

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RODGERS P. DEJARNETTE, Jr.

Appeal No. 2003-1825
Application No. 09/672,492

ON BRIEF

Before KRATZ, DELMENDO and PAWLIKOWSKI, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-3, 7, 8, 11, 12 and 16. Claims 4-6, 9, 10 and 13-15, which are all of the other claims pending in this application, have been indicated as allowable by the examiner but stand objected to as being dependent on a rejected base claim (answer, page 2).

BACKGROUND

Appellant's invention relates to a coupling device that may be used for adding a shoulder stock to a handgun. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A coupling device for interaction between an elongated object of police equipment and a handgun whose hand grip has a recess, said coupling device comprising:

a) a rigid mounting ring comprised of a sidewall of flat band configuration that defines a circular interior aperture having a center axis, circular outer wall, forward and rearward edges, and upper and lower extremities,

b) a prong attached to said upper extremity and directed forwardly of said forward edge in parallel relationship to the axis of said interior aperture, and

c) manually operable securing means interactive with said sidewall at said lower extremity to permit controlled engagement with an object disposed within said interior aperture.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Brookhyser	2,539,008	Jan. 23, 1951
Martel	5,787,630	Aug. 04, 1998

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Brookhyser. Claims 2, 3, 7, 8, 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brookhyser in view of Martel.

OPINION

We have reviewed the record, including all of the arguments advanced by the examiner and appellant in support of their respective positions. This review leads us to conclude that the examiner's § 102 rejection and § 103 rejection are well-founded. Accordingly, we will sustain the examiner's rejections for the reasons set forth in the answer and add the following for emphasis.

§ 102(b) Rejection

A prior art reference anticipates the subject matter of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) 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 what the appellants are claiming, but only that the claims on appeal "read on" something disclosed 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)).

Anticipation is a factual determination. See In re Baxter Travenol Labs., 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)). In the case before us, the examiner has determined that Brookhyser discloses, either expressly or inherently, a coupling device including a rigid mounting ring (25), prong (lug, 20) and a manually operable securing device (set screw, 28) that meets (describes) every limitation of the invention set forth in claim 1.

Appellant, on the other hand, argues (brief, page 9) that the here claimed prong does not read on the lug (20) of Brookhyser and that the lug of Brookhyser is not associated with a rigid mounting ring as required by claim 1.¹ As pointed out by the examiner (answer, pages 5 and 6), however, both the lug of Brookhyser and the claimed prong are projecting parts that appellant has not structurally distinguished on this record. We note that appellant has not furnished a special definition for the term "prong" in their specification that would suggest a structure that differs from the lug (20) taught by Brookhyser or otherwise explained in the brief how the parts differ

¹ See 37 CFR 1.192(a).

structurally. Moreover, the assertion of a functional difference by appellant at page 9 of the brief is made without identifying the claimed functional difference and without explaining how that alleged difference establishes a structural difference.

Consequently, we do not find those unsubstantiated contentions persuasive on this record.

We also agree with the examiner's rebuttal of appellant's argument that there is no association of a rigid mounting ring with the lug of Brookhyser as set forth at page 6 of the answer. Consequently, we shall sustain the examiner's § 102(b) rejection.

§ 103(a) Rejection

At the outset, we note that appellant has not separately argued the patentability of each of the claims subject to the § 103(a) rejection. Consequently, we select claim 2 as the representative claim on which we shall decide this appeal as to that rejection. See 37 CFR § 1.192(c)(7) and (c)(8)(2000).

Representative dependent claim 2 requires that the coupling device of claim 1 be of metal construction.

Appellant contests the examiner's obviousness determinations with respect to the § 103(a) rejection by repeating the rigid ring argument that was not found convincing, as discussed above. Appellant further contends, in essence, that neither Brookhyser

nor Martel is directed to steadying a handgun and that the examiner's proposed combination of such alleged non-analogous references so as to evince the obviousness of using metal material for the coupling device of Brookhyser is based on impermissible hindsight reconstruction of appellant's invention.

We do not find those arguments persuasive on this record. As tacitly acknowledged by appellant at pages 2-4 of the brief, the appealed claims before us require a narrowing amendment to render the claim 1 preamble concerning a handgun utility for the coupling more than just an intended use of the now claimed coupling.² Moreover, the test of whether a reference is from an analogous art is first, whether it is within the field of the inventor's endeavor, and second, if it is not, whether it is reasonably pertinent to the particular problem with which the inventor was involved. See In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in

² We note that the examiner's decision to deny entry of appellant's proposed amendment is not a matter within our jurisdiction to review.

considering the inventor's problem. See In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). Here, we determine that each of Brookhyser and Martel is directed to couplings for use in combination with firearms for attaching auxiliary equipment thereto. Consequently, we determine that those references represent analogous art.

In addition, we find that there would have been ample motivation for one of ordinary skill in the art to employ metal as the material of construction of the coupling device of Brookhyser based on the teachings of Martel with respect to employing aluminum or steel in constructing a ring clamping device for a firearm scope. See column 5, lines 20-25 of Martel. As noted by Martel, one of ordinary skill in the art would be motivated to employ a rugged mounting system for mounting devices to a firearm. See column 2, lines 26-33 of Martel.

It follows that we shall sustain the examiner's § 103(a) rejection on this record.

CONCLUSION

The decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) as being anticipated by Brookhyser and to reject claims 2, 3, 7, 8, 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Brookhyser in view of Martel is affirmed.

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

AFFIRMED

PETER F. KRATZ)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ROMULO H. DELMENDO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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