

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN E. WICHT

Appeal No. 96-0535
Application 08/113,185¹

ON BRIEF

Before COHEN, ABRAMS and McQUADE, *Administrative Patent Judges*.
ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1, 3 through 6, 8, 15 and 17 through 20. Claims 9 through 14 and 21 have been allowed, and claims 2 and 7 have been indicated as containing allowable subject matter.

¹ Application for patent filed August 30, 1993.

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The appellant's invention is directed to a fishing lure of the type having a rattle. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. A rattle jig for use in fishing which comprises:

A) a solid metallic body of generally circular cross-section,

B) a forwardly extending generally longitudinally aligned body extension of lesser diameter

C) a fish hook secured to the forwardmost end of said body extension, the shank of said fish hook being centrally disposed within said body extension generally in alignment with the longitudinal axis of the body,

D) at least on annular channel in the surface of the body extension,

E) a rattle chamber within said body having at least one noise-making rattle element loosely held therein,

F) a fiber weed guard secured to and extending radially outward from said body, spaced rearward of the barb of said fish hook, and

G) an eyelet secured to the rearward end of said body for attaching the jig to a fish line.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Hoover et al. (Hoover)	4,712,326	Dec. 15, 1987
Hughes	5,231,786	Aug. 3, 1993
Link	5,261,182	Nov. 16, 1993
Jukes (UK Patent Application)	2,207,841	Feb. 15, 1989

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THE REJECTIONS

Claims 1 and 3 through 6 stand rejected under 35 USC §103 as being unpatentable over Hughes in view of Hoover.

Claims 8, 15 and 17 through 20 stand rejected under 35 USC §103 as being unpatentable over Hughes in view of Hoover, Jukes and Link.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief and the Reply Brief.

OPINION

The field of the appellant's invention is fishing lures of the type having a hook, a rattle and a weed guard. The invention itself is directed to a particular arrangement of these elements. Independent claim 1 recites a body, a body extension, a fish hook secured to the body extension, an annular surface in the body extension, a rattle chamber within the body with a rattle therein, a weed guard extending radially outward from the body, and an eyelet for attaching the lure to a fish line.

Claim 1 stands rejected as being unpatentable over the combined teachings of Hughes and Hoover. The examiner finds in Hughes all of the claimed structure except for the rattle chamber, a feature for which he looks to Hoover. In rejecting claims under 35 USC §103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re*

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Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983); *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The appellant has set forth several arguments in opposition to the positions taken by the examiner with regard to the rejection of claim 1. The first of these is that it would not have been obvious to incorporate a rattle chamber into the structure disclosed by Hughes because the shank of the Hughes fish hook passes fully through the body and this would interfere with the rattle chamber. Our response to this is that Claim 1 requires merely that there be "a rattle chamber within said body," with no other limitations as to location, and there

appears to be ample space in the bottom portion of the Hughes lure body within which a rattle chamber could be located.

The appellant goes on to point out that if it had been obvious, Hughes would have done so. We are not persuaded by this argument, either. The legal guidance which directs our evaluation of the issue of obviousness does not include an assumption that if a patentee did not incorporate a feature that pre-dated his or her invention, non-obviousness must be presumed. The correct standard is, as stated above, what the combined teachings of the references would have suggested to one of ordinary skill in the art.

Insofar as the required suggestion to combine is concerned, we note Hoover's comment that such rattles are well known and have been used with baits and lures "of the most varied sort" (column 1, line 7). In fact, the appellant has admitted that rattling lures have been known for many years (Brief, page 7). It thus is our view that one of ordinary skill in the art would have found suggestion to install a rattler in the Hughes device to improve its performance as a fish lure, in view of the teachings of Hoover.

The appellant further argues that the forwardly extending body extension and the fish hook mounted therein in the Hughes device are not, respectively, "generally longitudinally aligned" and "generally in alignment with the longitudinal axis

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of the body," as required by claim 1. There are several issues which arise in confronting this question. First of all, in the absence of direction to the contrary, we shall assume that the intention of the claims is that the body extension and the shank of the fish hook both be "generally" aligned to the same longitudinal axis.

Proceeding from this point, we observe that the longitudinal axis of the body is not designated in the drawings or described in the specification, nor does the disclosure include a definition of the term "generally" or set forth the limits within which an element must fall in order to qualify as being "generally" in alignment. The presence of "generally" establishes that the axis and the two elements need not be in exact alignment. For example, looking to Figure 2 and considering the body alone as a starting point, if the bottom face 18 were considered to be the reference point for the body, and the longitudinal axis of the body oriented thereto, the body extension and the fish hook shank would be at 18 to 20 degrees to the body axis (see specification, page 4), and in order for the disclosure to be covered by the claim "generally" would have to include this 20 degree variance. Considering Hughes in the same fashion, the angle of the body extension and the fish hook shank to the axis would be at "about" 45 degrees "although other angles can be used" (column 2, line 55). In view of the lack of detail

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surrounding the appellant's expression of this feature in the application, and the absence of evidence to the contrary, it is our view that the showing in Hughes meets the claim requirement of being "generally" in alignment.

This conclusion is supported by considering that no criticality has been alleged for the orientation of the body extension or the fish hook shank with respect to the longitudinal axis, insofar as the operation of the device is concerned. In fact, these limitations do not even appear in the original claims. Moreover, it is interesting to note that the orientation of the body extensions and the fish hook shanks in the references of record in this application differ from one another, indicating that those of ordinary skill in this art have utilized a variety of designs.

In view of the above, there is nothing which would contradict our belief that: (1) the body extension and fish hook shank of Hughes meet the claim limitations of being "generally" in alignment with the longitudinal axis of the body, and; (2) the angle of these elements to the longitudinal axis of the body presents no novel or unexpected result over the angle shown in Hughes, and solves no stated problem, and therefore would have been a matter of obvious design choice to one of ordinary skill in the art (see *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)).

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It is our conclusion that the combined teachings of Hughes and Hoover establish a *prima facie* case of obviousness with respect to the subject matter recited in claim 1, which has not been rebutted by evidence of record. The rejection of independent claim 1 therefore is sustained, along with the rejection of claims 3 through 6, which the appellant has chosen not to challenge with any reasonable specificity. See *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987).

The structure recited in independent claim 15 is the same as that of claim 1, except for the requirements that the body be made of brass and the fiber weed guard be installed by adhesively sealing in a second transverse recess. The appellant has admitted that the substitution of brass for lead in the Hughes device would have been obvious (Brief, page 9). As for the adhesive attachment, we first voice our agreement with the examiner that the manner of mounting taught by Link constitutes an "adhesive" mounting, considering that during examination before the Patent and Trademark Office, the pending claims in an application must be interpreted as broadly as their terms reasonably allow, without reading any limitations from the specification into the claims. See, for example, *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). Further in this regard, we voice the additional view that the attachment of elements to one another by means of adhesives is a notoriously

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old and well-known technique, the appropriate use of which would have been obvious to one of ordinary skill in the art. We agree that it would have been obvious to adhesively attach the weed guard bristles of Hughes in their mounting aperture.

A *prima facie* case of obviousness also has been established with regard to the subject matter of claim 15, and therefore the rejection of claim 15 is sustained. The rejection of claims 8 and 17 through 20, which were grouped with claim 15, also is sustained.

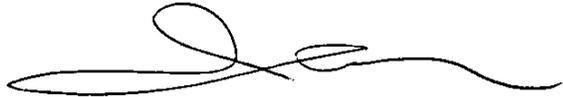
We have, of course, carefully considered all of the appellant's arguments. However, they have not persuaded us that the decision of the examiner was in error. Our position with regard to these arguments should be apparent from the discussion of each of the rejections.

The decision of the examiner is affirmed.

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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).

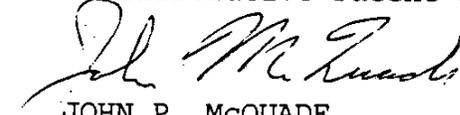
AFFIRMED



IRWIN CHARLES COHEN)
Administrative Patent Judge)



NEAL E. ABRAMS)
Administrative Patent Judge)



JOHN P. McQUADE)
Administrative Patent Judge)

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L. Paul Burd
1300 Foshay Tower
Minneapolis, MN 55402