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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DILLIS V. ALLEN

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Appeal 2020-004128  
Application 14/677,820  
Patent 8,911,301 B1  
Technology Center 3900

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Before MICHELLE R. OSINSKI, JILL D. HILL, and  
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant<sup>1</sup> appeals the Examiner’s rejections of claims 1–7, 10–12, 15–19, and 23–26. We sustain at least one rejection for each claim on appeal and we enter a new ground of rejection. Therefore, we affirm and designate our affirmance as a new ground of rejection.<sup>2</sup>

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<sup>1</sup> The Appellant is the “applicant” as defined by 37 C.F.R. § 1.42. “The real party in interest” is “the named inventor, Dillis V. Allen.” (Appeal Br. 8.)

<sup>2</sup> We have jurisdiction under 35 U.S.C. §§ 6 and 134(a).

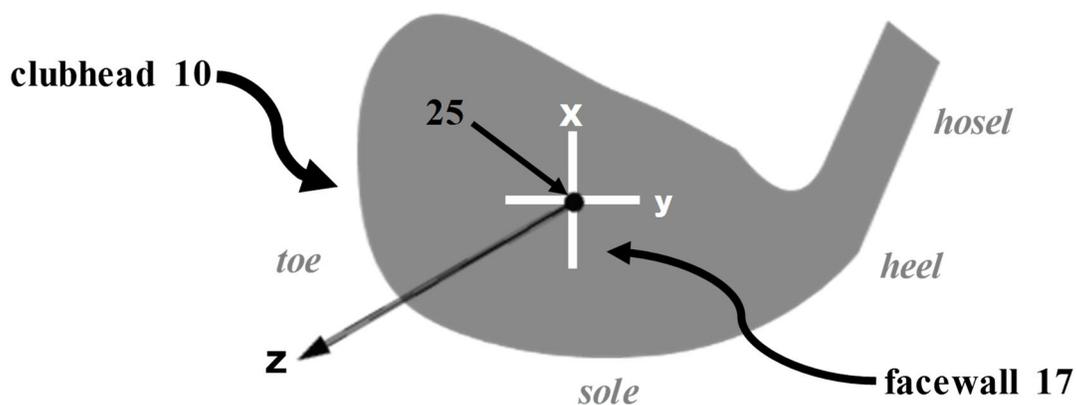
## BACKGROUND

The above-identified application on appeal (the “Reissue Application”) seeks a broadened reissue of US Patent 8,911,301 B1 (the “Issued Patent”). The Issued Patent issued on December 16, 2014 and matured from a patent application (the “Patent Application”) filed on January 15, 2013. The Reissue Application was filed on April 2, 2015, which is within two years of the issue date of the Issued Patent.

## THE APPELLANT’S INVENTION

The Patent Application dubs the Appellant’s invention “facetongue technology,” and discloses a single embodiment of a golf iron clubhead 10 that “incorporates” this facetongue technology. (Patent Application p5:18–20.)<sup>3</sup>

The disclosed clubhead 10 has an overall profile corresponding to that of a traditional clubhead configuration, as shown in our annotated drawing below.

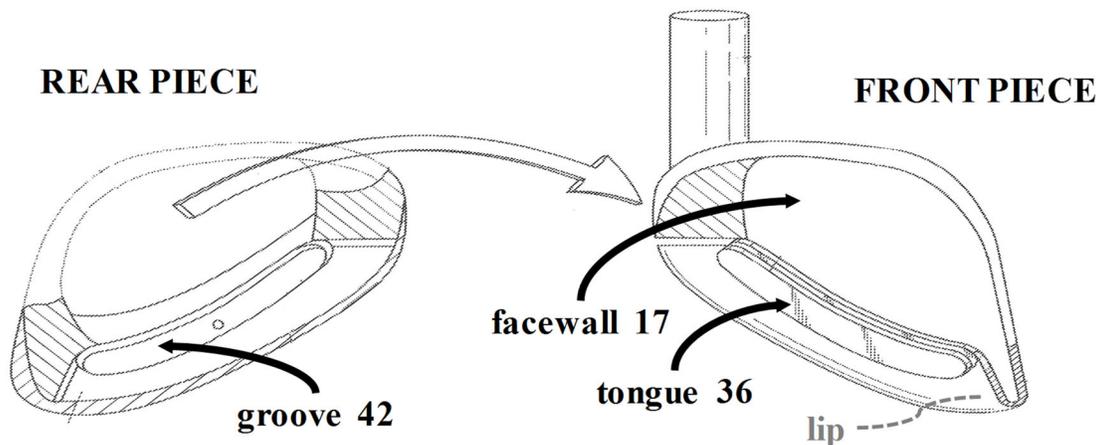


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<sup>3</sup> Our citations to the “Patent Application” throughout this opinion refer to the patent application filed on January 15, 2013.

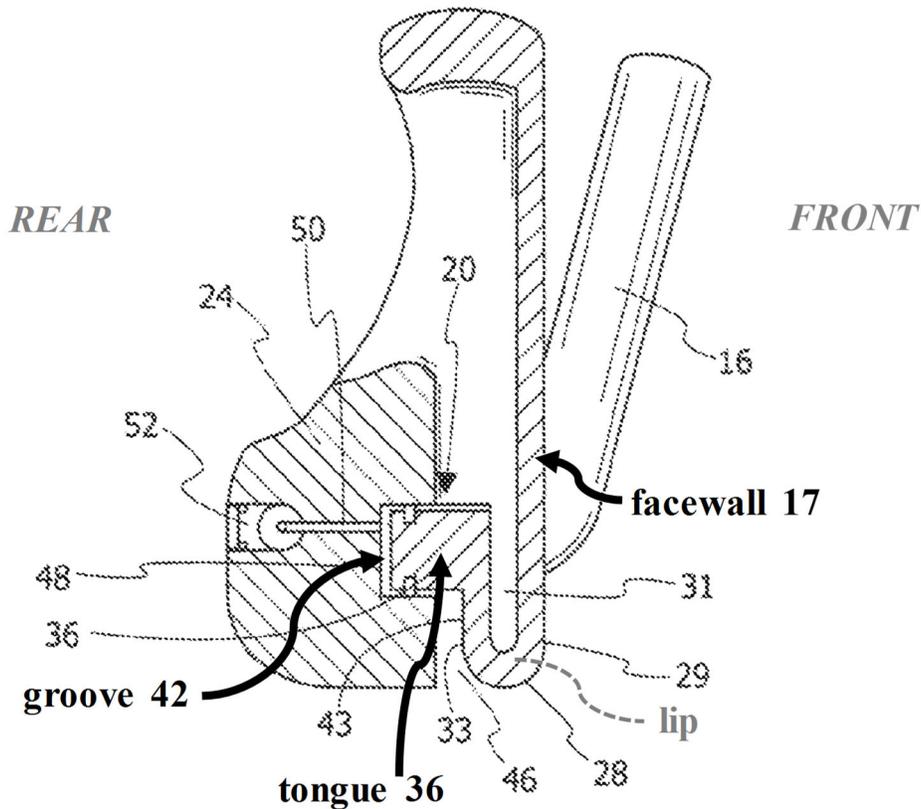
The above drawing is a darkened profile of the clubhead 10 when it is viewed from the front. (See Patent Application p5:2, p5:20–p6:2, Fig. 1.) A facewall 17, a toe, a sole, a heel, and a hosel are labeled on this profile. The facewall 17 is what “impacts the [golf] ball” (*id.* p2:4), is “generally planar” (*id.* p6:1), and has a “geometric center 25” (*id.* p6:18). As plotted on the clubhead’s profile, the Patent Application uses a standard x-y-z convention to substantiate planar, parallel, perpendicular, and other orthogonal orientations of the clubhead 10. (See *id.* p3:4–8, p4:1–4, p6:5–7, p7:1–3, p7:22–8:2.)

The clubhead 10 has “separate pieces” that could be “cast” and “fastened together, after casting.” (Patent Application p9:3–5.) This two-piece construction is shown in our annotated drawing below.



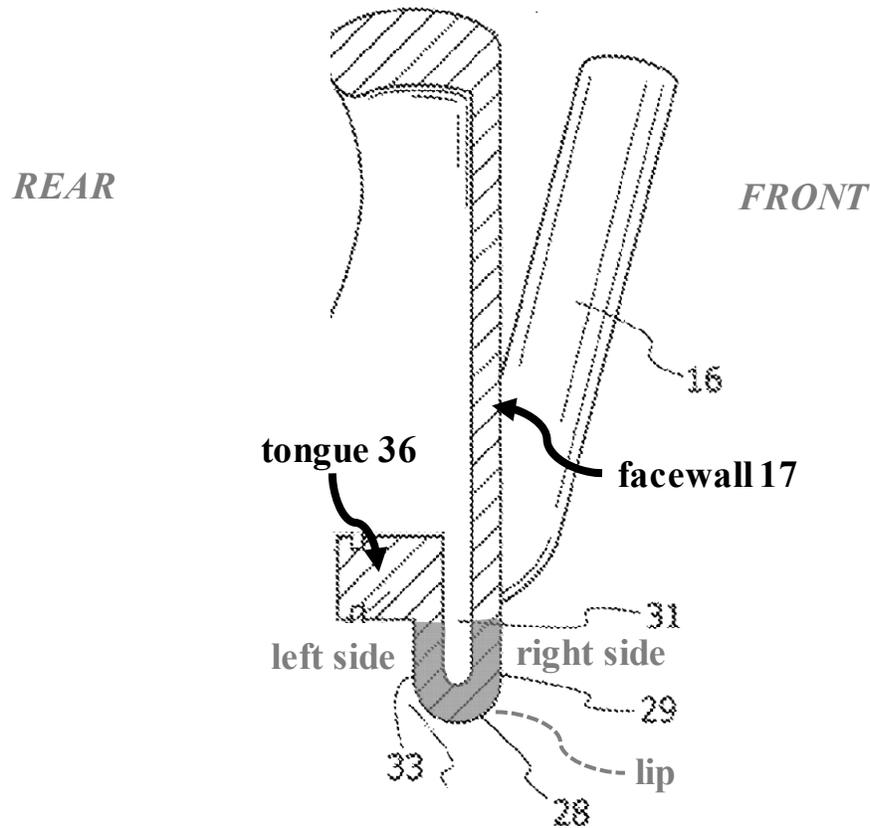
The above drawing is an exploded view of the clubhead 10 showing that it has a front piece and a rear piece. (See *id.* p5:14–16, Fig. 7.) As labeled on this drawing, the front piece has a facewall 17, a tongue 36, and what we call a “lip” for the sake of expediency only. The tongue 36 has a symmetrical arcuate shape, and, as also labeled on the above drawing, the rear piece has a groove 42 with a “complementary” shape. (*Id.* p6:10.)

The front and rear pieces of the clubhead 10 are shown fastened together in our annotated drawing below.



The above drawing is a sectional view of the clubhead 10 showing the interface between the tongue 36, the groove 42, and adjacent slot-forming surfaces. (See Patent Application p5:10–11, Fig. 5.) As shown in the above drawing, the clubhead has a two-slot arrangement in which a first slot 31 spaces the facewall 17 from the tongue 36 and a second slot 46 spaces the lip from a neighboring surface of the rear piece. (See *id.* p6:12–15, p7:4–6.) As also shown in the above drawing, the tongue 36 (which is also called “a piston 36” (*id.* p8:8)) and the groove 42 (which is also called “a cylinder 42” (*id.* p7:7)) engage in a piston-cylinder fashion.

The front piece of the clubhead 10 is shown isolated from the rear piece in our annotated drawing below.



The above drawing is a sectional view of the front piece of the clubhead 10. (See *id.* p5:10–11, Fig. 5.) This drawing shows that the facewall 17, the tongue 36, and the lip (shaded in gray) are all part of the same integral structure. The lip has a U-shape with a right side (formed by a lower region of the facewall 17), a left side (positioned parallel behind the right side), and a curved bight therebetween. The tongue 36 resides at the top of the lip's left side, and only the lip connects the tongue 36 to the facewall 17.

Although there is only one disclosed embodiment of the clubhead 10, the above-depicted integral structure is described in two different ways.

The Patent Application firstly describes a “facewall,” a “‘U’ shaped channel,” a “rear leg,” and an “[a]n arcuate horizontally elongated tongue.” (Patent Application p3:13–20.) The U-shaped channel is “just behind” the facewall (*id.* p3:13–14), the rear leg of the channel “extends vertically upwardly behind and parallel to the facewall” (*id.* p3:14–15), and the tongue “is formed on the rear surface of the rear leg” (*id.* p3:19–20).

The Patent Application secondly describes a “facewall 17,” a “tongue and groove assembly 20,” a “U-shaped flange 28,” a “lower portion [29] of facewall 17,” an “upwardly extending wall 33,” and a “tongue 36.” (Patent Application p6:8–12.) The tongue and groove assembly 20 “includes” the U-shaped flange 28 and the tongue 36. (*Id.* p6:8–10.) The U-shaped flange 28 “includes” the lower portion 29 of the facewall 17 and the wall 33. (*Id.* p6:8–10.)

There appears to be some discord in the appeal papers as to the precincts of the integral structure,<sup>4</sup> the flexibility, movability, and heel-to-toe extensions of these precincts, and the connections (or lack thereof) associated therewith. (*See* Non-Final Action 8–30; Appeal Br. 35–52; Answer 23–47; Reply Br. 8–18.)

As for the precincts of the integral structure, per the first description, at least a lower region of the U-shaped channel’s rear leg serves as the left side of the lip; and the tongue is formed on the rear surface of the rear leg. (*See* Patent Application p3:19.) Per the second description, at least a lower

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<sup>4</sup> We use the term “precincts,” for the sake of expediency only, to discuss regions of the front piece which, while perhaps not physically demarked in the drawings, collectively correspond to the integral structure that includes the facewall, the tongue, and the lip.

region of the wall 33 serves as the left side of the lip; the wall 33 is included in the U-shaped flange 28; and the U-shaped flange 28 and the tongue 36 are listed as separate elements of the tongue and groove assembly 20. (*See id.* p6:12–14.) Thus, regardless of nomenclature, the Patent Application delineates the tongue as an element which is distinct from (although integral with) whatever region of the integral structure is serving as the left side of the lip. Put another way, the Patent Application does not describe a clubhead without a tongue.<sup>5</sup>

As for the flexibility/movability of the precincts of the integral structure, the first description describes the upper edge of the channel's rear leg as having "unrestricted movement fore and aft along the clubhead target line." (Patent Application p3:15–16.) The second description describes the second slot 46 of the clubhead's two-slot arrangement as "increase[ing] the flexibility of not only the facewall 17 but also the upwardly extending wall 33." (*Id.* p8:3–5.) As discussed above, the tongue is integrally formed with these movable/flexible elements (*see id.* Figs. 5–7), and the tongue slides in the groove in the clubhead's rear piece (*see id.* p3:10–11, p8:6). Thus, the Patent Application describes the facewall, the tongue, and the lip as being flexible/movable relative to the clubhead's rear piece.

As for the toe-to-heel extension of the precincts of the integral structure, the first description describes the U-shaped channel as "running along the entire length of the lower edge of the facewall." (Patent

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<sup>5</sup> A dictionary definition of "tongue" is "[a] protruding strip along the edge of a board that fits into a matching groove on the edge of another board." (<https://www.thefreedictionary.com/tongue>, last visited September 27, 2020.)

Application p3:13–14.) The second description describes the U-shaped flange 28 as defining a slot (the first slot 31 of the clubhead’s two-slot arrangement) which extends between a heel-adjacent “point 39” and a toe-adjacent “point 40” of the clubhead. (*Id.* p6:12–13, *see also* Fig. 3.) The left side of the lip (i.e., the channel’s rear leg or the wall 33) and the tongue 36 residing on top thereof, are described and depicted as sharing this substantial heel-to-toe span. (*See id.* p6:17–20, p8:8–13, Figs. 1, 2, 6.)

As for connections associated with the precincts of the integral structure (or lack thereof), the lip is disclosed as forming a flexible hinge along the lower edge of the facewall 17 and so its left side is not rigidly connected to the facewall 17. (*See* Patent Application p3:15–17, p8:3–5.) The tongue 36 is disclosed as only being connected to the facewall 17 by this flexible hinge, and so the tongue is not rigidly connected to the facewall 17. (*See id.* p3:8–19, p4:11–13, p6:3–5, Fig.4).

With respect to the clubhead’s rear piece, the lip is spaced therefrom by a slot (the second slot 46 in the clubhead’s two-slot arrangement) and the tongue 36 engages with the groove 42 in a piston-cylinder fashion. (*See* Patent Application p3:10–11, p6:15–16, p8:3–5, Fig. 4.) Thus, the facewall 17, the tongue 36, and the lip are not rigidly connected to the clubhead’s rear piece.<sup>6</sup>

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<sup>6</sup> We disagree with the Examiner that the clubhead’s piston-cylinder engagement rigidly connects the tongue to the clubhead’s rear piece. (*See* Non-Final Action 9.) The Patent Application expressly distinguishes the clubhead 10, and particularly the piston-cylinder engagement of the tongue 36 and the groove 42, from prior art clubheads in which “piston devices are connected directly to the rear of the clubface.” (Patent Application p4:8–11.)

Thus, the Patent Application discloses an integral structure (formed at least in part by a facewall, a tongue, and a lip) which possesses the flexibility, movability, toe-to-heel span, and unconnectedness outlined above.

#### ILLUSTRATIVE CLAIMS<sup>7</sup>

[Issued Claim] 1. An iron golf clubhead, comprising: a clubhead body having a facewall with a lower portion, a toe portion, a heel portion, and a rearwardly extending portion, a hosel extending generally upwardly from the heel portion, a wall portion extending rearwardly and integrally upwardly from the lower portion of the facewall, and a tongue defined at least in part by and integral with the upwardly extending wall portion unconnected to the body rearwardly extending portion so it is free to flex forwardly and rearwardly relative to the rearwardly extending portion.

[Reissue Claim] 1. An iron golf clubhead, comprising: a clubhead body having a facewall with a lower portion, a toe portion, a heel portion, and a rearwardly extending portion, a hosel extending generally upwardly from the heel portion, a wall portion extending rearwardly and integrally upwardly from the lower portion of the facewall and extending upwardly parallel to the facewall, said upwardly extending wall portion being unconnected rigidly to the body rearwardly extending portion so it is free to flex forwardly and rearwardly relative to the rearwardly extending portion, said body rearwardly extending portion having a forward surface parallel to and closely spaced from the upwardly extending wall portion.

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<sup>7</sup> We refer to the claims issued in the Issued Patent as the “Issued Claims,” refer to the claims pending in the Reissue Application as the “Reissue Claims,” refer to the prosecution history of the Issued Patent, from the filing of the Patent Application to allowance, as the “Patent FileWrapper,” and refer to the prosecution history of the Reissue Application, to date, as the “Reissue FileWrapper.”

## OVERVIEW OF REJECTIONS

The Examiner rejects some or all of the Reissue Claims under 35 U.S.C. § 102 (Rejection I), 35 U.S.C. § 103 (Rejection II), 35 U.S.C. § 112 (Rejections III and IV), and 35 U.S.C. § 251 (Rejections V–VII). We enter a new ground of rejection under 35 U.S.C. § 251 for some of the Reissue Claims (Rejection VIII).

### REJECTION I

The Examiner rejects Reissue Claims 1 and 7 under 35 U.S.C. § 102(e) as anticipated by the Wahl Patent.<sup>8</sup> (*See* Non-Final Action 32.) We sustain this rejection.

#### *Status as a Prior Art Reference*

“[A] patent granted on an application for patent by another filed in the United States before the invention by the applicant for [a] patent” qualifies as a prior art reference. (35 U.S.C. § 102(e).) Thus, in order for the Wahl Patent to qualify as a prior art reference under 35 U.S.C. § 102(e), it must have an effective filing date before the filing date of the Issued Patent.

The filing date of the Wahl Patent is March 14, 2013, which does not predate the Issued Patent’s filing date of January 15, 2013. However, the Wahl Patent “claims the benefit of” a provisional application (“Wahl Provisional”)<sup>9</sup> which was filed on June 8, 2012. (Wahl Patent c1:6–7.) If the Wahl Patent is entitled to the filing date of the Wahl Provisional then it qualifies as a prior art reference under 35 U.S.C. § 102(e).

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<sup>8</sup> US 9,044,653 B2, issued June 2, 2015.

<sup>9</sup> US Provisional Application 61/657,675, filed June 8, 2012.

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“A provisional application’s effectiveness as prior art depends on its written description support for the claims of the issued patent of which it was a provisional.” (*Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1382 (Fed. Cir. 2015).) Here, the Wahl Provisional provides written description support for at least one claim in the Wahl Patent. For example, issued claim 1 of the Wahl Patent mirrors the subject matter of claim 4 (which depends from claim 1) of the Wahl Provisional. (*Compare* Wahl Patent c34:54–c35:22, *with* Wahl Provisional p41:3–22, p42:6–9.) Also, as demonstrated by the citations below, the disclosures in the Wahl Patent necessary to support the Examiner’s rejection are correspondingly contained in the Wahl Provisional.

#### *Anticipation*

“A prior art reference can only anticipate a claim if it discloses all the claimed limitations ‘arranged or combined in the same way as in the claim.’” (*Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381 (Fed. Cir. 2015).) “However, a reference can anticipate a claim even if it ‘d[oes] not expressly spell out’ all the limitations arranged or combined as in the claim, if a person of skill in the art, reading the reference, would ‘at once envisage’ the claimed arrangement or combination.” (*Id.*)

#### *Analysis*

Reissue Claim 1 requires the clubhead to comprise a “heel portion,” a “toe portion,” and a “hosel.” (Appeal Br., Claims App.) The Examiner finds that Wahl discloses a clubhead comprising these elements. (*See* Non-Final Action 32.) Wahl discloses “an iron type golf club head 100” comprising “a heel 102, a toe 104, a sole portion 108, a top line portion 106,

and a hosel 114.” (Wahl Patent c10:64–66, Fig. 1A; *see also* Wahl Provisional p5:22–23, Fig. 1A.)

Reissue Claim 1 requires the clubhead to also comprise “a facewall with a lower portion,” a “wall portion extending rearwardly and integrally upwardly from [a] lower portion of the facewall and extending upwardly parallel to the facewall.” (Appeal Br., Claims App.) The Examiner finds that Wahl’s clubhead 100 comprises these elements. (*See* Non-Final Action 32.) Wahl discloses that its clubhead 100 comprises a striking face 110 and a channel 150 defined by a forward wall 152 and a rear wall 154; and Wahl depicts the forward wall 152 as extending in the claimed manner. (*See* Wahl Patent c13:27–31, c15:20–22, Figs. 1E, 1F; *see also* Wahl Provisional p10:3–6, p13:8–10, Figs. 1E, 1F.)

Reissue Claim 1 requires the clubhead to additionally comprise a “rearwardly extending portion” having “a forward surface parallel to and closely spaced from the upwardly extending wall portion.” (Appeal Br., Claims App.) The Examiner finds that Wahl’s clubhead 100 comprises such a rearwardly extending portion. (*See* Non-Final Action 32.) As indicated above, Wahl discloses that the channel 150 has a rear wall 154; and Wahl depicts this rear wall 154 as having a forward surface parallel to and closely spaced from the front wall 152. (*See* Wahl Patent, Figs. 1C–1F; *see also* Wahl Provisional Figs. 1C–1F.)

Reissue Claim 1 further requires “said upwardly extending wall portion” to be “unconnected rigidly to the body rearwardly extending portion so it is free to flex forwardly and rearwardly relative to the rearwardly extending portion.” (Appeal Br., Claims App.) The Examiner

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finds that Wahl discloses such flexibility. (*See* Non-Final Action 32.) Wahl discloses that a golf clubhead can be provided with “a flexible boundary structure” that “enhances the capability of an adjacent or related portion of the golf clubhead to flex or deflect and to thereby provide a desired improvement in the performance of the golf clubhead.” (Wahl Patent c2:5–11; *see also* Wahl Provisional p2:18–22.) Wall also discloses that this flexible boundary structure can be “a channel.” (Wahl Patent c2:6, *see also* Wahl Provisional p2:19.)

The Appellant argues that, in Wahl, “[the] upward wall 152 is integral with and cast as one piece together with the rear 135, so that prevents the wall 152 and the lower part of the face 110 from freely moving back and forth in the direction of ball travel from the facewall 110 at ball impact.” (Appeal Br. 64.) However, Wahl expressly discloses that a one-piece clubhead can have a channel which allows its facewall “to flex under the load of a golf ball impact.” (Wahl Patent c15:30–39, Fig. 2C; *see also* Wahl Provisional p13:15–21, Fig. 2C.)

Reissue Claim 7, which depends from Reissue Claim 1, requires the facewall to have a “portion” that is “free to move in a direction perpendicular to the facewall.” (Appeal Br., Claims App.) The Wahl Patent discloses that, with a channel configuration (e.g., channel 150’s configuration), the striking face 110 deflects upon golf ball impact. (Wahl Patent c15:30–39, Figs. 1F, 2F; *see also* Wahl Provisional p13:8–21, Figs. 1F, 2F.)

Thus, the prior art reference discloses all of the claimed limitations and their claimed arrangement. Inasmuch as Wahl may not expressly spell

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out the flexibility required by Reissue Claim 1 and/or the freedom required by Reissue Claim 7, one of ordinary skill in the art would at once envisage the claimed flexibility and freedom after reviewing Wahl's disclosure. Therefore, we sustain Rejection I.

## REJECTION II

The Examiner rejects Reissue Claims 1 and 7 under 35 U.S.C. § 103(a) as obvious over the Wahl Patent. (*See* Non-Final Action 32.) We sustain this rejection.

### *Obviousness*

“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.” (*KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).) “[H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” (*Id.*)

### *Analysis*

As discussed above, Reissue Claim 1 requires “said upwardly extending wall portion” to be “unconnected rigidly to the body rearwardly extending portion so it is free to flex forwardly and rearwardly relative to the rearwardly extending portion,” and Reissue Claim 7 further requires the facewall to have a “portion” that is “free to move in a direction perpendicular to the facewall.” (Appeal Br., Claims App.) As also

discussed above, inasmuch as Wahl may not expressly spell out this flexibility and freedom with respect to its golf clubhead 100, one of ordinary skill in the art would at once envisage this flexibility and freedom.

Moreover, inasmuch as one of ordinary skill in the art would not at once envisage the claimed flexibility and freedom, one of ordinary skill in the art would immediately understand from Wahl's teachings that the prior art clubhead 100 could be provided with such flexibility and freedom.

As pointed out by the Examiner, Wahl discloses not only the golf clubhead 100, but also other "similar embodiments." (Non-Final Action 32.) In particular, Wahl teaches that a channel configuration, nearly duplicating that of the channel 150 in golf clubhead 100, can have "hinge" regions that "flex under the load of a golf ball impact," which "in turn, creates additional deflection of the striking face." (Wahl Patent c15:30–39, Figs. 1F, 2F; *see also* Wahl Provisional p13:8–21, Figs. 1F, 2F.) Wahl further teaches that such a "flexible boundary structure" provides "a desired improvement in the performance of the golf clubhead." (Wahl Patent c14:57–62; *see also* Wahl Provisional p12:14–17.)

Thus, the record sufficiently supports a determination that one of ordinary skill in the art would understand that Wahl's golf clubhead 100 could be provided with the flexibility and freedom recited in Reissue Claims 1 and 7. The record also sufficiently shows that one of ordinary skill in the art would be motivated to do so, because this flexibility and freedom would provide a desired improvement in the performance of the golf clubhead. Therefore, we sustain Rejection II.

### REJECTION III

The Examiner rejects claims 1–7, 10–12, 17–19, and 23–26 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement. (Non-Final Action 24–25.) We do not sustain this rejection.

#### *Written Description*

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. (*In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983).)

#### *Analysis*

The Examiner determines that the Patent Application does not reasonably convey possession of subject matter specified by the Reissue Claims because they recite “new matter” for which “[t]here is no support” in the Patent Application. (Non-Final Action 24–25.)

Many of the Examiner’s new-matter concerns stem from the Reissue Claims’ imprecise naming of the clubhead’s elements which, in turn, causes an imperfect correlation between them and those described in the Patent Application. As discussed above, the Patent Application conveys possession of an integral structure including a facewall, a tongue, and a lip, although the precincts of this integral structure are described with different words. The Examiner does not maintain that the named elements in the Reissue Claims do not collectively constitute the disclosed precincts of the integral structure; and the Examiner does not maintain that the named elements collectively do

not possess the claimed flexibility, movability, toe-to-heel span, or unconnectedness. Although the imprecision pointed out by the Examiner is symptomatic of indefiniteness, this imprecision does not reflect an intention to inject new matter into the Reissue Claims.

The Examiner's new-matter concerns also involve limitations which require a claimed element to be "perpendicular" or "parallel" to something else. (*See* Non-Final Action 10, 13.) The Examiner acknowledges that these perpendicular/parallel limitations are consistent with the drawings, but maintains that "the drawings cannot be relied upon alone to support" these limitations. (*Id.*) However, as discussed above, the Patent Application uses a standard x-y-z convention to substantiate the parallel and perpendicular orientations disclosed in the drawings. (*See* Patent Application, p3:4–8, p4:1–4, p6:5–7, p7:21–p8:2, Fig. 1.)

The Examiner's remaining two new-matter concerns pertain to the claimed projection of the clubhead's hosel (*see* Non-Final Action 14) and the claimed location of a lubrication system (*see id.* at 11).

As for the hosel's projection, the at-issue claim (Reissue Claim 26) sets forth that the hosel "project[s] forwardly from the facewall ball striking surface when viewed from the toe side of the clubhead toward the heel side of the clubhead." (Appeal Br., Claims App.) The Patent Application discloses this view of the clubhead 10, and this view shows the hosel 16 projecting forwardly from the facewall. (*See* Patent Application, Fig. 4.) We disagree with the Examiner's implication that the claim language requires the hosel to extend directly from the facewall (*see* Non-Final Action 14), especially because Reissue Claim 26 also requires the hosel to

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“exten[d] generally upwardly from” the clubhead’s “heel portion” (Appeal Br., Claims App.).

As for the lubrication system’s location, the at-issue claim (Reissue Claim 3) sets forth a lubrication system “in” the tongue-receiving groove in the clubhead’s rear piece. (Appeal Br., Claims App.) The Patent Application describes the groove 46 as having a rear “chamber 48” which is “lubricated by a passage 50,” via lubricant being fed through a “fitting 52.” (Patent Application p7:6–13, *see also* Fig. 5.) As correctly pointed out by the Examiner, the passage 50 and the fitting 52 are located behind, not “in,” the tongue-receiving groove 42. (*See* Non-Final Action 11.) However, Reissue Claim 3 does not require all of the components of the lubrication system to be located in the tongue-receiving groove. The chamber 48 can be considered a component of the lubrication system, and the chamber 48 is located “in” the tongue-receiving groove.

Thus, the Patent Application reasonably conveys possession of the subject matter specified by the Reissue Claims in compliance with the written description requirement. Therefore, we do not sustain Rejection III.

#### REJECTION IV

The Examiner rejects Reissue Claims 1–7, 10–12, 15–19, and 23–26 under 35 U.S.C. § 112(b) as being indefinite. (Non-Final Action 25.) We sustain this rejection.

#### *Indefiniteness*

The test for definiteness under 35 U.S.C. § 112, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” (*Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*,

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806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).) A claim is properly rejected as indefinite if the “claim is ambiguous, vague, incoherent, opaque, or otherwise unclear.” (*In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014).)

### *Analysis*

The Examiner determines that the scope of the Reissue Claims are “unclear,” contain “inaccurate” suggestions or descriptions, “lack proper antecedent basis,” are “open to multiple interpretations,” and/or their scope “cannot be determined with any reasonable degree of certainty.” (*See, e.g.*, Non-Final Action 28.)

The Examiner is initially troubled with the word “iron” in the Reissue Claims’ preamble phrase “[a]n iron golf clubhead.” (Appeal Br., Claims App.) The Examiner maintains that “it is unclear” what role the word “iron” plays with respect to the scope of the Reissue Claims. (Non-Final Action 25.) We agree.

The word “iron” was defined in the following paragraph in the Issued Patent:

It should also be understood that the specific embodiment of the present invention is incorporated into iron-type golf clubs because the metal thickness behind the facewall provides increased opportunity to house the presently designed tongue and groove. However, it may be that some future visionary may well adopt these principles into a metal wood-type club so that possibility is within the scope of the present invention and that the term “iron” in the Claims is intended to be only preferable and not limiting.

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(Issued Patent c2:20–28; *see also* Patent Application p4:14–19.) This paragraph remains in the Reissue Application, and thus the record contains a definition of the term “iron” that does not limit the Reissue Claims to “iron-type-golf clubs,” and specifies that their scope would encompass a “metal wood-type club” developed by a future visionary.

However, the record also contains contentions that the term “iron” does not “expand the scope of the ‘iron’ [Reissue] Claims to encompass metal woods.” (Reissue FileWrapper, Response filed June 18, 2018, page 26.) The Appellant contends that the above-quoted paragraph was intended to mean that “in cases where the underlying [Reissue] Claims do not specify whether the clubhead is a metal wood or an iron wood, then in that case, and in only that case, the Claims are to be interpreted to include both irons and metal woods.” (*Id.*) As for the “metal wood-type club” and the “future visionary” sentence, the Appellant contends that it was intended to mean that “the present invention could, in some remote circumstances, be applied to metal woods.” (*Id.*)

But one of ordinary skill reading the Issued Patent would be unaware of the Appellant’s intentions, even with the help of the Patent FileWrapper.

Thus, the record sends two conflicting messages regarding the word “iron” in the Reissue Claims: 1) the word “iron” is not limiting; and 2) the word “iron” is limiting. “This renders the claims indefinite because it is unclear whether or not the claims are limited to a traditional iron-type club.” (Non-Final Action 25.)

The Appellant argues that, although “there is an inconsistency, admittedly,” this inconsistency “does not create an indefiniteness.” (Appeal

Br. 52.) The Appellant argues that this inconsistency, and any indefiniteness created thereby, is erased by “application of the common file wrapper estoppels rule.” (*Id.* at 53.) According to the Appellant, when the file-wrapper-estoppel rule is applied here, “the [Reissue] Claims are in fact, under law, limited to iron-type clubheads.” (*Id.*)

To be sure, the prosecution history of the Issued Patent “serves as intrinsic evidence for purposes of claim construction” and may be relevant when “construing patent claims before the PTO.” (*Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973, 977 (Fed. Cir. 2014).) Here, however, we are looking at claims in a still pending application, and, to boot, the bothersome indefiniteness was introduced during prosecution of this still-pending application. Thus, the still-evolving prosecution history of the Reissue Application does not resolve the indefiniteness surrounding the word “iron.” Moreover, even with respect to the prosecution history of the Issued Patent, file wrapper estoppel “generally only binds the patent owner” and we are “under no obligation to accept a claim construction” proffered during prosecution of the Issued Patent. (*Id.* at 978.)

Aside from the preamble, the Examiner determines that a long list of limitations recited in the Reissue Claims are problematic (*see* Non-Final Action 25–30); and the Appellant advances arguments challenging, to some extent, these determinations (*see* Appeal Br. 54–61; Reply Br. 11–18).<sup>10</sup>

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<sup>10</sup> We do not share the Appellant’s overall sentiment that the Examiner’s indefiniteness determinations are unworthy of response. (*See* Appeal Br. 61.) The Examiner quotes each instance of troublesome claim language, and identifies, in each instance, why the quoted claim language is indefinite. (*See* Non-Final Action 25–30.) When an examiner has “issued a well-

We are persuaded by some of the Appellant’s arguments. We agree with the Appellant that one of ordinary skill would: (1) deduce that a wall/leg portion (not a surface or slot) is “free to move forwardly and rearwardly;” (2) would know that a clubhead has one “target line;” (3) would accurately appreciate what is meant by a wall portion “having an upper edge with unrestricted movement along [the] clubhead target line;” (4) would recognize that the “maximum extent possible” is a ceiling set by clubhead integrity (*see* Patent Application p3:3–8); and (5) would understand the magnitude of the modifier “significantly” with respect to the toe-to-heel span of a golf clubhead. We also agree with the Appellant that adequate antecedent basis for the term “piston” is established by an earlier recital of a “piston and groove assembly,” and that it is acceptable to refer to “the” length of an already introduced element when length is an inherent characteristic of that element.

However, we agree with the Examiner that the predominant problem with the Reissue Claims is the Appellant’s serial imprecision when naming the clubhead’s elements. As pointed out by the Examiner, the Appellant

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grounded rejection that identifies ways in which language in a claim is ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention,” an applicant must “provide a satisfactory response.” (*In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014).) A satisfactory response “can take the form of a modification of the language identified as unclear, a separate definition of the unclear language, or, in an appropriate case, a persuasive explanation for the record of why the language at issue is not actually unclear.” (*Id.*) If an applicant “fails to provide a satisfactory response,” an examiner can “properly reject the claim[s] as failing to meet the statutory requirements of § 112(b)” (*id.*), and, in turn, it is proper for us to sustain such a rejection.

repeatedly uses the same words, in different sequences, to define various elements of the clubhead. (*See* Non-Final Action 25–30.) For example, the Reissue Claims recite a “lower portion,” a “facewall lower portion,” an “arcuate lower portion,” a “body rearwardly extending portion,” an “upwardly extending wall portion,” a “rearwardly and upwardly extending wall portion,” a “wall portion extending rearwardly,” and a “rear leg wall,” along with defining still other elements with the words “portion,” “facewall,” “wall,” “lower,” “front,” “rear,” “rearwardly,” and “upwardly.” (*See* Appeal Br., Claims App.)

The Appellant’s repetitive and extensive use of the same words does not, in and of itself, doom the Reissue Claims to indefiniteness. However, with such a lexicographic strategy, there must be a faithful adherence to these words, and their sequences, when referring to claim elements. The Appellant falls short in his regard, and this shortcoming renders the Reissue Claims confusing to the degree of indefiniteness. As pointed out by the Examiner, this confusion is compounded in means-plus-function clauses which define the “means” by connecting “portions” to “portions” of host “portions” at locations between “portions.” (*See, e.g.*, Non-Final Action 28–30.)

Thus, the Reissue Claims fail to particularly point out and distinctly claim the subject matter which the Appellant regards as its invention. Therefore, we sustain Rejection IV.

#### REJECTION V

The Examiner rejects Reissue Claims 1–7, 10–12, 17–19, and 23–26 under 35 U.S.C. § 251 (the “Reissue Statute”) because the Appellant

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introduces new matter into the Reissue Application. (Non-Final Action 18.)  
We do not sustain this rejection.

*New Matter in Reissue Application*

The Reissue Statute allows a patentee to seek reissue of an issued patent if certain conditions are met. (35 U.S.C. § 251.) However, even when these conditions are met, “[n]o new matter shall be introduced into the application for reissue.” (*Id.*)

*Analysis*

The Examiner determines that the Appellant introduces new matter into the Reissue Application. (*See* Non-Final Office Action 18.) The Reissue Application, as filed, revised the Issued Patent’s specification to include the following paragraph:

A facewall flexure portion from the tongue and groove assembly 20 is defined in the U-shaped flange 28 and the rear upwardly extending wall 33 that has an upper area within unrestricted movement along a target line to increase facewall flexure.

(*See* Reissue File Wrapper, specification filed on April 2, 2015.) The Examiner maintains that this paragraph “introduces new matter” and the Appellant is “required to cancel the new matter.” (Non-Final Act. 8.)

According to the Appellant, the Reissue Application’s specification “has been amended to duplicate” that of the Patent Application, thereby mooting any new-matter issues related thereto. (Appeal Br. 3.) The Examiner states that “[t]he amendments to the specification have been entered” (Non-Final Action 2); and the Answer reflects that the Examiner also considers new matter issues related to the Reissue Application’s specification resolved (*see* Answer 3–9, 14, 23–33).

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Thus, even if the above-quoted paragraph did introduce new matter, it is not included in the current version of the Reissue Application's specification. Therefore, we do not sustain Rejection V.

#### REJECTION VI

The Examiner rejects Reissue Claims 1, 7, 17, and 23–26 under 35 U.S.C. § 251 as an attempt to recapture surrendered subject matter. (Non-Final Action 18.) We do not sustain this rejection.

#### *Recapture*

The Reissue Statute allows a patentee to pursue broadened claims by reissue, provided the patentee can show “error.” (35 U.S.C. § 251.) “[N]ot every event or circumstance that might be labeled ‘error’ is correctable by reissue,” and “one such circumstance that does not satisfy the ‘error’ requirement is embodied by the recapture rule.” (*In re Youman*, 679 F.3d 1335, 1343 (Fed. Cir. 2012).)

“The recapture rule bars a patentee from recapturing subject matter, through reissue, that the patentee intentionally surrendered during the original prosecution in order to overcome prior art and obtain a valid patent.” (*Youman*, 679 F.3d at 1343.) A three-step test is applied to discern whether a reissue claim “violate[s] the recapture rule.” (*Id.*) In the first step, it is determined what “aspect” of the reissue claim is “broader than the patent claims.” (*Id.*) In the second step, it is determined whether the reissue claim’s broader aspect “relate[s] to the surrendered subject matter.” (*Id.*) If a reissue claim’s broader aspect does not relate to surrendered subject matter, the reissue claim does not violate the recapture rule, and the third step need not be applied. (*See id.*)

*Analysis*

Under the first step of the recapture rule, the Examiner determines that Reissue Claims 1, 7, 17, and 23–26 are broader than the Issued Claims because they do not require a “tongue.” (Non-Final Action 19.) We agree with the Examiner. While these Reissue Claims could be infringed by a tongue-less clubhead, the Issued Claims could not.

Under the second step of the recapture rule, the Examiner determines that the identified broader aspect (i.e., a tongue-less clubhead) was surrendered during prosecution. (Non-Final Action 20.) We agree with the Appellant that this determination does not align with the evidence of record. (*See, e.g.*, Appeal Br. 24.)

“[T]o determine what subject matter the patentee surrendered,” we look to “changes in the claim language and arguments in the prosecution history that were made in an effort to overcome prior art.” (*Youman*, 679 F.3d. at 1344.) More particularly, we look to the prosecution history of the issued patent “for evidence of an admission by the patent applicant regarding patentability.” (*Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480 (Fed. Cir. 1998).) “The recapture rule does not apply where there is no evidence” of “an admission that the scope of that claim was not in fact patentable.” (*Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995 (Fed. Cir. 1993).)

During prosecution of the Issued Patent, an independent claim (claim 1) was rejected as being anticipated by the prior art. (*See* Patent FileWrapper, Office Action mailed June 4, 2014, page 10.) The rejected claims required a U-shaped lip and a tongue (*see id.*, Claims filed March 14,

2014),<sup>11</sup> and the anticipation rejection was premised upon a prior art clubhead purportedly possessing a U-shaped lip and a tongue (*see id.*, Office Action mailed June 4, 2014, page 11). The Appellant overcame this prior art rejection by amending the rejected claims to require an “integral” U-shaped lip, and arguing the same. (*See id.*, Response filed July 23, 2014, pages 6, 20–21; *see also* Office Action mailed August 15, 2014, page 10.)<sup>12</sup>

The Appellant did not mention, in its effort to overcome the prior art, the presence or absence of a tongue. (*See* Patent FileWrapper, Response filed July 23, 2014, page 20–21, Response filed September 9, 2014, page 8.) Thus, any and all tongue-less clubheads could not have been surrendered by virtue of this effort alone. What could have been surrendered is a clubhead (with or without tongue) sans an integral U-shaped lip. But Reissue Claims 1, 7, 17, and 23–25 require an integral U-shaped lip, and so this is not a broader aspect of these claims.

Reissue Claim 26 does not require an integral U-shaped lip, but it does require the clubhead to have a two-slot arrangement. During prosecution of the Issued Patent, an independent claim (claim 17) was not rejected on prior art grounds and, therefore, the Appellant made no amendments or arguments to specifically distinguish it over the prior art.

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<sup>11</sup> Independent claim 1 required a “wall portion extending upwardly from a lower portion of the facewall” and “a tongue defined by the upwardly extending wall portion.” (Patent FileWrapper, preliminarily-amended Claims filed March 14, 2014, page 3.)

<sup>12</sup> Independent claim 1 was amended to recite “a wall portion extending rearwardly and integrally upwardly from the lower portion of the facewall.” (Patent FileWrapper, Response filed July 23, 2014, page 6.)

Independent claim 17 required, from start to finish, an integral U-shaped lip and a two-slot arrangement similar to that recited in Reissue Claim 26.<sup>13</sup>

We could speculate that the “integral” limitation in independent claim 17, alone, was the reason it was excused from the prior art rejection. If this speculation was adopted, a broader aspect of Reissue Claim 26 relates to surrendered subject matter. We could just as easily speculate that the two-slot limitation in the non-rejected claim 17, alone, was the reason it was excused from the prior art rejection. But it matters not, because there is no evidence in the Patent FileWrapper supporting either one of these speculations.

Thus, the Patent FileWrapper does not adequately evidence that the broader aspects of Reissue Claims 1, 7, 17, and 23–26 relate to surrendered subject matter under the second step of the recapture-rule analysis. And if a reissue claim’s broader aspect does not relate to surrendered subject matter, it does not violate the recapture rule. Therefore, we do not sustain Rejection VI.

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<sup>13</sup> Independent Claim 17 recited an “integral ‘U’ shaped flange,” an “upwardly extending wall portion behind the facewall,” a “slot” between “the facewall and the upwardly extending wall portion,” and another “slot” between “the upwardly extending wall portion and [a] rearwardly extending portion of the clubhead body.” (Patent FileWrapper, Claims filed March 14, 2014, pages 5–6.) Reissue Claim 26 recites “a ‘U’ shaped channel formed with the lower edge of the facewall having a rear leg wall extending upwardly behind and parallel to the facewall defining a slot between the facewall and the rear leg wall” and “[a] rearwardly extending portion having a forward surface parallel to the rear leg wall and defining a slot between the rear portion forward surface and the rear leg wall.” (Appeal Br., Claims App.)

## REJECTION VII

The Examiner rejects Reissue Claims 1–7, 10–12, 15–19, and 23–26 under 35 U.S.C. § 251 as being based upon a defective reissue declaration. (Non-Final Action 18.) We sustain this rejection.

### *Reissue Declaration*

“The inventor’s oath or declaration for a reissue application” must “identify” an error pursuant to 35 U.S.C. § 251 that is “being relied upon as the basis for reissue.” (37 C.F.R. § 1.175(a).) “The most commonly asserted correctable error is the failure of the patentee’s attorney to appreciate the full scope of the invention during prosecution of the original patent application.” (*Youman*, 679 F.3d at 1342.) However, as indicated above, “not every event or circumstance that might be labeled ‘error’ is correctable by reissue.” (*Id.* at 1343.)

### *Analysis*

The Examiner determines that the “error” identified in the Appellant’s Reissue Declaration is not an error that is correctable via reissue. (*See* Non-Final Action 17.) We agree.

The Appellant acknowledges in its reissue declaration that the impetus for the Reissue Application is to expand claim scope to encompass tongue-less clubheads. (*See* Reissue FileWrapper, Declaration filed April 2, 2015.) The Appellant declares that he claimed “less than he had a right to claim in the patent,” and the Appellant declares that this deficiency is due to the word “tongue” in Issued Claims 1 and 17. (*Id.*) The Declaration also conveys that the Appellant planned to remedy this deficiency by writing new claims without the tongue limitations. (*See id.*)

Thus, the Appellant's declared "error" is that it did not file claims having a scope broad enough to cover a tongue-less clubhead during prosecution of the Issued Patent. However, as explained below, this is not an error correctable by reissue. As such, the Appellant's reissue declaration is defective because it does not identify an "error" as required by the Reissue Statute. Therefore, we sustain Rejection VII.

#### REJECTION VIII

We enter a new ground of rejection rejecting Reissue Claims 1, 7, 17, and 23–26 under 35 U.S.C. § 251 as failing to comply with the original patent requirement.

#### *Original Patent*

The Reissue Statute confines the "reissue" of a patent to "the invention disclosed in the original patent." (35 U.S.C. § 251.) "Thus, for broadening reissue claims, the specification of the original patent must do more than merely suggest or indicate the invention recited in reissue claims." (*Forum US, Inc. v. Flow Valve, LLC*, 926 F.3d 1346, 1351 (Fed. Cir. 2019).) Rather, to satisfy the original-patent requirement of the Reissue Statute, "it must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original [patent]." (*Id.* at 1351–1352.) More concisely, the original patent "must clearly and unequivocally disclose the newly claimed invention as a separate invention." (*Id.* at 1352.)

*Analysis*

We determine that Reissue Claims 1, 7, 17, and 23–26 cover an invention that was not clearly and unequivocally disclosed in the Issued Patent, namely a tongue-less clubhead.

This rejection is best explained by following the Federal Circuit’s reasoning in the *Forum* case, which involved a strikingly similar fact pattern. In *Forum*, the technology related to “fixtures for holding workpieces during machining,” and the issued patent disclosed “only embodiments with arbors.” (*Forum*, 926 F.3d at 1348.) The issued patent’s claims required the fixture to comprise a “body member,” and “a plurality of arbors supported by the body member.” (*Id.* at 1349.) The patentee broadened the claims during reissue, “to include embodiments of fixtures that do not use arbors by writing new claims without the arbor limitations.” (*Id.*)

In *Forum*, the patentee argued “that [one] of ordinary skill in the art would understand that the patent disclosed multiple inventions, consisting of embodiments with and without arbors.” (*Forum*, 926 F.3d at 1350.) The patentee supported its argument with an expert declaration evidencing “what a person of ordinary skill in the art would purportedly understand in the absence of the disclosure of an arbor-less embodiment.” (*Id.* at 1352.) The Federal Circuit clarified that this argument and its supporting evidence were not germane to the pivotal question of whether the “face of the instrument” (i.e., the issued patent) disclosed an arbor-less embodiment. (*Id.*)

Consequently, in the *Forum* case, the Federal Circuit held that the reissue claims did not comply with the original-patent requirement because

there was no disclosure of “an arbor-less embodiment of the invention.”  
 (*Forum*, 926 F.3d at 1350.)

As discussed above, the Patent Application does not describe a clubhead without a tongue, and, correspondingly, neither does the Issued Patent. As also discussed above, the Appellant is attempting to broaden claims during reissue to include embodiments of clubheads that do not have tongues by writing new claims without the tongue limitations. Thus, Reissue Claims 1, 7, 17, and 23–26 do not comply with the original-patent requirement because there was no disclosure of a tongue-less embodiment of the invention. Therefore, we enter this new ground of rejection.

#### CONCLUSION

<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, 7	102	Wahl	1, 7		
1, 7	103	Wahl	1, 7		
1–7, 10–12, 17–19, 23–26	112(a)	Written Description		1–7, 10–12, 17–19, 23–26	
1–7, 10–12, 15–19, 23–26	112(b)	Indefiniteness	1–7, 10–12, 15–19, 23–26		
1–7, 10–12, 17–19, 23–26	251	New Matter		1–7, 10–12, 17–19, 23–26	
1, 7, 17, 23–26	251	Recapture		1, 7, 17, 23–26	

Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed	New Ground
1-7, 10-12, 15-19, 23-26	251	Defective Declaration	1-7, 10-12, 15-19, 23-26		
1, 7, 17, 23-26	251	Original Patent	1, 7, 17, 23-26		1, 7, 17, 23-26
Overall Outcome			1-7, 10-12, 15-19, 23-26		1, 7, 17, 23-26

#### FINALITY AND RESPONSE

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

37 C.F.R. § 41.50(b) also provides that 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. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

AFFIRMED; 37 C.F.R. § 41.50(b)