

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY W. STONE

Appeal No. 2002-0339
Application No. 09/226,252

ON BRIEF

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

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 4 through 11 and 14 through 26. Claims 2, 3, 12, and 13 stand objected to as depending from a rejected base claim. These claims constitute all of the claims in the application.

Appellant's invention pertains to a lead free frangible unsintered firearm projectile, to a process for making a lead free frangible unsintered cold compacted iron projectile, to an

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unsintered firearm projectile, and to a frangible unsintered firearm projectile. A basic understanding of the invention can be derived from a reading of exemplary claims 1, 11, 23, 24, 25, and 26, respective copies of which appear in APPENDIX I of the brief (Paper No. 11).

As evidence of anticipation and obviousness, the examiner has applied the respective documents listed below:

Patch et al (Patch)	2,409,307	Oct. 15, 1946
Dautzenberg et al (Dautzenberg)	3,951,035	Apr. 20, 1976
Lowden et al (Lowden)	5,760,331	Jun. 2, 1998
Knight et al (Knight) (Great Britain)	1,091,551	Nov. 15, 1967
Slater et al (Slater) (Great Britain)	2,278,423	Nov. 30, 1994

The Condensed Chemical Dictionary, revised by Gessner G. Hawley, Tenth Edition, Van Nostrand Reinhold Company, 1981, page 1016 (Hawley)

The following rejections are before us for review.¹

¹ The final rejection (Paper No. 6) also included fourteen obviousness-type double patenting rejections, which the examiner now indicates are withdrawn in view of the Terminal Disclaimer of May 23, 2000 and the Terminal Disclaimer of September 11, 2000.

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Claims 24, 25, and 26 stand rejected under 35 U.S.C. § 112, first paragraph (lack of description issue).

Claims 8 through 10 and 21 stand rejected under 35 U.S.C. § 112, second paragraph (indefiniteness issue).

Claim 23 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Knight.

Claims 1, 5, 6, 8 through 11, 16, and 19 through 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lowden.

Claims 4, 14, 15, and 24 through 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lowden in view of Dautzenberg.

Claims 7 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lowden in view of Slater.

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Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lowden in view of Slater, Patch, and Hawley (The Condensed Chemical Dictionary).

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 17), while the complete statement of appellant's argument can be found in the brief (Paper No. 11).²

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims, the applied teachings,³ and

² A reply brief (Paper No. 18) was denied entry by the examiner as being untimely (Paper No. 20). As per the telephone call of April 3, 2002 initiated by Program and Resource Administrator Craig Feinberg of the Board of Patent Appeals and Interferences, we are informed that counsel Huntley will not file any petition regarding the denial of entry of the reply brief. Thus, the reply brief is not before us for consideration.

³ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not
(continued...)

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the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Lack of Description

We sustain the rejection of claims 24, 25, and 26 under 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. Further, the content of the drawings may also be considered in determining compliance with the written description requirement.

³(...continued)
only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

In the present case, the examiner asserts that there is no basis in the original specification to support the now claimed recitation of "at least one lubricant", which is indicated to mean one or more lubricants (answer, page 3). In the brief (page 8), appellant argues that other lubricants besides the disclosed zinc stearate can be used and refers to the British patent to Knight applied by the examiner in prior art rejections also before us.

Unlike appellant, we share the examiner's point of view (answer, page 6) that there is no support in the original disclosure for more than one lubricant, i.e., two or more lubricants, being combined with iron powder or powdered iron particles, irrespective of whether one of them is zinc stearate or otherwise. The original specification (pages 4, 5, and 7) only conveys that a lubricant is to be mixed with powdered iron, and appellant does not point to any part of the original

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disclosure which descriptively supports mixing more than one lubricant with the iron powder.

Indefiniteness

We sustain the rejection of claims 8 through 10 and 21 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Simply stated, as recognized by the examiner (answer, page 6), appellant shares the examiner's point of view (brief, pages 8 and 9) as to the instances of existing indefiniteness.

Anticipation

We sustain the rejection of claim 23 under 35 U.S.C. § 102(b) as being anticipated by Knight.

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911

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F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The unsintered firearm projectile of claim 23 comprises cold compacted iron powder.

Knight teaches (page 1, lines 64 through 79) a method of making bullets wherein a mixture of lead powder and iron powder with fat, wax, or oil is extruded into wire, and then cut into short wire lengths and pressed into a bullet in a bullet press.

The examiner perceives that the Knight reference discloses the projectile of claim 23 comprising cold compacted iron powder, with the pressing step being cold compaction. On the other hand,

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appellant argues (brief, page 9) that the applied reference discloses "only projectiles formed by extruding mixed metal powders, and fails to disclose or suggest a cold compacted projectile of claim 23".

We share the examiner's view that the projectile of claim 23 reads on the bullet (projectile) disclosed by Knight. Further, this panel of the board notes that appellant has neither argued nor presented evidence that the now claimed unsintered firearm projectile article comprising cold compacted iron powder would be recognized by one skilled in the art as, in fact, structurally distinguishable from the bullet yielded by the method described by Knight.

Obviousness

We sustain the rejection of claims 1, 5, 6, 8 through 11, 16, 19 through 21, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Lowden, but do not sustain the rejection of claim 22 on this same ground of rejection.

Appellant argues (brief, pages 9 through 16) that the rejected claims are not obvious since Lowden does not provide any examples of a projectile comprising iron powder, and fails to disclose or suggest such a projectile. According to appellant, Lowden is devoid of any teaching or suggestion of the use of iron in a projectile. We find ourselves in basic agreement with the examiner's response in the answer (pages 6 through 12) to the arguments advanced by appellant relative to claims 1, 5, 6, 8 through 11, 16, 19 through 21, and 23, but add the following in further support thereof.

Contrary to appellant's statement before this panel of the board that Lowden is "devoid" of any teaching or suggestion of the use of iron in a projectile, a reading of the Lowden patent quickly reveals to us that iron is very well known for use in a projectile to those having ordinary skill in the art, as follows: iron in projectiles during World War II (column 1, lines 64 through 67); partially densified iron powder in a frangible projectile (column 2, lines 6 through 15); and lead-free shotshell pellets made of an alloy of iron and tungsten (column 2, lines 57 through 61). Thus, in following the material choice guidelines outlined by the patentee Lowden, iron would, as

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pointed out by the examiner, have been well understood to be an appropriate binder material in the mixture of powders that are cold pressed (compacted) together to form a projectile. Thus, notwithstanding the arguments of appellant to the contrary, the overall Lowden disclosure, rather than teaching away, would have clearly been suggestive of the invention now claimed.

The rejection of claim 22, dependent from claim 1, is not sustained since, in our opinion, the Lowden patent, the only reference applied to claim 22, would not have been suggestive of a projectile "consisting essentially of cold compacted iron powder". As above, iron powder would have fairly been understood to be a binder in accordance with the teaching of Lowden. As such, we do not perceive that one having ordinary skill in the art would have fabricated a projectile "consisting essentially of" cold compacted iron powder, when following the teaching of Lowden alone.

We sustain the rejection of claims 4, 14, 15, and 24 through 26 under 35 U.S.C. § 103(a) as being unpatentable over Lowden in view of Dautzenberg. In the brief (page 17), appellant's only argument is that the Dautzenberg reference fails to cure the

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deficiency of the Lowden patent. The argument is not convincing since we earlier determined that Lowden was not deficient. It is well worthy of noting that Dautzenberg again informs us that, at the time of appellant's invention, iron powder was, in fact, known for its use in making bullets, albeit for disintegrating dummy bullets. Of course, Dautzenberg also clearly teaches the use of zinc stearate with iron powder to facilitate powder compression in the bullet making process, akin to appellant's use of zinc stearate with iron powder in making a frangible projectile.

We sustain the rejection of claims 7 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Lowden in view of Slater. The only argument in the brief (page 17) is the assertion that the Slater reference fails to cure the deficiency of the Lowden patent. The argument is not persuasive for the reason that we determined above that Lowden was not deficient. Slater also clearly instructs us that, prior to appellant's invention, metal powder, "especially" iron powder (page 2), was known for use in fabricating a frangible projectile, notwithstanding that the alternative of a sintered form of powder was used.

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We sustain the rejection of claim 18 stands under 35 U.S.C. § 103(a) as being unpatentable over Lowden in view of Slater, Patch, and Hawley. The argument that each of the Knight, Patch, and Hawley references fails to cure the deficiencies of the Lowden patent is not convincing in light of our earlier determination that the Lowden patent is not deficient, contrary to the assertion of appellant.

In summary, this panel of the board has sustained the rejections under the first and second paragraphs of 35 U.S.C. § 112, the anticipation rejection, and the obviousness rejections, but for the obviousness rejection of claim 22.

The decision of the examiner is affirmed-in-part.

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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).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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