

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WILLIAM F. WHIPPLE

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Appeal 2008-0822  
Application 10/939,229  
Technology Center 3600

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Decided: March 25, 2008

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Before DONALD E. ADAMS, ERIC GRIMES, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

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

*Background*

“Artificial or plastic worms, jigs and spinner baits are some of the most popular and versatile fishing lures in use today” (Spec. 1). The Specification notes that a “popular rigging technique involves the use of an

exposed hook point but with a wire weedguard covering the point of the hook to keep the lure from becoming snagged" (Spec. 1). According to the Specification, the "weight in such lures is usually employed to keep the lure on the bottom of the lake, river or the like and to help in casting the lightweight lure" (Spec. 1). "However, with a freely sliding weight on the line, it often happens during fishing that the weight will slide up the line before a fish is hooked" (Spec. 2).

Appellant teaches a

fishing weight and hook combination . . . . The fishing weight has a front portion having an elongated bore therethrough for receiving a fishing line therethrough and a rear portion having a slit in the side thereof intersecting the front portion bore and sized for the fish hook eye to slide sideways therein. The fishing weight has an enlarged hollow area at the intersection of the front portion elongated bore and the rear portion slit sized for the fishing hook eye to rotate therein so that sliding the eye of the hook sideways into the rear portion of the slit and rotating the eye, locks the fishing hook to the weight.

(Spec. 4.)

*Statement of the Case*

*The Claims*

Claims 1-3 and 5-8 are on appeal. We will focus on claim 1, which is representative and reads as follows:

1. A fishing weight and hook combination comprising: a fish hook having a shank having a barbed point at one end and an eye for attaching a fishing line at the other end thereof;

a solid fishing weight having a side and front and rear portions, said front portion having an elongated bore

therethrough for receiving a fishing line therethrough and said rear portion having a slit in the side thereof intersecting said front portion bore and sized for said fish hook eye to fit sideways therein, said solid fishing weight having an enlarged hollow area at the intersection of said front portion elongated bore and said rear portion slit, said enlarged hollow area being sized for said fish hook eye to rotate therein locking said hook eye to said solid fishing weight; whereby sliding said hook eye sideways into said fishing weight rear portion slit and rotating said eye locks said fishing hook to said weight.

*The prior art*

The Examiner relies on the following prior art reference to show unpatentability:

Blackwell US 5,335,441 Aug. 9, 1994

*The issues*

The rejections as presented by the Examiner are as follows:

Claims 1-3 and 5-8 stand rejected under 35 U.S.C. § 103(a), as being obvious over Blackwell.

*35 U.S.C. § 103(a) rejection over Blackwell*

The Examiner reasons that

Blackwell uses the protective sleeve as part of the weight. Blackwell shows the weight and the sleeve (which is read as the weight) as having an elongated bore there through for receiving the fishing line. Blackwell has a slit or a slot 19 having a longitudinal portion 23 which intersects a portion of the bore and is sized for a fish hook eye to fit sideways therein.

(Ans. 3.)

The Examiner argues that “the hook is connected to [the] tubular sleeve 12 which is part of the weight” (Ans. 4).

Appellant argues that Blackwell

does not teach, as in the present invention, a solid fishing weight (such as 27 in Blackwell) which has been totally reshaped to provide a slot therein with an enlarged portion where the slot intersects the bore passing through the weight to thereby allow a fishing hook to be slid in sideways with the eye of the hook rotated within the enlarged area of the solid fishing weight to movably lock the hook.

(App. Br. 7.)

Appellant argues that the “present invention eliminates every feature of the Blackwell patent and would require a total redesign starting from scratch to produce the present invention using a solid weight to hold a hook and lure together without a protective sleeve or crooked hook or bayonet type connection.” (App. Br. 10.)

In view of these conflicting positions, we frame the obviousness issues before us as follows:

Would it have been obvious to a person of ordinary skill to modify the Blackwell lure into the structure of claim 1, where the weight and lure protection device are combined to function as a single entity?

*Findings of Fact*

1. Blackwell teaches a “means for securing the weight to the lure in such a manner as to protect the lure during use” (Blackwell 1:37-39).

2. Blackwell teaches “a new and improved lure protection device that is manufactured in various sizes so that it can accommodate different size lures and weights” (Blackwell 2:15-17).

3. Blackwell discloses a fish hook with a shank and barbed point and an eye for attaching fishing line (*see* Blackwell 4:16, fig. 1).

4. Blackwell teaches that a “weight 27 defines a cylindrical passage 33 therethrough extending substantially axially from a tip 34 defined by a conical portion 28 to the proximate center of end 31. The size of cylindrical passage 33 is such that only a fishing line 18 may totally pass therethrough” (Blackwell 4:42-47, fig. 1).

5. Blackwell teaches a lure protection device 11 comprising a sleeve 12, where the “combination of hook 21, lure 32 and weight 27 is then urged into sleeve 12 such that weight 27 is placed in frictional contact with the interior surface of the conically tapered portion 14” (Blackwell 4:53-56, fig. 1).

6. Blackwell discloses that the hook is secured by slot 19 in notch 26 (*see* Blackwell 4:56-59, fig. 1).

7. Blackwell teaches “an adhesive (not shown) may be applied to the external surface of weight 27 for enhancing the securing of it into conical abutment with sleeve 12” (Blackwell 5:15-18).

8. Blackwell teaches that “[w]eight 27 is held in loaded position by the tension on fishing line 18 and by the reaction force placed on it by eyelet 34 when hook 21 has engaged notch 26” (Blackwell 5:24-28).

9. Blackwell teaches that “weight 27 counters the natural buoyancy of a lure 32 and allows the tackle to submerge” (Blackwell 4:39-42).

*Discussion of 35 U.S.C. § 103(a) over Blackwell*

We conclude that the Examiner has set forth a *prima facie* case that claim 1 would have been obvious to the ordinary artisan in view of

Blackwell. Blackwell teaches a fishing weight and hook combination in which a fish hook is coupled to a weight and sleeve (FF 1-9).

We use the broadest reasonable interpretation to interpret claim 1. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”). While the Specification discusses the “fishing weight” and prefers that it be formed from metal (Spec. 5:4-6), neither the Specification nor claim 1 exclude a weight with a metal core that is surrounded by other materials. Blackwell states that “weight 27 counters the natural buoyancy of lure 32 and allows the tackle to submerge” (Blackwell 4:39-42). Blackwell also teaches that the weight may be secured to the sleeve by means of an adhesive (*see* FF 7).

When the weight of Blackwell is secured by adhesive to the sleeve, as expressly suggested by Blackwell, the two components form a single entity which meets the requirements of the “solid fishing weight” of claim 1. We note that the Supreme Court has recently emphasized that “[obviousness] analysis need not seek out precise teachings directed to the subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ”. *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). In this context, the person of ordinary skill would recognize that when the sleeve and weight of Blackwell are adhered together, these become a single entity, which has the functions of both counteracting the buoyancy of the lure and attaching the hook to a notch in the sleeve (*see* FF 6-9).

We are not persuaded by Appellant's argument that the invention is drawn to a "solid fishing weight (such as 27 in Blackwell) which has been totally reshaped" (App. Br. 7). Claim 1 does not distinguish Blackwell, because when Blackwell adheres the weight 27 to the sleeve 12, Blackwell has formed a solid, physically linked object which meets all of the requirements of the fishing weight of claim 1 (*see* FF 6-9).

We reject Appellant's arguments that Blackwell's weight lacks elements recited in claim 1 (*see* App. Br. 8). Appellant is not interpreting the weight limitation as being met by the adhered weight and sleeve together (FF 5, 7). It is well settled that, "in a section 103 inquiry, 'the fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.'" *Merck & Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (quoting *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976) .) In the instant case, Blackwell's embodiment of an adhered weight and sleeve render the claimed fishing weight of claim 1 obvious (*see* FF 5-9).

We also reject Appellant's argument that a component has been eliminated from Blackwell relative to claim 1 (App. Br. 9). Claim 1 includes no requirement that the fishing weight cannot partly enclose the lure (*see* claim 1). As already noted, the sleeve and weight of Blackwell, when adhered, meet the requirements of the claimed fishing weight. Consequently, the sleeve is not eliminated in Blackwell, but is incorporated into the weight. As the Supreme Court noted, a "patent for a combination which only unites old elements with no change in their respective functions ... obviously withdraws what is already known into the field of its monopoly

and diminishes the resources available to skillful men.” *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 71 S.Ct. 127, 130 (1950) (quoted with approval in KSR, 127 S.Ct. at 1739).

We are not persuaded by Appellant’s argument that the “Blackwell patent does not rotate the hook and does not hold the hook with the eye of the hook” (App. Br. 9). First, Blackwell teaches placement of the hook eye into the weight and sleeve combination and Blackwell teaches that “[w]eight 27 is held in loaded position by the tension on fishing line 18 and by the reaction force placed on it by eyelet 34 when hook 21 has engaged notch 26” (Blackwell 5:24-28). However, even if this teaching is discounted, the claim is drawn to a product, not a method, and the product of Blackwell has a hollow area, which is the only structural element of claim 1 (*see* Claim 1). That hollowed area would have been capable of permitting the eyelet 34 to rotate into a locking position where notch 26 engages the hook as functionally required by claim 1 (*see* Blackwell, fig. 1). We note that when the eyelet of hook 34 is rotated as recited in claim 1, the shank of hook 21 also rotates, permitting notch 26 to engage the hook.

We affirm the rejection of claim 1 as obvious over Blackwell. Claims 2-3 and 5-8 fall with claim 1 as they were not separately argued.

#### CONCLUSION

In summary, we affirm the rejection of claim 1 under 35 U.S.C. § 103(a). Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 2-3 and 5-8 as these claims were not argued separately.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

Ssc:

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