

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK WACKERMAN

Appeal No. 1998-3007
Application No. 08/690,994¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS
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 12 to 22. Claims 1, 2, 4 to 6 and 8 to 11 have been allowed. Claims 3 and 7 have been canceled.

¹ Application for patent filed August 1, 1996.

Appeal No. 1998-3007
Application No. 08/690,994

We AFFIRM-IN PART.

BACKGROUND

The appellant's invention relates to a fishing lure and a method of using a fishing lure. An understanding of the invention can be derived from a reading of exemplary claims 12 and 19, which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims (i.e., the applied prior art) are:

Patterson 10, 1961	3,003,276	Oct.
Pippert 1991	5,070,639	Dec. 10,
Cole 4, 1996	5,522,170	June

Claims 12 and 14 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Cole.

Claims 13, 16 and 19 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cole.

Claims 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Cole in view of Pippert.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cole in view of Patterson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 8, mailed May 27, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 7, filed March 3, 1998) and reply brief (Paper No. 9, filed June 1, 1998) 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, 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 12 and 14 under 35 U.S.C. § 102(a).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 12

Claim 12 "reads on" the fishing lure shown in Cole's Figure 3 as follows: A fishing lure comprising: a substantially rigid head section having a bait simulating appearance, a front end and a rear end (Cole's front section 37); a substantially rigid middle section having a front end and a rear end (Cole's rear section 43); a multi-dimensional pivot connection between said head section rear end and said middle section front end (Cole's interlocking eyelets 50, 52); a flexible material tail section having a front end and a rear end, said front end of said tail section fixed to said rear end of said middle section (Cole's tail 53); at least one hook receiving connection fixed to at least one of said head and middle sections (Cole's unlabeled connections from which the unlabeled fish hooks are suspended); at least one attachment for connecting at least one of said head and middle sections to a fishing line (Cole's front eyelet 41); said head and middle sections each have a top and a bottom (Cole's front section 37 and rear section 43 each have a top and a bottom);

and wherein said at least one hook-receiving connection includes a connection at said bottom of at least one of said head and middle sections (Cole's unlabeled connections from which the unlabeled fish hooks are suspended include a connection at the bottom of the front section 37 and rear section 43); and a substantially continuous scoop formed in said head section at said front end thereof and in said top of said head section, said scoop dimensioned and configured to cause erratic action of said head section as said lure is pulled through the water (Cole's slightly concave surface 38).

The argument presented by the appellant that Cole does not teach the claimed "scoop" is unpersuasive for the following reasons.

First, it is our view that the recited function (i.e., "to cause erratic action of said head section as said lure is pulled through the water") is met by Cole's slightly concave surface 38. In that regard, Cole discloses (column 4, lines

18-26) that in the second embodiment of the lure (i.e., Figure 3) the front face of the front section 37 is flat beveled or **slightly concave** surface 38 such that the leading edge 39 of the front face is located at the bottom of the lure and the trailing edge 40 of the front face is at the top of the lure. Cole teaches that "[s]uch a configuration causes the lure to oscillate or wobble from side to side as it is pulled through the water." In addition, Cole teaches (column 2, lines 7-10) that in the second embodiment, "the front face of the first section has a completely angled surface to reduce the side-to-side motion of the lure somewhat and to produce more of an **irregular wobble type action.**" [Emphasis ours]. Thus, we find that the motion produced by Cole's slightly concave surface 38 is erratic as the lure is pulled through the water.²

² We have also considered the declaration of Al K. Kalin (dated August 20, 1997). However, that declaration does not establish that Cole's Figure 3 embodiment is not capable of erratic action as the lure is pulled through the water.

Second, it is our opinion that Cole's slightly concave surface 38 is formed in the front end and in the top of front section 37. The term "top" in claim 12 must be given its broadest reasonable meaning.³ Thus, we conclude that the "top" of the head section as used in claim 12 means an upper portion of the head section. In reading claim 12 on Cole's Figure 3 we note that the "top" of front section 37 is considered to be the portion of front section 37 above the level of the eye. Accordingly, Cole's slightly concave surface 38 is formed in both the top of front section 37 and in the front end of the front section 37.

Similarly, it is our determination that the claimed term "scoop" is readable on Cole's slightly concave surface 38. As

³ It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

set forth in the appellant's reply brief (p. 2), the term "scoop" requires a curvature. However, such curvature is present due to the concave nature of Cole's surface 38.

Claim 14

We agree with the examiner that claim 14 is readable on Cole's Figure 3.

The appellant argues (brief, p. 8, and reply brief, pp. 2-3) that "by the language of claim 14 itself, extending through the entire lure body is not within the scope of claim 14." We do not agree. In that regard as set forth above, limitations are not to be read into the claims from the specification. In re Van Geuns, supra. We fail to find any limitation in claim 14 that excludes the claimed pins from extending to both sides of the middle section.

For the reasons stated above, the decision of the examiner to reject claims 12 and 14 under 35 U.S.C. § 102(a) is affirmed.

The obviousness issues

We will not sustain the rejection of claims 13 and 15 to 22 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie 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, 458 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).

The appellant argues that the examiner has not set forth a prima facie case of obviousness with regard to claims 13 and 15 to 22. We agree.

With regard to claim 13, and claims 16 to 18 and 21 dependent thereon, it is our opinion that the applied prior art would not have suggested the scoop "extending from said front end of said head section past said eyes." In that regard, the examiner's determination that the above-noted

limitation of claim 13 would have been obvious is not supported by any evidence and thus must be reversed.⁴

With regard to claim 15, it is our opinion that the applied prior art would not have suggested the tail section of soft flexible plastic having "an open-top socket for receipt of a rattle." The examiner's determination that the above-noted limitation of claim 15 would have been obvious is not supported by evidence and thus must be reversed. In that regard, we agree with the appellant (brief, pp. 11-12) that Pippert does not teach or suggest an open-top socket for receipt of a rattle in a soft flexible plastic tail section.⁵

With regard to claim 22, it is our opinion that the applied prior art would not have suggested the shape of the

⁴ We note that the patent to Wardrip (U.S. Patent No. 2,503,529) was not applied by the examiner in the rejection of claim 13. Wardrip shows in Figures 1-3 that the concave face 5 extends past the eyes 27.

⁵ We note that the SWIM BAIT® lure cited by the appellant was not applied by the examiner in the rejection of claim 15. The SWIM BAIT® lure teaches an open-top socket for receipt of a rattle in a soft flexible plastic tail section of the lure.

scoop as recited in claim 22. In that regard, the examiner's determination that the recited shape limitations of claim 22 would have been obvious is not supported by any evidence and thus must be reversed.

With regard to claim 19, and claim 20 dependent thereon, it is our opinion that the applied prior art would not have suggested the recited method steps. The examiner's determination that the method steps of claim 19 would have been obvious is not supported by any evidence and thus must be reversed. In that regard, we agree with the appellant (brief, p. 10) that there is no suggestion or teaching in the applied prior art of the recited step of "ripping" (see paragraph (a) of claim 19) the tail section.

For the reasons stated above, the decision of the examiner to reject claims 13 and 15 to 22 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 12 and 14 under 35 U.S.C. § 102(a) is affirmed and the decision of the examiner to reject claims 13 and 15 to 22 under 35 U.S.C. § 103 is reversed.

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

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/690,994

APJ NASE

APJ ABRAMS

SAPJ McCANDLISH

DECISION: **AFFIRMED-IN PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 11 May 99

FINAL TYPED: