

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASARU AKIBA

Appeal No. 2000-0693
Application 08/845,282

HEARD: November 28, 2000

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-59, all the claims then pending in the application. Subsequent to the final rejection, appellant filed an amendment seeking to cancel claims 1-3, 5-7, 16, 20 and 58, and to make minor changes to claims 44, 45, and 52, which amendment was entered by the examiner (see the advisory letter mailed July 23, 1999 (Paper No. 22)). Accordingly,

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only claims 4, 8-15, 17-19, 21-57 and 59 remain before us for review.

Appellant's invention pertain to an "inter-line" fishing rod, that is, a fishing rod "in which a fishing line is introduced into the inside of the fishing rod and laid therein in the longitudinal direction of the rod" (specification, page 1). A substantially correct copy of the claims on appeal is found in the appendix to appellant's brief.¹

The references of record relied upon by the examiner in final rejection are:²

Barnett (Japanese Patent Application)	56-127032	Oct. 5, 1981
Harada (Japanese Patent Application)	63-169871	Apr. 25, 1987
Kure	1-304836	Dec. 8, 1989

¹ The claims as reproduced in the appendix to appellant's brief contain several errors. For example, in the penultimate line of claim 1 "contact are" should be --contact area--. Suffice it to say, in considering the obviousness issues raised in this appeal, we have considered the claims in their proper form.

² Our understanding of these Japanese language patent documents is derived from translations obtained by the Patent and Trademark Office. Copies of these translations are attached to this decision.

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(Japanese Patent Application)

Claims 4, 8-15, 17-19, 21-57 and 59 stand rejected under 35 U.S.C. § 103 as being unpatentable over Japanese patent document 63-169871 to Harada (JA '871) in view of Japanese patent document 1-304836 to Kure (JA '836) and further in view of Japanese patent document 56-127032 to Barnett (JA '032).³

According to the examiner, "[t]his rejection is set forth in prior Office action, Paper No. 7 and Paper No. 17" (answer, page 4).⁴ As it turns out, the examiner's position as set forth in the "Response to Argument" section of the answer regarding a very relevant feature of the claimed invention is substantially different than the positions taken in previous office actions. Accordingly, our focus will be on the

³ The final rejection (Paper No. 17) also included a rejection of all the then pending claims under the judicially created doctrine of obviousness-type double patenting. This rejection was subsequently withdrawn by the examiner. See section 6 ("Issues") on page 2 of the answer.

⁴ The procedure followed by the examiner here of incorporating by reference more than one previous office action in explaining the rejection is not in compliance with Section 1208 of the Manual of Patent Examining Procedure (MPEP), which expressly provides that incorporation by reference may be made only to a *single* other action.

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examiner's explanation of the rejection as found on pages 4 and 5 of the examiner's answer.

Reference is made to appellant's brief and reply brief (Paper Nos. 23 and 26) for appellant's arguments regarding the merits of the standing § 103 rejection.⁵

Discussion

As explained on pages 1-2 of the specification, an objective of appellant is to improve upon the performance of the inter-line fishing rod disclosed in JA '871. To this end, appellant's provide a coating film on the inner surface of the inter-line fishing rod that is water-repellant and has a low coefficient of friction. In order to further improve the performance of the coating film, the thickness of the film is provided with inner annular projections to reduce the area of

⁵ Submitted concurrently with the reply brief is the declaration (improperly labeled "Affidavit") of Tomoyoshi Tsurufuji. In that the examiner has not considered this declaration, it is not properly before us and will not be considered. Based on our reading of 37 CFR § 1.195 and MPEP §§ 1210 and 1211.02, it would appear that the examiner had authority to consider this declaration, notwithstanding his views to the contrary as expressed in the letter mailed February 15, 2000 (Paper No. 27). In any event, in view of our disposition of this appeal, appellant has not been prejudiced by the examiner's action in this regard.

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contact between the fishing rod and the fishline
(specification; page 6, lines 4-19).

Each of the independent claims on appeal include limitations directed to this annular projection feature of the coating film. More specifically, independent claim 4 calls for a film layer on the inner circumferential surface of the tubular member

[having] a varied thickness to define a plurality of projections . . . to reduce contact area between said film layer and said fishline,

independent claim 8 requires a coating film on the inner circumferential surface of the tubular member

[having] a varied thickness to define a plurality of annular projections having a longitudinal length, said annular projections being spaced apart from an adjacent annular projection by a longitudinal distance,

independent claim 10 sets forth a tubular member

[having] an inner circumferential surface defined by a recessed portion and a protruding portion alternately arranged in a sectional view, . . . wherein at least a portion of said inner circumferential surface defined by said recessed portion has a water repellant property,

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independent claim 17 calls for a film layer provided on the inner circumferential surface of the tubular member that

defines a plurality of longitudinal spaced apart projections extending circumferentially with respect to said tubular member to reduce contact area between said film layer and said fishline,

and independent claim 21 requires

an inner circumferential surface of said tubular main body . . . formed with recessed and protruding portions alternately arranged in a longitudinal direction . . . wherein surface portions defined by said recessed portions have a water repellant property.

In prosecution before the examiner leading up to this appeal, the examiner employed a number of theories in an attempt to account for claim limitations directed to the inner surface of the fishing rod being provided with projections. For example, in the parent case of the present application, the examiner took the

position (office action mailed January 21, 1997 (Paper No. 7), pages 3-4) that

it would have been further obvious to provide the interior surface of the inner-line fishing rod with annular projections within the rod in view of the Japanese patent ('032) to reduce the contact area between the line and the interior surface of the fishing rod and to thereby reduce the wear to the

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fishing line and to enable the fishing line to slide through the interior of the fishing rod more easily.

Thereafter, the examiner contended (final rejection (Paper No. 17), page 5) that "[t]he varied thickness limitation is deemed to be a matter of choice since the function is the same and no showing of unexpected results was made."

The examiner's present position with respect to the above noted limitations of the independent claims is found on pages 4-5 of the answer and reads as follows:

The Office Action mailed on Jan. 21, 1997 states near the bottom of page 3, that it would have been obvious to provide annular projections within the rod to reduce the contact area between the line and the interior of the rod. The annular projections are interpreted to be a film layer of varied thickness. Also, as shown in the JA '836 patent in Fig. 6, a tape layer 51 is wound around a mandrel (in the production of the rod using bundled filament yarns such as glass fibers or carbon fibers) in an overlapping spiral fashion which produces a layer of varied thickness to define a plurality of projections as can be viewed in the Fig. The tape produces a film layer of varied thickness because the tape is overlaid and the overlapped areas are thicker than a single layer of tape. See US '126 to Barnett which is the English equivalent to JA '032 in column 4, lines 52-58.^[6] This discloses an end

⁶ In that we have available to us a translation of the JA '032 reference, it is unnecessary for us to resort to the U.S. equivalent thereof in order to determine the teachings of this

section of the rod which would be adjacent the rod tip as having lining of ptfе tape (a fluoroplastic) which is a low friction material. This tape would substantially cover an inner circumferential surface of the tubular member and the ptfе tape is [a] water repelling substance. To cover the inside of Barnett's rod with ptfе tape the tape is wound around a mandrel prior to molding the rod section and one skilled in the art would expect it to be wound in the manner shown by JA '836. In regard to claims 10-15, 17-19, 21-57 and 59, the result of the proposed combination^[7] for the reasons stated above is that the inner circumference is defined by recessed and protruded portions since the wrapping of the tape on a mandrel in the manner stated produces alternate sections of protrusions and recesses having a water repellent property.

reference. The relevant portion of the translation of JA '032 is found on page 11, lines 14-19, and reads as follows:

When the final span of the end section 3 of stem has too smaller [sic] inner diameter to provide feed rings, this section can be lined with an antifriction material such as polytetrafluoroethylene, and this is most readily carried out by winding a polytetrafluoroethylene tape on an arbor for forming the stem before the section is molded.

⁷ It is not entirely clear what constitutes the "proposed combination" referred to here by the examiner, although presumably it would involve providing a polytetrafluoroethylene tape lining of the type taught by JA '032 on the inner circumferential surface of the tubular member of JA '871, and in so doing initially apply the tape to a forming mandrel in the manner illustrated in JA '836 in Figure 6 for tape 51 (i.e., with the edges of the wrapped tape overlapping).

None of the examiner's positions persuade us that the claimed subject matter on appeal here would have been obvious in light of the teachings of the applied references. In this regard, we are in substantially agreement with the arguments made by appellant in the reply brief in response to the examiner's positions as set forth in the answer. In particular, we note, as does appellant, that the tape 51 of JA '836 is used solely for the purpose of securing the bundled filament yarn 49 to the mandrel while curing the bundled filaments and that thereafter tape 51 is removed and discarded. Thus, tape 51 does not form any part of the finished tubular member. Based on the lack of correspondence between the tape 51 of JA '836 and the unillustrated polytetrafluoroethylene tape mentioned by JA '032 on page 11 of the translation at lines 14-19, we conclude that there is no logical basis for the examiner's conclusion that "one skilled in the art would expect it [i.e., the unillustrated polytetrafluoroethylene tape mentioned of JA '032] to be wound in the manner shown by JA '836" (answer, page 5). Moreover, even if the tape of JA '032 was wrapped about the forming mandrel in the manner shown by JA '836 in Figure 6 prior to

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being cured, it is at best speculative that the resulting polytetrafluoroethylene, when cured, would have alternating recessed and protruded portions, as called for in the claims. In this regard, appellant's argument (reply brief, page 4) that "the PTFE tape would soften and form a smooth substantially continuous thickness between the mandrel and outer layer of the fishing rod during curing" is reasonable and has not been adequately addressed by the examiner.

In light of the above, the standing § 103 rejection of independent claims 4, 8, 10, 17 and 21, as well as claims 9-15, 18, 19 and 22-57 that depend therefrom, shall not be sustained.

Turning to claim 59, in that this claim depends from canceled claim 20, its metes and bounds cannot be determined. When a claim's metes and bounds cannot be determined, it should be rejected under 35 U.S.C. § 112, second paragraph, and not over the prior art. *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Accordingly, we are constrained to reverse the standing § 103 rejection of claim 59. It should be understood, however, that our reversal of

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this rejection is not a reversal on the merits thereof, but rather a procedural reversal predicated upon the failure of the claim to particularly point out and distinctly claim the subject matter sought to be patented.

Rejection under 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), we enter the following new rejection.

Claim 59 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In that claim 59 depends from a canceled claim, its metes and bounds cannot be determined.

Remand

Pursuant to 37 CFR § 1.196(a) and MPEP § 1211, this case is remanded to the examiner for consideration of the following matter.

Claims 10 and 21 appear to allow for the recessed and protruded portions to be formed in the inner surface of the tubular member. However, it is not immediately apparent where in appellant's original disclosure there is descriptive support for this construction as opposed to, for example, the

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arrangement shown in Figure 4 where the recessed and protruded portions are formed on the film layer applied to the tubular member.

The examiner should consider whether there is proper descriptive support in the disclosure as originally filed for the subject matter of claims 10 and 21, as well as the claims that depend therefrom. If descriptive support for the subject matter of any such claim is found to be lacking, the examiner should enter a rejection thereof under the first paragraph of 35 U.S.C. § 112.

Summary

The rejection of claims 4, 8-15, 17-19 and 21-57 is reversed on the merits.

The rejection of claim 59 is reversed on procedural grounds.

Under the provisions of 37 CFR § 1.196(b), a new rejection of claim 59 has been made.

Under the provisions of 37 CFR § 1.196(a), this case is remanded to the examiner for the reason noted above.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final

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rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203
Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not
be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant,
WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise
one of the following two options with respect to the new
ground of rejection to avoid termination of proceedings
(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the
claims so rejected or a showing of facts relating to
the claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

Reversed and Remanded; 37 CFR § 1.196(b)

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IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	
Administrative Patent Judge)	INTERFERENCES
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)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

LJS/kis
LONGACRE & WHITE
SUITE 401
1919 S EADS STREET
ARLINGTON, VA 22202