

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte GARY L. SITTON

Appeal No. 2002-0606
Application No. 08/989,574

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 to 6, 15 to 18, 20 and 22. Claims 19, 21 and 23 have been objected to as depending from a non-allowed claim. Claims 7 to 10 and 14 have been withdrawn from consideration. Claims 11 to 13 have been canceled.

We REVERSE.

BACKGROUND

The appellant's invention relates to a fishing hook having improved penetration capability which is comprised of two or more materials (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Nobusato

JP 6-269236¹

Sept. 27, 1994

Claims 1 to 5, 15 to 17, 20 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nobusato.

Claims 6 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nobusato.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 17, mailed February 7, 2001) and the answer (Paper No. 20,

¹ In determining the teachings of Nobusato, we will rely on the translation of record provided by the Japanese Patent Office.

mailed September 11, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 19, filed July 9, 2001) 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.

The anticipation rejection

We will not sustain the rejection of claims 1 to 5, 15 to 17, 20 and 22 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

All the claims under appeal are drawn to a fish hook comprising, inter alia, (1) integral eye, shank, bight, and barb formed of plastic and (2) a member, comprised of a material having a hardness greater than that of the plastic, running longitudinally through a portion of the plastic wherein one end of the member extends through the plastic comprising the barb to form the point of the barb.

The appellant argues (brief, pp. 4-5) that claims 1 to 5, 15 to 17, 20 and 22 are not anticipated by Nobusato since Nobusato lacks a member which extends through the plastic comprising the barb (i.e., the member must extend through a plastic barb). We agree. While Nobusato does disclose a fishhook made of a metal member 1 covered with plastic 2 (see Figures 1-4), Nobusato does not teach a member extending through the plastic comprising the barb to form the point of the barb. In that regard, as shown in Figures 1 and 4 of Nobusato, the metal member 1 does not extend through the plastic comprising the barb. Likewise, while the metal member 1 does extend through the plastic to form the barb as shown in Figures 2 and 3 of Nobusato, the metal member 1 does not extend through the plastic comprising the barb.

Since all the limitations of claims 1 to 5, 15 to 17, 20 and 22 are not found, either expressly described or under principles of inherency, in Nobusato for the reasons set

forth above, the decision of the examiner to reject claims 1 to 5, 15 to 17, 20 and 22 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

We will not sustain the rejection of dependent claims 6 and 18 under 35 U.S.C. § 103 for the reason set forth above with respect to their parent claims. In that regard, the examiner has not set forth any rationale as to why the above-noted limitation not taught by Nobusato would have been obvious at the time the invention was made to a person of ordinary skill in the art. Accordingly, the decision of the examiner to reject claims 6 and 18 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 5, 15 to 17, 20 and 22 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 6 and 18 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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