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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK BARBARY

Appeal No. 2005-0845
Application 10/249,204

ON BRIEF

Before PATE, McQUADE, and BAHR, **Administrative Patent Judges**.

PATE, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the rejections of claims 2, 4, 5, 7, 10 through 12, 21 through 23 and 25 through 29. The rejection of claims 21 through 23 and 25 has been carried over from a final rejection, and claims 2, 4, 5, 7, 10 through 12 and 26 through 29

are newly rejected in the examiner's answer. All other rejections have been dropped by the examiner in the examiner's answer.

The claimed invention is directed to a fishing lure which when towed or retrieved through the water oscillates or swings at the end of the fishing line and is made to dive into and raise out of the water. The lure also has apertures at the rear end in which air trapped in the lure bubbles out of the lure attracting fish.

The claimed subject matter may be further understood with reference to the appealed claims appended to appellant's brief.

The reference of record relied upon by the examiner as evidence of anticipation is:

Davis	4,881,340	Nov. 21, 1989

The Rejections

Claims 2, 4, 5, 7, 10 through 12, 21 through 23, 25 and 27 through 29 stand rejected under 35 U.S.C. § 102 as anticipated by Davis.

Claim 26 stands rejected under 35 U.S.C. § 112, second paragraph as indefinite.

For the full details of these rejections reference is made to the examiner's answer. For the full details of appellant's

arguments and response thereto reference is made to the brief and the reply brief.

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 we have determined that claims 2, 4, 5, 7, 10 through 12, 21 through 23, 25, and 27 through 29 are not anticipated by Davis. Furthermore, we affirm the section 112 rejection of claim 26. Our reasons follow.

At the outset we merely note that the appellant has wrongly identified the quantum of proof needed to sustain an examiner's rejection. See Brief, page 7. While the Agency's burden before the Federal Circuit is substantial evidence, *In re Lee,* 277 F.3d 1338, 1342-43, 61 USPQ2d 1430, 1432 (Fed. Cir. 2002), an examiner's burden of proving unpatentability when rejecting claims in a patent application within the agency is by a preponderance of the evidence. *In re Caveney,* 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985). In order to satisfy this standard, the evidence must demonstrate that a fact is more likely than not. *See Bosies v. Benedict*, 27 F.3d 539, 541-42,

30 USPQ2d 1862, 1864 (Fed. Cir. 1994) (the preponderance of the evidence standard requires the finder of fact to believe that the existence of a fact is more probable than its nonexistence).

We note that the appellant has acceded to the examiner's rejection of claim 26 under 35 U.S.C. § 112, second paragraph. This rejection is affirmed.

The following comprise our findings of fact as to the scope and content of the prior art. Davis discloses a fishing lure that may be used in alternative configurations. Davis discloses a first means 12 with interior channels or tubes 20. The first means includes a second means forming a front opening to the interior channels or tubes 20. Inasmuch as these tubes are disclosed as extending the full length of the body, we infer that these tubes also have openings (not shown) in the rear thereof. These tubes 20 comprise a fourth means for providing the interior channel in the first means. The openings at the rear of the tubes (not shown) comprise a third means to allow water to be forced through the openings when the lure is pulled through the water. The first means also includes a fifth means C for pulling the first means through the water. See Figure 6. Note that Davis describes the release of air bubbles from the tubes 18 as the lure is drawn through the water. Col. 2, lines 31-34. Thus, it is our finding that Davis has similar structure to that called

for in claim 29. However, there is no disclosure in Davis that Davis rises into the ambient air in response to the pull on line 104 in combination with the drag force of the water on the body. The examiner merely states that it does so with reference to Figures 1-8 and columns 3 and 4. We find no specific mention of this characteristic or capability of Davis in the disclosure pointed out by the examiner. Indeed, in the Figures pointed to, when they do show water, they show the lure of Davis entirely submerged. If the examiner's finding is based on inherency, the examiner has failed to provide a reasonable explanation as to why oscillating and submerging and rising is *necessarily present* in Davis. Accordingly, it is our determination that the examiner has not shown this function of the claimed subject matter is present in Davis by a preponderance of the evidence. Both independent claims 27 and 29 are directed to this feature. Consequently, we reverse the rejections of these claims and the claims dependent thereon.

Turning to claim 21, we are in agreement with appellant that Davis cannot be said to have a longitudinal axis through said front opening, said interior channel, and said rear opening of said elongate body, with said rear opening also having a pattern of apertures. While we understand the examiner's argument on page 10 of the answer, we note that the inferred rear opening of

a single interior channel 20 does not have plural apertures as required by claim 21. The rejection of claim 21 and the dependent claims depending therefrom is reversed.

In Summary, the rejection of Claims 2, 4, 5, 7, 10 through 12, 21 through 23, 25 and 27 through 29 under 35 U.S.C. § 102 is reversed. The rejection of claim 26 under 35 U.S.C. § 112, second paragraph is affirmed.

AFFIRMED-IN-PART

WILLIAM F. PATE III Administrative Patent Judge	)	
JOHN P. McQUADE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

WFP/pgc

Joel I. Rosenblatt
445 11th Avenue
Indialantic, FL 32903