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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT D. GALLI and CHRISTOPHER J. O'BRIEN

Appeal 2019-005048
Application 15/787,944
Technology Center 2800

Before DONNA M. PRAISS, MICHELLE N. ANKENBRAND, and
JEFFREY R. SNAY, *Administrative Patent Judges*.

PRAISS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–4. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Emissive Energy Corporation as the real party in interest. Appeal Brief (“Appeal Br.”) filed Mar. 23, 2019, 1.

STATEMENT OF THE CASE²

The invention “relates generally to a multi-function flashlight assembly that includes an integrated weapon mounting interface making the flashlight capable of being utilized for a handgun having an accessory rail provided ahead of the trigger guard.” Spec. ¶ 2. The Specification states that prior flashlights for military applications were actuated by a user pressing a button in an axial manner. *Id.* ¶ 3. According to the Specification, this configuration was awkward and contributed to the displacement of the flashlight within its clamp. *Id.* In addition, smaller flashlight accessories for handguns typically had toggle levers that moved up and down and required a weak, awkward finger motion. *Id.* ¶ 4. In view of this, the Specification discloses a flashlight that includes at least one paddle switch that extends rearwardly of the flashlight’s body and includes a clamping assembly that mounts the flashlight to the rail of a handgun. *Id.* ¶¶ 6, 7, 13.

Claim 1, reproduced below from the Claims Appendix to the Appeal Brief, is illustrative (disputed limitation italicized).

1. A flashlight comprising:

a housing having a light source disposed at a first forward end thereof and further having a switching mechanism disposed at a second rearward end thereof, said housing having a longitudinal axis extending between said first and second ends thereof, and said housing having a recess;

² Our Decision refers to the Specification (“Spec.”) filed Oct. 19, 2017, the Final Office Action (“Final Act.”) dated May 10, 2018, the Examiner’s Answer (“Ans.”) dated Apr. 17, 2019, and Appellant’s Reply Brief (“Reply Br.”) filed June 17, 2019.

a fixed clamp arm extending longitudinally along a first side of the housing, said fixed clamp arm being fixed relative to the housing;

a movable clamp arm extending longitudinally along a second side of the housing and slidably disposed within said recess of said housing, said fixed and movable clamps cooperating to engage a dovetail mounting rail;

a spring band fixedly secured to said fixed clamp arm and extending laterally across said housing, *said spring band extending through an opening in said movable clamp to moveably retain said movable clamp within said recess such that said movable clamp can laterally move and pivot within said recess*; and

a laterally extending actuator lever seated within an external cavity in said movable clamp arm, said actuator lever including a longitudinal retaining pin wherein a second end of said spring band is received around the retaining pin to fix the second end relative to said retaining pin, said actuator lever further including an offset camming pin adjacent said retaining pin,

said cavity defining a cam follower surface wherein pivoting movement of the actuator lever causes camming action of the camming pin against the cam follower surface to move the movable clamp arm between an open position, a neutral position and a closed position.

Appeal Br. Claims Appendix i.

The remaining claims on appeal depend directly or indirectly from claim 1.

ANALYSIS

We review the appealed rejections for error based upon the issues Appellant identifies. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (*cited with approval in In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011)) (“[I]t has long been the Board’s practice to require an applicant to

identify the alleged error in the examiner’s rejections.”)). After considering the positions of both the Examiner and Appellant, we are persuaded the Examiner reversibly erred for the reasons set forth in Appellant’s briefs and discussed below.

Rejection 1: Anticipation of Claims 1, 2, and 4

The Examiner rejects claims 1, 2, and 4 under 35 U.S.C. § 102(a)(1) as anticipated by Kincaid ’255.³ Final Act. 3–6.

The Examiner finds Kincaid ’255 discloses a flashlight that includes a housing having a recess, a fixed clamp arm, a movable clamp arm, a spring band that aids in retaining the movable clamp arm within the recess such that the movable clamp arm can laterally move and pivot, and a laterally extending actuator lever. Final Act. 3–4.

Appellant contends Kincaid ’255 does not disclose a movable clamp arm that can laterally move and pivot because Kincaid ’255’s movable clamp arm 143 is pivotally connected to housing 112 via attachment pin 149, which prevents lateral movement. Appeal Br. 3–4. Appellant asserts that interpreting Kincaid ’255’s movable clamp arm 143’s pivoting movement as including both lateral movement and pivoting essentially renders the limitation “laterally move” superfluous and does not give full effect to all claim terms. *Id.* at 4–5.

The Examiner responds by finding Kincaid ’255’s secondary locking arm 143 functions as a movable clamp arm that laterally moves and pivots between the positions shown in Kincaid ’255’s Figures 6A and 6B. Ans. 3–4. The Examiner specifically finds “movable clamp (143) pivots about the pivot point (149/150), and in doing so, the movable clamp (143) also moves

³ US 7,735,255 B1, issued June 15, 2010 (“Kincaid ’255”).

laterally (i.e. situated on, directed toward, or coming from the side, [Merriam-Webster]) within said recess with respect to said longitudinal axis of the housing.” *Id.* at 4. The Examiner determines Appellant’s claim 1 does not preclude movement restricted about a pin and finds Kincaid ’255’s attachment pin 149 does not “limit[] the motion of the movable clamp arm to strictly pivoting only.” *Id.* at 5–6. The Examiner states that the rejection over Kincaid ’255 “[does] not equate ‘pivoting’ to ‘lateral motion’” but, rather, is based on the finding that “lateral movement simply implies that a device is moving to the side with respect to a reference point or object, and not that the object is moving linearly.” *Id.* at 7 (emphasis omitted). The Examiner finds “two effects of the motion of” Kincaid ’255’s movable clamp arm 143 based on this understanding of “lateral movement.” *Id.*

Appellant’s arguments are persuasive of harmful error. Kincaid ’255’s Figures 6A and 6B are reproduced below.

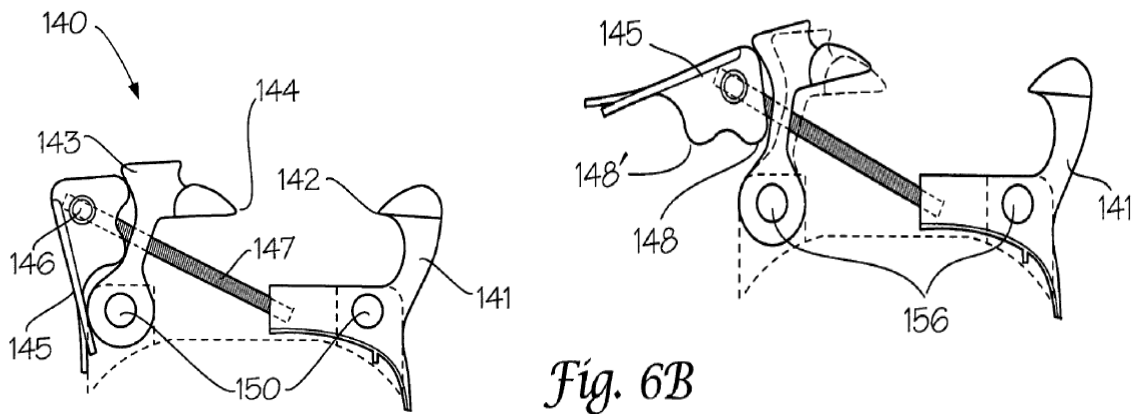


Fig. 6A

Fig. 6B

Figure 6A is a front view of Kincaid ’255’s adjustable accessory mounting clamp and Figure 6B depicts the adjustable accessory mounting clamp in an open position. Kincaid ’255, 3:31–39.

Figure 6A shows adjustable accessory mounting clamp 140 including primary locking arm 141, secondary locking arm 143, cam lever 145, and threaded adjustment rod 147. Kincaid '255, 11:47–48, 11:57–60. Primary locking arm 141 includes primary locking claw 142 and secondary locking arm 143 includes secondary locking claw 144. *Id.* at 11:61–64. Kincaid '255 discloses primary locking arm 141 is fixed “while the secondary locking arm 143 is maintained in a pivotable position relative to the light body 112 and the primary locking arm 141.” *Id.* at 11:65–12:2. Clamp attachment pins 149 are received in apertures 150 to removably couple accessory mounting clamp 140 to light body 112. *Id.* at 12:47–54.

Kincaid '255 discloses that when cam lever 145 is moved to an open position, as shown in Figure 6B, “the secondary locking claw 144 is pivoted away from the primary locking claw 142” and when cam lever 145 is moved to a closed position, as shown in Figure 6A, “the secondary locking claw 144 is pivoted towards the primary locking claw 142.” Kincaid '255, 12:18–22. Kincaid '255 thus teaches secondary locking arm 143 pivots. Figures 6A and 6B indicate pivoting occurs about receiving aperture 150, through which clamp attachment pin 149 couples adjustable mounting clamp 140 to the body of a flashlight. *Id.* at 12:47–54. The cited record in this appeal does not support the Examiner’s finding (Ans. 7) that Kincaid '255’s moveable clamp arm has “two effects” of movement, both “pivoting” and “lateral movement.” The Examiner directs us to Kincaid '255’s Figures 3A and 3B as suggesting secondary locking arm 143 is capable of lateral movement because it moves to the side to attach and detach from the firearm. Ans. 7. Figures 3A and 3B are shown below.

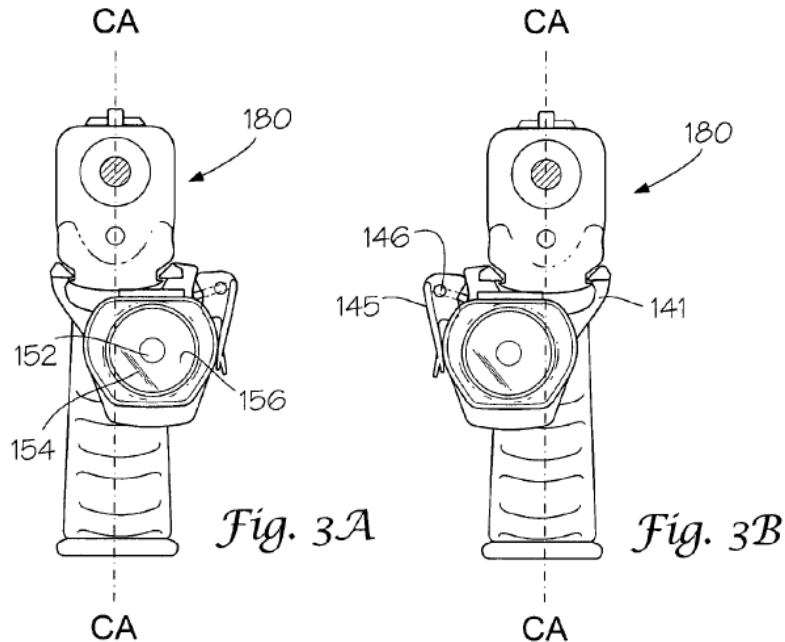


Figure 3A shows a front elevational view of an offset mountable light mounted to a handgun for a left side application and Figure 3B is a front elevation view of an offset mountable light mounted to a handgun for a right side application. Kincaid '255, 3:1–8. Based on Kincaid '255's description of Figures 3A and 3B as two separate applications of the invention for a right or left side configuration of the light attachment, these figures do not show lateral movement to the side of Kincaid '255's clamp arm 143. Therefore, the record does not support the Examiner's finding that Kincaid '255's clamp arm 143 is capable of moving laterally.

Kincaid '255's disclosure, as discussed above, also does not support the Examiner's finding that "movable clamp (143) pivots about the pivot point 149/150, and in doing so, the movable clamp (143) also moves laterally . . . with respect to a reference point or give[n] object." Ans. 7. It is also harmful error to the extent that it does not give full effect to all of terms recited in claim 1, specifically "said movable clamp can laterally move and pivot within said recess." In other words, claim 1 requires that the

movable clamp is capable of both laterally moving and pivoting. As Appellant argues, the Examiner's position (Ans. 5) that pivot motion alone encompasses lateral movement renders the language "laterally move" superfluous.

In view of the above and for the reasons provided in the Appeal Brief and the Reply Brief, we reverse the Examiner's rejection of claim 1 over Kincaid '255. We also reverse the Examiner's rejection of claims 2 and 4, which depend from claim 1, for the same reasons.

Rejection 2: Anticipation of Claims 1–4

The Examiner rejects claims 1–4 under 35 U.S.C. § 102(a)(1) as being anticipated by Kincaid '355.⁴ Final Act. 6–9.

The Examiner finds Kincaid '355 discloses a flashlight that includes a housing having a recess, a fixed clamp arm, a movable clamp arm, a spring band that aids in retaining the movable clamp arm within the recess such that the movable clamp arm can laterally move and pivot, and a laterally extending actuator lever, as claim 1 recites. *Id.* at 6–8 (annotating Kincaid '355's Figure 12B).

Similar to the rejection of claim 1 over Kincaid '255, Appellant contends Kincaid '355 does not disclose a movable clamp arm that both laterally moves and pivots. Appeal Br. 7–8. Appellant also argues that interpreting the pivoting movement of Kincaid '355's movable clamp arm as including both lateral movement and pivoting essentially renders the limitation "laterally move" superfluous and does not give full effect to all claim terms. *Id.*

⁴ US 8,132,355 B1, issued Mar. 13, 2012 ("Kincaid '355").

Appellant's arguments are persuasive of harmful error for reasons similar to those discussed above with regard to the rejection over Kincaid '255. Kincaid '355's Figure 12B is reproduced below.

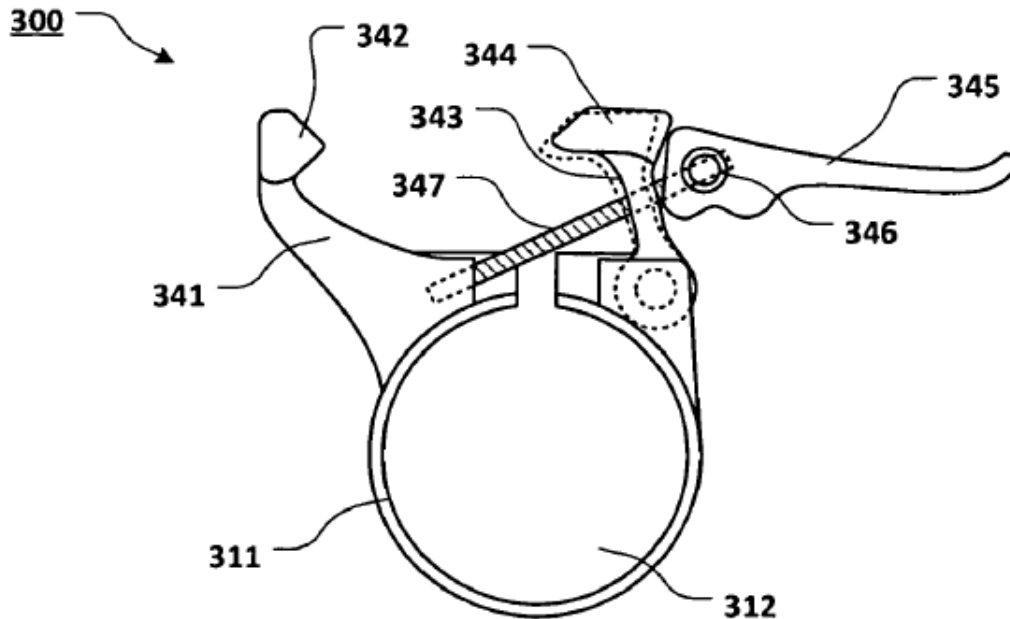


FIG. 12B

Figure 12B is a front view of an adjustable accessory mounting clamp in an open position. See Kincaid '355, 4:18–22.

Figure 12B shows adjustable accessory mounting clamp 300 including accessory band 311 (which forms accessory aperture 312), primary locking arm 341, secondary locking arm 343, cam lever 345, and threaded adjustment rod 347. Kincaid '355, 20:8–10, 20:24–28. Similar to Kincaid '255's locking arm, Kincaid '355 discloses that its secondary locking arm 343 pivots. *Id.* at 20:33–38 (“secondary locking arm 343 is maintained in a pivotable position relative to the accessory band 311 and the primary locking arm 341”).

Although Kincaid '355's clamp embodiment differs from Kincaid '255's clamp, the Examiner responds to Appellant's arguments in a similar manner. Specifically, the Examiner finds Kincaid '355's "movable clamp (343) pivots about a pivot point at a base portion thereof, and in doing so, the movable clamp (343) also moves laterally" and "a pivoting motion can encompass, or otherwise cause, an object to move laterally with respect to a reference point or object." Ans. 13–16. The Examiner's position that the pivoting motion of Kincaid '355's secondary locking arm 343 includes lateral movement, however, does not give full effect to all of the terms of claim 1, which recites that "said movable clamp can laterally move and pivot within said recess." Stated differently, the Examiner's position renders the claim language "laterally move" superfluous.

In addition, we agree with Appellant that the Examiner has not identified a recess of a flashlight's housing in which the movable clamp arm is slidably disposed as claim 1 requires, because Figure 12B only depicts Kincaid '355's adjustable accessory mounting clamp 300. Appeal Br. 7; Final Act. 8; Ans. 12; Kincaid '355, 20:8–10. Adjustable accessory mounting clamp 300 is attached to an accessory, such as the flashlight depicted in Figure 13A. Kincaid '355, 4:23–25, 21:4–11.

In view of the above, and for the reasons provided in the Appeal Brief and the Reply Brief, we reverse the Examiner's rejection of claim 1 over Kincaid '355. We also reverse the Examiner's rejection of claims 2–4, which depend from claim 1, for the same reasons.

Rejection 3: Obviousness of Claim 3

The Examiner rejects claim 3 under 35 U.S.C. § 103 as unpatentable over Kincaid '255 in view of Kincaid '355. Final Act. 9–10.

The Examiner's obviousness rationale for the rejection of claim 3 does not cure the deficiencies discussed above with regard to the § 102 rejection of claim 1 over Kincaid '255. Therefore, we do not sustain the Examiner's rejection of claim 3 under § 103.

CONCLUSION

For these reasons and those the Appellant provides, we reverse the Examiner's rejections of claims 1–4 under 35 U.S.C. §§ 102(a)(1) and 103.

DECISION SUMMARY

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 4	102(a)(1)	Kincaid '255		1, 2, 4
1–4	102(a)(1)	Kincaid '355		1–4
3	103	Kincaid '255, Kincaid '355		3
Overall Outcome				1–4

REVERSED