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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PATRICK E. MOFFITT

Appeal 2011-000313
Application 12/034,192
Technology Center 3600

Before STEVEN D. A. McCARTHY, RICHARD E. RICE and
TIMOTHY O'HEARN, *Administrative Patent Judges*.

RICE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Patrick E. Moffitt (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM-IN-PART.

CLAIMED SUBJECT MATTER

The claimed subject matter relates to methods applicable to recreational bait fishing and to commercial “longlining.” Spec., para. [0002]. Claims 1 and 18 are independent. Claim 1, reproduced below, is illustrative of the claims on appeal:

1. A method of commercial long line fishing with a main line and a plurality of branch lines connected to the main line, comprising:

rigging a plurality of branch lines by attaching a hook at or near the end of each of the lines and by attaching a bait attachment device on each of the plurality of branch lines at a distance from the hook;

attaching bait to the bait attachment device on each of the plurality of lines; and

attaching each of the plurality of branch lines to a main line.

REFERENCES RELIED ON BY THE EXAMINER

| | | |
|---------|--------------|---------------|
| Bond | US 1,670,185 | May 15, 1928 |
| Allen | US 2,996,827 | Aug. 22, 1961 |
| Goodman | US 3,217,443 | Nov. 16, 1965 |
| Krieg | US 3,421,250 | Jan.14, 1969 |
| Hague | US 4,862,633 | Sep. 5, 1989 |

THE REJECTIONS

Claims 1, 3, 5, 7, 15, 18 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Krieg.

The following claims are rejected under 35 U.S.C. § 103(a): claims 2, 8 and 19 as being unpatentable over Krieg and Hague; claim 4 as being unpatentable over Krieg, Hague and Bond; claim 6 as being unpatentable over Krieg and Goodman; claims 9-13 as being unpatentable over Krieg and

Bond; claim 14 as being unpatentable over Krieg, Bond and Allen; and claims 16 and 17 as being unpatentable over Krieg.

ANALYSIS

Claims 1, 3, 5, 7, 15, 18 and 20 – Anticipation – Krieg

Appellant argues claims 1, 3, 5, 7 and 15 as a group and claims 18 and 20 as a group; App. Br. 10-12. We select claims 1 and 18 as representative; thus, claims 3, 5, 7 and 15 stand or fall with claim 1 and claim 20 stands or falls with claim 18. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2011).

The Examiner finds that Krieg discloses all of the recited steps and limitations of claims 1 and 18. Ans. 3-4. The Examiner pertinently finds that Krieg discloses attaching a bait attachment device (Krieg's elements 14, 18, 20, 22 or 12, 30, 32, 34) on each of two branch lines (Krieg's elements 26 and 48) at a distance from a hook (attached at the end of each branch line). *Id.* at 8 (referencing Krieg, figs. 1 and 2). The Examiner further finds that Krieg discloses attaching bait (spinner 24) to the bait attachment device "via latch/clasp – at 20 or 32." *Id.* The Examiner finds that Krieg also discloses attaching the plurality of branch lines to a main line 60 via intervening components. *Id.* at 4.

We do not agree with Appellant's argument that the claims require first attaching a bait attachment device to a line and "then" attaching bait to the bait attachment device. App. Br. 11; Reply Br. 4. Unless the steps of a method claim actually recite or implicitly require an order, the steps are not ordinarily construed to require one. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003); *Interactive Gift Express, Inc. v. CompuServe*

Inc., 256 F.3d 1323, 1342-43 (Fed. Cir. 2000); *see also Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1322 (Fed. Cir. 1999). Here, nothing in the language of claim 1 or claim 18 requires the recited steps to be performed in a particular order.

We also do not agree with Appellant's argument that "[t]he Examiner's Answer does not . . . clearly specify what the bait attachment device is." Reply Br. 4. The Examiner clearly identifies Krieg's elements 14, 18, 20, 22 and 12, 30, 32, 34 as defining two bait attachment devices. The first of these devices includes wire leader 14, convolutions 18, spring latch 20 and a pair of decorative beads or spacers 22, and the second includes wire leader 12, convolutions 30, spring latch 32 and decorative beads or spacers 34. *See Krieg*, col. 2, ll. 31-36 and 40-44, fig. 1.

Appellant argues that, if items 12, 30 and 32 of Krieg are considered the bait attachment device, then Krieg fails to teach or suggest a branch line. App. Br. 11. Appellant also argues that Krieg does not disclose attaching a bait attachment device on a branch line that is connected to a main line, at a distance from the hook. *Id.* This argument is conclusory and does not point to any specific error in the Examiner's findings. In particular, this argument does not adequately rebut the Examiner's findings that Krieg's elements 48 and 26 are branch lines attached to bait attachment devices at a distance from a hook (at latches 32 and 20, respectively) and connected to main line 60 through intervening components. *See Ans.* 4, 8.

Appellant additionally argues that there is no bait attachment device in Krieg "that allows bait attached to the line to be removed" (App. Br. 11) and that "claim 1 requires the bait to be *on* the bait attachment device (Reply Br. 5, emphasis added). However, claims 1 and 18 do not recite the step of

removing bait from the bait attachment device or limit the term “bait attachment device” to a device that allows *both* attachment *and* removal of bait; further, claim 1 recites attaching bait “to,” not “on,” the bait attachment device (*see* Ans. 8-9).

We have considered all of Appellant’s arguments. However, we are not persuaded of any error in the Examiner’s findings with respect to claims 1 and 18. Accordingly, we sustain the rejection of claims 1 and 18 under 35 U.S.C. § 102(b) as being anticipated by Krieg. Claims 3, 5, 7, 15 and 20 fall with claims 1 and 18.

Claims 2, 8 and 19 – Obviousness – Krieg and Hague

Appellant argues that dependent claims 2, 8 and 19 are patentable because Krieg and Hague do not individually teach or suggest the steps and limitations of independent claims 1 and 18 and thus the combination of Krieg and Hague does not teach or suggest those steps and limitations. App. Br. 13-14. As discussed *supra*, Krieg alone discloses all of the steps and limitations of claims 1 and 18. Accordingly, we sustain the rejection of claims 2, 8 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Krieg and Hague.

Claim 4 – Obviousness – Krieg, Hague and Bond

Claim 4 recites that “the bait stays in a fish's mouth cavity during hook setting.” Bond discloses a fishing lure comprising a spoon 19 connected at one end to a line 20 and at the other end to a hook 30. Bond, fig. 1. The Examiner finds that the spoon (bait) of Bond’s fishing lure stays in the fish’s mouth during hook setting. Ans. 5. In response to Appellant’s argument that Bond does not disclose this feature (App. Br. 14), the

Examiner contends that it is “an *inherent* feature of fishing lures.” Ans. 9 (emphasis added).

Based on the record before us, we cannot find by a preponderance of the evidence that the spoon of Bond’s lure necessarily stays in a fish’s mouth cavity during hook setting. The Examiner has not explained, for example, why spoon 19 might not be pulled from a fish’s mouth by line 20 during setting of hook 30 in the fish’s mouth.¹ See Bond, fig. 1. Inherency cannot be established by mere probabilities or possibilities.² Accordingly, we do not sustain the rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Krieg, Hague and Bond.

Claim 6 – Obviousness – Krieg and Goodman

Claim 6 recites that “the bait is pulled free from the bait attachment device during hooking.” Goodman discloses a fishing lure comprising spoon elements 48 and hook 50 carried by a leader 46 that pulls free from a tension release device 44 when the lure become snagged. Goodman, col. 2, ll. 40-42, fig. 1.³ The Examiner finds that, as disclosed in Goodman, the bait

¹ “Inherency can be established when ‘prior art necessarily functions in accordance with, or includes, the claimed limitations.’” *Bettcher Indus., Inc. v. Bunzl USA, Inc.*, 661 F.3d 629, 639 (Fed. Cir. 2011) (quoting *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed.Cir.2002)).

² *Bettcher Indus.*, 661 F.3d at 639 (“Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”) (quoting *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)).

³ Goodman expressly discloses that “if the hook 50 becomes snagged the tension release device 44 operates to release it and the spoons 48.” Goodman, col. 2, ll. 56-58 (bold omitted).

(spoon elements 48) is pulled free from the bait attachment device (tension release device 44) during hooking. Ans. 6.⁴

Appellant argues that Goodman's tension device "is not a bait attachment device and it does not include any way to hold bait" and that "no bait is pulled free from the tensioning device during hooking, as required by claim 6." App. Br. 15. These arguments are not responsive to the rejection as articulated by the Examiner. Further, claim 6 does not require the bait attachment device "to hold bait." Rather, claim 6, which depends from claim 1, requires "attaching" bait to the bait attachment device. Appellant has not persuaded us that tension release device 44 is not a bait attachment device or that attaching spoons 48 to tension release device 44 via leader 46 does not satisfy the recited step of "attaching bait to the bait attachment device."

Appellant finally argues that dependent claim 6 is patentable because Krieg and Goodman do not individually teach or suggest the steps and limitations of claim 1 and accordingly the combination of those references fails to teach or suggest the method of claim 1. *See* App. Br. 15-16. For the reasons discussed *supra* in connection with claim 1, as well as claim 6, we disagree.

Accordingly, we sustain the rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Krieg and Goodman.

Claims 9-13 – Obviousness – Krieg and Bond

Claim 10 recites that "the fish does not take the bait and the hook

⁴ The phrase "during hooking" in claim 6 is broader than the phrase "during hook setting" in claim 4 and reasonably encompasses hooking (snagging) an obstacle in the water, as the Examiner reasons.

simultaneously into its mouth.” The Examiner finds that Bond’s lure comprising a hook and a spoon inherently discloses that “the fish would first envelope the hook in its mouth prior to enveloping the bait since the hook [i]s located at the end of the associated branch line.” Ans. 10. The Examiner has not explained, however, why a fish would necessarily approach the bait from the end of the branch line, and not from some other direction. *See Bettcher Indus.*, 661 F.3d at 639.

Accordingly, we do not sustain the rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Krieg and Bond.

Appellant argues that the combination of Krieg and Bond does not teach or suggest claim 1 and argues that claims 9 and 11-13 are patentable based on their dependency from claim 1. App. Br. 16. This vague argument does not constitute a separate argument for the patentability of any of claims 9 and 11-13 pursuant to 37 C.F.R. § 41.37(c)(1)(vii) (2011) and is insufficient to persuade us of error in the Examiner’s rejection.⁵

Accordingly, we sustain the rejection of claims 9 and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over Krieg and Bond.

Claim 14 – Obviousness – Krieg, Bond and Allen

Claim 14 depends from claim 10. For the reasons discussed *supra* with respect to claim 10, we do not sustain the rejection of claim 14.

⁵ *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (holding that the Board reasonably interpreted its rule as requiring “more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art”).

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Claims 16 and 17 – Obviousness – Krieg

Appellant argues the patentability of claims 16 and 17 based solely on their dependency from claim 1. App. Br. 18. For the reasons discussed *supra* with respect to claim 1, we sustain the rejection of claims 16 and 17.

DECISION

We affirm the rejections of claims 1-3, 5-9, 11-13 and 15-20.

We reverse the rejections of claims 4, 10 and 14.

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

AFFIRMED-IN-PART

JRG