

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM R. WALLACE

Appeal No. 2000-2015
Application 08/843,060

ON BRIEF

Before COHEN, FRANKFORT, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 5, all of the claims pending in this application.

Appellant's invention relates to a lighted fishing rod assembly that includes a light source (20) disposed on the rod

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member towards a free end thereof and spaced a slight distance apart from a tip of the free end. The light source is provided within a housing (24), which housing is disposed within the rod member (i.e., forms a part of the rod member) at a slight distance apart from a tip of the free end. See Figures 1, 3, 4 and 5 of the application drawings, and the specification at pages 3, 4 and 5. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ward	5,586,403	Dec.
24, 1996		
Kelly	5,644,864	Jul. 8,
1997		
	(filed Nov. 13,	
1995)		

Claims 1 through 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Ward.

Rather than reiterate the examiner's full statement of

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the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the final rejection (Paper No. 18, mailed August 6, 1999) and the examiner's answer (Paper No. 21, mailed March 24, 2000) for the reasoning in support of the rejection, and to

appellant's brief (Paper No. 20, filed January 10, 2000) and reply brief (Paper No. 22, filed May 25, 2000) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination which follows.

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In rejecting claims 1 through 5 under 35 U.S.C. § 103(a) on the basis of the collective teachings of Kelly and Ward it is the examiner's position (final rejection, page 3), that Kelly shows all of the elements recited except for the light source being spaced a slight distance from the rod tip free end. To address this difference, the examiner turns to Ward, urging that this reference discloses a fishing rod (10) with a light source (46) located on the rod towards a free end thereof and spaced a slight distance apart from a tip of the free end. From these teachings, the examiner has concluded that it would have been obvious to one of ordinary skill in the art "to provide Kelly with the light source mounted a slight distance from the rod tip as shown by Ward since the exact location of the light is a matter of design choice to be determined by routine experimentation."

Having reviewed and evaluated the applied references, we are of the opinion that the examiner's position regarding the purported obviousness of claims 1 through 5 on appeal represents a classic case of the examiner using impermissible

hindsight in order to reconstruct appellant's claimed subject matter. In our opinion, there is no motivation or suggestion in the applied patents to Kelly and Ward which would have reasonably led one of ordinary skill in the art to modify the rod of Kelly in the particular manner urged by the examiner so as to provide that rod with a light source in a housing wherein the housing is disposed within the rod member and spaced a slight distance apart from a tip of the free end of the rod member. In fact, it appears to us that if one of ordinary skill in the art were inclined to alter the fishing rod of Kelly in view of the teachings and suggestions found in Ward, they would have either merely included an additional light source like that specifically shown in Ward on the rod of Kelly, retaining the light source at the tip of the rod in Kelly, or eliminated the light source at the tip of the rod in Kelly and replaced it with a light source applied to the rod in the particular manner shown and taught by Ward.

As urged by appellant (reply brief, page 2), the broad concept of having a light source spaced a slight distance from

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the tip of a fishing rod as in Ward does not itself provide sufficient teaching, suggestion or motivation for structurally modifying the rod member in Kelly so as to have a light source and housing structure incorporated therein as specifically called for in appellant's claim 1 on appeal. The examiner's added reliance on design choice to somehow justify the combination of Kelly and Ward is also misplaced.

We note that the mere fact that the prior art could be modified in the manner urged by the examiner would not have made such modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In this case, it is our opinion that the examiner has impermissibly drawn from appellant's own teaching and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540,

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1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

Since we have determined that the teachings and suggestions that would have been fairly derived from Kelly and Ward would not have made the subject matter as a whole of claim 1 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of that claim under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 2 through 5 under 35 U.S.C. § 103(a) based on Kelly and Ward will also not be sustained.

In light of the foregoing, the decision of the examiner

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to reject claims 1 through 5 under 35 U.S.C. § 103(a) is
reversed.

REVERSED

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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)
) BOARD OF PATENT
CHARLES E. FRANKFORT)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
JENNIFER D. BAHR)
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