

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEFFERY MOORE

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Appeal No. 1999-2361  
Application 08/410,496

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ON BRIEF

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Before PATE, STAAB and McQUADE, Administrative Patent Judges.  
PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-8, 11, 12, 16 and 17 and the examiner's refusal to allow claims 13-15 as amended after final rejection. Since claims 9 and 10 have been canceled, these are all the claims remaining in the application.

With respect to claims 7 and 15, the examiner has neither

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included a rejection of these claims in the examiner's answer nor has he indicated their allowability. Accordingly, to clarify the record, we will, in our decision, consider the rejection of claims 7 and 15 as advanced by the examiner in the final rejection.

The claimed invention is directed to an artificial fishing lure with a parabolically shaped anterior section, a parabolically shaped posterior section and a circumvolute middle section which includes a 90 degree twist therein. The circumvolute middle section and the posterior section comprise less than half the length of the fishing lure but the balance of the lure's mass, therefore making the center of gravity of the fishing lure rearward of the fishing lure's longitudinal center.

The claimed subject matter can be further considered with reference to the claims on appeal appended to appellant's brief.

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

Turner	2,244,378	Jan. 29, 1940
Panicci	3,418,744	Dec. 31, 1968

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The following reference was cited in a rejection of  
claims 7

and 15 in the final rejection:

Baker, Jr. (Baker)	4,891,901	Jan. 9, 1990
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#### THE REJECTIONS

Claims 1, 2, 8, 16 and 17 stand rejected under 35 U.S.C. § 103 as unpatentable over Turner.

Claims 3-6 and 11-14 stand rejected under 35 U.S.C. § 103 as unpatentable over Turner in view of Panicci.

Claims 7 and 15 were rejected in the final rejection under 35 U.S.C. § 103 as unpatentable over Turner in view of Panicci and Baker.

With respect to the rejection based on Turner alone, the examiner is of the opinion that it would have been obvious to merely reverse the lure body of Turner, thereby rendering the claimed subject matter of claims 1 and 8 prima facie obvious.

With respect to the rejection based on Turner in view of Panicci, it is the examiner's opinion that Panicci shows the claimed 90 degree twisted middle section. Therefore, the examiner is of the view that it would have been obvious to make the twist of Turner of the specified 90 degrees.

#### OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, it is our conclusion that the

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examiner has not

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established a prima facie case of obviousness with respect to the subject matter on appeal. Therefore, the rejections on appeal are reversed. Our reasons follow.

In the instant appeal, the examiner's rationale for the rejection is reminiscent of the situation in In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In that case, a rejection under 35 U.S.C. § 103 was reversed. The rationale for the rejection was that the claimed subject matter was prima facie obvious from the reference subject matter turned upside down. The Federal Circuit reasoned that it would not have been obvious to turn the reference subject matter upside down, in use, absent some motivation or suggestion therefor. In the situation at bar, the examiner provides no such motivation or suggestion. Accordingly, we are constrained to reverse.

We also note the presence in the examiner's arguments of the long discredited obvious to try rationale for a 35 U.S.C. § 103 rejection. The examiner expressly argues that one skilled in the art would be inclined to try the opposite configuration. Obvious to try is not the proper standard to be applied under 35 U.S.C.

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§ 103.

Neither Pancci nor Baker, contains any disclosure that would ameliorate this fundamental shortcoming of the examiner's rejection of the independent claims. Accordingly, the rejections of all claims on appeal are reversed.

The rejections on appeal are reversed.

REVERSED

WILLIAM F. PATE, III	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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