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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* KEITH F. DOLEZEL

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Appeal 2020-000172  
Application 15/611,111  
Technology Center 3700

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Before JILL D. HILL, LEE L. STEPINA, and ARTHUR M. PESLAK,  
*Administrative Patent Judges.*

HILL, *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 1–20. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

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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 Dunlop Sports Co. Ltd. Br. 1.

## BACKGROUND

Appellant's invention relates to a golf club head indicia and method of generating the same. Claims 1 and 10 are independent. Claim 1, reproduced below, illustrates the claimed invention, with certain limitations italicized:

1. A golf club head comprising:
  - a striking face;
  - a bottom portion secured to, and extending rearward of, the striking face; and
  - a top portion secured to, and extending rearward of, the striking face, the top portion comprising a substrate layer and a sealant layer disposed on the substrate layer, a roughened region defining visually identifiable indicia being included *within only the sealant layer*.

## REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Sano	US 2002/0183133 A1	Dec. 5, 2002
Bingle	US 2015/0022994 A1	Jan. 22, 2015
Trahan	US 2016/0067558 A1	Mar. 10, 2016
Dolezel	US 2016/0129321 A1	May 12, 2016

## REJECTIONS

- I. Claims 1–9 stand rejected under 35 U.S.C. § 103 as unpatentable over Sano, Dolezel, and Bingle. Final Act. 6.
- II. Claims 10–20 stand rejected under 35 U.S.C. § 103 as unpatentable over Sano, Dolezel, Bingle, and Trahan. Final Act. 10.

## OPINION

### *Rejection I; Obviousness -- Claims 1–9*

The Examiner finds that Sano discloses many of the limitations of the golf club head of claim 1, including a top portion having a substrate and a

sealant layer on the substrate. Final Act. 6–7. The Examiner further finds that Sano does not disclose a visual identifiable indicia, but Dolezel discloses a visually identifiable indicia on the top of a golf club head. *Id.* at 7. The Examiner concludes that it would have been obvious to modify Sano’s device to include a suitable indicia on the top surface to help a golfer align the club head with an intended target. *Id.* The Examiner finds that, although Dolezel does not disclose that the indicia is only within the sealant layer, Bingle discloses an indicia in a single layer. *Id.* at 8. The Examiner concludes that it would have been obvious to modify Sano to form a roughened surface within a single layer – i.e., only within the top, sealant layer – to keep the substrate intact, while enabling the indicia to remain visible. *Id.*

*Claims 1–3 and 7–9*

Appellant argues claims 1–3 and 7–9 as a group. Br. 6–10. We select independent claim 1 as representative. Claims 2, 3, and 7–9 stand or fall with claim 1.

Appellant takes issue with the Examiner’s finding that it is known to apply indicia only in a sealant layer. Br. 6. Specifically, Appellant asserts that Dolezel does not specify which layer has the indicia. *Id.* Appellant asserts, moreover, that because Sano’s clear coat layer protects the substrate, one of ordinary skill in the art would not sand-blast this protective coating and remove the protection it provides. Br. 7. According to Appellant, based on the thickness of Sano’s coating, there is no suggestion in the art that “a clear coat is both capable of abrasion without deleteriously affecting its function and capable of being abraded in a manner to adequately and permanently bear indicia.” Br. 8.

The Examiner responds that Dolezel is only cited for the location of the indicia, i.e., on the top of the club head. Ans. 9. The Examiner notes that Bingle, which Appellant does not address, was relied on for a roughened surface only in the sealant layer. *Id.* We agree.

Appellant does not explain why the Examiner's proposed combination of references, which includes Bingle, fails to suggest a region "defining visually identifiable indicia being included within only the sealant layer." Specifically, the Examiner cites to paragraphs 68–74 and Figures 26–31 of Bingle as teaching an indicia only within the sealant layer. Final Act. 5. In these cited paragraphs, Bingle discloses "indicia **18'** being defined by the creation of one or more lines through the basecoat **32b'**, such as by laser etching." Bingle ¶ 70. Bingle discloses that "the indicia . . . may be defined to a depth that is less than the overall thickness of [the basecoat 32b]." *Id.* ¶ 75. Given that Sano's coating thickness range of 25 to 90 microns is within Appellant's disclosed thickness range of 20 to 200 microns (Spec. ¶ 27), and Bingle provides indicia in a coating that is less than the overall thickness of the coating, we are not persuaded that Sano's coating could not be partially abraded, as taught by Bingle, to maintain the protecting function of its sealant while providing an indicia. Further, it is unclear to us why a skilled artisan would not find partial removal of a top sealant coat of a club head obvious in light of these combined teachings. For these reasons, we are not persuaded that the Examiner erred in finding that it was known to apply an indicia only in a sealant layer.

Having considered all of Appellant's arguments, we are not apprised of Examiner error, and we sustain the rejection of claim 1. Claims 2, 3, and 7–9 fall with claim 1.

*Claims 4 and 5*

The Examiner finds that the claimed height and average surface roughness of the roughened region is “an obvious matter of choice in the design scheme.” Final Act. 8–9.

Appellant argues that the claimed sealant layer thickness of claim 4 and the claimed surface roughness of claim 5 “are not arbitrary” and provide particular benefits. Br. 10. According to Appellant, the Examiner’s position that these values are a “design choice” is improper. *Id.*

The Examiner responds that Appellant has not explained the criticality of the claimed features, and only states that they provide “the ability to renew, modify, or remove the indicia when practicing the media blasting procedure.” Ans. 11.

The Examiner has the better position. Claim 4 requires that “the sealant layer comprises a thickness,  $t$ , and the roughened region comprises a maximum height  $R_y$  [that] is no greater than  $0.6 \times t$ ,” and claim 5 requires that “the roughened region comprises an average surface roughness,  $R_a$ , no less than  $10 \mu\text{m}$ .” Spec. ¶ 27. This roughened region is applied to a coating having a thickness of from 2–20 microns. *Id.* These “preferential parameters enable the particular benefits of . . . indicia formed in this manner may be renewed, modified, or removed.” *Id.* Sano discloses a clear coat thickness of between about 20 micron and 50 micron (Sano, Table 1), which lies within the claimed range. Bingle discloses removal of material to “less than the overall thickness” (Bingle ¶ 75) and discloses that the material can be “selectively thinned” (Bingle ¶ 80). Thus, the combined teachings of the references disclose a thickness within the claimed range and roughening

less than the entirety, which would appear to be within the claimed roughness range.

The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves *unexpected results* relative to the prior art range.

*In re Woodruff*, 919 F. 2d 1575, 1578 (Fed. Cir. 1990) (citations omitted)(emphasis added). Given Sano's coating thickness range and Bingle's selective thinning, absent a showing that the claimed height Ry and the surface roughness Ra are critical or achieve unexpected results, we do not find error with the Examiner's position of obviousness. We sustain the rejection of claims 4 and 5.

#### *Claim 6*

The Examiner finds that hollow wood-type club heads are well-known in the club head art for saving weight and to increase the sweet spot, and are disclosed in paragraph 145 of Dolezel. Final Act. 9; *see also* Ans. 11.

Appellant asserts that the Examiner has not provided evidence that a hollow-type golf club head with indicia in the sealant layer on the top of the club head was well-known. Br. 9.

We are not apprised of Examiner error. Dolezel discloses that, although the disclosed indicia features are directed to the top of putter-type club heads, they "may be similarly applied to, and be similarly advantageous in, wood-type club heads, hollow-type club heads," etc. Dolezel ¶ 145; *see also* Ans. 11. Thus, a preponderance of the evidence supports the Examiner's position that it would have been obvious to apply indicia in a

single sealant layer to the top of a hollow-type golf club head. We sustain the rejection of claim 6.

*Rejection II; Obviousness – Claims 10–20*

For claims 10–20, the Examiner makes similar findings regarding the disclosures of Sano, Dolezel, and Bingle, and relies on similar reasoning to combine these references. Final Act. 10–12. The Examiner additionally relies on Trahan to disclose masking to protect regions. *Id.* at 11 (citing Trahan ¶ 26).

*Claims 10, 15, 16, 19, and 20*

Appellant argues claims 10, 15, 16, 19, and 20 as a group. Br. 6–10. We select independent claim 10 as representative. Claims 15, 16, 19, and 20 stand or fall with claim 10.

Appellant “submits that claim 10 is patentable for reasons similar to claim 1.” Br. 9.

For the same reasons that we are unpersuaded of Examiner error in claim 1, we also sustain the Examiner’s rejection of claim 10. Claims 15, 16, 19, and 20 fall with claim 10.

*Claims 11–13*

The Examiner finds that using the claimed (1) glass beads, (2) blast pressure, and (3) MOH Hardness of the media, achieves a desired indicia appearance, which is printed matter deserving no patentable weight. Final Act. 11. The Examiner states that the claimed region is not considered to distinguish over the prior art, because there exists no new and non-obvious functional relationship to the substrate. *Id.* (citing MPEP 2112.01 (III); *In re*



*Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004); *In re Gulack*, 217 USPQ 410 (Fed. Cir. 1983); and *In re Miller*, 164 USPQ 46 (CCPA 1969)).

The Examiner's position that the indicia is printed matter is misplaced. Claims 11–13 are not directed to the content of information recorded in a substrate, but rather to how the indicia is created. The Examiner has not adequately established that the claimed method, when properly given patentable weight, would have been obvious.

For these reasons, we do not sustain the rejection of claims 11–13.

#### *Claim 14*

Claim 14 requires that “the portion [of the golf club head] comprises the top portion of the golf club head.” The Examiner finds that Dolezel includes “indicia on the top or crown surface of the club head.” Final Act. 11; *see also* Ans. 11. Appellant argues that “it is certainly not known to include a roughened region within a top portion of a golf club as claimed.” Br. 9.

Appellant's argument is not persuasive. Dolezel discloses “to enhance visibility of the top surface of the alignment feature **411**, indicia **415** is preferably applied thereto for purposes of generating visual contrast.” Dolezel ¶ 120; *see also* Ans. 11. Dolezel also discloses that the “indicia may comprise a media-blasted region (e.g. sand-blasted region) ... known to alter the appearance of the top surface **411(c)** of the alignment feature **411**.” *Id.* Thus, as the Examiner correctly finds, the prior art discloses that the portion of the club head in which the appearance is altered (roughened region) is the top portion.

For this reason, we sustain the rejection of claim 14.

*Claims 17 and 18*

Claim 17 requires that “the sealant layer comprises a thickness,  $t$ , and a roughened region of the sealant layer comprises a maximum height  $R_y$  such that  $R_y$  is no greater than  $0.6 \times t$  after media blasting the portion.”

Claim 18 requires that “a roughened region of the sealant layer comprises an average surface roughness,  $R_a$ , no less than  $10\mu\text{m}$  after media blasting the portion.”

For the reasons discussed above regarding claims 4 and 5, the Examiner has the better position on this issue. Specifically, claim 17 includes the same limitations as claim 4, and claim 18 includes the same limitations as claim 5. As discussed above, absent a showing that the claimed  $R_y$  height and the  $R_a$  surface roughness are critical or achieve unexpected results, we are not apprised of Examiner error. *See In re Woodruff*, 919 F. 2d at 1578.

For these reasons, we sustain the rejection of claims 17 and 18.

CONCLUSION

The Examiner’s rejections are affirmed as to claims 1–10 and 14–20, and are reversed as to claims 11–13.

More specifically,

DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–9	103	Sano, Dolezel, Bingle	1–9	
10–20	103	Sano, Dolezel, Bingle, Trahan	10, 14–20	11–13
<b>Overall Outcome:</b>			1–10, 14–20	11–13

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TIME PERIOD FOR RESPONSE

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 IN PART