

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2003-1981
Application No. 09/715,684

ON BRIEF

Before COHEN, FRANKFORT, 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 1, 3, 4 and 7 to 9, which are all of the claims pending in this application.

We AFFIRM-IN-PART and have denominated our affirmance of claim 1 to be a new ground of rejection under 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to fly fishing and, more particularly, to a fly casting trainer and method of teaching fly casting to enable an instructor to impart a muscle memory of the proper casting form to a trainee (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief.

The independent claims on appeal read as follows:

1. A fly cast training rod, comprising a flexible shaft attached to a pair of spaced handles to allow a trainer and trainee to stand side-by-side with each gripping one of said handles, whereby said trainee can follow said trainer in order to get the feel and rhythm of proper casting technique.

3. A fly cast training device, comprising:
 - a fly rod having a flexible shaft section and a butt section adjoining said flexible shaft section;
 - a spool attached to said fly rod;
 - a handle assembly for gripping said fly rod, said handle assembly including a plurality of handles secured together at their distal ends in a spaced relation.

7. A fly cast training device, comprising:
 - a flexible shaft section;
 - a butt section attached to said flexible shaft section;
 - a spool attached to said butt section;
 - a handle assembly between said butt section and said flexible shaft section, said handle assembly including a plurality of handle sections secured together at both ends in a spaced relation by a pair of brackets.

Claims 1, 3, 4, 7 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,559,735¹ to Batick, Jr. (Batick).

Claims 1 and 7 to 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,016,621² to Maeda.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 15, mailed May 14, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 14, filed March 27, 2003) 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 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.

¹ Issued December 24, 1985.

² Issued January 25, 2000.

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."

The teachings of Batick

Batick's invention relates to the sport of fishing and more particularly to an apparatus mounted on a fishing rod in the vicinity of the fishing reel to facilitate holding and manipulating the rod and reel by a handicapped person. This invention includes a holding apparatus which can be attached to a fishing rod in generally juxtaposed relationship with respect to the fishing reel such that a person can insert a hand through resilient portions of the apparatus to effect a holding action for the rod. The positioning of the hand in the holding apparatus aligns the thumb of the hand with manipulative portions of the reel, such as the brake button on the rear of a spin cast type reel. A

person with a muscular disorder in the arm and hand is able to insert his hand between the resilient portions of the apparatus so as to hold the rod with or without wrapping the hand around the rod, thereby making it possible to control the rod with the one hand while the other hand is used to crank the handle for retrieving the line, the bait and any fish that may have been caught. The holding apparatus makes it possible for the user to cast a bait manipulating the brake button during the cast. In this way it is possible to hold the fishing rod and reel, cast the bait using the rod and reel and retrieve the bait, even with severely handicapped hands and arms.

Figures 1 and 2 depict a fishing rod 11 and reel 12 with the holding apparatus 30 of Batick's invention secured thereto. The fishing rod 11 (only one end of which is shown) includes a handle 10 to which is removably attached the fishing reel 12 with a fishing line 14 extending from a line guide 16 at the front of the reel. The fishing line 14 extends along the length of the rod through eyelets or line guides and has attached at the end of the line appropriate hooks, bobbers and sinkers (not shown). The fishing reel 12 has a body portion 18 with a rotatable handle 20 operatively associated with the parts of the reel for winding the line onto a spool (not shown) carried on the body portion of the reel and shielded by a tapered front cover 22. A rear cover 24 is attached to the body portion 18 and has an exposed rearwardly facing thumb button 26 pivotally affixed thereto and extending rearwardly from the rear cover 24. In normal use, by

depressing the thumb button 26 the line 14 is braked or held against the inside of the front cover and is prevented from exiting the reel so that the reel and rod can be swung in an arc from in front of the fisherman to behind the fisherman and then as the rod is swung forward, the thumb button is released, whereupon the hook and bait on the end of the line will pull the line from the reel until the hook and bait drops gently into the water. At this point, the crank handle 20 can be rotated to retrieve the line and hook and hopefully a fish caught thereon.

Batick teaches (column 2, line 37, to column 3, line 25) that:

A handicapped person, and in particular a person that has nerve or muscle disorder or damage in the arm and hand, is not able to grip the handle 10 on the rod 11 to hold same during casting, during the wait for a fish to nibble or bite, and during retrieve of the line.

The improvement is directed to a holding apparatus 30 which can be removably attached to the handle 10 of a rod in juxtaposed relationship to the reel which facilitates holding the rod 11 and manipulating the reel 12 by a handicapped person. Specifically, the holding apparatus includes a frame 40 which is composed of a pair of spaced apart side walls 42 and 44 and a pair of spaced apart end rods 46 and 48 extending between the side walls. The side walls 42,44 lie parallel to each and parallel to the handle 10 of the rod. The end rods 46,48 are threaded at 47 and 49, respectively, into opposite end portions of side wall 42. The rods 46,48 pass through apertures 50 in the opposite end portions of the side wall 44 so that the wall 44 can be moved along the axes of the rods 46 and 48 toward and away from the wall 42. A pair of identical compression springs 52 are mounted between the walls 42 and 44 with each spring surrounding one of the rods 46 or 48, with the springs 52 urging the wall 44 away from the wall 42. The rods 46 and 48 are rigidly secured to cylindrical expandable connectors or clamps 54 and 56 and projects radially from said cylindrical connectors or clamps. The cylindrical connectors 54,56 are substantially identical and are composed of a circular band of material 55, such

as metal or the like, and have radially directed flanges 57 on each end thereof, with the flanges 57 lying parallel to each other. A screw fastener 59, such as a screw with a wing nut on the head thereof, extends through one of the flanges and is threaded into a threaded aperture in the other of the flanges so that as the screw is tightened, the flanges will be drawn together. To adjust the spacing between the walls 42,44, a pair of adjusting screws 60 and 62 pass freely through apertures 61 in the side wall 42 and have the distal end portions 64,66 threaded into threaded apertures 65 in the side wall 44. An actuating knob 68 is formed on each adjusting screw 60 and 62 and has a knurled peripheral surface facing radially outward therefrom to facilitate turning the adjusting screws to move the wall 44 farther from or closer to the wall 42 as desired.

Attached to the facing surfaces of the side walls 42 and 44 are resilient pads 70,72, respectively, which abut each other along a parting line 74 in the midportion of the space between the walls 42 and 44. The pad 70 is secured to the facing surface 76 of the side wall 42 with pad 72 secured to the facing surface 78 of the side wall 44. The pads 70 and 72 may be formed of any one of a large number of resilient sponge-like material, such as polyurethane foam or the like. The adjusting screws 60 and 62 are manipulated to compression load the pads 70,72 to a degree desired by the fisherman.

The teachings of Maeda

Maeda's invention relates to a fishing rod which makes it possible to sensitively detect a delicate strike using the reel, and which is convenient for storage, transportation and easiness for practical use, and which is particularly suitable for fishing on board a ship. Figures 3-4 depict one exemplary fishing rod comprising a grip handle 2 provided with a reel pedestal fixing device 1 on the upper side thereof. A reel 6' is mounted on the reel pedestal fixing device 1 on the upper side of the grip handle 2. A fishing-line-guiding ring 5' is inclined to the side of the grip handle 2 with respect to the direction at right angles to the lengthwise direction of the fishing rod. Five

fishing-line-guiding rings 5 are fixedly secured to the lower surface of a fishing rod member 3. A space 51 is formed by two parallel rods 50a, 50b which are spaced apart by a predetermined width, and whose one ends are connected with and fixedly secured to one end of the grip handle 2, and whose other ends are connected with and fixedly secured to one end of the fishing rod member 3. A fishing line 4 extends from the reel 6' through the space 51 and the fishing-line-guiding rings 5', 5 secured to the lower surface of the fishing rod member 3. The fishing line 4 is moved through the space 51 formed in the intermediary axially central part of the fishing rod so as to prevent the fishing line 4 from contacting the fishing rod body.

The rejections under appeal

In the rejection under 35 U.S.C. § 102(b) before us in this appeal, the examiner concluded that the claimed handles or handle sections were readable on Batick's side walls 42 and 44. In the rejection under 35 U.S.C. § 102(e) before us in this appeal, the examiner concluded that the claimed handles or handle sections were readable on Maeda's rods 50a and 50b. The appellant argues that the claimed subject matter as set forth in the independent claims under appeal is not readable on either Batick's fishing rod or Maeda's fishing rod. For the reasons which follow, it is our view that independent claims 1 and 7 are readable on Batick's fishing rod but not on Maeda's fishing rod and that independent claim 3 is not readable on Batick's fishing rod.

The American Heritage[®] Dictionary of the English Language, Third Edition 1992 by Houghton Mifflin Company (1992) defines the noun handle as "[a] part that is designed to be held or operated with the hand." In our view, this is the broadest reasonable meaning of the noun handle in its ordinary usage as it would be understood by one of ordinary skill in the art taking into account the written description contained in the appellant's specification. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

With this definition of handle, it is our determination that the claimed handles or handle sections are not readable on Maeda's rods 50a and 50b since Maeda's rods 50a and 50b are not designed to be held or operated with the hand. Maeda's fishing rod has a handle 2 and rods 50a and 50b do not constitute handles or handle sections since a fisherman would not inherently be able to place their fingers in the space 51 between the rods. In that regard, the examiner's assertion (answer, pp. 7-8) to the contrary is not supported by the disclosure of Maeda. It is well settled that the burden of establishing a prima facie case of anticipation resides with the Patent and Trademark Office (PTO). See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When relying upon 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. Patent App. & Int. 1990). This the examiner has not done. Accordingly, the decision of the examiner to reject claims 1 and 7 to 9 under 35 U.S.C. § 102(e) as being anticipated by Maeda is reversed.

With the above-noted definition of handle, it is our determination that the claimed handles are not readable on Batick's side walls 42 and 44 since Batick's side walls 42 and 44 are not designed to be held or operated with the hand. However, Batick's side walls 42 and 44 are part of holding apparatus 30 which is designed to be held or operated with the hand (i.e., one of the claimed handles). Moreover, it is our opinion that the handles as set forth in claim 1 are readable on Batick's handle 10 and holding apparatus 30.

Claim 1 is readable on Batick as follows: A fly cast training rod, comprising a flexible shaft (Batick's fishing rod 11) attached to a pair of spaced handles (Batick's handle 10 and holding apparatus 30) to allow a trainer and trainee to stand side-by-side with each gripping one of said handles, whereby said trainee can follow said trainer in order to get the feel and rhythm of proper casting technique (Batick's handle 10 and

holding apparatus 30 inherently allows a trainer and trainee to stand side-by-side with one gripping the handle 10 and the other gripping the holding apparatus 30, whereby the trainee can follow the trainer in order to get the feel and rhythm of proper casting technique).

Claim 7 is readable on Batick as follows: A fly cast training device, comprising: a flexible shaft section (Batick's fishing rod 11); a butt section (Batick's handle 10) attached to said flexible shaft section; a spool (Batick's fishing reel 12) attached to said butt section; a handle assembly (Batick's holding apparatus 30) between said butt section and said flexible shaft section, said handle assembly including a plurality of handle sections (Batick's side walls 42 and 44 while not handles are sections of the handle assembly) secured together at both ends in a spaced relation by a pair of brackets (Batick's rods 46 and 48 and/or adjusting screw 60 and 62).

The appellant's argument that claims 1 and 7 clearly distinguish over Batick is unpersuasive since claims 1 and 7 are met by Batick as set forth above.

The appellant's argument that claim 3 clearly distinguishes over Batick is persuasive since Batick's handle 10 and holding apparatus 30 are not secured together at their distal ends in a spaced relation. All disclosed embodiments of the appellant's

invention except for the embodiment disclosed in Figures 5-6 clearly depict a handle assembly including a plurality of handles secured together at their distal ends in a spaced relation. The embodiment of Figures 5-6 portrays a training handle connected to the periphery of a handle of a conventional fly rod. The training handle and the handle of the conventional fly rod while spaced apart are not secured together at their distal ends in a spaced relation. Batick's holding apparatus 30 is secured to the periphery of handle 10 by clamps so that the holding apparatus 30 is spaced from the handle 10. Batick's holding apparatus 30 is not secured to the distal end of handle 10 and therefore, Batick's handle 10 and holding apparatus 30 are not secured together at their distal ends in a spaced relation.

For the reasons set forth above, the decision of the examiner to reject claims 1, 3, 4, 7 and 8 under 35 U.S.C. § 102(b) as being anticipated by Batick is affirmed with respect to claims 1, 7 and 8³ and reversed with respect to claims 3 and 4. Inasmuch as the basic thrust of our affirmance of the 35 U.S.C. § 102(b) rejection of claim 1 differs from the rationale advanced by the examiner for the rejection, we hereby designate the affirmance to be a new ground of rejection pursuant to 37 CFR § 1.196(b)

³ The appellant has grouped claims 7 and 8 as standing or falling together (brief, p. 4). Thereby, in accordance with 37 CFR § 1.192(c)(7), claim 8 falls with claim 7.

to allow the appellant a fair opportunity to react thereto (see In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 4, 7 and 8 under 35 U.S.C. § 102(b) as being anticipated by Batick is affirmed with respect to claims 1, 7 and 8 and reversed with respect to claims 3 and 4 and the decision of the examiner to reject claims 1 and 7 to 9 under 35 U.S.C. § 102(e) as being anticipated by Maeda is reversed.

In addition to affirming the examiner's rejection of one or more claims, we have denominated our affirmance of claim 1 a new ground of rejection under 37 CFR § 1.196(b). 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)

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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