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11/675,383	02/15/2007	Brian Gallagher	GALG-09CI	6206
26875	7590	03/01/2013	EXAMINER	
WOOD, HERRON & EVANS, I.L.P. 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			GRAHAM, MARK S	
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1 Claim 18 recites:

2 18. A training bat comprising:

3 An outer structural shell having a handle  
4 section 26, a barrel section 22 having an outside  
5 diameter (D2) and an inside substantially  
6 cylindrical surface, and a transition section 24  
7 between the handle section and the barrel section;

8 a rubber tube 28 in tight contact with the  
9 inside substantially cylindrical surface;

10 wherein the outside diameter (D2) of the  
11 barrel section is in the range between about 1 ½  
12 inches and about 1 ¾ inches; and

13 wherein the rubber tube, substantially  
14 cylindrical surface, and outside diameter combine  
15 to give a ball hit by the training bat true  
16 compression and game-like exit speeds, and the  
17 weight and swing weight of a regulation diameter  
18 bat of the same length.

19

20 DISMISSAL OF THE APPEAL AS TO CLAIMS 1-17

21 The Notice of Appeal filed August 14, 2009 states that the Appellant  
22 “hereby appeals to the Board of Patent Appeals and Interferences [now the  
23 Patent Trial and Appeal Board] from the last decision of the examiner.”  
24 Page 3 of the Appeal Brief filed December 30, 2009 states that “[c]laims 1-  
25 21 stand rejected. Claims 18-21 are now on appeal.” Neither the Appeal  
26 Brief nor the Reply Brief filed June 16, 2010 includes any argument  
27 addressed to the rejection of claims 1-17. Since the Appellant’s submissions  
28 unequivocally indicate that they do not intend to pursue an appeal from the  
29 rejection of claims 1-17, we DISMISS the appeal as to those claims. *See Ex*  
30 *parte Ghuman*, 88 USPQ2d 1478, 1480 (BPAI 2008)(precedential). We

1 note that § 1215.03 of the MANUAL OF PATENT EXAMINING PROCEDURE  
2 states that a “withdrawal of the appeal as to some of the claims on appeal  
3 operates as an authorization to cancel those claims from the application.”  
4

5  
6 ISSUES

6 The Examiner finally rejects claims 18-21 under 35 U.S.C. § 103(a) as  
7 being unpatentable over Buiatti (US 6,663,517 B2, issued Dec. 16, 2003)  
8 and Mulhausen (US 6,050,908, issued Apr. 18, 2000). The Examiner also  
9 provisionally rejects claims 18-21 on the ground of non-statutory  
10 obviousness-type double patenting as being unpatentable over claims 5-8  
11 and 11 of Gallagher (US Appl’n 11/000,278, filed Nov. 30, 2004) in view of  
12 Buiatti. We decline to address the latter ground of rejection as moot: On  
13 July 27, 2010, during the pendency of this appeal, the Appellant abandoned  
14 the prior application on which the obviousness-type double patenting  
15 rejection was based.

16 The Appellant appears to argue the patentability of claims 19-21  
17 solely on the basis of the dependency of claims 19-21 from independent  
18 claim 18. (*See* App. Br. 11). Therefore, the rejection of claim 18 under  
19 § 103(a) is representative of the rejections of the other claims on appeal.

20 Only issues and findings of fact contested by the Appellant have been  
21 considered. *See Ex parte Frye*, 94 USPQ2d 1072, 1075-76 (BPAI 2010)  
22 (precedential). Two issues are dispositive of this appeal:

23 *First*, do the evidence and technical reasoning underlying  
24 the rejection of claim 18 adequately support the conclusion that  
25 one of ordinary skill in the art would have had reason to  
26 provide a training bat having an insert and elastomeric layer

1 similar to that described by Buiatti; a reduced diameter of 1½  
2 inch to 1¾ inch; but the same weight and swing weight? (*See*  
3 App. Br. 9-11; Reply Br. 1-2).

4 *Second*, does the Examiner have a sound basis for belief  
5 that a training bat as proposed by the Examiner having an insert  
6 and elastomeric layer similar to that described by Buiatti; a  
7 reduced diameter of 1½ inch to 1¾ inch; but the same weight  
8 and swing weight, necessarily would have given a ball hit by  
9 the training bat true compression and game-like ball exit  
10 speeds? (*See* Reply Br. 2).

#### 11 12 FINDINGS OF FACT

13 The record supports the following findings of fact (“FF”) by a  
14 preponderance of the evidence.

15 1. Buiatti describes a bat having a handle *12*, barrel *14* and a  
16 tapered section *16* interconnecting the handle *12* and the barrel *14*. (Buiatti,  
17 col. 2, ll. 36-38).

18 2. Buiatti further describes the bat as having a rigid outer shell *10*  
19 which confines a substantially cylindrical rigid insert *30* in the barrel *14*.  
20 The bat also has a resilient elastomeric layer *40* sandwiched between the  
21 outer shell *10* and the rigid insert *30*. (Buiatti, col. 2, l. 65 – col. 3, l. 8). In  
22 other words, the elastomeric layer *40* is trapped in tight contact with an  
23 inside substantially cylindrical surface of the barrel *14*. (*See* Buiatti, fig. 1).

24 3. Buiatti teaches that the bat “is designed for increased wall  
25 compliance and trampoline effect, strength and durability by use of a unique

1 layered construction which is light weight yet strong and dent resistant.”  
2 (Buiatti, col. 2, ll. 56-59).

3 4. Buiatti states as an object “to provide a more compliant  
4 lightweight yet strong and durable metal shell softball bat.” (Buiatti, col. 2,  
5 ll. 5-7). Buiatti further teaches that “[r]eduction of the wall thickness of the  
6 outer shell **10** of a tubular bat *desirably* reduces the weight of the bat . . . .”  
7 (Buiatti, col. 2, ll. 44-49 (italics added)).

8 5. Mulhausen describes a training bat *10* including a handle  
9 member *20* and at least one detachable elongated contact surface member  
10 *30*. (Mulhausen, col. 4, ll. 31-36). Each detachable elongated contact  
11 surface member *30* has an outer diameter between one inch and one-and-a-  
12 half inch. (Mulhausen, col. 4, ll. 39-40).

13 6. Mulhausen teaches use of the training bat *10* by attempting to  
14 strike a ball *5* with the detachable elongated contact surface member *30*.  
15 (*See* Mulhausen, col. 6, ll. 53-55). Therefore, the detachable elongated  
16 contact surface member *30* of Mulhausen’s training bat *10* serves the same  
17 purpose as the barrel portion of a regulation bat.

18 7. Mulhausen teaches that use of the training bat *10* with the  
19 detachable elongated contact surface member *30* of outer diameter in the  
20 range of one inch to one-and-a-half inch improves a batter’s batting  
21 technique and eye-to-hand coordination. (Mulhausen, col. 3, ll. 10-13).

22 8. Mulhausen states as an object “to provide a training bat with a  
23 plurality [of] detachable elongated contact surface members wherein each  
24 detachable elongated contact surface member has a different length and  
25 weight, or diameter.” (Mulhausen, col. 3, ll. 6-10). Mulhausen teaches that  
26 “the increased length and weight of each detachable elongated contact

1 surface member allows the training bat to be adapted for various ages,  
2 heights and strengths of the batter.” (Mulhausen, col. 3, ll. 14-17).

3

4

## ANALYSIS

### 5 *First Issue*

6 Mulhausen suggests that the use of a training bat having a barrel (or  
7 detachable elongated contact surface member 30 functioning as a barrel (*see*  
8 FF 6)), of one inch to one-and-a-half inch improves batting technique and  
9 eye-to-hand coordination. (*See* FF 7). Therefore, one of ordinary skill in the  
10 art would have had reason to reduce the diameter of the barrel 14 of a  
11 regulation bat such as that described by Buiatti in order to provide a training  
12 bat. The Appellant does not appear to argue that the implementation of this  
13 reduction in barrel diameter would have been beyond the level of ordinary  
14 skill in the art. Neither does the Appellant appear to contend that the success  
15 of this effort might not have been reasonably predictable.

16 As the Examiner correctly concludes, as a matter of common sense,  
17 one of ordinary skill in the art would have had reason to retain physical  
18 characteristics such as the weight and swing weight of a regulation bat even  
19 while reducing the barrel diameter to improve batting technique and eye-to-  
20 hand coordination. (*See* Ans. 5-6). Given the popularity of organized  
21 baseball and softball in the United States, an ordinary layman, not to  
22 mention one of ordinary skill in the art, would have recognized that training  
23 with a bat of reduced weight or swing weight relative to a regulation bat  
24 might have diminished the batter’s ability to swing a regulation bat properly  
25 when desired. *Perfect Web Techs. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328-29  
26 (Fed. Cir. 2009)(an examiner when analyzing evidence of obviousness may

1 employ common sense not inconsistent with the ordinary level of knowledge  
2 and skill in the art at the time of the invention). Once again, the Appellant  
3 does not appear to argue that the implementation of this retention of bat  
4 weight and swing weight would have been beyond the level of ordinary skill  
5 in the art. Neither does the Appellant appear to contend that the success of  
6 this effort might not have been reasonably predictable.

7 Buiatti does not teach away from reducing the diameter of the barrel  
8 *14* of a regulation bat such as that described by Buiatti while retaining the  
9 same weight and swing weight. (*See* App. Br. 10-11). Buiatti describes a  
10 regulation bat, not a training bat. Therefore, Buiatti’s teaching that it may be  
11 desirable to make a *regulation* bat lightweight (*see* FF 3 and 4) would not  
12 have discouraged one of ordinary skill in the art from retaining a regulation  
13 weight and swing weight when constructing a *training* bat. *In re Gurley*, 27  
14 F.3d 551, 553 (Fed. Cir. 1994)( A reference teaches away from the subject  
15 matter of a claim only if “a person of ordinary skill, upon reading the  
16 reference, would be discouraged from following the path set out in the  
17 reference, or would be led in a direction divergent from the path that was  
18 taken by the applicant.”). Likewise, Mulhausen’s suggestion that detachable  
19 elongated contact surface members might be provided having lesser weights  
20 for batters of lesser height, age, or strength (*see* FF 8) would not have  
21 discouraged one of ordinary skill in the art from providing a training bat  
22 having regulation weight and swing weight for an adolescent or adult of  
23 suitable strength.

24



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