

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINYA TAKIZAWA

Appeal No. 1999-1504
Application No. 08/787,262

HEARD: February 9, 2000

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS and BAHR,
Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11-15, 18-22, 25 and 26. Claims 1-10 have been canceled and claims 16, 17, 23 and 24, the only other claims remaining in the application, have been indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims from which they depend.

BACKGROUND

The appellant's invention relates to a fastener for attaching a fishing reel to a fishing rod. The fastener includes a bulge extending radially outward away from the longitudinal axis of the fishing rod as well as a constriction located between the bulge and a tip end of the fishing rod. According to appellant, the bulge increases the stability while grasping the fastener whereas the constriction is adapted to receive an angler's finger for precisely controlling minute movements of the fishing rod (specification, page 2). A copy of the claims on appeal appears in the appendix to the appellant's brief.

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

Ozeki et al. (Ozeki)	4,848,022	Jul. 18, 1989
Oyama	5,115,591	May 26, 1992

The following rejections are before us for review.¹

1. Claims 11, 12, 14 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ozeki.
2. Claims 11-15, 25 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Oyama.
3. Claims 18-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Oyama.

¹ The rejection under the judicially created doctrine of double patenting has apparently been withdrawn in view of the filing of a supplemental terminal disclaimer on July 21, 1998 (Paper No. 10).

Reference is made to the main and reply briefs (Papers No. 12 and 15) and the final rejection and answer (Papers No. 9 and 13) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

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 rejections

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v.

Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Turning first to the examiner's rejection of independent claim 11 as being anticipated by Ozeki, we note that claim 11 requires, *inter alia*, a primary body including a first hood for cooperating with the reel mounting means, a bulge opposite the first hood, an expanded portion and a constriction, and a secondary body including a second hood for cooperating with the reel mounting means, wherein "said primary body and said second hood are relatively rotatable." While Ozeki discloses, in the embodiment of Figures 1-5, a handle for a fishing rod comprising a primary body (reel attaching portion 3) having a first hood (hollow 9) and a second hood (fixing means 8), the second hood is not rotatable relative to the primary body, as required by the claim. As for the embodiment of the handle illustrated in Figures 9-15, and discussed in column 5 of Ozeki, while the second hood (means 24) is movable longitudinally relative to a primary body (the reel attaching portion 23), as explained in column 5, lines 27-31, the means (24) is prevented from rotating (column 5, lines 25-26) and the reel attaching portion does not rotate. Therefore, we conclude that Ozeki does not anticipate claim 11.

Accordingly, we shall not sustain the examiner's rejection of claim 11, or claims 12 and 14 which depend therefrom, under 35 U.S.C. § 102(b) as being anticipated by Ozeki.

With regard to the rejection of claim 25 based on Ozeki, the only argument presented in appellant's brief (page 9) is that Ozeki fails to teach the "bulge" and the "constriction" recited in

claim 25. The examiner, on the other hand, finds that the Ozeki fishing rod handle comprises a primary body having a bulge (trigger 10) and a constriction (at D in Figure 1). Upon examination of the Ozeki handle illustrated in Figures 1-3, we find that the trigger (10) is a "bulge"² and that the reel attaching portion (3) of the handle further comprises a portion, in the vicinity of the fixing means (8), of reduced cross-section relative to the trigger (i.e., a "constriction"). Accordingly, appellant's brief does not persuade us that the examiner has erred in rejecting claim 25 as anticipated by Ozeki. Therefore, we shall sustain the examiner's rejection of claim 25 under 35 U.S.C. § 102(b) as being anticipated by Ozeki.³

Turning next to the examiner's rejection of independent claim 11 as being anticipated by Oyama, we find the examiner's assertion (page 3) that the portion of the handle (5) "just to the right of 11 in Fig. 11 [*sic*: Fig. 4]" is a "constriction" of relatively reduced cross section with respect to the "bulge" (cover cylinder 8) and the "expanded portion" (contact portion 11) untenable. On the contrary, the region to the right of the contact portion 11 is of greater cross section relative to the contact portion 11, as clearly illustrated in Figure 4 of Oyama. Therefore, we shall not sustain the examiner's rejection of independent claim 11, or of claims 12-15 which depend therefrom, under 35 U.S.C. § 102(b) as being anticipated by Oyama.

² A "bulge" is "an outward swelling; protuberance" (Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)).

³ While neither the appellant's brief nor the examiner's final rejection and answer specifically addresses the limitation of a "movable hood," we note, for the record, that, in the embodiment of Figures 9-15, the second hood (hold means 23h and means 24) for engaging the reel-foot of the reel attaching plate (27) is movable relative to the first, fixed hood (hollow 23b).

The only argument presented in the appeal brief (page 12) with regard to the rejection of claim 25 as being anticipated by Oyama is that Oyama fails to disclose a "bulge" and "constriction." From our viewpoint, the cover cylinder (8) has a "bulge" therein, while the portion of the cover cylinder (8) in the vicinity of the contact portion (11) is a "constriction" having a reduced cross section as compared with the peak of the bulge of the cover cylinder (8). It follows then that appellant's brief does not persuade us that the examiner has erred in rejecting claim 25 under 35 U.S.C. § 102(b) as anticipated by Oyama.⁴ Accordingly, we shall sustain the examiner's rejection of claim 25 as being anticipated by Oyama.

With regard to claim 26, however, we find ourselves in agreement with appellant (brief, page 12) that the height of the cover cylinder (8) of Oyama, as seen in Figure 4, first increases along the direction from a point "diametrically opposite the fixed hood" (2) toward the movable hood (7) until the peak height is reached, at which point the height then decreases to a point diametrically opposite the movable hood (7). Thus, it is clear that Oyama lacks disclosure of a reel seat wherein a height of the bulge "is **continuously** reduced from a first point diametrically opposite from the fixed hood to a second point diametrically opposite from the movable hood" as required by claim 26. It follows that we cannot sustain the examiner's rejection of claim 26.

The obviousness rejection

⁴ Although these limitations were not addressed in appellant's brief, we note, for the record, that the Oyama fishing rod handle device comprises a movable hood (7), a fixed hood (2) and a seat base (including cover cylinder 8 and handle 5) extending between the fixed and movable hoods and surrounding the fishing rod (1) in the vicinity of the fixed hood (2).

With regard to the examiner's rejection of claims 18, 20 and 21, the only issue in dispute involves the limitation that "a distance from the longitudinal axis of a peripheral surface of said bulge is continuously reduced from a first point diametrically opposite from the first hood to a second point diametrically opposite from the second hood." As to claim 19, which depends from claim 18, the only additional issue in dispute is with regard to the limitation that "a center of said bulge is located at a position diametrically opposed to said first hood with respect to said longitudinal axis."

The appellant and the examiner appear to be in agreement that Oyama does not disclose such positioning of the peak or center of the bulge. However, it is the examiner's position (final rejection, page 4) that the location of the high point of the bulge would have been an obvious matter of design choice to be determined through routine experimentation, since the function is the same and no showing of unexpected results has been made. We agree with the examiner.

The stated objective of the Oyama handle is "to provide a fishing rod including a handling portion where a fishing reel can be mounted without any step, gap or looseness" (column 1, lines 59-61), thereby permitting the handle to be positioned in the middle portion of the fishing rod rather than the end portion thereof (column 2, lines 7 and 8). This objective is accomplished by providing the engaging grip (6) in contact with the cover cylinder (8) integrally attached to the sliding member (17) having the movable hood (7), with the cover

cylinder (8) attached to the movable hood (7) surrounding the handle except for the reel mounting portion and the fixed hood (column 3, lines 48-53). The cover cylinder, in essence, bridges the fixed and movable portions to prevent any undesired gap in the handle in the region of the reel attachment. The bulge shape of the cover cylinder (8), of course, helps accommodate an angler's hand to permit easy gripping of the portion of the rod onto which the reel is mounted to attain a smooth fishing operation. Thus, it would have been apparent to one of ordinary skill in the art that the bulge or cover cylinder (8) should be located in the region of the reel attachment portion of the rod and should overlap the fixed handle portion (5). As the positioning of the center of the bulge diametrically opposite from the fixed hood and the peak of the bulge either opposite from or to the butt end side of the fixed hood, such that the height of the bulge is continuously reduced from a point opposite the fixed hood to a point opposite the movable hood, solves no stated problem, it is our opinion that the exact positioning of the center or peak of the bulge would have been an obvious matter of design choice within the skill of the art. See In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Appellant (brief, page 13), in essence, alleges that the positioning of the peak and center of the bulge solves a stated problem in that appellant has "developed a uniquely beneficial [*sic*: beneficial] fishing rod handle that enables the angler to precisely manipulate the fishing rod through the use of his/her fingers, while at the same time stably grasp the rod handle (see page 5, lines 9-11 of the specification)." Turning to page 5, lines 9-11, of the specification as

directed by appellant's brief, we are informed that "the fishing rod can be precisely manipulated through the use of the finger received in the constriction 22, while the bulge ensures a stable grasp may also be comfortably maintained." However, appellant has provided no explanation, much less evidence, as to whether or how the exact positioning of the peak or center of the bulge is critical in achieving these advantages.⁵ Moreover, as discussed below in the new ground of rejection, on the basis of appellant's original disclosure, and most notably original Figures 3 and 4, it appears that the above-noted advantages may be obtained even if the peak or center of the bulge is offset from a position "diametrically opposed from" the fixed hood. Accordingly, we find the examiner's position with regard to the positioning of the peak or center of the bulge to be reasonable and shall sustain the examiner's rejection of claims 18-21 under 35 U.S.C. § 103.

As to claim 22, based on our review of Figure 4 of Oyama, we find the "constriction" (contact portion 11) to be "radially spaced" from the fishing rod by the portion of handle (5) extending between the hoods and ending in a cylindrical screw (4). Therefore, we shall also sustain the examiner's rejection of claim 22 under 35 U.S.C. § 103.

NEW GROUND OF REJECTION

Pursuant to 37 CFR § 1.196(b), we enter the following new ground of rejection.

⁵ Attorney's arguments in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

Claims 13, 18-22 and 26 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

The written description requirement of the first paragraph of 35 U.S.C. § 112 serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

Claims 13, 18-22 and 26⁶ each recite that the height of the bulge (claims 13 and 26) or the distance from the longitudinal axis of a peripheral surface of the bulge (claims 18-22) is continuously reduced from a first point diametrically opposite from the first hood to a second point diametrically opposite from the second hood. Claim 19 further recites that the center of the bulge is located at a position diametrically opposed to said first hood. Appellant's original

⁶ These claims were presented for the first time in the amendment filed April 14, 1997 (Paper No. 2) and, thus, do not form part of the original disclosure.

written specification is silent with regard to the positioning of the center of the bulge and does not state that the height of the bulge is continuously reduced from a point diametrically opposite from the first/fixed hood (or securing means 28B) to a point diametrically opposite from the second/movable hood (or securing means 28A). Moreover, it is apparent to us, based on our review of original Figures 3 and 4, that both the center and the peak height of the bulge are located to the left (the tip end side) of a point diametrically opposite from the first/fixed hood. This, of course, also means that the height of the bulge either increases or remains constant for a given longitudinal distance from the point diametrically opposite from the first/fixed hood toward the second/movable hood before it begins to decrease.

For the foregoing reasons, we conclude that appellant's originally filed disclosure does not support the subject matter of claims 13, 18-22 and 26 as required by the first paragraph of 35 U.S.C. § 112.

CONCLUSION

To summarize, the decision of the examiner to reject claims 11, 12, 14 and 25 under 35 U.S.C. § 102(b) as being anticipated by Ozeki is affirmed as to claim 25 and reversed as to claims 11, 12 and 14. The examiner's decision to reject claims 11-15, 25 and 26 under 35 U.S.C. § 102(b) as being anticipated by Oyama and claims 18-22 under 35 U.S.C. § 103 as being unpatentable over Oyama is affirmed as to claims 18-22 and 25 and reversed as to claims 11-15 and 26. Additionally, a new ground of rejection of claims 13, 18-22 and 26

under the first paragraph of 35 U.S.C. § 112 is entered pursuant to the provisions of 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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; 37 CFR § 1.196(b)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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