

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS W. CONSTANTIN

Appeal No. 2001-1848
Application 08/932,988

HEARD: JANUARY 23, 2002

Before MCCANDLISH, Senior Administrative Patent Judge, and
ABRAMS and BAHR, Administrative Patent Judges.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL
AND
REMAND TO THE EXAMINER

This is a decision on an appeal from the examiner's final rejection of claims 1, 2, 6, 7, 9 and 10. Claims 3-5 and 8 have been objected to as being dependent on a rejected claim (see the final office action dated February 28, 2000).¹ In his main brief

¹ With regard to the status of the claims, appellant's statement on page 2 of the main brief that claims 1-10 are all rejected is incorrect.

(see page 2), appellant has withdrawn claims 2 and 6-10 from the appeal. The appeal as to claims 2 and 6-10 is therefore dismissed. Accordingly, the only remaining issue is the question of patentability of claim 1.

We reverse and remand this application to the examiner for consideration of the matters discussed at the end of this decision.

Appellant's invention relates to a fly-fishing line (10) having a proximal or first end that is adapted to be connected to a reel or a backing line and distal or second end that is adapted to be connected to a leader (32). According to claim 1, the fly-fishing line has "a strike indicator comprising a plurality of regular,² distinct light and dark alternating bands of similar width [sic, widths?]³ beginning at the second end [of the fly-fishing line] and continuing along a substantial portion of the line, . . ." In appellant's specification, the claimed dark bands are described as "spaced apart bands" and are designated by the reference numeral 38 (see, for example, page 6, lines 29-31). The claimed light bands are not designated by any reference numeral or reference character in

² Consistent with appellant's specification, the term "regular" is interpreted to refer to bands having uniform widths.

³ Consistent with appellant's specification, the recitation of "width" is the dimension of each band measured longitudinally along the length of the fishing line.

the specification. Instead, the claimed light bands are described in the specification as the "spacings" or simply "the spacing" between the spaced apart bands 38 (see for example, page 3, lines 34-35).

A copy of claim 1 is appended to appellant's brief.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the U.S. Patent No. 1,578,189 which issued to C. A. Dawson on March 23, 1926. This rejection cannot be sustained.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). It follows that the absence from the reference of any element of the claim negates anticipation of that claim by the reference. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986), cert denied, 479 U.S. 1034 (1987).

The Dawson patent discloses a fly-fishing line 5 that is attached at its distal end to a leader 1. This patent admittedly discloses alternating light and dark colored band sections 2, 3. However, contrary to the examiner's remarks on page 6 of the answer, these light and dark band sections, as pointed out by appellant on pages 4-5 of the reply brief and

elsewhere, are provided in the leader 1, not in the fly-fishing line 5 itself. The leader of the fishing assembly is a component that is separate and distinct from the fly line itself as evidenced by the description in appellant's specification (see, for example page 6, lines 20-27), by the description in the Dawson patent that the leader 1 is attached at one end to the fly-fishing line 5 (see page 1, lines 43-45 of the Dawson specification), by the description of the various fishing components in pages 1-15 of the Cortland catalog which accompanied appellant's main brief and by the description in the patents cited on page 2 of appellant's reply brief. Moreover, claim 1 defines the fly-fishing line as being separate from the leader by explicitly stating that the fly line is adapted to be attached at its second end to the leader consistent with the description in the specification.

The examiner agrees that "the terms 'fly fishing line' and 'leader' may have particular meaning in the fishing art" (answer, page 6). He nevertheless contends that when "the language of claim 1 has been interpreted as broadly as reasonably possible . . . there is nothing in claim 1 which differentiates it from Dawson" (answer, page 6). This statement is not entirely consistent with the applicable case law governing the interpretation of claim language.

In the first place the examiner's statement of the law as quoted supra overlooks the qualifier that the interpretation of the claim language must be consistent with the specification. See In re Morris, 127 F.3d 1048, 1052, 44 USPQ2d 1023, 1027 (Fed Cir 1997). Thus, the general rule is that the claims in an application are to be given their broadest reasonable interpretation consistent with the specification. In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Furthermore, technical terms, such as the terms "leader" and "fly-fishing line," are to be interpreted as having the meanings that they would be given by persons experienced in the field of the claimed invention, unless it appears that the inventor applied a different meaning to those terms. See Hoeschst Celanese Corp. v. BP Chem., Ltd., 78 F.3d 1575, 1578, 38 USPQ2d 1126, 1129 (Fed. Cir. 1996). See also In re Barr, 444 F.2d 588, 597, 170 USPQ 330, 339 (CCPA 1971) (Absent a special definition in the specification, it must be assumed that a technical term is used in its commonly accepted technical sense.) and In re Morris, 127 F.3d at 1052, 44 USPQ2d at 1027 (Terms in a claim are to be given the broadest reasonable meaning as they would be understood by one of ordinary skill in the art.).

Applying the foregoing principles to the present case, the items of evidence (namely appellant's specification, the cited Dawson patent, the other patents cited on page 2 of appellant's reply brief and the Cortland catalog) establish that a fly-fishing line and a leader are separate and distinct components of a fishing rod assembly. Thus, the recitation of a fly-fishing line in appealed claim 1 is not broad enough to read on Dawson's leader. Dawson's light and dark bands are located in the leader rather than the fly line itself. In contrast, appealed claim 1 expressly provides that the light and dark indicator bands are located in the fly-fishing line that is adapted to be attached to the leader. Since this limitation is not met by Dawson, Dawson does not anticipate the subject matter of claim 1.

The examiner's decision to reject claim 1 under 35 U.S.C. § 102(b) is therefore reversed.

This application is remanded to the examiner to consider whether claim 1 (as amended subsequent to the filing of this application) and dependent claims 3-5 are based on a specification which, as filed, satisfies the description requirement in the first paragraph of 35 U.S.C. § 112. As noted supra, appellant's specification describes the strike indicator as being defined by dark spaced apart bands 38. In

the specification as filed, the light region between "adjacent" or successive bands 38 is simply described as a "spacing" (see, for example, page 7, lines 17-18, of the specification). In amended claim 1, however, the region between the dark bands is also described as a "band" in the phrase "light and dark, alternating bands . . ." According to amended claim 1, therefore, the smallest angle subtended by a pair of visually discernable objects appears to be the angle subtended by two adjoining regions, namely two adjoining bands, one dark and one light. In comparison, the specification as filed describes the smallest subtended angle in question as being the angle subtended by three regions, namely two spaced apart dark bands (38) and the spacing therebetween or two "spacings" and the dark band (38) therebetween.

Additional questions are also raised about descriptive support for dependent claims 3-5 in view of the manner in which the bands are defined in parent claim 1. In claim 5, for example, both the light and dark bands of claim 1 are required to be in the form of "segments of shrink tubing which are applied over the coating [on the core] and heated to shrink fit." However, the specification as filed (see page 7) does not state that the spacing between the dark bands 38 is formed

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by a segment of shrink tubing. Instead, the specification as filed only states that the dark bands 38 may be formed by segments of shrink tubing.

REVERSED/REMANDED

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