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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte Taser International, Inc.

Appeal 2019-004963
Reexamination Control 90/013,945
Patent US 7,234,262 B2¹
Technology Center 3900

Before MEREDITH C. PETRAVICK, BRETT C. MARTIN, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant,² Adam R. Stephenson, appeals from the Examiner’s decision to reject claims 1–19, 21–43, and 45–47. Final Act. 2. Claims 20, 44, and 48–51 have been cancelled. App. Br. 55, 60, 61. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Issued to Patrick W. Smith on June 26, 2007 (hereinafter “the ’262 patent”)

² We use the word “Appellant” to refer to “Applicants” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Taser International, Inc. Appeal Br. 3.

Oral arguments were heard in this case on September 6, 2019 and a transcript of the hearing (“Transcript”) has been entered into the record.

We AFFIRM.

CLAIMED SUBJECT MATTER

The claims are directed to “apparatus and methods for assuring, with a high degree of certainty, that a police officer or other law enforcement agent can prevent an attacker or other violent individual from reaching and inflicting bodily harm on the police officer.” Spec., col. 1, ll. 19–24. Claim 13, reproduced below, is illustrative of the claimed subject matter:

13. An apparatus for causing involuntary contractions of skeletal muscles of a human or animal target, the apparatus comprising:
 - a circuit having a microprocessor that is
 - (1) programmed to track date and time,
 - (2) programmed to initiate a high voltage pulsed current from the circuit, and
 - (3) programmed to record tracked date and time in accordance with each initiation of the current, wherein the current launches a provided wire-tethered dart toward the target to conduct the current through the target and, when passing through the target, causes involuntary contractions of skeletal muscles of the target.

REFERENCES

The prior art relied upon by the Examiner is:

Cover	US 3,803,463	Apr. 9, 1974
Mendelsohn	US 5,502,915	Apr. 2, 1996
Murray	US 5,654,867	Aug. 5, 1997
Mangolds	US 5,750,918	May 12, 1998
Poole	US 2001/0015125 A1	Aug. 23, 2001
Smith	US 7,158,362 B1	Jan. 2, 2007

MedlinePlus Medical Encyclopedia, entry for “Types of muscle tissue.”³

REJECTIONS

Ground 1: Claims 13, 17–19, 22, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Poole, Murray, and Mendelsohn. Ans. 4.

Ground 2: Claims 1–12, 14–16, 21, 23, 24, 27–43, and 45–47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Poole, Murray, Mendelsohn, Cover, and Mangolds. Ans. 9.

Ground 3: Claims 1–19, 21–43, and 45–47 stand rejected on the ground of non-statutory double patenting as being unpatentable over claims 1–8 of Smith ’362, Poole, Murray, Mendelsohn, Cover, and Mangolds. Ans. 12.

OPINION

Appellant argues the claims as a group and focuses the arguments on claims 13 and 19, specifically the limitation in both claims regarding the

³ MEDLINEPLUS, <https://medlineplus.gov/ency/imagepages/19841.htm> (September 10, 2019).

“skeletal muscles limitation.” As both claims contain the same limitation at issue, we select claim 13 as representative and the remaining claims stand or fall with claim 13. Appellant provides three main arguments against the Examiner’s rejection. Appellant first argues that the combination of Poole, Murray, and Mendelsohn fails to disclose the “skeletal muscles limitation,” namely that the dart causes involuntary contractions of skeletal muscles of the target. App. Br. 16. Second, Appellant argues that the “combination fails to teach or suggest ‘a microprocessor’ that performs two of the claimed functions of claim 13.” *Id.* Lastly, Appellant argues that a person of ordinary skill in this art “would not have been motivated to combine these disparate references, but for the use of impermissible hindsight.” *Id.* We address each argument in turn below.

Appellant argues that none of Poole, Murray, or Mendelsohn teaches or suggests the skeletal muscles limitation. *See* App. Br. 22–27. According to Appellant, Poole and Murray both teach conducted electrical weapons, “CEWs,” that “merely provide a ‘shock,’” but do not reach the level of shock necessary to induce voluntary contractions of skeletal muscles as claimed. *Id.* at 24–25. Appellant correctly notes that the ’262 patent explicitly points out that “the failure of prior-art CEWs to satisfy this requirement motivated the Inventor to develop the claimed inventions.” *Id.* at 26 (citing ’262 patent, col. 4, ll. 23–59). Although we find this argument persuasive generally with regard to Poole and Murray, the Examiner also relies on Cover for evidence that it was known in the art how to achieve higher levels of stopping power by shocking the target with more powerful current.

Regarding Cover, Appellant first argues that the Examiner’s reliance on Cover in Ground 1 is improper because “Cover is not part of the rejection of claims 13 and 19.” App. Br. 29. Although this is true with regard to Ground 1, the Examiner also provides another ground, Ground 2, which includes Cover to teach the additional limitations recited by the dependent claims. *See* Ans. 9–11. For example, the Examiner relies upon Cover to teach the additional limitations of dependent claims 34 and 42, which specify a magnitude of voltage of the high voltage pulsed current. *See id.* at 11. Furthermore, regardless of whether Ground 1 specifically lists Cover, the Examiner has provided Appellant with notice of the teachings of Cover and Appellant has thoroughly responded to the Examiner’s inclusion of Cover throughout the Briefs. *See e.g.*, App. Br. 47 (“Independent claims 1, 6, 27, 35, and 43 would not have been obvious over the combination of Poole, Murray, Mendelsohn, Cover, and Mangolds.”). Accordingly, we consider the failure to list Cover in Ground 1 as a procedural rather than substantive argument against the Examiner’s rejections. Additionally, the Examiner does specifically include Cover in Ground 2 and so its inclusion in Ground 1 has little overall impact on our determination as to the propriety of the case as a whole.

Specifically with regard to the teachings of Cover, Appellant asserts, “Cover does not disclose a weapon that causes ‘involuntary contractions of skeletal muscles of the target,’ as required.” App. Br. 30. Appellant admits that Cover includes discussion of studies regarding the impact of various energy levels on a target, but asserts that “the operating parameters of Cover’s device fall squarely into the ranges that the Inventor of the ’262

patent determined are inadequate to meet the skeletal muscle limitation.” *Id.* at 31. Essentially, Appellant’s argument is that Cover, a CEW patent, indeed discloses that increased power delivered to the target results in increasingly severe impact, but that “Cover does not further reference these studies when describing his CEW,” and that Cover’s actual device does not achieve involuntary skeletal muscle contraction as claimed. *Id.* Appellant further notes that Cover’s device operates at around .5 joules per pulse, which is squarely within the range disclosed in the patent to be insufficient to achieve involuntary skeletal muscle contraction. *Id.*

We do not find this argument persuasive. First, we note that claim 13 recites (emphasis added) that the device is “for causing involuntary contractions of skeletal muscles of a human *or animal* target.” All of Appellant’s argument and evidence relates to the effects of devices such as Cover, Poole, and Murray on human targets, but does not offer any evidence that smaller animals or even smaller humans would not be affected by shocks delivered in the range of that of the prior art. The Examiner finds generally that Murray, as an improvement on Cover, inherently causes “involuntary contractions of skeletal muscles of a . . . target,” as recited in the claims. Ans. 18. This finding applies to any target, not just humans. As such, Appellant has essentially left un rebutted the finding that Murray inherently is capable of causing involuntary skeletal muscle contraction in animals. Additionally, when asked about this differing impact between a small animal and a human at the hearing, Patent Owner’s counsel responded, “[y]es, I think that’s probably right.” Hearing Tr. 6:11. For this reason alone we are not persuaded that the Examiner is incorrect in finding that the

combination teaches the skeletal muscle limitation at least with regard to animal targets, which again remains unrebutted by Patent Owner.

Accordingly, we are not persuaded that the Examiner improperly applied Murray in Ground 1.

Even with regard to humans, however, we are not apprised of error in the Examiner's finding that Cover teaches delivering a level of shock sufficient to meet the skeletal muscle combination. Cover, again, a CEW patent, specifically references the Dalziel and Lee study, which essentially lays out multiple levels of shock and their effects on humans. Cover, col. 1, l. 63 – col. 2, l. 14. Cover, via Dalziel and Lee, explains that at the lowest levels of magnitude, “electric currents produce a ‘shock’ and perhaps involuntary muscle movements.” *Id.* at col. 1, ll. 65–67. Cover goes on to explain that increased levels cause “increasing involuntary muscular contractions,” “loss of voluntary muscular control,” inability to “voluntarily overcome the contracting forces,” freezing a subject, and finally “serious, potentially lethal effects, including ventricular fibrillation, paralysis, asphyxia and burns.” *Id.* at col. 1, ll. 67–col. 2, l. 14. Although Cover does not specifically state that it causes involuntary muscle contractions, we consider the discussion of increasing contractions, loss of control, and freezing to sufficiently meet the skeletal muscle limitation. Even if Cover's disclosed device only achieves the lowest level of effect, we see no reason why, upon determining that the lowest level may be insufficient, one of ordinary skill in the art would not increase the power to intensify the effect.

Appellant also asserts that Cover discloses “that the delivered energy is ‘well below the levels considered dangerous’” and so cautions against

anything other than using the lowest level. App. Br. 31 (citing Cover, col. 6, ll. 17–19). We do not read this passage as cautioning against *any* increase beyond the lowest level because, as noted above, there are numerous non-harmful effects beyond a low-level shock, including involuntary skeletal muscle contraction, which is still on the lower end of the range of physiological effects disclosed in Cover. We agree that Cover cautions against reaching the highest levels where the “serious, potentially lethal effects” are implicated, but do not agree that Cover teaches away from anything above the lowest level. Cover, col. 2, ll. 11–14. Accordingly, we are not persuaded that the Examiner misapplied Cover in Ground 3.

Appellant’s second argument is that the combination fails to teach the claimed microprocessor. App. Br. 38. Appellant’s argument is that because Poole does not teach shooting darts, its microprocessor cannot teach launching those darts. *Id.* at 39–40. We disagree. As the Examiner states, “Poole teaches a CEW controlled by a microprocessor.” Ans. 13. In a device such as Poole, which launches spray instead of darts, all the microprocessor does is interpret a trigger signal and then initiates a control action to launch the spray. Ans. 4–5. Adapting these teachings to a dart device merely changes what is launched, but from the microprocessor’s end, it is essentially the same programming. At the very least, it would have been well within the ordinary skill in the art to alter a microprocessor’s programming to launch darts rather than spray. Accordingly, we do not find this argument persuasive.

Lastly, Appellant argues that the Examiner’s combination is improper, for example, because the combination “would require a complete redesign of

Poole's device and would completely change Poole's principle of operation." App. Br. 43 (citing Nerheim Dec. II, ¶ 15). Appellant takes too narrow of a view of the operation of Poole. Poole is a CEW that operates very similarly to that of Murray in that both involve launching a delivery of electrical shock to a target. Poole does so by electrifying a stream or cloud of pepper spray, whereas Murray launches tethered, electrified darts. The Examiner's combination essentially just swaps one charge/shock delivery system for another. As the Examiner states, Poole could be modified "by the teachings of Murray to include wire-tethered darts as a replacement for or augmentation of the electrified aerosol spray." Ans. 16.

Appellant also argues, "[t]he Examiner provides no explanation as to how the hypothetical weapon, having both pepper-spray and CEW capabilities, would function when the trigger is pulled." App. Br. 45. On the contrary, as noted above, the Examiner specifically states that the darts could replace the spray as the delivery system, thus, it would function essentially in the same manner as Murray. As to the combination of darts and pepper spray, Appellant also argues that combining a pepper spray device with a CEW is dangerous and one of skill in the art would avoid such a combination. Nerheim Dec. II, ¶ 18. The Examiner is correct, however, that Poole specifically teaches this combination such that "some of those skilled in the art view such a combination as desirable." Ans. 17; *id.* at 4 (citing Poole, col. 3, ll. 6–16) Most of Appellant's arguments appear to treat Poole as a CEW that has two distinct features: pepper spray and close-contact shock. Appellant does not address the fact that Poole also teaches the combined use of the spray as a delivery system for the shock, which is

analogous to a dart-fired CEW. As such, in addition to replacement, the augmentation would be to add dart functionality to the electrodes such that the device could be used both as a contact stun gun as well as a tethered dart, thus, improving the options in using Poole.

Appellant also argues that the Examiner's combination would defeat the handheld nature of Poole's device. App. Br. 44. As Appellant points out, however, Poole discloses that it is designed to be placed in a pocket *or holster* when not in use. *Id.* (citing Poole, col. 9, ll. 2–5). Both Appellant's and Murray's devices are intended to be holstered CEWs and so regardless of whether the modification might make the CEW somewhat larger, it would still clearly fall within the realm of a holsterable CEW. For the reasons stated above, we sustain all of the Examiner's rejections.

Lastly, regarding Ground 3, the Examiner rejects all pending claims based upon the ground of nonstatutory double patenting as being unpatentable over Smith '362 in view of Poole, Murray, Mendelsohn, Cover, and Mangolds. Appellant's only argument with regard to this rejection is to assert that the Examiner "relies on the reasoning and analysis from GROUNDS 1 and 2" and that the rejection should fail "for the reasons set forth above" in relation to Grounds 1 and 2. Having sustained Grounds 1 and 2, we likewise sustain Ground 3.

DECISION

The Examiner's rejections are AFFIRMED.

DECISION SUMMARY

Claims Rejected	Basis	Affirmed	Reversed
13, 17–19, 22, 25, and 26	§ 103 Poole, Murray, and Mendelsohn	13, 17–19, 22, 25, and 26	None
1–12, 14–16, 21, 23, 24, 27–43, and 45–47	§ 103 Poole, Murray, Mendelsohn, Cover, and Mangolds	1–12, 14–16, 21, 23, 24, 27–43, and 45–47	None
1–19, 21–43, and 45–47	Double Patenting – Poole, Murray, Cover, Mendelsohn, and Mangolds	1–19, 21–43, and 45–47	None

FINALITY AND RESPONSE

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

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