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THORPE NORTH & WESTERN, LLP. P.O. Box 1219 SANDY, UT 84091-1219			WEBER, JONATHAN C	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PETER HANINGTON

Appeal 2019-003095
Application 15/178,546
Technology Center 3600

Before EDWARD A. BROWN, MICHAEL L. HOELTER, and
LEE L. STEPINA, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant, Peter Hanington,¹ appeals from the Examiner's decision to reject claims 1 and 3–20.² We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter NEW GROUNDS OF REJECTION.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant is identified as the real party in interest. Appeal Br. 2.

² Claim 2 is cancelled. Appeal Br. 12 (Claims App.).

CLAIMED SUBJECT MATTER

Claim 1 is the sole independent claim and illustrates the claimed subject matter on the appeal.

1. A firearm stand for supporting, when not in use, a firearm having a magazine extending from the firearm, comprising:

a base, wherein the base is capable of resting upon a substantially horizontal resting surface and providing lateral and longitudinal stability for the firearm supported by the stand;

a coupler attached to and extending upwardly from attachment to the base when the base is resting on the resting surface and having a top; and

a cavity in the coupler adapted to receive the lower portion of the magazine extending from the firearm and within which the lower portion of the magazine extending from the firearm rests without further attachment of the magazine to the coupler when inserted into the cavity, said cavity having a top opening at the top of the coupler through which the lower portion of the magazine is removably inserted into the cavity from above the cavity, said top opening being sized and adapted to pass therethrough said lower portion of said magazine as said lower portion of said magazine is inserted into or withdrawn from the cavity through the top opening of the cavity.

Appeal Br. 12 (Claims App.).

REJECTIONS

Claims 1, 3–9, and 11–20 are rejected under 35 U.S.C. § 102(a)(1) as anticipated by “a forum post on ar15.com by username rexles” (hereinafter, “Rexles”) posted Jan. 19, 2002.

Claim 10 is rejected under 35 U.S.C. § 103 as unpatentable over Rexles.

ANALYSIS

New Ground of Rejection

Claim 1 is directed to “[a] firearm stand *for supporting, when not in use, a firearm having a magazine extending from the firearm.*” Appeal Br. 12 (Claims App. (emphasis added)). Accordingly, claim 1 is directed to a firearm stand, *not* a combination of a firearm stand *and* a firearm including a magazine. Claim 1 recites “a cavity in the coupler adapted to receive the lower portion of the magazine extending from the firearm.” *Id.* Appellant’s Specification describes, for example, that “[t]he size, shape, and orientation of cavity 18 *will depend upon the particular firearm magazine to be received by the cavity* and the particular type of firearm the coupler is to be used with,” and “[d]ifferent firearms use *different size and shaped magazines.*” Spec. ¶ 19 (emphasis added). The Specification further describes, “the coupler may be adapted for use with other types of firearms . . . and in such cases the cavity 18 in the coupler will be sized and shaped to receive and hold the lower end portion of *the particular magazine used with such other type of firearm.*” *Id.* ¶ 19 (emphasis added).

Accordingly, the Specification discloses that firearms have different sized and shaped magazines, and whether or not the cavity in the coupler is sized and shaped to receive a particular magazine will depend on the size and shape of that magazine. Claim 1 does not, however, recite any limitation relating to the type of firearm, or the size and shape of the magazine. Claim 1 does not define the shape and size of the cavity by reference to a well-defined shape and size of the magazine. Consequently, one of ordinary skill in the art would not know whether the cavity is sized and shaped to receive a magazine without also knowing the size and shape

of that magazine. That is, the ordinary artisan would not be able to tell whether there would be infringement without also having this additional information. Otherwise, it appears that an ordinary artisan would need to make separate infringement determinations for every size and shape of magazine. Based on the passages in the Specification discussed above, these determinations would likely result in non-infringing outcomes unless the magazine happened to have a certain size and shape relative to that of the cavity. We note, however:

When a proposed construction requires that an artisan make a separate infringement determination for every set of circumstances in which the composition may be used, and when such determinations are likely to result in differing outcomes (sometimes infringing and sometimes not), that construction is likely to be indefinite.

Halliburton Energy Services, Inc. v M-I LLC, 514 F.3d 1244, 1255 (Fed. Cir. 2008). Accordingly, claim 1 is unclear for this reason.

A claim is properly rejected as indefinite under 35 U.S.C. § 112(b), if, after applying the broadest reasonable interpretation in light of the specification, the metes and bounds of a claim are not clear because it “contains words or phrases whose meaning is unclear.” *See In re Packard*, 751 F.3d 1307, 1310 (Fed. Cir. 2014). Here, claim 1 contains language that has an unclear meaning. Thus, we conclude that claim 1 and its dependent claims 3–20 fail to comply with the requirements of 35 U.S.C. § 112(b). Therefore, pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection against claims 1 and 3–20 under 35 U.S.C. § 112(b).

Anticipation of Claims 1, 3–9, and 11–20 by Rexles

Obviousness of Claim 10 over Rexles

Appellant’s arguments for the patentability of claim 1 relate to the size and shape of any cavity disclosed by Rexles. *See* Appeal Br. 5–8. Appellant contends that Rexles does not disclose “a cavity in the coupler adapted to receive the lower portion of a magazine extending from the firearm,” as recited in claim 1 (*id.* at 7), or render obvious claim 1 (*id.* at 10). Having determined above, however, that claims 1 and 3–20 are indefinite because there is a lack of clarity regarding the size and shape of the recited cavity, we cannot sustain the rejections under 35 U.S.C. § 102(a)(1) or § 103, because to do so would require speculation on our part as to the scope of the claims. *See In re Aoyama*, 656 F.3d 1293, 1300 (Fed. Cir. 2011) (holding that the Board erred in affirming an anticipation rejection of indefinite claims); *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (holding that the Board erred in affirming an obviousness rejection of indefinite claims because the rejection was based on speculative assumptions as to the meaning of the claims). Thus, we do not sustain the rejection of claims 1, 3–9, and 11–20 as anticipated by Rexles, or the rejection of claim 10 as unpatentable over Rexles.³

³ It should be understood, however, that our decision is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the applied reference.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed	New Ground
1, 3-9, 11-20	§ 102(a)(1) Rexles		1, 3-9, 11-20	
10	§ 103 Rexles		10	
Overall Outcome			1, 3-20	1, 3-20

FINALITY AND RESPONSE

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(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 grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED;
37 C.F.R. 41.50(b)