

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILBUR R. PRIMOS

Appeal No. 2001-1740
Application 08/902,466

HEARD: November 29, 2001

Before MCQUADE, NASE, and BAHR, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Wilbur R. Primos appeals from the final rejection (Paper No. 17) of claims 62 through 65, 69 through 72, 76 through 79 and 83 through 85, all of the claims pending in the application.¹

THE INVENTION

¹ Claims 62, 69, 76 and 83 have been amended subsequent to final rejection.

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The invention relates to "game calls, and more particularly, to modular game call systems for imitating natural sounds of game

animals" (specification, page 1). Representative claim 62 reads as follows:

62. A game call apparatus, comprising:
a game call, comprising:
a tube having an upstream end and a downstream end;
a sound source operatively associated with the upstream end of the tube;
a volume chamber coupled to the downstream end of the tube, the volume chamber having an inlet, a single outlet, and an intermediate section between the inlet and the outlet;
the volume chamber comprising a wall of substantially constant thickness, the volume chamber being hollow and devoid of structure other than the wall;
the volume chamber having an inlet inside diameter, an outlet inside diameter, and an intermediate maximum inside diameter, the intermediate maximum inside diameter being larger relative to the outlet inside diameter and the inlet inside diameter, the intermediate maximum inside diameter located closer to the inlet inside diameter than the outlet inside diameter.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Schofield	1,120,980	Dec. 15,
1914		

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Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Schofield discloses a cotton picking tube adapted to be connected to a machine having a collection chamber and a means for generating a vacuum within the tube. As shown in Figure 1, the tube comprises a tapered nozzle tip 17, a nozzle proper 14, a ball and socket joint 11 and 13, and a flexible conduit 10.

The preambles of independent claims 62, 69 and 83 set forth a "game call apparatus." The bodies of these claims recite, inter alia, a "game call."³ In applying Schofield as

³ The record indicates that the appellant's insertion of the "game call" language into the bodies of the claims was prompted by the examiner's refusal to accord patentable weight

an anticipatory reference against these claims, the examiner takes the position that "[t]he entirety of the [Schofield] device can be taken to provide a game call structure, capable of creating sounds sufficient to be heard by game animals" (answer, page 4). The examiner further explains that

[g]iven the wide variety of game call techniques and devices for their practice, the examiner cannot deem the phrase "game call [apparatus]" (which has no specific structure) to inherently require anything beyond a sounding mechanism capable of capturing the attention of a game animal. Examiner believes that merely a sounding device that is capable of being heard by a game animal is all that is required. As stated above, the vacuum device of [Schofield] is sufficient to provide inherent sounds capable of being heard by a game animal [answer, page 5].

The preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention; however, terms appearing in a preamble may be deemed limitations of a claim when they give meaning to the claim and properly define the invention. See In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Although no litmus test exists as to what effect should be accorded to words contained in a preamble, review of a patent

to the recitation in the preambles of a "game call structure."

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application in its entirety should be made to determine whether the inventors intended such language to represent an additional structural limitation or mere introductory language. Id.

A review of the record in the instant application, and particularly the portions of the underlying specification describing the background problems and objectives of the appellant's invention, clearly demonstrates that the appellant intended the "game call apparatus" language in the preambles of independent claims 62, 69 and 83 to represent a structural limitation giving life and meaning to the claims. The somewhat redundant recitation of a "game call" in the bodies of these claims confirms this intent. Simply put, a person of ordinary skill in the art would not view Schofield's cotton picking tube and machine as embodying a game call or a game call apparatus.

The examiner's determination to the contrary, which is based solely on the premise that the Schofield apparatus is capable

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of producing a sound which can be heard by game animals, is manifestly unreasonable. Moreover, the record does not contain any evidence that the Schofield apparatus is inherently capable of functioning as a game call, i.e., capable of imitating the natural sounds of game animals. Thus, Schofield does not disclose each and every element of the invention set forth in claims 62, 69 and 83.

Consequently, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claims 62, 69 and 83, and dependent claims 63 through 65 and 70 through 72, as being by Schofield.

II. The 35 U.S.C. § 103(a) rejection of claims 76 through 79, 84 and 85 as being unpatentable over Schofield in view of Davis

Independent claim 76, from which claims 77 through 79 depend, is similar to independent claims 62, 69 and 83 in that it recites a "game call apparatus" comprising, inter alia, a "game call." Claims 84 and 85 depend from independent claim 83. In short, Schofield's deficiencies relative to the "game call apparatus" and "game call" limitations in the independent claims finds no cure in Davis' disclosure of a gutter cleaning nozzle.

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Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 76 through 79, 84 and 85 as being unpatentable over Schofield in view of Davis.

SUMMARY

The decision of the examiner to reject claims 62 through 65, 69 through 72, 76 through 79 and 83 through 85 is reversed.

REVERSED

JOHN P. MCQUADE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
)	
)	APPEALS AND
JEFFREY V. NASE)	
Administrative Patent Judge)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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