

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS J. BARRON

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Appeal No. 1998-1919  
Application No. 08/620,993<sup>1</sup>

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ON BRIEF

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Before STAAB, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 40, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

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<sup>1</sup> Application for patent filed March 22, 1996.

BACKGROUND

The appellant's invention relates to a fish-attracting system (claims 1 through 10), a fishing lure (claims 11 through 28) and a fish-attracting or repelling device (claims 29 through 40). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced in the opinion section below.

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

Smith 1957	2,784,399	March 5,
Ursrey et al. 14, 1980 (Ursrey)	4,227,331	Oct.

Claims 1, 2, 5-11, 15, 24, 25, 27-29 and 40 stand rejected under 35 U.S.C. § 102(b) as anticipated by Ursrey.

Claims 3, 4, 16-23 and 33-39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ursrey.

Claims 12-14, 26 and 30-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ursrey in view of Smith.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the first Office action (Paper No. 2, mailed February 6, 1997) and the examiner's answer (Paper No. 7, mailed December 18, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 6, filed September 16, 1997) for the appellant's arguments thereagainst.

#### OPINION

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

#### **The anticipation issue**

We sustain the rejection of claims 1, 2, 5-8, 11, 15, 24, 25, 27-29 and 40 under 35 U.S.C. § 102(b) as anticipated by Ursrey, but not the rejection of claims 9 and 10.

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d

760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied,  
465 U.S. 1026 (1984)).

*Claim 1*

Claim 1 reads as follows:

In a fish-attracting system of the type in which a pulse train source is connected in circuit with a transducer to emit signals of predetermined properties, the improvement which comprises:  
providing said pulse train source in a first container and said transducer in a second container, at least one of said first and second containers comprising a fish attracting device.

Claim 1 is anticipated by Ursrey. Claim 1 reads on Ursrey's fish lure (see Figures 1-3 and 5) as follows: In a fish-attracting system (Ursrey's fish lure 10) of the type in which a pulse train source (Ursrey's IC chip 26, battery 34, RC circuitry, transistor  $Q_1$ ) is connected in circuit with a transducer (the diode within one of Ursrey's LED light sources  $D_1$ ) to emit signals of predetermined properties, the improvement which comprises: providing said pulse train source (Ursrey's IC chip 26, battery 34, RC circuitry, transistor  $Q_1$ ) in a first container (Ursrey's body 12) and said transducer

(Ursrey's diode within one of the LED light sources  $D_1$ ) in a second container (the outer housing of Ursrey's LED light source  $D_1$ ), at least one of said first and second containers comprising a fish attracting device (Ursrey's body 12 is a fish attracting device).

The appellant argues (brief, pp. 3-4) that it is inappropriate to consider the LED light source  $D_1$  to be mounted within its own container. Specifically, the appellant contends that the LED requires its glass or plastic enclosure to function, and cannot be regarded as existing independent from an enclosure. We find this argument to be unpersuasive for the following reason. Ursrey discloses a LED light source  $D_1$ . One of ordinary skill in the art would know that a LED light source<sup>2</sup> consists of a "transducer" (i.e., the semiconductor PN junction diode which has an anode lead and a cathode lead) and a "housing" (i.e., the molded plastic lens which encloses the semiconductor PN junction diode). Thus, it

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<sup>2</sup> See page 302 of the McGraw-Hill Electronics Dictionary (1994) which defines the term "light-emitting diode."

is our view that claimed transducer provided in a second container "reads on" the LED light source D<sub>1</sub> of Ursrey.

Since all the limitations of claim 1 are found in Ursrey, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed.

*Claims 2, 5-8, 11, 15, 24, 25, 27-29 and 40*

The appellant has grouped claims 1, 2, 5-8, 11, 15, 24, 25, 27-29 and 40 as standing or falling together.<sup>3</sup> Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 2, 5-8, 11, 15, 24, 25, 27-29 and 40 fall with claim 1. Thus, it follows that the decision of the examiner to reject claims 2, 5-8, 11, 15, 24, 25, 27-29 and 40 under 35 U.S.C. § 102(b) is also affirmed.

*Claims 9 and 10*

Claim 9 reads as follows:

An improvement according to Claim 8, including a replacement transducer container constructed and arranged

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<sup>3</sup> See page 2 of the appellant's brief.

to be interchangeable in said device with said second container.

The appellant argues (brief, p. 4) that Ursrey "contains no suggestion of interchangeable containers." We agree. We note that the examiner did not respond to this argument in the answer. We have reviewed the disclosure of Ursrey, particularly the disclosure concerning the LED light sources and fail to find any teaching or suggestion that the LED light sources would have been made to be interchangeable with other LED light sources.

Since all the limitations of claim 9, and claim 10 dependent thereon, are not found in Ursrey, the decision of the examiner to reject claims 9 and 10 under 35 U.S.C. § 102(b) is reversed.

**The obviousness issues**

We will not sustain the rejection of claims 3, 4, 16-23 and 33-39 under 35 U.S.C. § 103 as being unpatentable over Ursrey. We sustain the rejection of claim 26 under 35 U.S.C.

§ 103 as being unpatentable over Ursrey in view of Smith, but not the rejection of claims 12-14 and 30-32.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight

reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

*Claims 3, 4, 16-23 and 33-39*

With respect to claims 3, 4, 16-23 and 33-39, the examiner determined (first Office action, p. 3) that it would have been obvious to provide Ursrey with an interchangeable battery case to install new batteries as the present batteries expire.

The appellant argues (brief, p. 4) that Ursrey does not suggest interchangeable containers for any purpose.

The examiner responded to this argument (answer, p. 4) by stating that

Ursrey does not show interchangeable containers but it would have been within the purview of one skilled in the art to have another and different lure body to mount the circuit elements in, to for example, change the lure color, shape or other characteristic to attract fish.

In our opinion the examiner has failed to present any evidence that would have suggested the proposed modification to Ursrey. In our view, the only suggestion for modifying Ursrey in the manner proposed by the examiner to meet the claimed limitations stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 3, 4, 16-23 and 33-39.

*Claims 12-14 and 30-32*

With respect to claims 12-14 and 30-32, the examiner determined (first Office action, p. 3) that it would have been

obvious to provide Ursrey with a sound generator as shown by Smith to attract more fish because sound is a well known fish attractor.

The appellant argues (brief, p. 5) that the claimed subject matter is not suggested from the applied prior art. We agree. Claims 12-14 and 30-32 require the transducer to be "an electromechanical device." Thus, these claims require the second housing to contain the electromechanical device at the same time the first housing contains the pulse train generator. In our view, this is not suggested by the combined teachings of the applied prior art. That is, there is no suggestion for modifying Ursrey in the manner proposed by the examiner to meet the claimed limitations absent the use of impermissible hindsight.

*Claim 26*

With respect to claim 26<sup>4</sup>, the examiner determined (first Office action, p. 4) that

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<sup>4</sup> Claim 26 requires the morsel to comprise "a jig bait."

Ursrey shows a crank bait but it would have been within the purview of one skilled in the art to use a jig bait with the LED system as shown by Ursrey.

The appellant argues (brief, p. 5) that "neither reference contains any suggestion of a jig type lure."

The examiner responded to this argument (answer, p. 4) by stating that

Claim 26 recites a jig type lure which can be considered as a jig bait. However, what structure is recited? Any lure that sinks or can be fished underwater can be used a jig lure since the term "jig" is nothing more than using the rod tip to move the lure up and down in the water.

The appellant did not respond to this new argument of the examiner.

We agree with the above-noted reasoning of the examiner as to why the subject matter of claim 26 would have been obvious to one of ordinary skill in the art at the time the invention was made. We observe that an artisan must be presumed to know something about the art apart from what the

references disclose (see In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is presumed on the part of those practicing in the art. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Thus, it is our conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ursrey's lure so that it sinks or can be fished underwater in the manner of a jig lure/bait.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 5-11, 15, 24, 25, 27-29 and 40 under 35 U.S.C. § 102(b) is affirmed with respect to claims 1, 2, 5-8, 11, 15, 24, 25, 27-29 and 40, but is reversed with respect to claims 9 and 10; and the decision of the examiner to reject claims 3, 4, 12-14, 16-23, 26 and 30-39 under 35 U.S.C. § 103 is

affirmed with respect to claim 26 but is reversed with respect to claims 3, 4, 12-14, 16-23 and 30-39.

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

AFFIRMED-IN-PART

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

Appeal No. 1998-1919  
Application No. 08/620,993

Page 16

DAVID V. TRASK  
TRASK BRITT & ROSSA  
PO BOX 2550  
SALT LAKE CITY, UT 84110

APPEAL NO. 1998-1919 - JUDGE NASE  
APPLICATION NO. 08/620,993

APJ NASE

APJ McQUADE

APJ STAAB

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 16 Mar 99

**FINAL TYPED:**