

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERB REED

Appeal No. 2004-1004
Application No. 10/011,074

ON BRIEF

Before WALTZ, KRATZ, and DELMENDO, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL & REMAND

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 1 through 9 (final Office action mailed Feb. 3, 2003, paper 5) in the above-identified application. Claims 10 through 22, which are the only other pending claims, have been withdrawn from further consideration pursuant to 37 CFR § 1.142(b) (2003) (effective Dec. 22, 1959). (Office action mailed Jul. 30, 2002, paper 2, page 2.)

The subject matter on appeal relates to a fishing lure. Further details of this appealed subject matter are recited in representative claims 1, 2, and 8 reproduced from the application, as amended on Dec. 2, 2002 (paper 3):

1. A fishing lure comprising:
a substantially solid flexible body portion;
at least one weight at least partially
encapsulated within said substantially solid flexible
body portion and stationary relative thereto; and
wherein said at least one weight being insoluble
in water.

2. A fishing lure as defined in claim 1 wherein
said at least one weight is completely encapsulated in
said flexible body.

8. A fishing lure comprising:
a substantially solid flexible body portion;
a plurality of independent weights, each said
weight being at least partially encapsulated in said
substantially sold [sic, solid] flexible body portion
and stationary relative thereto; and
wherein each of said weights is insoluble in
water.

The examiner relies on the following prior art references
as evidence of unpatentability:

Welch	1,689,541	Oct. 30, 1928
Elges	6,484,434 B1	Nov. 26, 2002 (filed Nov. 27, 2000)

Claims 1 and 8 stand rejected under 35 U.S.C. § 102(b) as
anticipated by Welch. (Examiner's answer mailed Oct. 20, 2003,
paper 10, page 3; final Office action, page 3.) Also, claims 1
through 5, 8, and 9 stand rejected under 35 U.S.C. § 102(e) as

anticipated by Elges. (Answer, page 3; final Office action, page 3.)¹

We reverse: (i) the 35 U.S.C. § 102(b) rejection of appealed claims 1 and 8 as anticipated by Welch; and (ii) the 35 U.S.C. § 102(e) rejection of appealed claim 2 as anticipated by Elges. We affirm, however, the 35 U.S.C. § 102(e) rejection of appealed claims 1, 3 through 5, 8, and 9 as anticipated by Elges.² Also, we remand this application pursuant to 37 CFR § 1.196(a) (2003) (effective Aug. 20, 1989).

¹ On page 3 of the answer, the examiner states: "Claims 1-9 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 5." We note, however, that claim 5 was not finally rejected under 35 U.S.C. § 103(a). Instead, claims 1-4, 8, and 9 were finally rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 2,149,054 issued to Jones on Feb. 28, 1939 in view of Elges or Welch (final Office action, p. 3), while claims 6 and 7 were finally rejected under U.S.C. § 103(a) as unpatentable over Jones in view of Welch or Elges and further in view of U.S. Patent 3,035,368 issued to Collins on May 22, 1962 (*id.* at p. 5). Also, the examiner contradicts the statement made on page 3 of the answer by commenting as follows: "The rejections of claims 1-9 under 35 U.S.C. 103(a) using the Jones reference US 2149054 as modified by Elges, Welch and/or Collins reference US 3035368, are dropped in that applicant's arguments are persuasive." (Answer, p. 4.) Notwithstanding this confusion, we note that the examiner does not dispute the appellant's understanding (reply brief filed Dec. 22, 2003, paper 11, pp. 6-7) that the 35 U.S.C. § 103(a) rejections based on Jones as a principal reference have been withdrawn. (Office letter mailed Feb. 10, 2004, paper 12.) We presume, therefore, that these rejections are not before us in this appeal.

² The appellant submits: "Claims 2-7 are dependent on independent claim 1. Claim 2 is separately patentable. Claims

Claims 1 & 8: The Welch Reference

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

The examiner argues (final Office action, page 3):

Referring to claims 1 and 8, Welch discloses a fishing lure comprising a substantially sold [sic, solid] flexible body portion - 10, at least one independent weight - 20 at least partially encapsulated in the substantially solid flexible body portion and stationary relative thereto and wherein each of the weights is insoluble in water - see for example figures 1-4 and columns 1-3.

The appellant, on the other hand, points out that Welch does not disclose a fishing lure with a body portion that is "flexible," as that term is defined in the specification.³

(Appeal brief, pages 5-6.)

1 and 3-7 stand or fall together. Claim 9 is dependent on independent claim 8. Claims 8 and 9 stand or fall together." The appellant, however, does not provide any argument on why claims 8 and 9 are considered to be separately patentable from claims 1 and 3-5. Accordingly, claims 1, 3-5, 8, and 9 stand or fall together. 37 CFR § 1.192(c) (7) (2003) (effective Apr. 21, 1995).

³ The present specification defines the term "flexible" as follows: "As used herein the term 'flexible' is to be construed to mean that the material from which the body portion of the lure is made is flexible and elastomeric or polymeric." (Underscoring added; p. 2, ll. 11-13.)

We agree with the appellant on this issue. When read in light of the specification, the recited term "flexible" would be understood by one skilled in the relevant art to require an elastomeric or polymeric material.⁴ Because the examiner does not account for this limitation, no prima facie case of anticipation can exist.⁵

Claims 1-5, 8, & 9: Elges

Elges describes a fishing lure including, inter alia, a body 412, which may be composed of rubber (i.e., elastomer), and a stationary weight 450 at least partially encapsulated within the body. (Figure 4; column 3, lines 9-43.) The examiner further determined (answer, page 4) that "[r]ubber is a common flexible material..." Elges, therefore, describes, either

⁴ In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("When the applicants state the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art."); see also Multifirm Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) ("When the specification explains and defines a term used in the claims, without ambiguity or incompleteness, there is no need to search further for the meaning of the term.").

⁵ We decline to make an initial determination on whether the subject matter of any of the appealed claims would have been obvious over Welch, alone or in combination with other art, within the meaning of 35 U.S.C. § 103(a). On remand, however, the examiner is free to do so.

expressly or inherently, every limitation of the invention recited in appealed claim 1.

The appellant argues that Elges discloses "rubber [] only in passing" and that "[t]here are numerous types of rubber, including both flexible and inflexible rubbers." (Reply brief filed Dec. 22, 2003, page 5.) Furthermore, the appellant contends that Elges teaches away from using a flexible rubber and that a flexible rubber would render Elges's lure inoperable. (Id.)

We see no merit in the appellant's arguments. Rubber is one of only a few materials enumerated in Elges as suitable for the lure body. Accordingly, Elges's disclosure is sufficient to anticipate appealed claim 1. In re Schaumann, 572 F.2d 312, 315, 316, 197 USPQ 5, 8, 9 (CCPA 1978) (holding that "the disclosure of a chemical genus...constitute[s] a description of a specific compound" within the meaning of §102 where the specific compound falls within a genus of a "very limited number of compounds.").

Regarding the appellant's argument on the flexibility or inflexibility of the rubber, neither the express terms of appealed claim 1 nor the description in the specification place any limitation on the degree of flexibility of the lure body.

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Thus, the term "flexible body portion" as recited in appealed claim 1 encompasses or reads on elastomers or polymers that are flexible to any degree of flexibility, however small that degree of flexibility might be. Also, the appellant proffers no objective evidence to establish that: (i) completely inflexible rubbers exist; and (ii) minimally flexible rubbers cannot be used as the lure body for purposes of Elges's invention. Accordingly, we cannot reverse the examiner's rejection on this basis.

As to appealed claim 2, the appellant argues that Elges does not describe at least one weight that is completely encapsulated in the flexible body. (Reply brief, page 6; appeal brief, page 8.) Because the examiner offers no rebuttal, we reverse this rejection as to appealed claim 2.

The rejection is affirmed as to appealed claims 1, 3 through 5, 8, and 9 but reversed as to appealed claim 2.

Remand

In the reply filed Dec. 2, 2002, the appellant amended claims 1 and 8 by inserting "substantially solid" before the recitation "flexible body portion." The examiner should analyze whether claims 1 and 8, as amended, comply with the requirements of 35 U.S.C. § 112.

Additionally, the examiner should analyze the scope of the appealed claims through claim interpretation. In particular, the examiner should ascertain the scope and meaning of the term "substantially solid," taking into account any enlightenment found in the specification. In this regard, we observe that the specification does not appear to contain any express definition for the term "substantially solid" but that Figures 7 and 8, for example, describe hollow bodies. Under these circumstances, the examiner should reconsider applying Jones against the appealed claims in rejections under 35 U.S.C. §§ 102 and 103.

Summary

In summary, we reverse the examiner's rejections under: (i) 35 U.S.C. § 102(b) of appealed claims 1 and 8 as anticipated by Welch; and (ii) 35 U.S.C. § 102(e) of appealed claim 2 as anticipated by Elges. We affirm, however, the examiner's rejection under 35 U.S.C. § 102(e) of appealed claims 1, 3 through 5, 8, and 9 as anticipated by Elges. Also, we remand this application pursuant to 37 CFR § 1.196(a) (2003) (effective Aug. 20, 1989).

Time Period for Taking Action

This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01(D) (8th ed., Rev. 1, Feb. 2003). Thus, it is important that the Board be

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promptly informed of any action affecting the appeal in this case.

This decision includes a remand to the examiner.
Therefore, for purposes of appeal, this decision is not final.
37 CFR § 1.196(e) (2003) (effective Aug. 20, 1989).

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Thomas A. Waltz)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Peter F. Kratz)	
Administrative Patent Judge)	APPEALS AND
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