.C. § 102(b) and a rejection of claims 15, 19 and 25-31 under 35 U.S.C. § 103, this appeal involves claims 12, 13, 15, 17-19 and 22-31.

BACKGROUND

The appellants’ invention relates to a golf club head (claims 12, 13, 15, 17-19 and 22-25) which includes, a detachable assembly of a recessed body and a housing (specification, page 1), as well as a golf club head assembly (claims 26-29) and method

¹ Any rejection not restated in the answer will be assumed to have been withdrawn. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

(claims 30 and 31) for assembling such a golf club head. A copy of the claims under appeal is set forth in the appendix to the appellants' brief (Paper No. 14).

The sole prior art reference relied upon by the examiner in rejecting the appealed claims under 35 U.S.C. §§ 102 and 103 is:

Reach	2,332,342	Oct. 19, 1943
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The following rejections are before us on appeal.²

Claims 17 and 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

Claims 12, 13 and 22-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Reach.

Claims 15, 19 and 25-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reach.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the Reach patent, and to the respective positions

² As noted by the examiner on page 6 of the answer, the objection to claim 31 for allegedly failing to comply with 37 CFR § 1.75(c) is reviewable by petition under 37 CFR § 1.181 and thus is not within the jurisdiction of the Board. See *In re Mindick*, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201.

articulated by the appellants in their brief and reply brief (Paper Nos. 14 and 17) and by the examiner in the answer. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Reach discloses a golf iron 20 including a blade 22 adapted to receive and hold a bottom plate 30, the plate 30 provided with an upwardly extending projection 40 adapted to fit into a suitable recess 41 at the back of the blade 22. The projection 40 is provided with a plurality of tapered sockets which may be left empty or which may be filled with weights 44 of lead or other heavy material and the main part 49 of the plate 30 is provided with a plurality of holes 48 into which lead or other slugs 50 may be dropped at any desired points longitudinally of the club head in order to achieve weighting near the center of the club or toward the heel or toe as desired. Preferably the holes 48 are also

tapered slightly so that the slugs may be knocked out by merely tapping the bottom plate 30 when it is disassociated from the blade 22. Ostensibly, an important feature of Reach's invention is that the weights or slugs be removably insertable into the sockets or holes to accommodate adjustments in weight distribution as desired.

One skilled in the art at the time of appellants' invention would not have viewed the weights or slugs of Reach as being "non-removably connected" to the housing (plate 30) as required in appellants' independent claim 12. We have not overlooked the examiner's position, as articulated on pages 6-7 of the answer, that the weights of Reach are "not 'removable' when the housing is 'located in said open cavity' as recited in the second paragraph of claim 12," but we do not consider this position to be well taken. As Reach discloses a detachable connection of the plate 30 to the blade 22, the plate 30 may be disassociated or detached from the blade 22 at any time, thereby permitting access to the sockets or openings for removal of the weights or slugs at any time as disclosed by Reach. The examiner's statement on page 7 of the answer that claims 22 and 24 do not even require that the weights be "non-removable" is perplexing, as these claims both depend from claim 12, which expressly recites that the weight is "non-removably connected to said housing."

Having determined that Reach fails to disclose the feature of claim 12 that the weight be "non-removably" connected to the housing, we conclude that this claim is not

anticipated by Reach. Thus, we cannot sustain the examiner's rejection of independent claim 12, or claims 13 and 22-24 which depend from claim 12, under 35 U.S.C. § 102.

The obviousness rejection

The 35 U.S.C. § 103 rejection of claims 15, 19 and 25-31³ rests in part on the examiner's finding that Reach discloses at least one weight which is "non-removably connected to said housing." The above discussed lack of support in Reach for this finding fatally taints the examiner's conclusion that the differences between the subject matter recited in claims 15, 19 and 25-31 and the prior art are such that the subject matter as a whole would have been obvious⁴ at the time the invention was made to a person having ordinary skill in the art. It follows that we shall also not sustain the examiner's rejection of these claims as being unpatentable over Reach.

The indefiniteness rejection

The examiner's basis for rejecting claims 17 and 18 as being indefinite is that "said cavity of said housing" lacks proper antecedent basis, the only previously recited "cavity" being an open cavity in the body. As appellants have not contested the merits of this

³ Claims 15, 19 and 25 depend from claim 12, and thus incorporate the limitation that the weight be "non-removably connected" to the housing, and claims 26-31 recite a plurality of housings having at least one weight "non-removably connected" thereto.

⁴ We also find no suggestion in Reach to connect the weights or slugs in a non-removable manner to the plate 30. In fact, such a modification would appear to diminish the versatility of the device, a significant feature of Reach's invention.

rejection⁵ and the examiner's position seems reasonable on its face, we shall sustain this rejection. Observing that the indefiniteness rejection is the only outstanding rejection of claims 17 and 18, we offer the following recommendation under 37 CFR § 1.196(c).⁶

RECOMMENDATION UNDER 37 CFR § 1.196(c)

Amendment of claims 17 and 18 to change the term "said" before "cavity" to --a-- would overcome the indefiniteness rejection sustained herein. In light of the absence of any other outstanding rejections of claims 17 and 18, these claims would appear to be allowable if so amended.

CONCLUSION

To summarize, the decision of the examiner to reject claims 17 and 18 under the second paragraph of 35 U.S.C. § 112 is affirmed and the decision of the examiner to reject claims 12, 13 and 22-24 under 35 U.S.C. § 102 and claims 15, 19 and 25-31 under 35 U.S.C. § 103 is reversed. We also include a recommendation under 37 CFR § 1.196(c) of an amendment to claims 17 and 18 to overcome the indefiniteness rejection sustained herein.

⁵ Appellants attempted to amend claims 17 and 18 in an amendment (Paper No. 18) filed with the reply brief, but the amendment was denied entry by the examiner (see Paper No. 19).

⁶ 37 CFR § 1.196(c) provides that, where, as here, the Board includes an explicit statement that a claim may be allowed in amended form, "appellant shall have the right to amend in conformity with such statement which shall be binding on the examiner in the absence of new references or grounds of rejection."

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

AFFIRMED-IN-PART; 37 CFR § 1.196(c)

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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