

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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TODD E. COLE and PATRICK J. KOWALSKI

Appeal No. 2000-0790
Application No. 08/992,637

ON BRIEF

Before CALVERT, COHEN, and BAHR, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 4 and 6, all the claims remaining in the application.

Claim 1, the only independent claim, defines the subject

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matter on appeal as follows:¹

1. An accessory for a golf club normally removably mounted on a golf club shaft for use in green repair, cleat cleaning, ball marking and as a general support comprising:

a substantially rectangularly elongated plate having a front face and a back face, a top and a bottom, the bottom being bifurcated, forming right and left legs and the top defining a cradle; said plate having opposed jaws integrally extending along a portion of the front face, along the longitudinal axis of said plate, said jaws being mutually spaced equidistantly along their length and dimensioned to be press fitted on a golf club shaft and not the grip; said plate, bifurcated bottom and cradle being contained in a common plane; and

removable ball marker mounted on said plate adjacent said jaws, said jaws comprising opposed clip members separated by a constant distance along the longitudinal axis of said plate.

The references applied in the final rejection are:

Notarmuzi	5,226,647	Jul.
13, 1993		
Zink	5,437,449	Aug.
1, 1995		

Claims 1 to 4 and 6 stand finally rejected under 35

U.S.C.

§ 103(a) as unpatentable over Notarmuzi in view of Zink.

¹ Claim 1 was amended following final rejection by an amendment (filed Dec. 9, 1998) whose entry was approved in the Advisory Action of Dec. 17, 1998 (Paper No. 8). We note that claim 1 is correctly copied in Appendix 1 of the brief, but incorrectly copied in the Supplemental Appendix 1 filed on Aug. 22, 2000.

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Appellants state on page 3 of the brief that the claims at issue should all stand or fall together. Therefore, we select claim 1 and shall decide the appeal on the basis of that claim. 37 CFR 1.192(c)(7).

The examiner's position is set forth on page 3 of the answer as:

Regarding claim 1, Notarmuzi discloses a golf accessory comprising a generally rectangularly elongated plate having a pair of legs (12) and a cradle (26). Further, Notarmuzi includes a ball marker (36). However, Notarmuzi lacks the teaching for the plate to have opposed jaws.

Zink discloses a golf accessory comprising a rectangularly elongated plate (14) having a pair of legs (28) and opposed jaws (22) along the longitudinal axis of the plate. Note Figure 3 of Zink which shows a constant distance between the jaws. It would have been obvious to one of ordinary skill in the art to provide the golf accessory of Notarmuzi with the jaws of Zink in order to permit the accessory to be secured to the shaft of a golf club. Further, it would have been obvious to one of ordinary skill in the art to modify the size of the jaws of Zink to fit around the shaft of the golf club in order to permit the user to attach the tool to the shaft of the golf club.

After fully considering the record in light of the arguments made in appellants' brief and reply brief, and in the examiner's answer, we conclude that the rejection is not

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well taken.

The Zink patent discloses a tool which is designed to hold a golf club when not in use. The grip 13 of the club is inserted into clamps (jaws) 22 on the tool 10 and then the club is pushed downward so that the prongs 28 on the tool penetrate the ground, holding the club vertically, with the head at the top (col. 3, lines 43 to 55).

We do not consider that Zink's disclosure would have suggested adding jaws to the Notarmuzi accessory "in order to permit the accessory to be secured to the shaft of a golf club" as the examiner states, supra, because the purpose of Zink's jaws is to support the club, not to be carried by it. Assuming that Zink would have suggested modifying the Notarmuzi accessory so that it could support a club, Zink would have taught one of ordinary skill to add to the Notarmuzi accessory not only jaws, but also a step (18 of Zink) so that downward pressure could be applied to push the device into the ground. However, providing such a step would violate the requirement of claim 1 that the plate, bifurcated bottom and cradle be contained in a common plane.

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Moreover, even if one of ordinary skill were to provide the Notarmuzi accessory with jaws in view of Zink, we find no teaching or suggestion in Zink that the jaws be "dimensioned to be press fitted on a golf club shaft and not the grip" as required by claim 1. The Zink jaws are designed to fit the grip 13 of the club because the purpose of the Zink device is to hold a golf club vertically, with the head uppermost. If Zink's jaws 22 were dimensioned to fit the shaft rather than the grip, they could not perform their intended function, and it is not clear how they could support the club if they were dimensioned to fit the shaft, because even if Zink's disclosure were disregarded and the club positioned with the head down, it appears that the club head would interfere with the jaws. In our view, the examiner's conclusion that it would have been obvious to space the jaws on the modified Notarmuzi accessory to fit around the shaft of a club is not supported by any evidence in the record and appears to be based on impermissible hindsight gleaned from appellants' own disclosure.

Accordingly, the rejection of claims 1 to 4 and 6 will

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not be sustained.

Summary

The examiner's decision to reject claims 1 to 4 and 6 is reversed.

REVERSED

IAN A. CALVERT)
Administrative Patent Judge)
)
) BOARD OF PATENT
IRWIN CHARLES COHEN)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
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JENNIFER D. BAHR)
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