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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/049,698	02/22/2016	Faisal Kedairy	07022 - P0020B	8014
131672	7590	08/28/2020	EXAMINER	
Whitmyer IP Group LLC 600 Summer Street 3rd Floor Stamford, CT 06901			WEBER, JONATHAN C	
			ART UNIT	PAPER NUMBER
			3641	
			MAIL DATE	DELIVERY MODE
			08/28/2020	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FAISAL KEDAIRY

Appeal 2019-005218
Application 15/049,698
Technology Center 3600

Before JENNIFER D. BAHR, MICHAEL J. FITZPATRICK, and
WILLIAM A. CAPP, *Administrative Patent Judges*.

Opinion for the Board filed by FITZPATRICK, *Administrative Patent Judge*

Opinion Concurring filed by CAPP, *Administrative Patent Judge*

FITZPATRICK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant, Skychase Holdings Corporation,¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s final decision rejecting claims 25–45. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held August 18, 2020. A transcript of the hearing will be entered in due course.

We affirm in part.

¹ “Appellant” refers to the applicant as defined in 37 C.F.R. § 1.42. Appellant identifies itself as the sole real party in interest. Appeal Br. 2.

STATEMENT OF THE CASE

The Specification

The Specification “pertains to a firearm cartridge” and describes “an improved .30 caliber cartridge that overcomes the limitations of the prior art.” Spec. ¶3.

The Claims

Claims 25–45 are rejected. Final Act. 1. Claims 1–24 are cancelled, and no other claims are pending. Appeal Br. 20. Claims 25, 43, and 44 are independent. *Id.* at 20–25. Claim 25 is illustrative of the claimed subject matter on appeal and is reproduced below.

25. A firearm cartridge configured for employment by a center fire pistol, the firearm cartridge comprising:

[a] a bullet having a bullet diameter greater than or equal to 7.45 mm and less than or equal to 7.74 mm;

[b] a case having a head having a rim, the case having a body extending from the head to a tapered shoulder, the body having a body diameter at the tapered shoulder, the case having a neck extending from the tapered shoulder and defining a mouth retaining the bullet, the case containing a primer pocket linked to a powder chamber through a flash hole, the powder chamber having a powder chamber length extending from a center of the flash hole through the tapered shoulder to the neck;

[c] wherein the body diameter divided by the bullet diameter is greater than or equal to 1.372 and less than or equal to 1.428;

[d] wherein the powder chamber length is greater than or equal to 19.57 mm and less than or equal to 20.37 mm; and

[e] wherein the powder chamber length divided by the bullet diameter is greater than or equal to 2.548 and less than or equal to 2.652.

Appeal Br. 20 (bracketed letters substituting for bullets).

The Examiner's Rejections

The rejections before us are:

1. claim 25 under 35 U.S.C. § 112(a) as lacking an adequate written description (Final Act. 4);
2. claim 43 under 35 U.S.C. § 112(a) as lacking an adequate written description (*id.* at 6);
3. claim 44 under 35 U.S.C. § 112(a) as lacking an adequate written description (*id.*); and
4. claims 25–45 under 35 U.S.C. § 103 as unpatentable over Dutch² (*id.* at 7).

DISCUSSION

Rejections 1–3 (Written Description)

Section 112(a) states the following:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

35 U.S.C. § 112(a).

The Examiner's rejections are based on the written description, not the enablement, requirement of § 112(a). Final Act. 4–6; *see also Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1344 (Fed. Cir. 2010) (en banc) (holding that the written description of the invention and enablement

² US 2011/0214583 A1, published Sept. 8, 2011 (“Dutch”).

of the invention are separate requirements of identically-worded predecessor statute, 35 U.S.C. § 112 ¶(1).

Whether the Specification contains a written description of the claims is a question of fact. *Ariad Pharms.*, 598 F.3d at 1355. Specifically, the question asks “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* at 1351.

Claim 25 (Rejection 1)

The Examiner found that two limitations of claim 25—namely, those we above labeled [d] and [e]—lack an adequate written description in the Specification. Final Act. 4. Our decision turns on limitation [e], which recites “wherein the powder chamber length divided by the bullet diameter is greater than or equal to 2.548 and less than or equal to 2.652.”

Appellant does not assert that the Specification includes *in haec verba* support for the limitation. Appeal Br. 5–7. In fact, in arguing against the rejection, Appellant does not even mention “bullet diameter.” *Id.* In the “Summary of Claimed Subject Matter,” however, the Appeal Brief cites Figures 1–2 and paragraphs 24 and 27 as providing support for the limitation. *Id.* at 3.

Figures 1 and 2 disclose a powder chamber length of 19.57–20.37 mm and a bullet diameter range of 7.45–7.86 mm. Spec., Fig. 1 (1, 2, 11), Fig. 2 (same), ¶24 (“indicated in the figures are the bullet (1) with a diameter of 7.45 to 7.86 mm”).³ But claim 25 explicitly recites a different range for the

³ The recited range of powder chamber length is disclosed in Figures 1 and 2 *indirectly*, as argued by Appellant, as the maximum and minimum differences between 23.60 +/- 0.2 mm and 3.63 +/- 0.2 mm. Appeal Br. 6.

bullet diameter: “a bullet having a bullet diameter greater than or equal to 7.45 mm and less than or equal to 7.74 mm.” Thus, it is those values that must be used.

Dividing the minimum and maximum values of the powder chamber length (19.57 mm and 20.37 mm) by each of the minimum and maximum values of the recited bullet diameter (7.45 mm and 7.74 mm) fails to result in either “2.548” or “2.652,” which are recited in the claim. More specifically, $19.57 \div 7.45 = 2.627$; $19.57 \div 7.74 = 2.528$; $20.37 \div 7.45 = 2.734$; and $20.37 \div 7.74 = 2.632$.

“In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.” *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). However, the law does require that the Specification as filed convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention, as now claimed. *Id.* at 1323. The Specification does not meet this standard with respect to limitation [e].

Appellant has not persuaded us of error in the Examiner’s finding that the Specification lacks an adequate written description of the last recited limitation of claim 25. Accordingly, we affirm the rejection of claim 25 under 35 U.S.C. § 112(a).

Claim 43 (Rejection 2)

The Examiner found that the Specification lacks an adequate written description of “the powder chamber length divided by the shoulder angle is greater than or equal to 0.61 and less than or equal to 0.73,” as recited in claim 43. Final Act. 6.

In the “Summary of Claimed Subject Matter,” the Appeal Brief cites Figures 1–2 and paragraphs 26 and 28 as providing support for the limitation. Appeal Br. 4. However, none of those figures or paragraphs discloses shoulder angle(s). *See* Spec. Figs. 1–2, ¶¶26, 28. Based on our own independent review of the Specification as filed, we find only a single reference to “shoulder angle.” *See* Spec. ¶13 (“The present invention has optimized the powder capacity to chamber pressure ratio by having the optimal case geometry and shoulder angle in relation to projectile weight and caliber ratio, thus giving this cartridge case the ability of attaining velocities that significantly exceed those of the prior art while achieving higher external ballistics results, in addition to terminal ballistics due to the higher sectional densities of the projectiles that can be used in this cartridge.”). That general reference to “shoulder angle” does not provide adequate support for the limitation in question.

Appellant has not persuaded us of error in the Examiner’s finding that the Specification lacks an adequate written description of the last recited limitation of claim 43. Accordingly, we affirm the rejection of claim 43 under 35 U.S.C. § 112(a).

Claim 44 (Rejection 3)

The Examiner found that the Specification lacks an adequate written description of, among other things, “the powder chamber length divided by the shoulder angle is greater than or equal to 0.61 and less than or equal to 0.73,” as recited in claim 44. Final Act. 6. As with the same limitation recited in claim 43 and for reasons already discussed above, we affirm the rejection of claim 44 under 35 U.S.C. § 112(a).

Rejection 4 (Obviousness)

The Examiner determined that claims 25–45 would have been obvious over Dutch and accordingly rejected them under 35 U.S.C. § 103. Final Act. 7.

Claims 25–41 and 45

Appellant argues the rejection of claims 25–42 and 45 together. Appeal Br. 7–19. We choose claim 25 as representative of claims 25–41 and 45 (*see* 37 C.F.R. § 41.37(c)(1)(iv)), and we exercise our discretion to treat claim 42 separately as discussed below.

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Graham v. John Deere Co., 383 U.S. 1, 17–18 (1966).

The Examiner found that Dutch discloses a firearm cartridge configured for employment by a center fire pistol. Final Act. 7 (citing Dutch generally and specifically citing its title and paragraph 152). The Examiner found that Dutch teaches or suggests all of the limitations of claim 25, albeit not as arranged in the claim. *Id.* at 7–9.

For example, the Examiner found that, although Dutch discloses a bullet having a diameter of 7.62 mm, which is squarely within the recited range of 7.45–7.74 mm, “Dutch does not directly disclose a cartridge”

within the scope of claim 25 with such a bullet. Final Act. 7. The Examiner continued:

However, Dutch discloses that there are numerous alternative example embodiments that are conceived within the teachings of the specification and that known projectile sizes can be used in the invention (See at least Paragraph 212). Throughout the [Dutch] specification a 7.62 mm projectile is mentioned, therefore, the examiner asserts that it would have been obvious to utilize a projectile having a diameter of 7.62 mm within the identified cartridge assemblies with a reasonable expectation of success, since such a bullet diameter is within the specific ranges identified in Table 1 and close to the ranges that are disclosed in Paragraphs 0121 & 0153-0169. The suggestion/motivation for doing so would have been to allow the cartridge system to include a wider variety of projectiles as is consistent with the teachings of Dutch.

Id. at 7–8.

Appellant argues that Dutch fails to teach “[a] firearm cartridge configured for employment by a center fire pistol, the firearm cartridge comprising: ... a case having a head having a rim, the case having a body extending from the head to a tapered shoulder, ... the case having a neck extending from the tapered shoulder.” Appeal Br. 9 (quoting claim 25 (Appellant’s ellipses)). Appellant concedes that Dutch discloses a cartridge for use in pistols and also a cartridge having a case with a tapered shoulder. *See id.* at 10 (“Dutch clearly teaches that its system includes *both rifle cartridges (bottlenecked) and pistol cartridges (straight-walled)*, such as shown in FIGS. 3, 4, and 23.”), 11 (“Dutch only teaches that the rifle cartridges are bottlenecked and thus have a tapered shoulder.”). But Appellant emphasizes that Dutch describes different characteristics for pistol and rifle cartridges and only discloses tapered shoulders in the context of rifle cartridges. *Id.* at 9–11.

Appellant's argument does not apprise us of error. The Examiner's rejection is not premised on Dutch teaching a pistol cartridge having a case with a tapered shoulder. Rather, it is based on the obviousness of adapting a cartridge having a tapered shoulder for use with a 7.62 mm bullet. *See* Final Act. 7–8. Appellant's arguments do not rebut the Examiner's findings regarding what Dutch *suggests* and what a person of ordinary skill in the art would have been *motivated* to do in view of Dutch's teachings.

Appellant next argues that Dutch fails to teach, in the context of a pistol cartridge, “wherein the body diameter divided by the bullet diameter is greater than or equal to 1.372 and less than or equal to 1.428,” as recited by claim 25. Appeal Br. 11. The Examiner found that Dutch teaches a body diameter of about 0.411 to 0.438 inches. Final Act. 8 (citing Dutch ¶110). Dividing each of those values by 0.3 inches (~7.62mm) results, respectively, in minimum and maximum values of 1.37 and 1.46, which range overlaps substantially with the recited range.

Appellant argues for using different, smaller bullet diameters in the calculations. Appeal Br. 11–13. Appellant's argument is premised on the fact that “Dutch does not teach the bullet diameter is 7.62 mm.” *Id.* at 11. However, as already discussed, Appellant has not apprised us of error in the Examiner's determination that “it would have been obvious to utilize a projectile having a diameter of 7.62 mm within the identified cartridge assemblies with a reasonable expectation of success.” Final Act. 7. And, utilizing a 7.62 mm (0.3 inches) bullet, the Examiner has shown how this additional limitation is met by Dutch.

Finally, Appellant argues that evidence of secondary considerations is probative of non-obviousness of the claims. Appeal Br. 15. Appellant

argues that such evidence “must be considered in any obviousness analysis.” *Id.* However, “to be accorded substantial weight in the obviousness analysis, the evidence of secondary considerations must have a ‘nexus’ to the claims, *i.e.*, there must be ‘a legally and factually sufficient connection’ between the evidence and the patented invention.” *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1332 (Fed. Cir. 2019). Appellant bears the burden of proving nexus. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995) (“For objective evidence to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the claimed invention.”); *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988) (“The burden of proof as to this connection or nexus resides with the patentee.”). Appellant does not meet, or even attempt to meet, this burden. Appeal Br. 15–19.⁴

For example, Appellant asserts that its “*invention* has received predominant praise from professionals in the industry.” Appeal Br. 15 (emphasis added). But, on its face, the evidence presented relates—as such evidence typically does—to products, and not to the claimed invention *per se*. We acknowledge that Appellant refers to the product at issue as “the *claimed* cartridge designated 7.5FK.” *Id.* (emphasis added). However, even if we were to presume that claim 25, for example, reads on the 7.5FK cartridge in view of Appellant’s characterization of it as “the claimed cartridge designated 7.5FK,” nexus would still not be established.

⁴ Appellant belatedly addresses the concept of “nexus” in its Reply Brief, but even there it fails to *show* nexus. *See* Reply Br. 12; *see also* 37 C.F.R. § 41.41(b) (barring new arguments in a reply brief absent limited circumstances not present here).

Nexus can be established in one of two ways, neither of which Appellant has done here.

First, “a patentee is entitled to a rebuttable presumption of nexus between the asserted evidence of secondary considerations and a patent claim if the patentee shows that the asserted evidence is tied to a specific product and that the product ‘is the invention disclosed and claimed.’” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019) (quoting *Demaco*, 851 F.2d at 1392). “That is, presuming nexus is appropriate ‘when the patentee shows that the asserted objective evidence is tied to a specific product and that product [1] ‘embodies the claimed features, and [2] is coextensive with them.’” *Id.* (quoting *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018)). Thus, there are two requirements; it is not enough that a product be “claimed” as Appellant asserts the 7.5FK cartridge to be. *See, e.g., Fox Factory*, 944 F.3d at 1373 (“We have reaffirmed the importance of the ‘coextensiveness’ requirement in subsequent opinions.”); *see also Fox Factory, Inc. v. SRAM, LLC*, 813 F. App’x 539, 542 (Fed. Cir. 2020) (“[W]e reaffirmed in [the first *Fox Factory*, (944 F.3d 1366)] that a product is not coextensive with a claimed invention simply because it falls within the scope of the claim.”).

Here, Appellant merely asserts that the 7.5FK cartridge is “claimed” without specifying which claim(s) purportedly cover the cartridge. Appeal Br. 15. Further, Appellant does not assert, let alone show, that the cartridge is coextensive with any of the rejected claims. *Id.* at 15–19. More specifically, Appellant has not shown that the 7.5FK cartridge lacks any significant yet unclaimed features. *See Fox Factory*, 944 F.3d at 1374 (“To be sure, we have never held that the existence of one or more unclaimed

features, standing alone, means nexus may not be presumed. . . . Thus, if the unclaimed features amount to nothing more than additional insignificant features, presuming nexus may nevertheless be appropriate.”). Accordingly, Appellant is not entitled to a presumption of nexus with respect to its secondary considerations evidence.

The second way to prove nexus is directly, by showing that the presented evidence of secondary considerations is “a direct result of the unique characteristics of the claimed invention.” *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996); *Fox Factory*, 944 F.3d at 1373–74 (“A finding that a presumption of nexus is inappropriate does not end the inquiry into secondary considerations. To the contrary, the patent owner is still afforded an opportunity to prove nexus by showing that the evidence of secondary considerations is the direct result of the unique characteristics of the claimed invention.” (quotation marks and citation omitted)). Appellant has not made a showing in this regard either. Appeal Br. 15–19.

The need for a nexus between the claimed invention and the secondary considerations evidence is particularly evident in a case such as this one where the claimed invention is a combination of prior art features, all of which were known in the art, and indeed in the same reference (Dutch). *See Fox Factory*, 944 F.3d at 1378, providing:

[Patentee] bear[s] the burden of proving that the evidence of secondary considerations is attributable to the claimed combination of wide and narrow teeth with inboard or outboard offset teeth, as opposed to, for example, prior art features in isolation or unclaimed features. *See, e.g., Ethicon Endo-Surgery, Inc. v. Covidien LP*, 812 F.3d 1023, 1034 (Fed. Cir. 2016) (for patent claims covering a combination of prior art features, to establish nexus, patentee must show that the evidence of secondary considerations is attributable to “the combination of

the two prior art features ... that is the purportedly inventive aspect of the [challenged] patent” as opposed to unclaimed features or either prior art feature in isolation).

944 F.3d at 1378.

In the instant case, for example, one of Appellant’s evidentiary offerings of secondary considerations is an article published in the *American Rifleman* magazine. See “Attachment N” (filed as part of a Supplemental Response filed January 2, 2019 and cited by named inventor Faisal Kedairy’s declaration filed December 28, 2018). However, the article is directed to the FK BRNO Field Pistol much more so than it is about the ammunition that it shoots. *Id.* The article concedes that FK BRNO Field Pistol is largely derivative of the popular, prior art CZ 75 firearm. *Id.* Having read the article, it is difficult to conclude that it provides much, if any, industry praise for the ammunition apart from praise for the firearm that shoots it. Thus, Appellant fails to furnish a nexus between the alleged industry praise and claimed ammunition.

In view of Appellant’s failure to show nexus, its secondary considerations evidence is not accorded substantial weight. *Henny Penny*, 938 F.3d at 1332. We nonetheless address each category of evidence offered by Appellant.

Commercial Success

Appellant argues that “[t]he 4/30/2018 Declaration provided evidence of such commercial success.” Appeal Br. 18. As Appellant further refers to the declaration as “Ex. E” (*see id.*), we understand Appellant to be relying on a different declaration by named inventor Faisal Kedairy, which was filed October 9, 2018, and labelled Exhibit E by the Appeal Brief. *See id.* at 27 (Appellant’s Evidence Appendix not listing a “4/30/2018 Declaration” but

listing a “10-9-2018 Declaration” as Exhibit E). In particular, Appellant relies on paragraphs 18–20 of the Declaration (*see id.* at 18), which state:

18. My company, Skychase Holdings Corp. (herein “SCH”), has been able to commercialize the firearm cartridge based on the claimed device. For example, my company has executed multiple license agreements with groups across the world. As proof, Attachments D, E, F, G, & H are license agreements that SCH has with FK BRNO Ammunition, FK BRNO Engineering, Blackwater Ammunition, Fratelli Tanfoglio S.N.C., and Sabatti s.p.a. S.N.C. In each agreement, SCH provides cartridge case design, tooling design, bullet design, and load formulation, while the licensee implements the technological package into its manufacturing and production system to produce ammunition and/or firearms in caliber 7.5FK.

19. My company has and continues to enjoy commercial success of the 7.5FK and 7.5 FK Short. FK BRNO is the main producer of the 7.5FK caliber and corresponding pistol and has sold them to several military forces and police forces around the world. The 7.5FK caliber and corresponding pistol have been evaluated in test labs in at least seven countries and used in combat in at least four conflict zones.

20. FK BRNO is currently bound by Non-Disclosure Agreement with all of its customers and is therefore under obligation not to disclose the number of products sold or the identities of its clients to any party outside the Ministry of Foreign Affairs of the Czech Republic. With that said, Attachments I, J, K, L, & M are documents showing test samples of the 7.5FK caliber and/or 7.5FK Field Pistol being exported to 3 such forces and orders from 2 major commercial clients in the United States. It is noted that these documents pre-date the Non-Disclosure Agreement signed by FK BRNO.

Oct. 9, 2018, Decl. ¶¶18–20.

This evidence includes vague statements (e.g., that the product has been “sold . . . to several military forces and police forces around the world” and “used in combat in at least four conflict zones”), explicitly withholds

relevant evidence pursuant to non-disclosure agreements into which it has voluntarily entered, and lacks any meaningful context from which the alleged commercial success can be adjudicated. The Federal Circuit has previously characterized similarly presented evidence as weak.

Huang has simply not provided sufficient information upon which the PTO could determine whether the grips were commercially successful. Although Huang's affidavit certainly indicates that many units have been sold, it provides no indication of whether this represents a substantial quantity in this market. This court has noted in the past that evidence related solely to the number of units sold provides a very weak showing of commercial success, if any. *See Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026–27, 226 USPQ 881, 888 (Fed.Cir.1985) (finding that sales of 5 million units represent a minimal showing of commercial success because “[w]ithout further economic evidence ... it would be improper to infer that the reported sales represent a substantial share of any definable market”); *see also In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed.Cir.1991) (“[I]nformation solely on numbers of units sold is insufficient to establish commercial success.”).

Huang, 100 F.3d at 140.

Appellant's evidence of commercial success is weak. More importantly, it has not been shown to bear a nexus to any of the rejected claims.

Long Felt Unresolved Need

For this category of secondary considerations evidence, Appellant again erroneously cites to “the 4/30/2018 Declaration.” Appeal Br. 18. We again presume Appellant intended to cite to the October 9, 2018, Declaration. Appellant argues:

Mr. Kediary [sic] states that within the firearm industry and specifically the military, there are two long felt but unmet needs.

In particular, “there has been a long-felt but unresolved need for a pistol that optimizes propellant combustion without substantially increasing the size of the cartridge case and supports a heavier for caliber projectiles thus increasing sectional density and subsequently ballistic coefficient to attain higher velocity, longer range accuracy and effectiveness. There has also been a long-felt but unresolved need for a cartridge that is short enough to fit in an automatic pistol’s magazine and achieves ballistics which closely resemble that of a rifle carbine.”

Id. (presumably quoting Oct. 9, 2018, Decl. ¶3). Paragraph 3 of Mr. Kedairy’s Declaration, in turn, cites exclusively to the Specification as support. In other words, no citation is provided to any evidence that is not derived from the inventor himself. In any event, Appellant never identifies any previous but failed attempts to solve the purported problem, which is fatal. *See Texas Instruments Inc. v. U.S. Int’l Trade Comm’n*, 988 F.2d 1165, 1178 (Fed. Cir. 1993) (“[L]ong-felt need is analyzed as of the date of an articulated identified *problem and evidence of efforts to solve that problem.*” (emphasis added)).

Appellant’s evidence of long felt but unresolved need is weak. More importantly, it has not been shown to bear a nexus to any the rejected claims.

Industry Praise

For this category of secondary considerations evidence, Appellant relies on a different declaration by Mr. Kedairy, filed December 28, 2018. Appeal Br. 15 (citing Ex. B). Appellant argues that “the claimed cartridge has received industry praise for achieving ballistics that closely resemble a rifle carbine and thus ‘blur the lines between what handguns and rifles are capable of.’” *Id.* (quoting Dec. 28, 2018, Decl. ¶8). Appellant provides examples of the praise. *Id.* at 15–17.

It is generally true that industry praise may support an assertion that an invention is non-obvious. *See, e.g., WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1334 (Fed. Cir. 2016) (“Evidence that the industry praised a claimed invention or a product which embodies the patent claims weighs against an assertion that the same claim would have been obvious.”). However, Appellant’s evidence in the instant case needs to be evaluated in the context of which it is offered. “Industry participants, *especially competitors*, are not likely to praise an obvious advance over the known art.” *Id.* (emphasis added). Furthermore, industry praise may be considered probative as to what a person of ordinary skill in the art “would not have reasonably expected” from the claimed invention. *Institut Pasteur & Universite Pierre Et Marie Curie v. Focarino*, 738 F.3d 1337, 1347 (Fed. Cir. 2013). Here, the industry praise does not come from competitors, nor is it anything that a skilled artisan would not have reasonably expected.

In the instant case, the primary source of industry praise relied on by Appellant is a trade journal published by the National Rifle Association (“NRA”). Appeal Br. 15. The NRA is a well-known advocate for the rights of gun owners as well as a powerful lobbying force for the gun industry in the United States. A new product launch of almost any kind provides good copy to fill the pages of the NRA’s industry specific periodical. As long as the 7.5 FK cartridge and associated FK BRNO Field Pistol are functional, the only thing that would be surprising is if the NRA periodical did not give favorable press to a new product launch. In other words, it is entirely expected that the NRA would be willing to praise an obvious advance over the known art. *WBIP*, 829 F.3d at 1334.

Furthermore, the actual content of the NRA article undermines Appellant's position. *See* "Attachment N." Essentially, the NRA article acknowledges that the 7.5 FK is merely an adaptation of conventional carbine weapon ammunition for use in a handgun. *Id.* Carbines are shoulder-fired weapons, whereas pistols are typically fired from a hand held position. Carbines have longer barrels than pistols. Carbines are generally considered to be a relatively long range weapon compared to a pistol being a shorter range weapon. There are obvious tactical considerations that come into play when choosing to use either a pistol or a carbine. The relative advantages of adapting carbine type ammunition to a handgun would be readily apparent to anyone skilled in the art of designing firearms. What is entirely missing from Appellant's "industry praise" evidence and argument is anything that tends to show that adapting carbine ammunition characteristics to a handgun involved technological hurdles that proved challenging for a person of ordinary skill in the art to overcome. Stated differently, once someone conceives of the idea of using carbine type ammunition in a pistol, the actual execution of the concept requires no more than ordinary skill. Appellant's "industry praise" evidence amounts to no more than a testimony to the exercise of ordinary creativity. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) ("A person of ordinary skill is also a person of ordinary creativity, not an automaton"). In summary, although we are willing to consider Appellant's industry praise evidence for what it is worth, it is entitled to only a little weight in our overall analysis.

"Industry praise" is perhaps the secondary considerations category for which Appellant offered the most evidence. However, and even if we were to accord it substantial weight despite nexus not being established, this

evidence is outweighed by the Examiner's evidence supporting a conclusion of obviousness.

None of Appellant's arguments apprises us of error in the obviousness rejection of claim 25. Accordingly, the obviousness rejection of claims 25–41 and 45 is affirmed.

Claims 42–44

Independent claims 43 and 44, like claim 25, are also directed to “[a] firearm cartridge configured to be fired by a center fire pistol.” Appeal Br. 24. Unlike claim 25, however, claims 43 and 44 each recite “the tapered shoulder having a diameter of approximately 8.45 mm at a position between 21.0 mm and 23.6 mm from an end face of the head.” *Id.* at 24–25. Because claim 42, which depends from claim 25, also recites this limitation, we discretionarily group claim 42 with claims 43 and 44.

Appellant argues that “Dutch fails to teach a pistol cartridge wherein the tapered shoulder has a diameter of approximately 8.45 mm at a position between 21.0 mm and 23.6 mm from an end face of the head.” Appeal Br. 13 (underlining removed).

In rejecting claim 42, the Examiner relied on Dutch paragraph 127 and found as follows:

Dutch further discloses wherein the tapered shoulder has a diameter of approximately 8.45 mm at a position between 21.0 mm and 23.6 mm from an end face of the head, the tapered shoulder having a shoulder angle of approximately 30 degrees (See at least Paragraph 0127, the range of cartridge lengths has been identified in Dutch as provided above, *the shoulder would require such a diameter at such a position to transition between the base diameter and the neck holding the identified diameter bullet*).

Final Act. 11 (emphasis added).

Appellant argues that “Paragraph [0127] (cited by the Office Action with respect to claim 42, which recites the same limitations) fails to teach that the tapered shoulder is 8.45 mm in diameter at a position between 21.0 mm and 23.6 mm from an end face of the head.” Appeal Br. 13–14. Appellant is correct. Paragraph 127 speaks to shoulder angle only and does not disclose any diameter.

The Examiner answers Appellant’s argument merely by pointing out that the “limitation was already addressed in the rejection of claim 42.” Ans. 7. Thus, the Examiner stands by the citation of paragraph 127 and the unexplained assertion that “the shoulder would require such a diameter at such a position.” Final Act. 11.

This is inadequate by the Examiner. Appellant has raised a legitimate argument with respect to a limitation for which the Examiner appears to be relying on speculation.⁵ In response to that argument, the Examiner merely directs us back to the rejection.

Appellant has apprised us of error in the obviousness rejection of claims 42–44. Accordingly, the obviousness rejection of claims 42–44 is reversed.

⁵ Perhaps, the Examiner is relying implicitly on the doctrine of inherent disclosure. Even still, the requirements for doing so have not been met. *See, e.g., Wasberg v. Ditchfield*, 155 F.2d 408, 411 (CCPA 1946) (“Inherency requires certainty and cannot be established by possibilities or mere probabilities.”).

SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
25	112(a)	Written description	25	
43	112(a)	Written description	43	
44	112(a)	Written description	44	
25–45	103	Dutch	25–41, 45	42–44
Overall Outcome			25–41, 43–45	42

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 IN PART

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FAISAL KEDAIRY

Appeal 2019-005218
Application 15/049,698
Technology Center 3600

OPINION CONCURRING

CAPP, *Administrative Patent Judge*

I concur in the result reached by the panel in all respects. I write separately to express concern over some of Appellant's secondary considerations evidence.

The Federal Circuit substantially revised the case law standards for establishing inequitable conduct in the case of *Therasense, Inc. v. Becton, Dickinson and Co.*, 649 F.3d 1276 (Fed. Cir. 2011). However, one principle of inequitable conduct that remains in our post-*Therasense* world is that when a patent applicant engages in affirmative acts of egregious misconduct, such as the filing of an unmistakably false or misleading affidavit, such conduct is material. *Id.* at 1292. "There is no room to argue that submission of false affidavits is not material." *Rohm & Haas Co. v. Crystal Chem. Co.*, 722 F.2d 1556, 1571 (Fed. Cir. 1983).

In the case of *Refac Int'l, Ltd. v. Lotus Dev. Corp.*, 81 F.3d 1576, 1583 (Fed. Cir. 1996), the court found that the intentional omission of declarant's employment with inventor's company rendered the affidavit false. "Affidavits are inherently material." *Id.* In the instant case, the inventor is

Faisal Kedairy and the assignee of the application under review is Skychase Holdings Corporation (SHC). Appeal Br. 2. As evidence of commercial success, Appellant submitted a Declaration by Mr. Kedairy. In the declaration, Mr. Kedairy discloses that he is the “owner” of FK BRNO, a firearms manufacturing company. Kedairy Decl. (October 9, 2018) ¶ 1. In the declaration, Mr. Kedairy testifies, under oath, that SHC has executed multiple license agreements with groups across the world. *Id.* ¶ 18. At least two of the licensees, FK BRNO Ammunition and FK BRNO Engineering, have company names that suggest an affiliation with the inventor and/or SHC. *Id.* The declaration then proceeds to represent that product sales of embodiments of the claimed invention demonstrate commercial success. *Id.* ¶¶ 19–20. However, Mr. Kedairy represents, under oath, that the actual quantity of product sales is confidential and, therefore, evidence of such sales is withheld. *Id.*

An Appeal to the Board is an inefficient vehicle to conduct an investigation into an applicant’s candor in submitting evidence during prosecution. Nevertheless, I am troubled by the possibility that the various license agreements offered as evidence of commercial success may not be between participants in arms-length transactions and that Appellant’s relationships with such participants has not been fully disclosed. I am equally troubled that the terms of the licenses do not appear sufficiently detailed to indicate whether they represent normal commercial transactions. I am particularly troubled that certain terms of these licenses are redacted while, at the same time, we are expected to rely on such evidence with a view to allowing Appellant to obtain patent protection on this alleged invention. Kedairy Decl. Attachments D, E, F, G, H.

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I am not prepared, at this juncture, to refer this matter to the Office of Enrollment and Discipline. However, Appellant and its representatives are admonished, in the event that prosecution of this Application is continued after resolution of this appeal, that they operate under a duty of candor to the Office. 37 C.F.R. § 1.56.