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 JAMES RONALD DAVIS

Appeal 2007-2318
Application 10/947,324
Technology Center 3600

Decided: July 11, 2007

Before DONALD E. ADAMS, ERIC GRIMES, and LORA M. GREEN, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a fishing lure, which the Examiner has rejected as anticipated and obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

BACKGROUND

The Specification discloses a snag-resistant fishing lure comprising a blade member attached to "a generally conventional jig, comprising a

weighted body with a fishing hook extending rearward, and an eyelet extending forward" (Specification 5). The eyelet is

> attached to the blade member through [a] hole with the hook facing upward. The size of the hole and the proximity of the jig's weighted head to the flat edge keep the hook facing upward, even upon contact with an underwater obstacle. Additionally, the blade is limited in its side-to-side movement by contact between the blade edge and either the jig body or the eyelet. The limited side-to-side movement of the blade creates a quick, controlled, oscillating blade action that imparts a natural swimming motion to the lure, emulating prey species movements.

(*Id.*)

DISCUSSION

1. CLAIMS

Claims 18 and 19, the only claims pending, read as follows:

18. A snag-resistant fishing lure comprising:

a jig, said jig including

a body, said body having a bulbous shape with an exterior surface and a central axis, said exterior surface having a forward exterior surface area, a rearward exterior surface area, an upper exterior surface area, and a lower exterior surface area,

a hook, said hook having a shank and a hook end, said shank protruding from said rearward exterior surface area of said body of said jig, said hook end being oriented above said upper exterior surface area of said body of said jig,

an eyelet, said eyelet protruding from said forward exterior surface area of said body of said jig, said eyelet and said hook end being aligned about said central axis of said body of said jig; and

a blade, said blade being a rigid member including a first edge and a central axis, said blade being aligned with said hood end, a major portion of said blade being oriented above said upper exterior surface area of

said body of said jig during retrieval of the lure and said first edge being adapted to strike said jig during retrieval of the lure,

said blade having a mounting hole, said mounting hole being proximate said first edge and aligned about said central axis of said blade, said blade being attached to said jig via said mounting hole of said blade, said blade having therethrough a pair of line attachment holes, said pair of line attachment holes being aligned about said central axis of said blade and spaced away from said mounting hole of said blade and said pair of line attachment holes being space closely to one another.

19. A fishing lure comprising;

a jig having an upper surface;

a blade having an edge proximal said jig, said edge being adapted to strike said jig during retrieval and a major portion of said blade being above said upper surface of said jig during retrieval;

a mechanism for joining said jig and said blade together, whereby said blade oscillating about said joining mechanism, the striking of said edge upon said jig limiting the oscillation in one direction.

Thus, claim 18 defines a fishing lure having a conventional jig and a blade. The blade has a mounting hole close to one edge that attaches the blade to the jig, and a pair of holes to which the fishing line is attached. Claim 18 also requires that "a major portion of the blade [is] oriented above [the upper surface of the jig] during retrieval." We interpret this limitation to require that a *substantial* portion, but not necessarily a majority, of the blade be oriented above the jig body during retrieval.

Finally, claim 18 requires that the edge of the blade proximate the hole attaching the blade to the jig be "adapted to strike the jig during retrieval of the lure." This limitation is a major point of contention; it therefore merits careful interpretation. First, we interpret the claim to require only that the edge of the blade strike (i.e., contact) any part of the jig:

the hook, body, or eyelet. The Specification makes clear that the motion of the blade is "limited by contact between the blade edge and either the jig body *or the eyelet*" (Specification 5).

The Examiner interprets the "adapted to strike" claim language to require only that the blade be "capable of performing the function of the first edge striking the jig during retrieval" (Answer 14). We agree with this interpretation. During patent examination, claims are given their broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

Here, the Specification does not expressly define the phrase "adapted to strike." The Specification does state that the blade "is free to swing from side to side, but is limited in the range of side-to-side movement" by the eyelet or jig body (Specification 13). Those limitations, however, are not part of claim 18 and we may not read limitations into the claims based on the Specification's disclosure. *Sjolund v. Musland*, 847 F.2d 1573, 1582, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988) ("[T]he claims define the invention. . . . [L]imitations from the specification are not to be read into the claims.").

We agree with the Examiner that the broadest reasonable interpretation of claim 18's "adapted to strike" language is that it only requires the blade to be capable of striking the jig (hook, body, or eyelet) during retrieval. *Cf. In re Venezia*, 530 F.2d 956, 959, 189 USPQ 149, 151-52 (CCPA 1976) ("claim 31 calls for 'a pair of sleeves . . . adapted to be fitted over the insulating jacket of one of said cables.' . . . [T]his language imparts a structural limitation to the sleeve. Each sleeve is so structured or

dimensioned that it *can be fitted* over the insulating jacket of a cable.") (emphasis added).

Thus, we interpret the claim 18's limitation that the edge of the blade is "adapted to strike [the] jig during retrieval of the lure" to require only that the edge of the blade be *capable of striking* any part of the jig, including the eyelet, when the lure is being retrieved through the water.

Claim 19 is also directed to a fishing lure comprising a jig, a blade, and a "mechanism for joining" the two. We interpret the "jig" recited in claim 19 to be a conventional jig comprising a hook, body, and eyelet. Cf. Specification 5: 1-2. Claim 19 contains the same "adapted to strike" and "a major portion" limitations discussed above.

Finally, claim 19 contains a "whereby" clause: "whereby said blade oscillating about said joining mechanism, the striking of said edge upon said jig limiting the oscillation in one direction." We interpret this clause to mean that the jig and the blade are attached via a mechanism that causes the blade to strike part of the jig as it moves; i.e., the mechanism does not allow the blade to spin freely around the jig.

2. PRIOR ART

The Examiner relies on the following references:

Buddle	US 1,418,229	May 30, 1922
Yarvise	US 1,994,678	Mar. 19, 1935
Edwards	US 1,997,900	Apr. 16, 1935
Thomas	US 2,291,422	Jul. 28, 1942
Norman	US 3,541,718	Nov. 24, 1970
Werner	US 3,753,310	Aug. 21, 1973
Olson	US 4,453,333	Jun. 12, 1984
Perrick	US 5,857,283	Jan. 12, 1999

3. ANTICIPATION BY PERRICK

Claim 18 stands rejected under 35 U.S.C. § 102(b) as anticipated by Perrick. The Examiner finds that Perrick discloses a fishing lure meeting all the structural limitations of claim 18 (Answer 4-5). Regarding the functional "adapted to strike" limitation, the Examiner concludes that the rear edge of the blade of Perrick's lure "is clearly capable of striking the jig . . . during retrieval of the line" since the connection between them is a split ring, which does not restrict contact between the edge and the jig, and no other structure would prevent the two from contacting each other (*id.* at 13-14).

We agree with the Examiner's reasoning and conclusion. We also note that Perrick indicates that the jig and the blade move back-and-forth and up-and-down relative to each other during retrieval (Perrick, Fig.4, arrows E through J). Such movements support our conclusion that the edge of the blade in Perrick's lure would be capable of contacting at least the eyelet of the jig.

Appellant argues that "Perrick's blade 31 *does not* strike lure hook body 43" (Br. 16) and that "a plain reading of Perrick '283 . . . clearly shows that Perrick's blade is not intended to strike the body during retrieval" (*id.* at 17).

Appellant may well be correct that the blade of Perrick's lure is not intended to strike the jig body, and does not strike the jig body during normal use. However, claim 18 does not require the claimed lure to have a blade that strikes the jig *body*; it only requires that the blade strike the jig, and the jig is made up of a hook and an eyelet in addition to a body. Thus,

since the blade of Perrick's lure is capable of striking at least the eyelet of the jig, it is capable of striking the jig as defined in claim 18.

4. OBVIOUSNESS IN VIEW OF PERRICK AND OLSON

Claim 18 stands rejected under 35 U.S.C. § 103 as obvious in view of Perrick and Olson. We have already found that Perrick anticipates claim 18. We therefore affirm the instant rejection: "anticipation is the epitome of obviousness." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Appellant argues that Perrick does not teach or suggest the "adapted to strike" limitation (Br. 18, Reply Br. 4). This argument has been addressed above.

5. OBVIOUSNESS BASED ON YARVISE

Claim 18 stands rejected under 35 U.S.C. § 103 as obvious in view of Yarvise combined with either of Werner or Norman. The Examiner relies on Yarvise as disclosing a fishing lure meeting all of the limitations of claim 18 except for the "pair of line attachment holes": Yarvise's lure has a single hole with which to attach the fishing line (Answer 7-8). The Examiner cites Werner and Norman for their disclosure of fishing lures having paired line attachment holes and concludes that "[i]t would have been obvious to a person of ordinary skill in the art to modify the blade of Yarvise such that there are a pair of line attachment holes . . . in view of Werner and Norman" (*id.* at 9).

Appellant argues that Yarvise's lure does not meet the "adapted to strike" limitation of claim 18 (Br. 18; Reply Br. 5). We disagree. As the Examiner pointed out, the blade of Yarvise's lure (as shown in the figures)

appears to be capable of contacting the jig body, and no more is required by the claim language.

Appellant also argues that the Examiner has applied an unreasonable definition to the claim limitation stating that "a major portion of said blade [is] above the upper surface of said jig during retrieval" (Reply Br. 10-11). The Examiner maintains that this limitation is met because the entire blade will be above the lure during the part of the retrieval "when the lure is out of the water and suspended in the air by the fishing line" (Answer 8).

Appellant provided a Rule 132 declaration by Michael T. Shelton, who described himself as a professional fisherman and declared that "the skilled fisherman understands 'retrieval' as being the act of drawing a lure under the surface of the water or through the water," and would not "consider the act of lifting the lure out of the water as part of the 'retrieval' of the lure" (Shelton Declaration, ¶¶ 8 and 9). The Examiner provided no evidence to show that those skilled in the art recognize a broader definition of "retrieval" (see Answer 21).

"Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach." *In re Cortright*, 165 F.3d 1353, 1358, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999). Here, the evidence of record shows that those skilled in the art did not consider the act of lifting a lure out of the water to be part of the "retrieval" of the lure, and the Examiner has not provided any alternative explanation of how Yarvise describes a lure in which a major portion of the blade is above the upper surface of the jig

during retrieval. We therefore reverse the rejection of claim 18 as obvious in view of Yarvise and either Werner or Norman.

6. OBVIOUSNESS BASED ON THOMAS

Claim 18 stands rejected under 35 U.S.C. § 103 as obvious in view of Thomas, Olson, and either of Werner or Norman.[1] The Examiner relies on Thomas as disclosing a fishing lure meeting all of the limitations of claim 18 except for the bulbous-shaped body and the "pair of line attachment holes" (Answer 10-11). The Examiner relies on Olson for its disclosure of a jig with a body having a bulbous shape, and relies on Werner and Norman for their disclosure of fishing lures having paired line attachment holes (*id.* at 11, 12). The Examiner concludes that it would have been obvious to modify Thomas' lure by using a jig body having a bulbous shape, as disclosed by Olson, in order to "more closely resemble a fish prey species such as a minnow or a tadpole" (*id.* at 11) and to use the paired line attachment holes disclosed by Werner and Norman (*id.* at 12).

Appellant argues that Thomas' lure does not meet the "adapted to strike" limitation of claim 18 (Br. 19; Reply Br. 6-7). We disagree. As the Examiner pointed out, the blade of Thomas' lure (as shown in the figures) appears to be capable of moving freely on the split ring connecting it to the jig body, and therefore appears to be capable of striking (contacting) the jig body. As we interpret the claim language, that is all that claim 18 requires.

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[1] The Examiner also rejected claim 18 as obvious in view of Thomas combined with Werner or Norman, but conceded (Answer 11) that Thomas must be modified to produce a lure with a bulbous-shaped body. We therefore reverse the rejection of claim 18 based on Thomas and either Werner or Norman.

We also agree with the Examiner's conclusion that those skilled in the art would have found it obvious to modify Thomas' lure to use a bulbous-shaped jig body, since bulbous jig bodies were conventional in the art. (Olson, Figure 1; Specification 5: 1-2 ("The jig itself is a generally conventional jig, comprising a weighted body . . .") and Figure 1 (showing a bulbous-shaped weighted body)). And, as discussed above, the evidence shows that single and paired line attachment holes were both well-known in the art.

7. ANTICIPATION – CLAIM 19

Claim 19 stands rejected under 35 U.S.C. § 102(b) as anticipated by any of Buddle, Thomas, or Edwards. The Examiner finds that all of the references disclose fishing lures comprising a jig joined to a blade, and that the lures are configured such that the blade is capable of striking part of the jig (Answer 5-6). The Examiner also points to figures in each patent that show, in his view, that a major portion of the blade is above the upper surface of the jig during retrieval (*id.*).

With respect to the rejections based on Buddle and Thomas, Appellant argues that neither reference shows the edge of the blade adapted to strike the jig so as to limit its oscillation in one direction (Br. 20-21, 22-24).

We do not find this argument persuasive. Buddle's blade 14 connects directly with the eyelet 8 of the jig (Buddle 1: 84-85). The blade is also connected in such a way that it cannot spin freely around the jig; i.e., contact with the jig (eyelet or body) limits the oscillation in at least one direction. Similarly, the blade of Thomas' lure is connected through a split ring (Thomas, col. 2, ll. 38-41) to the eyelet of the jig (*id.*, Figs. 8 and 9) in such

a way that it is capable of contacting the jig body through sideways or up-and-down movement and cannot spin freely around the jig.

Appellant also argues that the yarn shown on Buddle's lure would act as a stabilizer to stop the lure from wobbling. No evidence, however, is cited to support this argument. In addition, as discussed above, the "adapted to strike" language of claim 19 only requires that the blade be capable of striking the jig, not that it actually do so when the lure is in use.

We affirm the rejections of claim 19 as anticipated by either of Buddle or Thomas.

With respect to the rejection based on Edwards, Appellant argues that Edwards' lure does not have a major portion of the blade above the upper surface of the jig (Br. 25). We agree. The blade in Edwards' lure is located in a slot cut into the body of the jig itself. Thus, while some part of the blade may be located above the upper surface of the lure, that part does not reasonably appear to be "a major part" of the blade, as required by claim 19. The Examiner's argument to the contrary – that all the surface above the very bottom is "upper surface" (Answer 20) – is not a reasonable interpretation of the claim language. The Specification makes clear that upper surface of the jig body is the upper*most* surface (see, e.g., Specification 11: 14 to 12: 20, Figures 4A and 4B).

8. DECLARATIONS

Appellant has submitted three Rule 132 declarations as evidence of nonobviousness. The Declaration of Michael J. Fewell is cited as evidence "that the average fisherman thinks that the instant invention is something special" (Reply Br. 11-12). The Declaration of John C. McElwaine is

"offered to show copying (secondary indicia of [non]obviousness)" (*id.* at 12). The Declaration of Ron A. Davis is "offered to show how the industry views the CHATTERBAIT™, how the instant invention is different from the prior art, and the commercial success of the instant invention" (*id.* at 13). (CHATTERBAIT™ is the commercial embodiment of the claimed lure; Br. 3.)

The evidence provided in the declarations does not overcome the prima facie cases of obviousness. The evidence in all three declarations suffers from the same problem: it is limited to the CHATTERBAIT™ commercial embodiment of what is claimed, while claims 18 and 19 are so broadly written that they encompass embodiments that are either already described in the prior art or obvious based on what has been described.

We take no position on whether the CHATTERBAIT™ itself is patentable: that issue is not before us. Even assuming that Appellant's evidence shows that the CHATTERBAIT™ is patentable, however, the scope of claims 18 and 19 as presently written precludes their issuance. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007) ("If the claim extends to what is obvious, it is invalid under § 103."); *In re Slayter*, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960) ("It is well settled that a generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus.").

OTHER ISSUES

Claim 18 seems to say that the blade is part of the jig ("said jig including a body, . . . a hook, . . . an eyelet, . . . ; and a blade"). Claim 18 also requires that the blade strike the jig, meaning that they have to be

separate elements. If this application is subject to further prosecution, claim 18 should be amended to make clear that the blade is not a part of the jig.

SUMMARY

We reverse the rejection of claim 19 as anticipated by Edwards and the rejections of claim 18 as obvious in view of either Yarvise or Thomas, combined with Werner or Norman. However, we affirm the following rejections: claim 18 as anticipated by Perrick; claim 18 as obvious in view of Perrick and Olson; claim 18 as obvious in view of Thomas, Olson, and Werner or Norman; claim 19 as anticipated by Buddle; and claim 19 as anticipated by Thomas.

AFFIRMED

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