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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SIMON GARRY MOORE

Appeal 2016-003342
Application 13/712,571
Technology Center 3700

Before LYNNE H. BROWNE, JEFFREY A. STEPHENS, and
ERIC C. JESCHKE, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Simon Garry Moore (Appellant) appeals under 35 U.S.C. § 134(a) from the rejection of claims 1, 5, 6, 8–10, 19, and 23–25, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

CLAIMED SUBJECT MATTER

Claims 1 and 19 are independent. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A golf club having a coupled head and shaft comprising:
 - a connection mechanism to couple the head to the shaft, said connection mechanism including:
 - a first part and a second part, the first part having a body that defines a first internal bore, wherein the first part engages a hosel of the head and rotates with respect to the hosel between a first plurality of rotational positions, wherein each of the first plurality of rotational positions is respectively identified by a different one of a first plurality of markings; and
 - the second part coupled to the shaft at a distal end of the shaft and configured to be inserted into the first internal bore, wherein the second part is rotatable with respect to the first part between a second plurality of rotational positions, wherein each of the second plurality of rotational positions is respectively identified by a different one of a second plurality of markings, said second part having a second internal bore, wherein the second internal bore is inclined with respect to the first internal bore and receives said distal end of the shaft,
 - wherein aligning a first marking selected from the first plurality of markings and a second marking selected from the second plurality of markings with an indicia provided on at least one of the head and the shaft disposes the head at an orientation that is defined by a loft angle and a lie angle of the head relative to the shaft;
 - wherein rotating the first part, while maintaining the second marking in alignment with the indicia, alters at least one of the loft angle and the lie angle of the head relative to the shaft;
 - wherein rotating the second part, while maintaining the first marking in alignment with the indicia, alters at least one of the loft angle and the lie angle of the head relative to the shaft;
 - wherein the first part includes a spline, key detail, or ridge to inhibit relative rotation of the second part relative to the first part when the second part is fully inserted into the first internal bore; and

wherein the first part and the second part are slidably engaged to provide for rotational adjustment of the second part relative to the first part.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Rusing	US 2,027,452	Jan. 14, 1936
Wettlaufer	US 2,219,670	Oct. 29, 1940
Wharton	US 4,948,132	Aug. 14, 1990
Ingalls	US 7,210,693 B2	May 1, 2007
Soda	JP 9-164227	Dec. 15, 1995

REJECTIONS

- I. Claims 1, 6, 8–10, 19, and 23–25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Soda, Ingalls, Wettlaufer, and Wharton.
- II. Claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Soda, Ingalls, Wettlaufer, Wharton, and Rusing.

DISCUSSION

Rejection I

The Examiner finds that Soda, Ingalls, Wettlaufer, and Wharton disclose or suggest all of the limitations of claim 1. *See* Final Act. 2–7. In particular, the Examiner finds that “Ingalls discloses a dual axis bushing assembly with both a first and second rotatable part (Fig. 2C).” *Id.* at 4. The Examiner further finds that each part of Ingalls’ dual axis bushing assembly has “inner and outer surfaces which are circular (Figs. 9A, 9B)” and that the

“second part is configured to be rotatably inserted into a first internal bore” of the first part. *Id.* The Examiner finds that the “second part is rotatable with respect to the first part between a second plurality of rotational positions, [and the] second part [has] a second internal bore [] inclined with respect to the first internal bore . . . in order to have the most offset potential.” *Id.* (citing Ingalls 14:47–50). Based on these and other findings, the Examiner determines that it would have been obvious

to modify the club of [Soda] to have a second rotatable part coupled at a distal end of the shaft and configured to be rotatably inserted into a first internal bore in addition to first rotatable part that engages the head, [wherein the] second part is rotatable with respect to the first part between a second plurality of rotational positions, [and the] second part [has] a second internal bore [that is] inclined with respect to the first internal bore and receives the distal end of the shaft . . . in order to have the most offset potential between a shaft and a head as compared to using only one rotatable bushing with an inclined bore..

Id. at 4–5.

Appellant contends that the Examiner fails to set forth reasoning with rational underpinning for the proposed modification. *See* Appeal Br. 9–10. In support of this contention, Appellant argues that “[t]he presently claimed connector . . . is not concerned with ‘offset.’ Instead, claim 1 specifically requires ‘an orientation that is defined by a loft angle and a lie angle of the head relative to the shaft.’” *Id.* at 9. In this regard, claim 1 requires a connection mechanism “wherein rotating the first part, while maintaining the second marking in alignment with the indicia, alters at least one of the loft angle and the lie angle of the head relative to the shaft” and “wherein rotating the second part, while maintaining the first marking in alignment with the indicia, alters at least one of the loft angle and the lie angle of the

head relative to the shaft.” *Id.* at 16–17 (Claims App.). Appellant further argues that “[r]egardless of whether dual bushing designs were known at the time of the invention, the rejection fails to provide any evidence that an increase in offset potential would provide any benefits or address any known issues.” *Id.* at 10.

Responding to this argument, the Examiner explains that:

Sometimes a structure is able to be described using different terms due to the fact there are different perspectives one is able to take with respect to the structure. The Examiner strongly believes that both the terms orientation and offset are able to be used to describe both the joint of Ingalls and the joint of [Soda]. In figure 7D in Ingalls clearly there are different orientations of the bore of the dual bushing assembly (10) which produces different orientations of stud (24) of the ball joint (22) (Fig. 1) which goes through the bore of the dual bushing axis (Fig. 70). It is the orientation changes that allow the offset and translation changes. The same is true with golf clubs. In figures 1 and 2 of [Soda] the different orientations of bushing (5) will produce a different offset of the grip at the end of the shaft.

Ans. 14.

While it may be true that, as shown in Soda’s Figures 1 and 2, different orientations of Soda’s bushing 5 result in varying the “offset” of the grip with respect to the end of the shaft, that finding alone is insufficient to explain why one skilled in the art would have made the proposed modification. In this case, despite explaining in detail why he considers Ingall’s offset potential to be the equivalent of the claimed orientation, the Examiner does not articulate sufficient reasons why one skilled in the art would have modified Soda in view of Ingall’s teachings. The Examiner merely opines that an increase in offset potential is desirable, without explaining why that would be so. However, “it is not enough to simply

show that the references disclose the claim limitations; in addition, ‘it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.’” *Transocean Offshore Deepwater v. Maersk Contractors*, 617 F. 3d 1296, 1303 (Fed. Cir. 2010) (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 401 (2007)).

Moreover, although we do not agree with Appellant that the Examiner must provide “evidence that demonstrates why [Soda] would benefit from increased offset potential, or that such a modification would even be desirable” (Appeal Br. 9 (citations omitted)), the Examiner must articulate reasons supported by rational underpinning for the proposed modification. *See KSR*, 550 U.S. at 418 (noting that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit). The Federal Circuit has stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR*, 550 U.S. at 418.

For this reason, we do not sustain the Examiner’s decision rejecting claim 1, and claims 6, and 8–10, which depend therefrom. The Examiner’s rejection of claim 19 and claims 23–25, which depend from claim 19, suffers from the same deficiency. *See* Final Act. 2–7. Accordingly, we do not sustain the Examiner’s decision rejecting these claims.

Rejection II

The Examiner's rejection of claim 5 suffers from the same deficiency as the rejection of claim 1 discussed *supra*. See Final Act. 7–8. Rusing does not cure this deficiency. See *id.* Accordingly, we do not sustain the Examiners' decision rejecting claim 5.

DECISION

The Examiner's rejections of claims 1, 5, 6, 8–10, 19, and 23–25 are REVERSED.

REVERSED