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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANK BOYER

Appeal 2010-010929
Application 10/800,403
Technology Center 3600

Before JOHN C. KERINS, STEVEN D.A. McCARTHY, and
MICHAEL C. ASTORINO, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claim 3. Claims 1, 2, and 4-10 have been cancelled. Br. 2. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

Claimed Subject Matter

Claim 3, reproduced below, is the sole claim on appeal.

3. A choke with integral wad stopper for use with an existing shotgun, comprising:

a hollow tubular member having a coupling at one end for concentrically securing said tubular member to a shotgun, said tubular member being defined by an internal channel having a stepwise taper running away from the coupling end to constrict shotgun pellets passing there through;

said stepwise taper being further defined by a plurality of raised annular step-projections spaced evenly along at least two-thirds a length of said channel to retard and separate wadding from behind said shotgun pellets while passing through said tubular member, wherein each of said plurality of raised annular step-projections comprises a sharp edge disposed toward said coupling end of said tubular member.

Rejections

Claim 3 is rejected under: (I) 35 U.S.C. § 112, second paragraph, as indefinite; 35 U.S.C. § 112, first paragraph, as failing to comply with (II) the written description requirement and (III) the enablement requirement; (IV) 35 U.S.C. § 102(b) as anticipated by Dow¹; (V) 35 U.S.C. § 103(a) as unpatentable over Janecek² and Catron³; (VI) under 35 U.S.C. § 103(a) as unpatentable over Briley⁴ and Janecek; and (VII) under 35 U.S.C. § 102(b) as anticipated by Linde⁵.

¹ US 2,348,114, iss. May 2, 1944.

² US 2,315,207, iss. Mar. 30, 1943.

³ US 2,372,315, iss. Mar. 27, 1945.

⁴ US 4,386,477, iss. Jun. 7, 1983.

⁵ US 4,058,925, iss. Nov. 22, 1977.

ANALYSIS

Rejections under 35 U.S.C. § 112, first and second paragraphs

Rejection I - Indefiniteness

The Examiner rejects claim 3 because the “use of the phrase 'a shotgun' [in line 3] makes the claim indefinite as to whether the previously claimed 'shotgun' [in the preamble of the claim] . . . or some other shotgun is intended.” Ans. 3. The Appellant correctly contends that the preamble “connotes that the present invention may be used with any existing shotgun” and “it is inapposite whether 'the shotgun' of the preamble is the same shotgun of line 3.” Br. 9-10.

A claim is not indefinite because it is not clear what the claim is intended to recite. A claim is indefinite when those skilled in the art would not understand what is claimed when the claim is read in light of the specification. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). In this case, as pointed out by the Appellant, the term “a shotgun” in line 3 of the claim may or may not be the same shotgun referred to in the preamble of the claim. This is a matter of breadth, not indefiniteness. *See In re Gardner*, 427 F.2d 786, 788 (CCPA 1970). Thus, the Examiner’s rejection of claim 3 under 35 U.S.C. § 112, second paragraph, is not sustained.

Rejection II – Written Description

The Examiner finds that “said stepwise taper being further defined by a plurality of raised annular step-projections spaced evenly along at least two-thirds a length of said channel,” as recited in claim 3, fails to comply with the written description requirement because the “subject matter . . . was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Ans. 3-4. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). *See also Hyatt v. Dudas*, 492 F.3d 1365, 1370 (Fed. Cir. 2007) (“When no such description can be found in the specification, the only thing the PTO can reasonably be expected to do is to point out its nonexistence.”). In this case, the Examiner finds that “‘at least 2/3 a length’ includes 2/3rds] and longer lengths up to a full length of the channel,” which is “unsupported by the application as originally filed.” Ans. 7 (citing Spec. 7, ll. 1-3).

The Appellant contends that “a plurality of raised annular step-projections spaced evenly along at least two-thirds a length of said channel,” as recited in claim 3, is amply supported since the figures clearly show and Specification describes “a plurality of raised annular step-projections spaced evenly along ‘approximately’ two-thirds a length of said channel.” *See* Br. 10. However, the claimed subject matter is broader than the Appellant’s proffered support. Although the Specification discloses “a fifth step 30e is located approximately 1 and 7/10 inches inside the input end” and choke 2 is approximately 3 inches in length (Spec. 6, 7), which is indeed approximately two-thirds a length of said channel, the claimed subject matter includes a plurality of raised annular step-projections spaced evenly along a range that extends from two-thirds the length of the channel to the entire length of the channel. *See* Ans. 7. The Appellant’s proffered support does not account for the scenario where a plurality of raised annular step-projections are spaced evenly along the entire length of the channel. *See Id.* The Specification as originally filed does not indicate possession of a range of lengths along which the plurality of raised annular step-projections are

evenly spaced as opposed to possession of a single length coincident with the lower bound of the range added to claim 3 by amendment.

Accordingly, the originally filed written description does not reasonably convey to one skilled in the relevant art that the Appellant's had possession of the claimed invention. Thus, we sustain the Examiner's rejection of claim 3 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Rejection III - Enablement

The Examiner determines that "said stepwise taper being further defined by a plurality of raised annular step-projections spaced evenly along at least two-thirds a length of said channel," as recited in claim 3, fails to comply with the enablement requirement because the originally filed written description "only has an enabling support for 'through approximately 2/3rds] the length of the choke [, i.e., channel.]'" See Ans. 4; *In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971) ("it is incumbent upon the Patent Office . . . to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement").

In this case, whether or not the plurality of raised annular step-projections are spaced evenly along approximately two-thirds the length of the channel or *at least* two-thirds the length of the channel would not affect whether or not one of ordinary skill in the relevant art would be able to make and/or use the invention. In *making* the evenly spaced plurality of raised annular step-projections there is little difference between making a shotgun choke with raised annular step-projections for approximately two-thirds the length of a channel or the entire length of a channel. In *using* the evenly

spaced plurality of raised annular step-projections the choke would function as a wad stopper and constrict shotgun pellets passing through the internal chamber regardless of whether the plurality of raised annular projections is evenly spaced between two-thirds the length or the entire length of the internal channel.

Thus, we cannot sustain the Examiner's rejection of claim 3 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a)

Rejection VI -Obviousness over Briley and Janecek

The Appellant acknowledges that Briley's device is a shotgun choke. Br. 8. In fact, Briley's patent is entitled "shotgun choke modifier and method." The Examiner finds that Briley discloses a choke including a hollow tubular member with an internal taper 10 and a coupling having an external series of screw threads 12. Ans. 5. Indeed, Briley's choke tube 10 is threaded 12, 34 into the counter bore 30 of shotgun barrel 18; the internal surface of the choke tube 10 tapers inwardly from its inner end 38 to its outer end as evidenced by angle B which forms a constriction for changing the pattern of pellets leaving the barrel. Briley, col. 1, ll. 14-17, col. 5, ll. 14-18, 47-51, fig. 6.

The Examiner also finds that Briley does not disclose, but that Janecek does disclose, "a plurality of evenly spaced steps." Ans. 5. The Examiner concludes that "[i]t would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Janecek . . . to the Briley choke and have a choke whose taper includes evenly spaced steps." Ans. 6. The Examiner explains that Janecek's Figures

2, 4, 7, and 9 depict various alternative firearm attachments encouraging the substitution one internal surface arrangement for another and that result this modification is predictable. *See* Ans. 5-6, 12.

The Appellant contends that Briley lacks a wad stopping feature and further, that the combined teachings of Briley and Janecek would not have resulted in “a choke with an integral wad stopper” as recited in claim 3. Br. 8. The Examiner responds that “the tapered section of Briley would certainly act to constrict the wad as it passed through. Whether or not it acted to stop the wad would depend upon the material and velocity [sic] of the wad as it passed through the tapered section of Briley.” Ans. 12. The Examiner also explains that Janecek’s step like knife edges 5 combined with Briley’s tapered section would further function as an internal wad stopper. *See id.*

The Appellant contends the Janecek is non-analogous art because it is not reasonably pertinent to the particular problem with which the inventor is involved. Br. 7, 8. The Appellant asserts that “[t]he particular problem pursued in the present inventor [sic] is the separation of wad from shot (wad stopper), plus the constriction of the shot pattern of shotgun pellets (choke), in a combined format.” Br. 7. Additionally, the Appellant asserts that Janecek discloses a single bullet size reducer which one would not look to as a wad stopper, a choke, or a combination thereof. *Id.* In response the Examiner reasons that “Janecek[’s device] is intended to separate a carrier portion from a projectile portion in this analogous art setting (see page 2, col. 1, lines 50-55 of Janecek)” and “[a]s such the Janecek device would separate the wad or carrier portion of the Briley shotgun shell from the projectile or shot portion of the Briley shotgun shell.” Ans. 12.

“Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Clay*, 966 F.2d 656, 658-659 (Fed. Cir. 1992). First, for the reasons provided by the Examiner, Janecek’s device is in the same field of endeavor, i.e., it includes slowing down a wad so that it will not follow behind a shot (*see Spec. 1, ll. 15-17*). Second, Janecek’s device is reasonably pertinent to the particular problem addressed by the inventor because, as discussed above, Janecek’s device may function as a wad stopper and logically it would have commended itself to an inventor’s attention in considering his problem. *See In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379-80 (Fed. Cir. 2007).

The Appellant contends that “there is no motivation, suggestion or teaching of the desirability of making the combination for Appellant’s purpose, and one skilled in the art simply would not make the combination.” Br. 8. However, the Appellant does not explain how the Examiner’s conclusion of obviousness, as discussed above, lacks rational underpinning.

The Appellant contends that the combined teachings of Briley and Janecek would not have resulted in “raised annular step-projections” because Janecek only has knife edged rings but no stepwise taper. Br. 8-9. However, the Appellant does not offer an explanation why, nor can we ascertain why, Janecek’s knife edged rings 5 do not correspond to the “raised annular step-projections” as called for by claim 3.

Thus, the rejection of claim 3 as unpatentable over Briley and Janecek is sustained.

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Rejections IV, V, and VII

Our affirmance of the rejection of claim 3 on one prior art ground specified by the Examiner, namely, under § 103(a) as unpatentable over Briley and Janecek constitutes a general affirmance of the decision of the Examiner on this claim. 37 C.F.R. § 41.50(a). We do not separately address the rejections of claim 3 under (Rejection IV) 35 U.S.C. § 102(b) as anticipated by Dow, (Rejection V) 35 U.S.C. § 103(a) as unpatentable over Janecek and Catron, and (Rejection VII) under 35 U.S.C. § 102(b) as anticipated by Linde.

DECISION

The decision of the Examiner to reject claim 3 is affirmed.

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

Klh