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EXAMINER

GORDEN, RAEANN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YASUSHI ICHIKAWA and CHIA-CHYI CHENG

Appeal 2014-009229
Application 13/004,829
Technology Center 3700

Before LINDA E. HORNER, ANNETTE R. REIMERS, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Yasushi Ichikawa and Chia-Chyi Cheng (Appellants)¹ seek our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1, 3, and 6–8.² We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Appellants identify the real party in interest as Nike, Inc. Appeal Br. 1.

² Claims 4 and 5 are withdrawn from consideration, and claims 2 and 9–20 are canceled.

CLAIMED SUBJECT MATTER

Appellants' claimed subject matter relates to "a cover layer on [a] golf ball includ[ing] areas having a higher hardness and areas having a lower hardness." Spec., para. 1. Claim 1 is the sole independent claim and is reproduced below.

1. A golf ball comprising:
 - a core, and
 - a cover layer, the cover layer substantially surrounding the core and including a plurality of dimples and at least one land area separating the dimples, the cover including
 - a first portion, the first portion of the cover layer having a first hardness and at least one dimple thereon, and
 - a second portion, the second portion of the cover layer having a second hardness and at least a part of the at least one land area thereon;
- wherein the first portion and the second portion are non-overlapping portions of a continuous cover layer material; and
- the first hardness is higher than the second hardness,
- wherein the first portion of the cover layer and the second portion of the cover layer have the same composition.

REJECTIONS

The Final Action, dated March 26, 2013 (“Final Act.”), from which this appeal is taken, included the following grounds of rejection³:

1. Claims 1, 3, and 6–8 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.
2. Claims 1, 3, and 6–8 under 35 U.S.C. § 103(a) as unpatentable over Chen (US 2008/0081710 A1, issued April 3, 2008).

ANALYSIS

First Ground of Rejection

The Examiner determined that the subject matter of claims 1, 3, and 6–8 is not enabled by Appellants’ Specification because “the [S]pecification does not disclose the difference in hardness [between the dimples and land areas] as a permanent feature.” Final Act. 2. The Examiner noted that the change in hardness effected by heating the golf ball is temporary and the “final” state of the golf ball cover does not have a hardness difference. *Id.* The Examiner also determined that “Applicant appears to be claiming a ‘method’ of using the golf ball and not the final ‘product’.” *Id.* at 2–3.

We are aware of no legal authority requiring that a specification enable a final product when a claim is directed to a transitory product. Rather, the Manual of Patent Examining Procedure (“MPEP”) instructs that “for unstable and transitory chemical intermediates, the ‘how to make’

³ The Final Action also included double patenting rejections of claims 1, 3, and 6–8. Final Act. 4–5. The Examiner withdrew these grounds of rejection in the Examiner’s Answer, dated June 25, 2014 (“Ans.”). Ans. 3.

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requirement [of 35 U.S.C. § 112, first paragraph] does not require that the applicant teach how to make the claimed product in stable, permanent or isolatable form.” MPEP § 2164.01(b) (9th ed.) (July 2015 revision) (citing *In re Breslow*, 616 F.2d 516, 521 (CCPA 1980) (reversing rejections under 35 U.S.C. §§ 101 and 112, first paragraph, for lack of enablement and holding that chemical intermediates are patentable compositions of matter under § 101 even if they are “transitory, unstable, and non-isolatable”).

The claimed subject matter, as defined by the appeal claims, is the golf ball comprising, *inter alia*, a cover having a first portion having a first hardness and at least one dimple thereon and a second portion having a second hardness and at least a part of the at least one land area thereon, wherein the first hardness is higher than the second hardness. The Specification describes how to make and use the claimed golf ball by selectively treating (e.g., heating) one of the two portions of the cover to change the material’s crystal structure to cause the land area to become softer or the dimple area to become harder. Spec., paras. 42–50. The fact that the golf ball cover, so treated, may not retain permanently the different hardnesses, does not render the claimed golf ball not enabled.

We agree with Appellants that that Examiner erred in determining that the claims are directed to a method of using the golf ball. The claims do not recite acts or steps. *See In re Nuijten*, 500 F.3d 1346, 1355 (Fed. Cir. 2007) (“The Supreme Court and this court have consistently interpreted the statutory term ‘process’ to require action”). Even if a user must perform certain acts to achieve different hardnesses of the claimed golf ball, such acts

do not transform a claim covering a thing – the golf ball itself – into one covering the process by which that thing was made or used. *See id.* In this case, as in *Breslow*, the claimed golf ball cover, while temporary, does exist. *Breslow*, 616 F.2d at 518, 521 (the court noting that in the enablement rejection, the board “was too literal about the need for the artisan to be in possession of the claimed compounds in the sense of hold them for a time in his hands in a ‘reasonable stable’ form”); *see also* Chen, paras. 46, 117, Table 2 (noting that the phase transition imparted by heating the cover can persist for hours or weeks). We are aware of no authority holding that claims are not enabled unless the claimed subject matter is limited to what will be sold in the market place.

For these reasons, we do not sustain the rejection of claims 1, 3, and 6–8 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Second Ground of Rejection

The Examiner found, with respect to independent claim 1, that Chen discloses a golf ball comprising a core and a dimpled cover, which is made from a phase transition material that allows the hardness to be changed temporarily due to heating. Final Act. 3 (citing Chen, para. 96). The Examiner determined:

Since the materials for the cover layers are identical[,] the method of temporarily altering the cover hardness will also be the same. In other words, the golf ball of Chen is capable of having dimples and[/]or land areas harder or softer than the other areas, which is based on the method of using the golf ball and not the final product.

Id.; *see also* Ans. 4.

While we agree with the Examiner's finding that the claimed golf ball includes the same phase transition cover material as disclosed in Chen (*see* Spec., para. 43), as we explained *supra*, the Examiner erred in interpreting claim 1 to be directed to a method of using the golf ball. Chen discloses that the temperature of the phase transition material may be raised by the following techniques:

in a warm water bath, a boiling water bath, a steam bath, a conventional oven, in another environment with a temperature higher than ambient, such as a glove compartment or the trunk of a car, in a microwave oven, by removal from a cold environment such as the interior of a refrigerator, or by magnetic or electromagnetic induction.

Chen, para. 42. Use of these disclosed techniques would result in the entire phase transition material layer (e.g., the cover) undergoing phase transition.

Chen does not disclose selective treatment of only a portion of the cover to result in a golf ball having a higher hardness in one portion of the cover as compared to another portion of the cover. *See, e.g.*, Chen, para. 88 (discussing adding a susceptor to the phase transition material by adding flakes of susceptor material to the phase transition material during pre-extrusion melt mixing “[t]o promote uniformity of distribution of the susceptor”). Thus, the structure of Chen's golf ball, after undergoing the treatment disclosed in Chen, differs from the claimed structure wherein a first portion of the cover layer has a higher hardness than a second portion of the cover layer. The Examiner's finding that Chen's ball would be capable of having the claimed hardness difference, if treated according to the method

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disclosed in Appellants' Specification, is not a sufficient basis for a determination of obviousness of the claimed golf ball.

For these reasons, we do not sustain the rejection of independent claim 1, or its dependent claims 3 and 6–8, under 35 U.S.C. § 103(a) as unpatentable over Chen.

DECISION

The decision of the Examiner to reject claims 1, 3, and 6–8 is REVERSED.

REVERSED