

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DICKORY RUDDUCK and LEONARD JOHN DWYER

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Appeal No. 1999-2186  
Application No. 08/857,571

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HEARD: April 19, 2000

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Before CALVERT, Administrative Patent Judge, MCCANDLISH, Senior Administrative Patent Judge, and PATE, Administrative Patent Judge.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 5, 6, 9 to 14, 16 to 19 and 21 to 48, all the claims remaining in the application.

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Appellants' invention is a golf tee which includes a writing point, such as pencil lead, a ball point pen, or crayon, and an eraser, such as rubber or felt.<sup>1</sup>

Claim 1 is illustrative of the subject matter in issue, and reads:

1. A golf tee having an enlarged head defining a hollow depression to provide a concave surface for supporting a golf ball, the golf tee comprising an eraser located at the head and a writing point.

The references applied in the final rejection are:

Pryde 1925	1,522,544	Jan. 13,
Ranseen 1928	1,670,123	May 15,
Lundy 1928	1,679,579	Aug. 7,
Liccardello 1990	4,893,818	Jan. 16,
Rudduck 1998	5,720,677	Fed. 24,
Jones 1930 (British Patent)	326,915	Apr. 17,
Stewart 1990 (British Application)	2,227,416	Jan. 8,

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<sup>1</sup> In reviewing the application drawings we note that although the tees shown in Figs. 1 to 6 are shown in section, none of them is cross-hatched.

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The appealed claims stand finally rejected on the following grounds:

I. Unpatentable under 35 U.S.C. § 103 over the following combinations of references:

(1) Claims 1, 2, 5, 6, 9 to 14, 17, 21 to 24, 26 to 30 and 32, Lundy in view of Stewart;

(2) Claims 18, 19, 33 to 41 and 47, Lundy in view of Stewart and Pryde;

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(3) Claims 25 and 42, Lundy in view of Stewart and Liccardello;<sup>2</sup>

(4) Claim 48, Lundy in view of Stewart, Pryde and Jones;

(5) Claims 1, 2, 5, 6, 9 to 12, 16, 21 to 24, 26 to 29, 31 and 32, Stewart in view of Ranseen;

(6) Claims 18, 19, 33 to 38, 41 and 43 to 47, Stewart in view of Ranseen and Pryde;

(7) Claim 25, Stewart in view of Ranseen and Liccardello;

(8) Claim 42, Stewart in view of Ranseen, Pryde and Liccardello.

II. Claims 1, 2, 5, 6, 9 to 14, 17, 21 to 24, 26 to 30 and 32, unpatentable over claims 1 to 10 of the Rudduck patent, on the ground of obviousness-type double patenting.

I. 35 U.S.C. § 103 Rejections

Considering first the references applied against claim 1, Stewart discloses a "basic commercial golf-tee" having a body 2 of unspecified material (presumably wood or plastic) into the tip of which is inserted a writing material "typically,

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<sup>2</sup> Since claim 42 depends on claim 39, it appears that Pryde should have been included in the rejection of claim 42. However, this is of no consequence in view of our disposition of the § 103 rejections.

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lead,<sup>3</sup> charcoal, wax or chalk" (page 2). Lundy discloses a golf tee having a metal tip 1 and "a flexible body member 4, preferably of rubber" (p. 1, lines 55 and 56), the purpose of the flexible body being so that "the same will yield upon being struck by the club, as shown in dotted lines in Figure 3" (p. 1, lines 101 to 103).

Ranseen discloses a conventional golf tee, usually made of wood, having a collar or sleeve "preferably of flexible, resilient rubber, demountably attached thereto," which strengthens the shank of the tee and provides a buffer for the head or seat of the ball (p. 1, lines 15 to 27).

In rejecting claim 1, the examiner found that it would have been obvious, in view of Stewart, to provide Lundy's rubber-bodied tee with a writing point (rejection (1)), or, in view of Ranseen, it would have been obvious to provide the tee of Stewart with a rubber collar (rejection (5)). Although neither Lundy nor Ranseen indicates that the disclosed rubber performs any erasing function, or otherwise teaches or discloses the inclusion of an eraser, the examiner takes the

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<sup>3</sup> We assume that by "lead" Stewart means a pencil lead, which is actually made of graphite.

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position that the rubber body 4 of Lundy's tee "is obviously capable of performing as an eraser" (answer, page 3), and "the collar of Ranseen is inherently capable of functioning as an eraser" (id, page 5).

We agree with the examiner that it would have been obvious to modify Lundy in view of Stewart, or Stewart in view of Ranseen, in the manner proposed in rejections (1) and (5) respectively, in order to achieve the advantages taught by the secondary references. Also, we consider that it was reasonable for the examiner to assume that the rubber disclosed by Lundy or Ranseen would inherently function as an eraser. Therefore, we conclude that a prima facie case of obviousness of claim 1 based on inherency was established and the burden shifted to appellants to show that the rubber structure of Lundy or Ranseen would not inherently function as an eraser, as claimed. Cf. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

Appellants sought to meet their burden by filing an Affidavit [sic: Declaration] Pursuant to 37 CFR § 1.132 by

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Geoffrey Henry Schuler (filed Aug. 26, 1998). According to the qualifications stated in the delcaration, Mr. Schuler, an industrial chemist of long experience, appears to be well versed on the subject of rubber. He states that pencil erasers and ink erasers must each have certain characteristics, and identifies the materials from which each may be made. Attached to the declaration as Annexures 'A' to 'F' are six items made of various rubber compositions, natural and/or synthetic. Annexure 'A' is a pencil eraser, Annexure 'B' is an ink/pencil eraser, and Annexures 'C', 'D', 'E' and 'F' are four other items, which Mr. Schuler states are unsuitable or ineffective to remove writing from paper. He concludes in paragraph 22 that "only the substances in Annexures A and B are suitable for use as an eraser, to remove writing from normal paper."

Concerning the Schuler declaration, the examiner states on pages 8 and 9 of the answer:

the disclosure of Lundy does not preclude the use of any of the rubber samples from being used in his tee construction. Therefore, it is seen as being obvious within the teachings of Lundy to one of ordinary skill in the art to form the shaft of the tee from any rubber, including those that are effective in erasing writing.

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The affidavit shows that certain types of rubber are more effective in erasing writing than others. However, the teachings of Lundy clearly recite "a flexible body member 4, preferably of rubber" (page 1, lines 55 and 56). Thus, lacking any specific teaching by Lundy for desirable or undesirable types of rubber from which to form the body member, it would have been obvious to one of ordinary skill in the art to form the member from any type of rubber (including those that are effective in erasing writing) in order to provide a resilient shaft portion for the tee.

The examiner does not discuss the declaration in relation to Ranseen, but presumably his position would be the same as for Lundy.

In a nutshell, the examiner's position seems to be that since the generic term "rubber" disclosed by Lundy or Ranseen would include rubber compositions effective as erasers, it would have been obvious to use such compositions for the rubber of Lundy's tee body, or of Ranseen's collar. However, the fact that some of the materials included within the scope of the material generically disclosed by a reference would have the

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property of the claimed material is not enough; rather, it is well settled that for a reference to be effective via inherency, the claim limitation in question must be "inevitably present" in the reference, and must be "the natural result flowing from the operation as taught." In re Oelrich, 666 F.2d 578, 581, 212, USPQ 323, 326 (CCPA 1981). In the present case, the Schuler declaration establishes that rubber, as generically disclosed by Lundy or Ranseen, might or might not be effective as an eraser, depending on its particular composition, so that in those references an eraser would not be "inevitably present," nor would the inclusion of an eraser be the natural result flowing from the operation (use of rubber) taught in those references. Since, as per the Schuler declaration, not all rubbers are usable as erasers, the rubber body of the Lundy tee, or the rubber collar of Ranseen, are not effective to inherently meet or render obvious the "eraser" limitation of claim 1, and the rejections of that claim, as well as of the other claims included in rejections (1) and (5), will not be sustained.

Rejections (2) to (4) and (6) to (8) also will not be sustained, since the additional references applied therein do

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not supply the deficiencies in the rejections of claim 1 as  
discussed above.

## II. Double Patenting Rejection

Appellants' only argument as to this rejection is, in effect, that it is unjustified because, by their calculation, the term of any patent issued on the present application will expire (in October 2012) prior to expiration of the term of the Rudduck patent (in June 2013), and thus there can be no extension of the monopoly represented by the latter. They assert that in view of the relative expiration dates, "the terminal disclaimer requested in the present case is moot" (brief, page 22).

This argument is not considered to be well taken, essentially for the reasons given in MPEP § 804.02, Part IV, pp. 800-26 and 27 (July 1998). Basically, there are two reasons for requiring a terminal disclaimer in this situation:

- (a) Under 35 U.S.C. § 154(b)(2), the term of a patent issued on the present application might be extended beyond the term of the Rudduck patent, if no terminal disclaimer is filed.
- (b) The inclusion in the terminal disclaimer of a provision, as required by 37 CFR § 1.321(c)(3), that the patent to be granted on the present application will be enforceable only as long as it and the Rudduck patent are commonly owned, avoids

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the potential harassment of an accused infringer by multiple parties having patents covering the same invention.

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Accordingly, the rejection will be sustained.

Conclusion

The examiner's decision to reject claims 1, 2, 5, 6, 9 to 14, 16 to 19 and 21 to 48 under 35 U.S.C. § 103 is reversed, and his decision to reject claims 1, 2, 5, 6, 9 to 14, 17, 21 to 24, 26 to 30 and 32 on the ground of obviousness-type double patenting is affirmed.

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

AFFIRMED-IN-PART

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
HARRISON E. MCCANDLISH	)	APPEALS
Senior	)	Administrative
Patent Judge )	)	
AND	)	INTERFERENCES
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WILLIAM F. PATE, III	)	
Administrative Patent Judge	)	

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AFFIRMED-IN-PART

Prepared: June 22, 2001