

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MARK RUSSELL HENAULT
and
PAUL W.R. HIELDS

Appeal No. 2004-0631
Application No. 10/236,715

ON BRIEF

Before ABRAMS, 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 to 6, 11 to 16 and 20. The examiner's various rejections of claims 7 to 10, 17 to 19 and 21 to 25, the only other claims pending in this application, have been withdrawn (answer, p. 6).

We REVERSE.

BACKGROUND

The appellants' invention relates generally to the field of fishing rod cases. More specifically, the appellants' invention is to a fishing rod case made of a series of modular segments that can be connected together in an end-to-end manner to accommodate a fishing rod of any length (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Sauey et al. (Sauey)	3,811,216	May 21, 1974
Ward	4,170,801	Oct. 16, 1979
Hepworth et al. (Hepworth)	5,341,590	Aug. 30, 1994

Claims 1, 2, 6 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sauey.

Claims 3, 4, 12 to 15 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sauey in view of Hepworth.

Claims 5 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sauey in view of Hepworth and Ward.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 5, mailed March 11, 2003) and the answer (Paper No. 8, mailed October 7, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 7, filed July 18, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We will not sustain the rejection of claims 1, 2, 6 and 11 under 35 U.S.C. § 102(b).

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."

Claim 1 reads as follows:

A fishing rod case comprising:
a plurality of segments, each segment having a connector enabling end-to-end removable engagement between adjacent segments and a tubular passageway in axial alignment with the tubular passageways of the other segments to store a fishing rod;
a plurality of elongated security bars removably attachable in series to one another and to the segments; and
a fastener removably securing the security bars to the segments and preventing disassembly of the segments while the fastener is in place.

Sauey's invention relates to a fishing rod case the length of which may be adjusted. As shown in Figures 3-8, the fishing rod case 28 includes an outer member 30, an inner member 32 and a cap 34. The outer member 30 is an elongated, cylindrical tube having an outer end 36 and an inner end 37. The outer end 36 is closed by a cover 38. Attached to the inner end 37 is a collar 44 having an outer end

69, an inner end 70, an outer portion 46 and an inner portion 48. The outer portion 46 fits over the end of the outer member 30. The inner portion 48 extends beyond the end of the outer member 30. The inner diameter of the inner portion 48 is less than the outer diameter of the outer member 30, thereby defining an annular projection 50 extending inwardly from the collar 44 and having an inner, circumferential surface 52. The outer member 30 also includes a pair of rectangular slots 56 and 58 near the inner end 37. The rectangular slots 56 and 58 receive a pair of projections 64 and 66, respectively, that extend inwardly from the inner surface of the outer portion 46 of the collar 44. The orientation of the rectangular slots 56 and 58 and the projections 64 and 66 provides a screwing action to force the outer member 30 into the collar 44 as the collar 44 is rotated about the outer member 30. The result is a tight-fitting collar 44 which in no way interferes with the telescoping action of the fishing rod case 28.

Sauey's collar 44 also includes a tab 71, a flange 74 and a plastic hinge lever 78. The tab 71 is adjacent to the inner end 70 and extends outwardly. The tab 71 includes an aperture 72 for receipt of a padlock (not shown). The flange 74 projects inwardly from the inner surface of the inner portion 48 of the collar 44. The plastic hinge lever 78 is affixed at one end by a rivet 80 to the outer end 69 of the collar 44. The plastic hinge lever 78 is pliable and therefore may be flexed or pivoted about the rivet 80. The

plastic hinge lever 78 includes an opening (not shown) which allows the plastic hinge lever 78 to fit over the tab 71 when the plastic hinge lever 78 is not flexed or pivoted. Thus, when the tab 71 receives a padlock (not shown), the plastic hinge 78 cannot be retracted. A portion 84 of the plastic hinge lever 78 extends beyond the inner end 37 of the outer member 30. The portion 84 includes a pin 86 which extends from the lower surface of the portion 84 towards the center of the outer member 30. The plastic hinge lever 78 is affixed to the collar 44 such that the pin 86 and the flange 74 align.

Sauey's inner member 32 is an elongated, cylindrical tube. The outer diameter of the inner member 32 is substantially equal to the inner diameter of the outer member 30. This permits the telescoping action of the two members 30 and 32 by placing the outer surface of the inner member 32 and the inner surface of the outer member 30 in a sliding relationship. A portion of the inner member 32 is recessed to form a longitudinal groove 88. The longitudinal groove 88 receives the flange 74 on the collar 44 of the outer member 30. A series of equally spaced holes 89 are formed along the length of the longitudinal groove 88. A series of well-shaped cups 90 are forcibly inserted into the holes 89 in the longitudinal groove 88. A threaded collar 92 is attached to an outer end 94 of the inner member 32. The threaded collar 92 includes an outwardly extending connecting eyelet 96 and an outwardly extending locking eyelet 98.

Sauey's cap 34 is threaded to screw onto the threaded collar 92. The cap 34 includes an outwardly extending connecting eyelet 100 and an outwardly extending locking eyelet 102. A strap or cord 104 ties between the connecting eyelets 96 and 100, fastening the cap 34 to the threaded collar 92. The locking eyelets 98 and 102 are arranged such that they align when the fishing rod case 28 is assembled and closed by the cap. The alignment allows the cap 34 to be locked to the threaded collar 92 by means of a padlock (not shown).

In the assembled fishing rod case of Sauey, the inner member 32 slides within the outer member 30 in a telescoping fashion, and it is this action which gives the fishing rod case 28 variable length. The longitudinal groove 88 in the inner member 32 receives the flange 74 on the collar 40 of the outer member 30 to allow longitudinal sliding, but to prohibit the rotation of the inner member 32 with respect to the outer member 30. With this tracking mechanism, the series of well-shaped cups 90 in the inner member 32 is guided to and passes under the plastic hinge lever 78 and the pin 86, aligned with the flange 74, as the two members 30 and 32 are telescoped. To secure the inner member 32 to the outer member 30, the pin 86 is inserted into any one of the well-shaped cups 90. To adjust the length of the fishing rod case, the outer member 30 is held in one hand as the

plastic hinge lever 78 is retracted, disengaging the pin 86 from one of the well-shaped cups 90. The inner member 32 is then pulled or pushed from or into the outer member 30 until the desired length is reached. The plastic hinge lever 78 is then released and a final adjustment of the inner member 32 is made so that the pin 86 may engage one of the well-shaped cups 90.

The appellants argue (brief, p. 8) that Sauey lacks a plurality of elongated security bars removably attachable in series to one another and to the segments as set forth in claim 1. The examiner's response to this argument (answer, p. 5) is that the claimed security bars are readable on Sauey's flange 74 and hinge lever 78 which are removably connected in series to another by rivet 80.

We find ourselves in agreement with the appellants' position that Sauey lacks a plurality of elongated security bars removably attachable in series to one another and to the segments as set forth in claim 1. In that regard, Sauey's flange 74 and hinge lever 78 are **not** removably attachable in series to another since they are fixed relative to one another by Sauey's rivet 80. Moreover, it is our opinion that one skilled in this art would not have considered Sauey's flange 74 to be an elongated security bar. Finally, we note that the examiner has never identified what structure of Sauey corresponds to the

claimed connectors.¹ It would appear to us that the examiner was relying on either the flange 74 or the hinge lever 78 with its pin 86 as being the connector on the outer member 30 and relying on either the groove 88 or the holes 89 with cups 90 as being the connector on the inner member 32. Thus, the examiner appears to have read either the flange 74 or the hinge lever 78 as being both the claimed connector and the one of the claimed security bars. This double reading of one component on two claimed elements is not appropriate.

For the reasons set forth above, claim 1 is not anticipated by Sauey. Accordingly, the decision of the examiner to reject claim 1, and claims 2, 6 and 11 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

The obviousness rejections

We will not sustain the rejection of claims 3 to 5, 12 to 16 and 20 under 35 U.S.C. § 103.

We have reviewed the references to Hepworth and Ward additionally applied in the rejection of claims 3 to 5, 12 to 16 and 20 but find nothing therein which would have

¹ Claim 1 recites that "each segment having a connector enabling end-to-end removable engagement between adjacent segments."

made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified the fishing rod case of Sauey to arrive at the claimed invention. Specifically, the applied prior art does not suggest a plurality of elongated security bars removably attachable in series to one another and to the segments as set forth in claims 1 and 12, the only independent claims on appeal. Accordingly, the decision of the examiner to reject claims 3 to 5, 12 to 16 and 20 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 6 and 11 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 3 to 5, 12 to 16 and 20 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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