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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/949,610	07/24/2013	In Hong HWANG	16129-000061-US	5857
28997	7590	12/19/2019	EXAMINER	
Harness Dickey (St. Louis) 7700 Bonhomme, Suite 400 ST. LOUIS, MO 63105			STANCZAK, MATTHEW BRIAN	
			ART UNIT	PAPER NUMBER
			3711	
			NOTIFICATION DATE	DELIVERY MODE
			12/19/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* IN HONG HWANG and KYUNG AHN MOON

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Appeal 2018-000033  
Application 13/949,610  
Technology Center 3700

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Before CHARLES N. GREENHUT, BENJAMIN D. M. WOOD, and  
FREDERICK C. LANEY, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1, 2 and 5–9. *See* Non-Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM AND DESIGNATE NEW GROUNDS OF REJECTION.

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<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Volvik, Inc. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed to a golf ball with a dimple pattern arranged in spherical polygons having sides with different lengths. Claim 1, reproduced below, with emphasis added, is the sole independent claim before us:

1. A golf ball comprising:

a dimple pattern of dimples on the golf ball that are arranged in spherical polygons having sides with different lengths,

wherein an arbitrary point on a surface of a spherical body constituting the golf ball is defined as a pole Pa,

wherein a great circle dividing the spherical body into a northern hemisphere and a southern hemisphere with respect to the pole Pa as a reference point is defined as an equator E,

wherein the surface of the spherical body is divided into six areas formed by segments connecting points E1, E3, E5, E7, E9, and E11 obtained by dividing the equator E in units of 60° and the pole Pa,

wherein each area is divided into spherical polygons formed by four spherical polygons each having four different-length sides and two spherical triangles having different side lengths,

wherein the spherical polygons arranged in different adjacent areas have dimple patterns of dimples on the golf ball, and

*wherein when points E1 to E7, E3 to E9, and E5 to E11 are connected to form three straight lines, each of the three straight lines successively alternates between dividing in half dimples arranged along the line and positioning, without dividing, dimples to the sides of the straight line.*

REFERENCE

The prior art relied upon by the Examiner is:

Name	Reference	Date
SAJIMA	US 2010/0190584 A1	July 29, 2010

## REJECTIONS

Claims 1, 2, and 5–9 are rejected under 35 U.S.C. § 112(b) as being indefinite. Non-Final Act. 2.

Claims 1, 2, and 5–9 are rejected under 35 U.S.C. § 103 as being unpatentable over Sajima. Non-Final Act. 4.

## OPINION

*35 U.S.C. §§ 112(a) and (b)*

The indefiniteness issue raised by the Examiner under 35 U.S.C. § 112(b) regarding the clause of claim 1 emphasized above relates to the fact that “the lines does [sic] not ‘position’ the dimples (unless appellant is claiming a method of creating and/or laying dimples). The dimples are already positioned on the product of the golf ball.” Final Act. 2; Ans. 7. Although we are in agreement that using the lines as the subject of the verb positioning is somewhat awkward and clarity might be improved, we do not agree with the Examiner that this actually rises to the level of indefiniteness. The only thing “the lines. . .positioning. . .dimples” could reasonably mean is that the imaginary lines described indicate the location or placement of the dimples. The Examiner does not sufficiently apprise us of an alternate understanding so as to render the claim indefinite. It is clear that the claim is not directed to a process and the claim is not describing the claimed golf by its process of manufacture. The fact that the claim language identified by the Examiner could be more clearly worded does not demonstrate that the claim language is sufficiently ambiguous, vague, or indefinite so as not to comply with 35 U.S.C. § 112(b). *See* MPEP § 2173.02(II) (“The examiner’s focus during examination of claims for compliance with the requirement for definiteness. . .is whether the claim meets the threshold requirements of

clarity and precision set forth in the statute, not whether more suitable language or modes of expression are available.”). Accordingly, we do not sustain the indefiniteness rejection on the basis set forth by the Examiner.

Although we do not sustain the rejection under 35 U.S.C. § 112(b) set forth by the Examiner, we conclude that the claim does not satisfy the requirements of 35 U.S.C. § 112(b) for other reasons.

Claim 1 employs the term “straight lines” to indicate how respective point combinations E1 to E7, E3 to E9, and E5 to E11 “are connected.” Those points are spaced at 60° intervals along the equatorial great circle according to claim 1. Thus, if any of those points are connected by “straight lines” those “straight lines” would necessarily pass internally through the spherical body as opposed to along the surface of the spherical body where the dimples must be located. In such a situation, due to the offset between the lines traversing through the spherical body and the surface of the spherical body, whether the dimples are divided by the line or straddle it would be determinable based only by giving consideration to the viewer’s perspective. This is not a reasonably definite way to define the meets and bounds of the claimed subject matter.

This appears to be an inadvertent error because the subject matter we have described in the preceding paragraph conflicts with that described in the Specification. Spec. 20–23. The Specification indicates the points referred to in the claim are joined by segments along great circles. Spec. 22–23. Such segments would be arcuate, and not “straight lines.” Unresolvable conflicts between the Specification and claims creates issues under *both* the “regards as the invention” and “particularly pointing out and distinctly claiming” prongs of 35 U.S.C. § 112(b). *See* MPEP § 2171 (regarding the two separate requirements of § 112(b)); MPEP § 2172 (concerning the

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“regards as the invention” prong of 35 U.S.C. § 112(b)); MPEP § 2173.03 (citing, inter alia, *In re Cohn*, 438 F2d 989, concerning inconsistencies between the claims and Specification creating indefiniteness). As it essentially amounts to an impossibility to employ lines through the interior of a spherical body, without more, to define the position of dimples on the surface of that body in the manner recited in claim 1, this claim limitation also runs afoul of the both written description and enablement requirements of 35 U.S.C. § 112(a). *See, generally*, MPEP §§ 2163–64.

For the foregoing reasons, pursuant to our authority under 37 C.F.R. § 41.50(b), we reject claim 1, and those claims depending therefrom, as failing to comply with 35 U.S.C. §§ 112(a) and (b).

#### *Obviousness*

Claim 1 is the only claim argued and is representative under 37 C.F.R. § 41.37(c)(1)(iv). Although the limitation at issue regarding the obviousness rejection is the same as that which we held renders the claim indefinite above, for purposes of advancing prosecution we will address herein the limited issues presented concerning the obviousness rejection. We do so under the assumption that Appellant intended, and will amend the claims, to refer to something more similar to arcuate segments joining respective points along the spherical surface, as opposed to the presently recited “straight lines.”

The Examiner advances several alternative positions in reaching a conclusion that the subject matter of claim 1 is obvious. Final Act. 4–6. The Examiner’s position regarding the absence of structural connotations for the recited lines is not well-taken. *See* Final Act. 4–5; Ans. 7; Appeal Br. 10; Reply. Br 2. For the reasons discussed above in connection with the

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Examiner's rejection under 35 U.S.C. § 112(b), although the lines themselves may be imaginary, they clearly have structural implications on dimple placement.

The Examiner's reliance on *In re Dailey*, 357 F.2d 669 (CCPA 1976) and the alleged absence of criticality (Final Act. 5; Ans. 8–9) is also not well-taken for the reasons expressed on pages 12–13 of Appellant's Brief and pages 4–5 of Appellant's Reply Brief. We adopt Appellant's analysis in that regard as our own.

Despite our disagreement with the rationales advanced by the Examiner as indicated above, the following point made by the Examiner is well-taken:

the claim language on its face is unclear if this alternation occurs along the entire length or partially (see Brief, filed 7/31/17, page 11; appellant arguing that 'entire' is implicitly read into the claim, and only with positive addition of 'partially' would the Examiner's position be appropriate; the Examiner confused how the former limitation is implicitly read into the claims while the latter must be explicitly added).

Ans. 8.

Without adding or removing anything from the claim language, the question one must ask for each line to determine if the limitation emphasized above is satisfied is whether successive alternation occurs for "dimples arranged along the line." Appellant agrees that this is the critical phrase and argues that "[t]he phrase 'along the line' indicates the whole line." Reply Br. 3.

Where a structure is recited with an attribute, it is often not unreasonable to regard a recitation of that structure as implying its entirety. For example if one recited, "the line is short" it would likely be

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unreasonable to regard “the line” as referring to only a portion of the line. Conversely, where a structure is recited as the object of a prepositional phrase it is often not unreasonable to regard a recitation of that structure as referring only to a part of that structure. For example, reciting that a dimple is “below the line” does not necessarily require its presence beneath the entire line. The prepositional phrase becomes the focus in such a case and each case must be decided on its own unique facts.

Here, the lines perform an action, they alternate between dividing and positioning, without diving, dimples. *Where* they must do so is “along the line.” In its ordinary use, an act can occur “along” something without happening “along” the entire thing. For example, a house can be built along a river. One can walk along a street or park along a curb. We are not apprised by Appellant of any evidence in the Specification or elsewhere demonstrating an intent to depart from the ordinary and customary meaning of “along.” In fact, in the context of describing the dimples arranged “along each segment” (Spec. 22), the Specification states “the dimples are alternately arranged from the equator to the pole” (Ans. 8 citing Spec. p. 23). This is only *half* of arc of the great circle that connects the respective points “E1 [to] E7, E3 [to] E9, and E5 [to] E11” and not the *entire* line. The Specification does go on to indicate that “the same spherical polyhedron division structure and dimple pattern are applied to the southern hemisphere below the equator E.” Spec. 24. However, our reviewing court has “cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described.” *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369 (Fed. Cir. 2004) (citations omitted).

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The Examiner's interpretation of the claim language "along the line" as not necessarily requiring alternation along the *entire* line strikes the proper balance of being consistent with the Specification without importing limitations from the Specification that Appellant elected to omit from the claims. *See In re Prater*, 415 F.2d 1393, 1404–05, (CCPA 1969) (“[R]eading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.”). With this interpretation, there is no dispute that the single missing dimple identified in Appellant's annotated version of Sajima Figure 10 (Appeal Br. 10) is inconsequential with regard to satisfying the limitation in question. Accordingly, we sustain the Examiner's obviousness rejection.

### CONCLUSION

The Examiner's indefiniteness rejection is reversed. New grounds of rejection are designated for claims 1, 2, and 5–9 under 35 U.S.C. §§ 112(a) and (b). The Examiner's obviousness rejection is affirmed.

DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>	<b>New Ground</b>
1, 2, 5-9	112(b)	Indefiniteness		1, 2, 5-9	1, 2, 5-9
1, 2, 5-9	112(a)	Written description, Enablement			1, 2, 5-9
1, 2, 5-9	103	Sajima	1, 2, 5-9		
<b>Overall Outcome</b>			1, 2, 5-9		1, 2, 5-9

RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection

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and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)