

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID M. RICHARDS

Appeal No. 1999-1744
Application No. 08/743,521

ON BRIEF

Before FRANKFORT, STAAB, and JENNIFER D. BAHR, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 2, 4 and 10-13, all the claims currently pending in the application. An amendment filed subsequent to

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the final rejection on June 25, 1998 (Paper No. 7) has been entered.

Appellant's invention pertains to a fishing hook remover. An understanding of the invention can be derived from a reading of exemplary claim 2 which appears in an appendix to appellant's brief.

The references relied upon by the examiner in support of the rejections are:

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| Lawrence | 2,561,281 | Jul. 17, 1951 |
| Cripps et al. (Cripps) | 4,342,171 | Aug. 3, 1982 |

The following rejections under 35 U.S.C. § 103 are before us for review:¹

(a) claims 2, 4, 10 and 11, unpatentable over Cripps in view of Lawrence; and

(b) claims 12 and 13, being unpatentable over Cripps.

¹In the final rejection, claims 2, 4 and 10-13 were also rejected under 35 U.S.C. § 112, second paragraph. However, in that the examiner indicated in the advisory letter mailed July 8, 1998 (Paper No. 8) that this rejection has been overcome by the amendment filed subsequent to the final rejection, and in that the rejection has not been repeated in the examiner's answer, it is not before us in this appeal.

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Each of the independent claims on appeal, namely, claims 2 and 12, claims the fishing hook engaging end of the remover as follows (with emphasis added):

an elongated shank that is fixed to the handle and extends forwardly from the handle to terminate in a forked end *having divergent branches;*

wherein one of the branches of the forked end is further configured with a J-shaped portion such that the forked end and J-shaped portion thereof are *contained in a common plane*, and that the J-shaped portion defines a rearwardly opening U-shaped slot .

. . .

In rejecting the claims, the examiner makes the following findings of fact with respect to Cripps, the primary reference:

Cripps shows a pistol grip handle 14, an elongated shank 12 that is fixed to the handle and extends forwardly from the handle to terminate in a forked end having divergent branches 17, 18. Cripps shows a J-shaped portion 17 that defines a rearwardly opening slot (not labeled). . . . Cripps shows all the elements recited in claim 2 with the exception of the lateral flange fixed to the pistol grip. [Final rejection, page 3.]

In addition, in the "Response to Argument" section of the answer, the examiner states that "[t]he J-shaped structure of Cripps and the forked end 18 are contained in a common plane which is the plane of the plunger 12" (answer, page 4).

From the above, it is apparent that the examiner considers hook 17 and tip 18 of Cripps as corresponding to the claimed branches of the "forked end" of the fishhook remover.² However, the examiner has not explained how these elements constitute "divergent" branches of a forked end, as now claimed. Apparently, the examiner is of the view that because the looped portion of hook 17 is slightly upturned at its extremity when viewed from the side (as seen, for example, in Figure 1), the hook 17 can be considered to "diverge" relative to the tip 18. While this may arguably be true to a certain extent at selected times during operation of the Cripps device, as when the hook 17 is retracted relative to the tip 18 (see column 2, lines 15-19), it is not generally the case. For this reason, we consider that it is debatable whether the Cripps device can be fairly said to meet the "divergent branches" limitation of independent claims 2 and 12.

In any event, even if we were to agree with the examiner's determination that elements 17 and 18 of Cripps comprise divergent branches of a forked end of the device,

²In a functional sense, it appears to us that the V-shaped end of tip 18 of Cripps more closely corresponds to appellant's "forked end having divergent branches."

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there remains the requirement of the claims that the forked end and the J-shaped portion "are contained in a common plane." While we acknowledge that a plane perpendicular to the plan view of Figure 2 can be drawn through the plunger 12 of Cripps that contains portions of the hook 17 and tip 18, we do not think this circumstance can be parlayed into a fair reading of appellant's claim language onto the structure of Cripps. In this regard, notwithstanding where any such perpendicular plane is located, only certain portions of hook 17 and tip 18 of Cripps would lie therein, with major parts of hook 17 and tip 18 lying completely beyond any such plane. In the present instance, we think appellant's characterization of Cripps' hook 17 and tip 18 as being contained in parallel planes (see, for example, the Figure 1 view of these elements) as opposed to being within a common plane, is a fairer and more accurate way of describing the relationship of elements 17 and 18 of the reference.

While it is true that the claims in a patent application are to be given their broadest reasonable interpretation consistent with the specification during prosecution of a patent application (see, for example, *In re Zletz*, 893 F.2d

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319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)), it is also well settled that terms in a claim should be construed as those skilled in the art would construe them (see *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and *In re Johnson*, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977)). Here, we think the examiner's reading of the claim terminology calling for a forked end and a J-shaped portion that are contained in a common plane on the end elements 17 and 18 is strained and unreasonable.

For these reasons, we find nothing in the disclosure of Cripps that corresponds to the claimed forked end and J-shaped portion contained in a common plane. Moreover, the examiner does not contend, and it is not apparent to us, that Cripps alone (in the case of claims 12 and 13), or Cripps in combination with Lawrence (in the case of claims 2, 4, 10 and 11) suggests modifying the end portion of Cripps to arrive at this claimed configuration. Accordingly, we will not sustain either of the standing rejections of the appealed claims.

The decision of the examiner is reversed.

REVERSED

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| | Charles E. Frankfort |) | |
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| | Lawrence J. Staab |) | BOARD OF |
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| | Administrative Patent Judge |) | APPEALS AND |
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| | Jennifer D. Bahr |) |) |
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