

1 The opinion in support of the decision being entered today was *not* written  
2 for publication and is *not* binding precedent of the Board.  
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5 UNITED STATES PATENT AND TRADEMARK OFFICE  
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8 BEFORE THE BOARD OF PATENT APPEALS  
9 AND INTERFERENCES  
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12 *Ex parte* M. SCOTT SMITH and RICHARD K. COLEMAN  
13

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15 Appeal 2006-1401  
16 Application 10/244,566  
17 Technology Center 3600  
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20 Decided: March 7, 2007  
21  
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24 Before TERRY J. OWENS, JENNIFER D. BAHR, and  
25 ROBERT E. NAPPI, *Administrative Patent Judges*.

26  
27 BAHR, *Administrative Patent Judge*.

28  
29 DECISION ON APPEAL

30 STATEMENT OF THE CASE

31 M. Scott Smith and Richard K. Coleman (Appellants) appeal under 35  
32 U.S.C. § 134 from the Examiner's decision rejecting claims 1-4 and 9-14,  
33 the only claims pending in the application. We have jurisdiction over this  
34 appeal under 35 U.S.C. § 6.

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*The Invention*

Appellants' invention is a system and method for assisting in the selection of optimal fishing equipment of a selected type of fish. Independent claims 1 and 11 are representative of the claimed invention and read as follows:

1. An equipment selecting system for assisting in selecting optimal fishing equipment for catching a desired type of fish comprising:

a correlating device displaying a first reference and a second reference, wherein said first reference is adapted to indicate a type of fish selected from a plurality of types of fish;

a plurality of prepackaged fishing kits, each optimized for fishing for one of said plurality of types of fish;

a label affixed to each of said prepackaged fishing kits;

wherein said second reference is adapted to match up with said label on one of said plurality of prepackaged fishing kits that are optimized for fishing for said type of fish selected from said plurality of types of fish; and

wherein said prepackaged fishing kits comprise a rod, reel and tackle.

11. A method of selecting fishing equipment for catching a desired type of fish comprising the steps of:

manipulating a correlating device to display a first reference adapted to indicate a selected type

1 of fish and a second reference adapted to match up  
2 with a label on a prepackaged fishing kit optimized  
3 for fishing for the selected type of fish;

4  
5 matching said second reference with said  
6 label on said prepackaged fishing kit optimized for  
7 fishing for the selected type of fish;

8  
9 selecting the fishing kit indicated by said  
10 second reference, said prepackaged fishing kit  
11 comprising:

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13 a rod having characteristics that are optimal  
14 for fishing for said selected type of fish;

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16 a reel having characteristics that are optimal  
17 for fishing for said selected type of fish; and

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19 fishing tackle having characteristics that are  
20 optimal for fishing for said selected type of fish.

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22 ***The Evidence***

23 The Examiner relies upon the following as evidence of  
24 unpatentability:

25 *Gear by Species*, eAngler online catalog, 1999-2003 [retrieved Oct, 29,  
26 2003],

27 [http://www.eangler.com/pro...ductdetail.asp?prod\\_id=4277&dept\\_id=526](http://www.eangler.com/pro...ductdetail.asp?prod_id=4277&dept_id=526)  
28 (eAngler I).

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30 eAngler online catalog, Jul. 21, 2001 [retrieved Oct. 13, 2005],

31 [http://web.archive.org/web/20010708080951/eangler.com/eangler/proshop/d](http://web.archive.org/web/20010708080951/eangler.com/eangler/proshop/default.asp)  
32 [efault.asp](http://web.archive.org/web/20010708080951/eangler.com/eangler/proshop/default.asp) (eAngler II).

***The Rejection***

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2 Appellants seek review of the Examiner's rejection of claims 1-4 and  
3 9-14 under 35 U.S.C. § 102(b) as being as anticipated by eAngler I.  
4 The Examiner provides reasoning in support of the rejection in the Answer  
5 (mailed October 19, 2005). Appellants present opposing arguments in the  
6 Brief (filed August 8, 2005) and Reply Brief (filed December 21, 2005).

7  
8 **OPINION**

9 In response to Appellants' contention that, in light of the copyright  
10 notice "Copyright ©1999-2003 eAngler.Inc.," the Examiner had not  
11 provided evidence that the passages of eAngler I relied upon in the rejection  
12 predate Appellants' filing date of September 16, 2002 (Br. 19), the Examiner  
13 retrieved eAngler II, which is a snapshot of the eAngler site on July 21,  
14 2001, from the wayback machine website. The eAngler II reference shows  
15 that the "Gear by Species" department of the website was available on July  
16 21, 2001, more than one year before Appellants' filing date (Answer 6).

17 Appellants contend that the eAngler II evidence presented by the  
18 Examiner provides no indication of what content was within the "Gear by  
19 Species" department on July 21, 2001, or any other date more than one year  
20 prior to Appellants' filing date (Reply Br. 5). Accordingly, the issue of  
21 whether the content of eAngler I relied on by the Examiner in fact predates  
22 Appellants' filing date is still in dispute. Prior to addressing this issue,  
23 however, we address first the issue of whether the content of eAngler I relied  
24 on by the Examiner fully responds to all of the limitations of claims 1 and 11  
25 so as to anticipate these claims, even assuming the content does predate  
26 Appellants' filing date.

1           In reading claims 1 and 11 on eAngler I, the Examiner contends that  
2 any one of the fish indicating references (links) on the top portion of page 1  
3 corresponds to the first reference, a second one of the fish indicating  
4 references (links) on the top portion of page 1 corresponds to the second  
5 reference, each list of merchandise items under a fish indicating heading  
6 (e.g., “Gear For Billfish”) is a prepackaged fishing kit, and each heading  
7 having a list of merchandise items under it is a label, as set forth in claims 1  
8 and 11 (Answer 3-4).

9           Appellants contend that the listed individual merchandise items are  
10 not a fishing kit, as required in claims 1 and 11. According to Appellants,  
11 no fisherman can be expected to purchase a kit with such a fantastic amount  
12 of gear; instead, the eAngler site simply lists a library of appropriate gear  
13 (Reply Br. 6). Additionally, Appellants argue that the eAngler site cannot  
14 respond to all of the “first reference,” “second reference,” and “label”  
15 limitations of claims 1 and 11 (Reply Br. 8).

16           We agree with Appellants that the lists of appropriate gear for each  
17 type of fish are not “prepackaged fishing kits” as called for in claims 1 and  
18 11. There is no indication in eAngler I that any of the items listed are  
19 packaged together as a kit. Rather, their separate listings would indicate that  
20 they are packaged separately and sold as separate items. The Examiner’s  
21 reference to a French patent to Dubert (FR 2,666,005, published February  
22 28, 1992) cannot make up for this deficiency in eAngler I. First, the Dubert  
23 patent has been given no consideration in deciding this appeal since it was  
24 not positively included in the statement of the rejection. *See In re Hoch*, 428  
25 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). In any event,  
26 even if the Dubert patent does establish that it was well known in the art of

1 fishing devices at the time of Appellants' invention that "rods, reels and  
2 tackle *can* be prepackaged," as urged by the Examiner (Answer 7; emphasis  
3 added), such knowledge, by itself, does not magically turn the lists of  
4 separately sold gear items offered on the eAngler site into "prepackaged  
5 fishing kits."

6       Moreover, even assuming the lists of separately offered merchandise  
7 items were considered to be "prepackaged fishing kits," Appellants' claims 1  
8 and 11 require more of the "first reference," "second reference," and "label"  
9 than simply three indicia. Rather, the "first reference" must be adapted to  
10 indicate a selected type of fish and the "second reference" must be adapted  
11 to match up with a label on a prepackaged fishing kit optimized for fishing  
12 *the selected type of fish*. The Examiner's reading of the "first reference" on  
13 one of the fish indicating references (links) on the top portion of the "Gear  
14 by Species" page and the "label" on the corresponding heading on the  
15 bottom portion of the page might seem reasonable. A second one of the fish  
16 indicating references (links) at the top of the page would not meet the claim  
17 limitation of the "second reference," however, because it would not be  
18 adapted to match up with the heading corresponding to the first (selected)  
19 fish indicating reference (i.e., the "label"). Rather, the second fish indicating  
20 reference is adapted to match up with a label of a fishing kit (list of gear)  
21 optimized for fishing for a fish different from the selected fish.

22       For the above reasons, we conclude that the content of eAngler I  
23 relied on by the Examiner does not meet all of the limitations of claims 1  
24 and 11 so as to anticipate these claims, even assuming the content does  
25 predate Appellants' filing date. Therefore, we need not reach the issue of  
26 whether the content predates Appellants' filing date. We cannot sustain the

1 rejection of claims 1 and 11, or claims 2-4, 9, 10, and 12-14 depending from  
2 claims 1 and 11.

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SUMMARY

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The decision of the Examiner to reject claims 1-4 and 9-14 is  
reversed.

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REVERSED

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FELLERS SNIDER BLANKENSHIP

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