

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONNIE G. LINE

Appeal No. 98-1427
Application 08/511,310¹

ON BRIEF

Before COHEN, MEISTER and ABRAMS, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claim 1. Claims 2 through 6, 8 through 10, and 15, the only other claims remaining in the application, have been indicated to be allowable by the examiner.

¹ Application for patent filed August 4, 1995.

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Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Pond.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the first office action and answer (Paper Nos. 3 and 10), while the complete statement of appellant's argument can be found in the main and reply briefs (Paper Nos. 9 and 11).

OPINION

We are constrained to reverse the rejection of claim 1 under 35 U.S.C. § 102(b), and enter a new ground of rejection, infra, for the reason which follows. As explained below, our reversal is procedural in nature, and is not based upon an assessment of the applied prior art relative to the claimed subject matter, i.e., the merits of the examiner's rejection.

When claimed subject matter is indefinite, an evaluation thereof relative to prior art is inappropriate. See In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) and In re Steele, 305 F.2d 859, 862-863, 134 USPQ 292, 295 (CCPA

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1962). In the present case, a reading of claim 1 reveals to us that this claim is indefinite within the meaning of 35 U.S.C. 112, second paragraph. The specific instances of indefiniteness are set forth in a new ground of rejection, *infra*. Since claim 1 is

indefinite, it follows that this panel of the board is unable to address the merits of the rejection of claim 1 under 35 U.S.C. § 102(b) based upon the patent to Pond.

NEW GROUND OF REJECTION

Under the authority of 37 CFR 1.196(b), this panel of the board enters the following new ground of rejection.

Claims 1 through 6, 8 through 10, and 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.²

² To be definite under 35 U.S.C. § 112, second paragraph, claims must set and circumscribe a particular area with a reasonable degree of precision and particularity. Claim language must be read in light of a specification, as it would be interpreted by one of ordinary skill in the art. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

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Independent claim 1 addresses an artificial snake or eel-like³ fish bait to be pulled through water in one direction which comprises, inter alia, an elongated flexible material having a unitary head, body, and tail, with the tail being a flattened web-like strip substantially transverse to the direction pulled through the water so as to retain, in a static position, a

normally S-shaped curve extending above the head, but capable of substantially undulating in one direction when pulled through water.

Independent claim 8 is drawn to an artificial fish bait comprising, inter alia, an elongated flexible material having a unitary head, body, and tail, with the body and a flattened web-like tail being formed so as to retain, in a static position, a normally S-shaped curve extending above the head.

Claim 3, dependent from claim 8, specifies that the body

³ In the recitation "snake or eel-like" fish bait of claim 1 (line 1) we understand "eel-like", in light of the underlying disclosure (page 2), to denote, e.g., a worm.

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is a flattened web-like strip.

As explained below, claims 1, 3, and 8, in particular, are considered to be indefinite under the second paragraph of 35 U.S.C. § 112, since the metes and bounds thereof are not defined with a reasonable degree of precision and particularity.

Claim 1 (lines 4 through 8) expressly sets forth the "tail" as a "flattened" web-like strip that retains, in a static position, a normally "S-shaped curve". However, as depicted, for example, the tail is clearly not a flattened strip. Thus, the characterization of the strip as being flattened is simply inaccurate (indefinite). Further, the recitation of both a "flattened" strip and an "S-shape curve" adds an inconsistency which renders the claim indefinite in meaning.

Claim 1 (lines 5 and 6) recites a "web-like" strip. It is not apparent what is intended by the recitation of "web-like", i.e., even if a particular meaning were attributed to the term web, the underlying disclosure does not inform us as to what would be like a web relative to the claimed "strip". Thus,

this language renders claim 1 indefinite in meaning.⁴

Claim 1 (line 8) sets forth that, in a static position, a normally S-shaped curve is "extending above the head".

However, as disclosed (depicted in Figures 1, 2, and 10), only water is above the head of the fish bait. Thus, the claim language is indefinite (inaccurate).

Claim 8 (lines 3 and 4) expressly sets forth the "tail" as being a "flattened" web-like tail that retains, in a static position, a normally "S-shaped curve". However, as depicted, for example, the tail is clearly not flattened. The "flattened" recitation is therefore an inaccurate (indefinite) characterization. Further, the recitation of both a "flattened" strip and an "S-shape curve" adds an inconsistency which renders the claim indefinite in meaning.

Claim 8 (line 3) recites a "web-like" tail. It is not apparent what is intended by the recitation of "web-like", i.e., even if a particular meaning were attributed to the term

⁴ See Ex parte Remark, 15 USPQ2d 1498, 1500 (BPAI 1990).

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web, the underlying disclosure does not inform us as to what would be like

a web relative to the claimed "tail". Thus, this language renders claim 1 indefinite in meaning.

Claim 8 (lines 4 and 5) sets forth that, in a static position, a normally S-shaped curve is "extending above the head". However, as disclosed (depicted in Figures 1, 2, and 10), only water is above the head of the fish bait. Thus, the claim language is indefinite (inaccurate).

Claim 3 recites a "flattened" and "web-like" strip. The terms in quotes render claim 8 indefinite in meaning for the reasons given above relative to the same terms appearing in claims 1 and 8.

In summary, this panel of the board has reversed the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Pond (procedural reversal). Additionally, we have introduced a new ground of rejection in accordance with 37 CFR 1.196(b).

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

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

REVERSED;
37 CFR 1.196(b)

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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)
) BOARD OF PATENT
JAMES M. MEISTER)
Administrative Patent Judge) APPEALS AND
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