

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte WILLIAM H. BRINE, JR., RICHARD BONANNO
and ERIK A. BRINE

Appeal No. 2003-0918
Application No. 09/395,659

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 15, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a handle for a lacrosse stick which inhibits a player's hand from rotating around the handle, but which does not inhibit the player's ability to adjust his or her hand position up and down the handle (specification, p. 3). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hoult	3,702,702	Nov. 14, 1972
Kuebler et al. (Kuebler)	5,749,798	May 12, 1998
Dupuis ¹	FR 2 403 172	Apr. 13, 1979

Claims 1, 2 and 6 to 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hoult in view of Kuebler.

Claims 3 to 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hoult in view of Dupuis.

¹ In determining the teachings of Dupuis, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellants' convenience.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 14, mailed October 22, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed July 12, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is sufficient to establish a case of obviousness only with respect to claims 1, 2, 6, 8 and 9. Accordingly, we will sustain the examiner's rejection of claims 1, 2, 6, 8 and 9 under 35 U.S.C. § 103. We will not sustain the examiner's rejection of claims 3 to 5, 7 and 10 to 15 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by

presenting evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Hoult's invention relates to a lacrosse stick. As shown in Figures 1 and 2, a lacrosse stick 10 comprises a handle 12 which is rigidly attached to a shank 13 of a hooked portion 14. The handle 12 is formed as shown in Figure 5 wherein a eight-flatsided plastic tube 42 has inwardly extending longitudinal ribs 44 for strengthening the tube 42 and for frictionally engaging a rod 46 which also strengthens the handle 12. The rod is preferably round and made of wood but it may be made of any other suitable material such as aluminum tubing or aluminum rod and the shape of the rod may be changed if required. Hoult teaches (column 2, lines 54-57) that "[t]he shape of the cross-section of the plastic tube 42 is optional although non-circular cross-section improves a player's grip and makes for a rotation-resistant joint at the shank."

Kuebler's invention concerns a racket for tennis or the like games, having a frame for receiving stringing, comprising a possibly hollow profile bar, as well as a

handle which is polygonal in cross-section and which can be wound around with a grip strip and whose blank is provided at the corners of the cross-section with longitudinal edges which each separate two longitudinal surfaces. Kuebler teaches (column 1, lines 11-38) that:

A racket of that kind is to be found for example in the present applicant's U.S. Pat. No. 4,664,380. The tennis player who is familiar with the racket is possibly in a position to be aware of the position of the racket in his hand, because of the longitudinal edges of the handle blank, which he can feel.

As it is increasingly attempted to increase the thickness of the grip strip and to improve the damping properties of the racket, for example by cushioning, the longitudinal edges can no longer be felt and the user of the tennis racket does not have the above-indicated information.

In consideration of those factors the invention [sic] set himself the aim of retaining the information-supplying capability of a racket handle, even when using a relatively thick grip strip.

That object is attained by the teaching of the independent claim which involves making the longitudinal edges raised relative to their longitudinal surfaces.

In accordance with the invention, arranged at the longitudinal edges are longitudinal ribs which can extend over the entire length of the blank or only over a part of the blank.

By virtue of that configuration, the information relating to the position of the tennis racket can still be felt, even when using handles which are foam-encased.

The appendant claims set forth desirable configurations.

The longitudinal ribs according to the invention may be of different cross-sections, for example they may be bead-like or ridge-like, round or polygonal, and they may possibly also be of an undercut configuration.

Figure 1 of Kuebler is a plan view of a tennis racket 10 having a stringing frame 12 comprising a profile bar 14 which is bent approximately to an oval shape, and a frame crosspiece 16 which completes that oval; arranged in the oval of the frame 12 is stringing comprising mutually crossing longitudinal and transverse strings 18 and 19 which pass through the frame 12 and the frame crosspiece 16. Outside the frame 12 the two end portions 15 of the profile bar 14 laterally define a free area 20, which is triangular in plan view, of a throat or heart zone which has the end portions 15 and the frame crosspiece 16. At the ends thereof which are remote from the frame, on the axis A of the racket, the end portions 15 merge into a handle neck 22 which is adjoined by a handle 24 with a handle strip winding 28 which covers over a handle cap 26.

In order to be able to supply the tennis player with information about the position of the handle 24 and thus the tennis racket 10 in the hand, the longitudinal edges of the handles are provided with longitudinal ribs 36, as shown in Figure 3 of Kuebler, which can be felt even through relatively thick foam. The longitudinal ribs 36 can be continuous or interrupted. Figure 4 of Kuebler shows a plurality of cross-sectional shapes, illustrated for the sake of clarity of the drawing in the form of portions of the wrapping tape or strip 34, more specifically substantially round longitudinal ribs 36 with an undercut configuration, round longitudinal ribs 36_a without an undercut configuration,

undercut quadrangular ribs 36_b and quadrangular ribs 36_c which are of right-angled cross-sectional configuration or which taper outwardly. The quadrangular ribs 36_b may also stand up at a right angle from their longitudinal surface 31, while the longitudinal ribs may also be of triangular cross-sections (not shown). Figure 5 of Kuebler depicts longitudinal ribs 37 of sawtooth-like longitudinal section.

Dupuis' invention provides a handle for a tool, instrument, or other object or article that enables perfect and natural adaptation of the shape of the handle to the hand that is holding it (translation, p. 4). As shown in Figures 1-9, the handle may be used on a tennis racquet. As shown in Figures 1-2, the handle has an octagonal core 3 surrounded by a flexible sheath 4. The flexible sheath 4 lies against the core 3 near the apexes of the core while forming bulged areas 5 that create spaces which are filled with small beads 6. The external configuration of the handle, thus, deforms to follow the contours of a gripping hand.

Claim 1

We sustain the rejection of claim 1 under 35 U.S.C. § 103.

Claim 1 reads as follows:

A lacrosse stick, comprising,

a rigid elongate member, having a length and a longitudinal axis, comprising a plurality of ridges and trenches which extend along substantially the entire length of said elongated member and which are substantially parallel to said longitudinal axis; and

a lacrosse stick head, comprising a means for fixing said rigid elongate member to said lacrosse stick head.

In the rejection of claim 1 under 35 U.S.C. § 103 before us in this appeal, the examiner concluded (answer, p. 3) that it would have been obvious to one of ordinary skill in the art to have formed Hoult's handle in the manner taught by Kuebler (i.e., to have provided the edges of Hoult's handle with longitudinal ribs as taught by Kuebler). The appellants argue (brief, p. 4) that this rejection of claim 1 is in error because Kuebler provides the longitudinal ribs to hold his handle covering in place, which is contrary to the purpose and benefits of the claimed invention.

In our view, the combined teachings of Hoult and Kuebler would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have provided the edges of Hoult's handle with longitudinal ribs as taught by Kuebler so that the information relating to the position of Hoult's lacrosse stick can still be felt, even when using heavy gloves.² The appellants' argument is not persuasive that any error in the examiner's determination regarding the obviousness of the claimed subject matter

² In our view, a heavy glove worn by a lacrosse player is the functional equivalent to the grip strip found on the handle of a tennis racket.

has occurred. As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventors. See In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert. denied, 500 U.S. 904 (1991) and In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

In addition, it is our view that the subject matter of claim 1 is anticipated by Hoult. In that regard, the claimed rigid elongate member is readable on Hoult's handle 12 which has a plurality of inwardly extending longitudinal ribs 44 which ribs define ridges and trenches which extend along substantially the entire length of the handle. Affirmance of the 35 U.S.C. § 103 rejection is appropriate, since it is well settled that a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is affirmed.

Claims 2, 6 and 8

The appellants have grouped claims 1, 2, 6 and 8 as standing or falling together.³ Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 2, 6 and 8 fall with claim 1. Thus, it follows that the decision of the examiner to reject claims 2, 6 and 8 under 35 U.S.C. § 103 is also affirmed.

Claim 9

We sustain the rejection of claim 9 under 35 U.S.C. § 103.

Claim 9 adds to parent claim 8⁴ the further limitation that an interior surface of the handle (i.e., the hollow elongated member) comprises a plurality of ridges and trenches.

The appellants argue (brief, p. 5) that the examiner has not specifically addressed the limitations of claim 9 and that none of the references disclose an interior surface of the handle comprising a plurality of ridges and trenches.

³ See page 2 of the appellants' brief.

⁴ Claim 8 recites that the exterior surface of a hollow elongated member (i.e., the handle) comprises a plurality of ridges and trenches substantially parallel to one another. As such claim 8 would not be anticipated by Hoult.

We find the appellants' argument unpersuasive since Hoult's handle 12 has a plurality of inwardly extending longitudinal ribs 44 which ribs define interior ridges and trenches. While the examiner should have responded to the appellants' argument by pointing to ribs 44 of Hoult, the examiner's failure to do so does not constitute grounds for reversal of the rejection.

For the reasons set forth above, the decision of the examiner to reject claim 9 under 35 U.S.C. § 103 is affirmed.

Claims 7 and 10

We will not sustain the rejection of claims 7 and 10 under 35 U.S.C. § 103.

Claims 7 and 10 add to their respective parent claims the limitation that the elongated member has "a top surface and a bottom surface and wherein one of said trenches is provided in said top surface and said bottom surface is flat."

We find ourselves in agreement with the appellants' argument (brief, pp. 4-5) that Kuebler does not disclose a flat bottom surface as claimed. In our view, contrary to the position taken by the examiner (answer, p. 3), the top surface of Kuebler's handle (see Figure 3) has a trench and the bottom surface has a trench. Thus, the bottom

surface is not flat as claimed. Accordingly, the decision of the examiner to reject claims 7 and 10 under 35 U.S.C. § 103 is reversed.

Claims 11 to 15

We will not sustain the rejection of claims 11 to 15 under 35 U.S.C. § 103.

Claims 11 to 15 include the limitation that "one or more of said ridges has an asymmetrical profile."

We find ourselves in agreement with the appellants' argument (brief, p. 5) that it would not have been obvious to modify Hoult to have a ridge with an asymmetrical profile as claimed. In our view, the ribs 36, 36_a, 36_b and 36_c of Kuebler all have a symmetrical profile. While the rib 37 of Kuebler has an asymmetrical profile as shown in Figure 5, it would not have been obvious at the time the invention was made to a person of ordinary skill in the art to have included such a profile in the lacrosse stick of Hoult since such a profile would interfere in a player moving their hands up and down the handle as is typically done when playing lacrosse. Accordingly, the decision of the examiner to reject claims 11 to 15 under 35 U.S.C. § 103 is reversed.

Claims 3 to 5

We will not sustain the rejection of claims 3 to 5 under 35 U.S.C. § 103.

Claims 3 to 5 include the limitation that "one or more of said ridges is a large ridge and one or more of said ridges is smaller than said large ridge."

We find ourselves in agreement with the appellants' argument (brief, p. 6) that Dupuis discloses only ridges having the same size and therefore does not suggest both a large ridge and a ridge which is smaller than the large ridge. In our view, the eight corners of Dubuis' core 3 are not ridges. Accordingly, the decision of the examiner to reject claims 3 to 5 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 6, 8 and 9 under 35 U.S.C. § 103 is affirmed and the decision of the examiner to reject claims 3 to 5, 7 and 10 to 15 under 35 U.S.C. § 103 is reversed.

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

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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NIELDS LEMACK & DIGMAN
176 EAST MAIN STREET STE 8
WESTBORO, MA 01581

JVN/jg