

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** JOHN C. BOUCHER, JR.

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Appeal No. 98-3354  
Application No. 08/427,743<sup>1</sup>

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ON BRIEF

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Before CALVERT, MEISTER, and NASE, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

John C. Boucher, Jr. appeals from the final rejection of claims 21-35 and 37.<sup>2</sup> Claims 38-40 stand allowed. Claim 36,

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<sup>1</sup> Application for patent filed April 24, 1995.

<sup>2</sup> Independent claim 21 has been amended subsequent to final rejection.

the only other claim remaining in the application, has been indicated as being allowable subject to the requirement that it be rewritten to include all the subject matter of the claims from which it depends.

The appellant's invention pertains to a fishing lure comprising a soft body that is flexible and resilient. Independent claim 21 is further illustrative of the appealed subject matter and a copy thereof may be found in APPENDIX A of the brief.

The references relied on by the examiner are:

Guzik	4,345,399	Aug. 24, 1982
Salminen	5,090,151	Feb. 25, 1992

The claims on appeal stand rejected in the following manner:<sup>3</sup>

(1) Claims 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by Guzik;

(2) Claims 23, 24 and 28-33 under 35 U.S.C. § 103(a) as being unpatentable over Guzik; and

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<sup>3</sup> The final rejection of claims 21-28 under 35 U.S.C. § 112, second paragraph, was deemed by the examiner to have been overcome by the above-noted amendment after final rejection (see the advisory action mailed on August 28, 1996 (Paper No. 6)).

(3) Claims 25-27, 34, 35 and 37 under 35 U.S.C. § 103(a)  
as being unpatentable over Guzik in view of Salminen.

**OPINION**

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and reply brief, and by the examiner in the answer. As a consequence of this review we will not sustain any of above-noted rejections.

Each of the above-noted rejections is bottomed on the examiner's view that Guzik teaches (a) a body portion 12 which can inherently be considered to be "flexible and resilient" and (b) a weight means 60. In support of position (a) the examiner opines that when the elastic members 28 and 60 of Guzik are inserted through the holes 24, 26 that "the body will also deform" (answer, page 6). In support of position (b) the answer states that:

The weight recited in claim 21 is not recited to cause the line to sink. Any object that has a different density than the density of the lure body can affect the overall density of the lure and can act as a weight to be used to make the lure operate on the water surface or at different depths beneath the water surface. [Page 5.]

The appellant, however, disagrees. As to examiner's position (a) the brief states that:

Applicant's specification states in lines 20-22 of page 7 that the lure body is to be "made from a plastic material that is sufficiently soft that the lure feels **lifelike** to game fish" . . . . Anyone skilled in the fishing lure art has handled a live bait, such as a minnow or a worm, and knows the way fish bait that is lifelike feels. Accordingly, a reasonable interpretation of the specification would **exclude** hard and rigid lure bodies from meeting the word "soft" or being covered by the word "soft" in the claims because such hard and rigid bodies would not feel lifelike. [Page 5.]

As to the examiner's position (b) the brief states that:

Those skilled in the fishing tackle art employ the word "weight" for things that are used to cause tackle or bait to sink in water. This is in accord with the definition of the word *weight* in standard dictionaries.

Applicant's specification states that the weight is used to cause the lure to sink. (Lines 29 and 30 on page 6 and lines 1 and 2 and 18 on page 7) Since the weight causes the lure to sink, it must have a specific gravity greater than water. Therefore, the Examiner's contention that the claims do not limit the weight to being heavier than water is incorrect. The limitations that the weight must be heavier than

water and that the weight causes the lure to sink in water are therefore inherent in all of the claims.  
[Page 6; footnote omitted.]

Having carefully considered the respective positions advanced by the examiner and appellant we find ourselves to be in substantial agreement with the appellant.

With respect to the examiner's position that the lure of Guzik "inherently" has a "a flexible resilient soft body" which would "deform" when the elastic members 28 and 60 are inserted through the holes 24, 26, we have nothing in Guzik which would reasonably support such a position. Guzik states that the tubular body 12 may be formed "from a variety of appropriate materials such as metal, plastic, or wood" (column 3, lines 18 and 19). Moreover, Guzik states that the hooks 20 and 22 are attached to the tubular body 12 by screws (column 2, line 68) and, additionally, states that the hooks may be attached "in any other appropriate manner such as by an elongated through bolt and nut, rivets spot welding, etc." (column 3, lines 2-4). These teachings all suggest that the tubular body of Guzik is relatively hard and rigid, not flexible, resilient and soft as the examiner contends. Inherency may not be established by probabilities or possibilities (**see *In re Oelrich***, 666 F.2d

578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)) and, when relying on the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art (*see Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990)). Here, we do not find the examiner has discharged that initial burden.

With respect to the examiner's position that the member 60 of Guzik can be considered as a "weight," we are of the opinion that the examiner is attempting to expand the meaning of this term beyond all reason. According to the appellant's specification:

The weight means 10, 47, 56, and 61 may be made from any convenient material, but preferably will be a metal such as lead, stainless steel, aluminum copper, or alloys of such metals. One of the advantages of this invention is that the action of a lure may be changed by changing the size and/or the material of the weight means inserted into the lure body cavity. For example, a fisherman may begin fishing with a lure as shown in FIG. 12 using a weight 61 made from aluminum. If the fisherman determines that the lure does not sink to a sufficient depth, the fisherman may stretch the

plastic body material around the hole 60 and remove the weight from cavity 59. The aluminum weight can then be replaced with a similar weight made from lead, so the heavier weight will sink the lure to a greater depth. Similar results can be achieved by using smaller or larger weights made from the same metal. This change in lure depth or action achieved by changing weights does not require that the fisherman untie and retie the fish line connected to the lure. [Pages 6 and 7.]

The member 60 of Guzik, however, is a resilient, elastic member that protrudes from the tubular body and bends as the lure moves through the water to produce different sonic effects (see, generally, column 3, and Fig. 7). While it is true that the claims in a patent application are to be given their broadest reasonable interpretation **consistent with specification** (*In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims during prosecution of a patent application (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)), it is also well settled that terms in a claim should be construed in a manner consistent with the specification and construed as those skilled in the art would construe them (**see *In re Bond***, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir.

1990), *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)). Here, we can think of no circumstances under which the artisan, consistent with the appellant's specification, would construe the resilient, elastic member 60 of Guzik to correspond to the claimed weight.

With respect to claims 25-27, 34, 35 and 37, we have carefully reviewed the teachings of Salminen but find nothing therein which would overcome the deficiencies of Guzik that we have noted above.

The examiner's rejections are all reversed.

**REVERSED**

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
JAMES M. MEISTER	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

JMM/jlb

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Charles M. Kaplan  
Rt 1  
1331 Olympia Avenue  
Mt Dora, FL 32757