

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK J. CATALANO

Appeal No. 2003-0067
Application No. 09/713,480

ON BRIEF

Before COHEN, STAAB, and 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 10-15, all the claims currently pending in the application.

Appellant's invention pertains to a fishhook "which assumes and maintains an inverted position in the water so as to minimize the possibility of hangups during retrieval" (specification, page 1). A further understanding of the invention can be derived from a reading of exemplary claims 10, 11 and 15, the three independent claims in the application, which are reproduced on pages 10-11 of appellant's brief.

The references relied upon by the examiner as evidence of obviousness are:

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Smith	77,774	May 12, 1868
Woolfe	2,765,572	Oct. 10, 1952
Dudeck	4,713,907	Dec. 22, 1987
Robertaccio	4,794,720	Jan. 3, 1989

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

- (1) Claim 10, rejected as being unpatentable over Robertaccio in view of Dudeck;
- (2) Claim 11, rejected as being unpatentable over Robertaccio;
- (3) Claims 12-14, rejected as being unpatentable over Robertaccio in view of Woolfe; and
- (4) Claim 15, rejected as being unpatentable over Robertaccio in view of Smith.

Reference is made to appellant's brief (Paper No. 12) and to the examiner's final rejection and answer (Paper Nos. 7 and 13) for the respective positions of appellant and the examiner regarding the merits of these rejections.

Discussion

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1446 (Fed. Cir. 1990). A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) and *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). If the examiner fails to establish a *prima facie* case,

the rejection is improper and will be overturned. *See In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Each of the independent claims on appeal is directed to a fishing hook having a shank with an eye at one end and a bent portion culminating in a point at the other end, in combination with either a buoyant body and a weight mounted on the hook (claim 10), or a buoyant body and centers of gravity of the hook and the buoyant body (claim 11), or a buoyant sleeve and “a plug”¹ (claim 15), situated to cause said hook to orient in water with said point above said eye and with “said shank vertically oriented.”

The starting point for each of the examiner’s rejections is Robertaccio. This reference pertains to an artificial bait for fishing that simulates a fish egg or other natural bait made by inflating a balloon or similar object with a pressurized fluid and then tying or otherwise closing it off (abstract). Robertaccio states that the balloon is inflated to a diameter in the preferred range of about ¼ to 1 inch (col. 4, lines 6-8), and that the pressurized fluid used to inflate the balloon may be a gas such as carbon dioxide, helium, or air (col. 5, lines 3-5). One or more inflated balloons may be tied or otherwise secured to a fishing hook to achieve one of the structures illustrated in 2-5. As explained by Robertaccio (col. 2, lines 24-29), the artificial fish bait adds buoyancy which “enhances the hooking ability of an associated fish hook by controlling hook orientation in the water

¹Applicant’s “plug” is illustrated in Figures 3-5 and denominated by the reference letter “P”. As we understand it, the “plug” may be, for example, an artificial fishing lure.

in any plane wished, i.e., in a vertical plane with barb above shank or a vertical plane with barb below shank, and hook and bait will not spin or twist line.” As further explained at col. 4, lines 35-45:

The buoyancy provided by bait 10 is useful in many instances to provide a desired orientation of hook 20 as, for example, when fishing in waters where current is present, or when line is being brought in by the fisherman as shown in FIG. 4. That is, the combined buoyant effect of egg 10 and the speed and direction of the current or the bringing in of the line will insure that the egg is presented to the fish, which are often facing in the upstream direction for feeding, in advance of the hook and with barb above or below shank as in FIG. 4.

In assessing the teachings of Robertaccio, the examiner has determined (answer, page 3) that the fishhook thereof “is vertically oriented.” The examiner considers (answer, page 3) that Figures 2-4 of Robertaccio “show the buoyant bodies (10) causing the hook to be vertically oriented with the pointed end of the hook above the eye as disclosed in the appellants [sic, appellant’s] claims.” The linchpin of each of the rejections is the examiner’s determination to the effect that Robertaccio’s “vertically oriented” fishhook meets the requirement of each of the independent claims that the hook orients in water with the point above the eye *and* with the shank vertically oriented.

The difficulty we have with the standing rejections under 35 U.S.C. § 103(a) is the apparent failure on the examiner’s part to take into account the claim terminology calling for the various elements of the claimed combination to be related in a manner that causes the *shank to be vertically oriented* in the water. As aptly pointed out by appellant, the fact that the fishhook of Robertaccio as a whole may be oriented in a vertical plane in the water does not necessarily mean that the shank is vertically oriented. This is made clear from a consideration of Robertaccio’s Figures 2-4, where, if

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the plane of the paper is considered to be a vertical plane with the top of the page being the upward direction, the shank of the fishhook is shown as being *inclined at an angle to the vertical* in each of the figures. Thus, the examiner has not accounted for the argued limitation in each of appellant's independent claims that the shank is vertically oriented in applying the Robertaccio reference against the claims. For this reason the examiner has not met his initial burden of establishing a *prima facie* case of obviousness of the subject matter of claim 11, which has been rejected on the basis of Robertaccio alone, such that rejection (2) of claim 11 cannot be sustained.

Furthermore, in rejecting claim 10 additionally in view of Dudeck, claims 12-14 additionally in view of Woolfe, and claim 15 additionally in view of Smith, the examiner likewise appears to be of the view that the limitation of the claims calling for the shank to be vertically oriented in the water is fully met by Robertaccio. For the reasons explained above, we cannot accept this position. Accordingly, the examiner also has not met his initial burden of establishing a *prima facie* case of obviousness of any of claims 10 and 12-15, such that rejections (1), (3) and (4) likewise cannot be sustained.

Remand

This case is remanded to the examiner for consideration of the following matters.

Robertaccio teaches that the hook portion of a fishhook may be provided with up to three balloons simulating artificial bait (see Figure 2) to control the buoyancy and orientation of the hook, that the balloons may be up to 1 inch in diameter (col. 4, lines 6-9), and that the balloons may be inflated with a gas such as helium (col. 5, lines 3-5), which is known to have a very low specific gravity. The examiner should determine whether a fishhook made in accordance with these teachings would inherently be capable of maintaining an orientation in still water with the shank vertically oriented, it being noted that the orientation of the fishhook shown in Figure 4 of Robertaccio where the shank is inclined to the vertical is for a presentation in current and/or when the hook is being pulled through the water by the fisherman (col. 3, lines 58-62, col. 4, lines 35-45).

In addition, in rejecting certain of the appealed claims as being unpatentable over the applied references, the examiner determined that it would have been obvious to include a weighted portion on the eyelet end of Robertaccio's shank in view of Dudeck, and that it would have been obvious to attach the eyelet of a fishhook made in accordance with Robertaccio's teachings to one of the eyelets of "a plug" of the type disclosed by Smith. In each instance, appellant did not specifically dispute the obviousness of the reference combinations proposed by the examiner. Instead, appellant argued, and we agreed, that the examiner's foundation position that Robertaccio's "vertically oriented" fishhook responded to the shank vertically oriented limitation of the claims was not correct. The examiner should determine whether a fishhook made in accordance with Robertaccio's above noted teachings and including either a weighted portion as taught by Dudeck, or attached to

“a plug” of the type disclosed by Smith, would inherently be capable of maintaining an orientation in still water with the shank vertically oriented.

We also observe that the limitation appearing in each of the independent claims that the hook is caused to orient with “said shank vertically oriented” was added by amendment to the claims. While the specification indicates that the fish hook assumes and maintains “an inverted position” in the water (see, for example, page 1 lines 15-18), it does not state that the shank is maintained with “said shank vertically oriented” as now claimed. The examiner should determine whether the combination of appellant’s specification and informal drawings reasonably conveys to the ordinarily skilled artisan that the inventor had possession at the time the application was filed of the presently claimed subject matter. That is, the examiner should determine whether there is descriptive support within the meaning of 35 U.S.C. § 112, first paragraph, for the “said shank vertically oriented” limitation now appearing in each of appellant’s independent claims.²

²With respect to the description requirement found in the first paragraph of 35 U.S.C. § 112,

[t]he test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. The content of the drawings may also be considered in determining compliance with the written description requirement.

In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citations omitted).

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Based on these determinations, the examiner should take whatever action is deemed appropriate.

Summary

The standing rejections of the appealed claims are reversed.

This case is remanded to the examiner for action in the matters discussed above.

REVERSED AND REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Letty

JUDGE STAAB

APPEAL NO. 2003-0067

APPLICATION NO. 09/713,480

APJ STAAB

APJ COHEN

APJ BAHR

DECISION: REVERSED AND REMANDED

PREPARED: Dec 31, 2003

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