



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/437,425	02/20/2017	Nihaal Nath	APP_5	1800
127270	7590	08/20/2020	EXAMINER	
Rattan Nath 1417 Pleasant Valley Way West Orange, NJ 07052			HAYES, BRET C	
			ART UNIT	PAPER NUMBER
			3641	
			MAIL DATE	DELIVERY MODE
			08/20/2020	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* NIHAAL NATH, RATTAN NATH, and URSULA NATH

---

Appeal 2020-001048  
Application 15/437,425  
Technology Center 3600

---

Before MICHAEL C. ASTORINO, CYNTHIA L. MURPHY, and  
AMEE A. SHAH, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), the Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 13–20.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

---

<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as Rattan Nath, Nihaal Nath, and Ursula Nath. Appeal Br. 2.

<sup>2</sup> Claims 1–12 have been withdrawn. Appeal Br. 2.

STATEMENT OF THE CASE

*Claimed Subject Matter*

The Appellant's invention "is directed to easily detectable ammunition." Spec. 7. Claim 13, the sole independent claim on appeal, is representative of the claimed subject matter and reproduced below.

13. A primer section detectable by a reader, the primer section comprising:
  - a tag;
  - a power storage component to power a signal emitting circuit in the tag;
  - a receiver for receiving power or a signal external to the piece of cartridge; and
  - one or more controllable flash vents whereby a likelihood of transmitting a flash to a powder section from the primer section is reduced when the one or more flash vents are closed.

*Rejections*

Claim 13 is rejected under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement.

Claims 13–20 are rejected under 35 U.S.C. § 112(b) as indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor regards as the invention.

ANALYSIS

*Enablement*

The Examiner rejects claim 13 as failing to comply with the enablement requirement. Final Act. 4. The Examiner determines that "one or more controllable flash vents" and "a likelihood of transmitting a flash to a powder section from the primer section is reduced," as recited in claim 13,

fails to comply with the enablement requirement because the Specification does not enable a person having ordinary skill in the art to make the invention. *See id.*

When rejecting a claim for lack of enablement, the USPTO bears an initial burden of setting forth a reasonable explanation as to why the Examiner believes that the scope of protection provided by the claim is not adequately enabled. *In re Wright*, 999 F.2d 1557, 1561–62 (Fed. Cir. 1993); *see* Manual of Patent Examining Procedure (“MPEP”) § 2164.04, Burden on the Examiner Under the Enablement Requirement (9th ed., rev. 10.2019, last rev. June 2020). The test for compliance with the enablement requirement is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent [application] coupled with information known in the art without undue experimentation.” *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). Determining whether any necessary experimentation is undue involves considering relevant factors including, but not limited to: (1) the quantity of experimentation necessary; (2) the amount of direction or guidance presented; (3) the presence or absence of working examples; (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill of those in the art; (7) the predictability or unpredictability of the art; and (8) the breadth of the claims. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988); *see* MPEP § 2164.01(a), Undue Experimentation Factors. “Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.” *Wands*, 858 F.2d at 737.

We are not convinced that the Examiner properly weighed all of the *Wands* factors. Initially, we note that the Examiner does not explicitly

reference any of the *Wands* factors. However, the record suggests that the Examiner may have considered one of the *Wands* factors; namely, (2) the amount of direction or guidance presented. *See* Ans. 6–8. Although the Examiner is not required to provide a discussion as to every *Wands* factor, it is not apparent from the Final Office Action or the Answer that these factors were properly weighed.<sup>3</sup> Based on the foregoing, we determine that the Examiner’s rejection under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement is not sufficiently complete to establish a prima facie case.

Further, we note that the Appellant’s arguments suggest that if the Examiner properly weighed all of the *Wands* factors, including (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, and (8) the breadth of the claims, the rejection would weigh against the Examiner’s determination. *See* Appeal Br. 4–6; Reply Br. 2–3.<sup>4</sup>

---

<sup>3</sup> MPEP § 2164.04 “Burden on the Examiner Under the Enablement Requirement” states:

While the analysis and conclusion of a lack of enablement are based on the factors discussed in MPEP § 2164.01(a) and the evidence as a whole, it is not necessary to discuss each factor in the enablement rejection. However, it is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. *In re Wands*, 858 F.2d 731, 737, 740 . . . (Fed. Cir. 1988).

<sup>4</sup> The Reply Brief lacks page numbers. We designate page 1 as the page that includes the heading “**REPLY TO EXAMINER’S RESPONSE**” and number the remaining pages in the Reply Brief consecutively therefrom.

In view of the foregoing, we do not sustain the Examiner's rejection of claim 13 as failing to comply with the enablement requirement.

### *Indefiniteness*

#### *Independent Claim 13 and Dependent Claims 14–20*

Claim 13 recites, in relevant part, “a receiver for receiving power or a signal external to the piece of cartridge.” Appeal Br., Claims App.

The Examiner rejects claim 13 under 35 U.S.C. § 112(b) as indefinite because “[i]t is unclear whether both power and signal are required to be external.” Final Act. 4. The Examiner rejects claims 14–20 because these claims depend from claim 13, i.e., a rejected base claim. *See id.* at 4, 5. Additionally, as discussed below, the Examiner further rejects claims 16 and 18–20 for separate reasons.

We agree with the Examiner that it is unclear how the above-recited limitation of claim 13 should be understood. The limitation provides two alternatives. *The first alternative* may be understood in *two ways*: (a) as requiring a receiver for receiving power; or (b) requiring a receiver for receiving power external to the piece of cartridge. *The second alternative* is clear. Namely, it requires a receiver for receiving a signal external to the piece of cartridge.

In the Appeal Brief, the Appellant contends that “it would have been plain that the limitation in claim 13 ‘a receiver for receiving power or a signal external to a piece of cartridge’ refers to either or both because the specification discloses both powering of the tag and signaling by way to detecting change in imped[ance].” Appeal Br. 4 (emphasis added) (citing *In*

*re Smith Int'l, Inc.*, 871 F.3d 1375 (Fed. Cir. 2017)). The Appellant's contention is not persuasive.

Initially, we note that the Appellant's contention itself is not entirely clear. Although it is clear the Appellant is attempting to suggest that two alternatives are being claimed, the Appellant does not appear to address the metes and bounds of the first alternative. More specifically, the Appellant's response is directed to "powering of the tag," rather than how the claimed "receiver" receives "power." Further, we note that the Specification discloses using a battery and/or passive energy to power the tag. *See, e.g.*, Spec. 9 ("In some embodiments the tag may be powered by a battery but be designed to continue functioning as a passive tag if the battery runs out."), 12 ("In another preferred embodiment, to make detectable ammunition, it is possible to provide a source of power, such as a battery, but the ID tags used should still be capable of functioning as passive ID tags if the source of power fails or runs out."); *see also id.* at 20–21, 31, 38. Although it is conceivable that the use of the word "receiver" requires a power source that is not a battery, the record is not clear on that point. Additionally, that point is not advanced by the Appellant. Therefore, the Appellant's contention does not clarify whether the first alternative requires: (a) a receiver for receiving power; or (b) a receiver for receiving power external to the piece of cartridge.

The Appellant also contends:

As to claim 13, Examiner claims that that one having ordinary skill in the art would be unclear whether the limitation 'a receiver for receiving power or a signal external to a piece of cartridge' means both power and the signal or just one of power/signal from an external source.

The context of the specification makes it clear that it is both but not necessarily at the same time because power or signal could be stored. This would be clear to one adopting a reasonable interpretation from the perspective of one having ordinary skill in the art.

Reply Br. 4 (emphasis omitted). This contention is not persuasive. Similar to our discussion above, we note that the Appellant's contention is not entirely clear. As with the first contention, the Appellant is attempting to suggest that two alternatives are being claimed, but does not appear to address the metes and bounds of the first alternative, i.e., whether the first alternative requires: (a) a receiver for receiving power; or (b) a receiver for receiving power external to the piece of cartridge.

Thus, we sustain the Examiner's rejection of independent claim 13. We likewise sustain the rejection of dependent claims 14–20 due to its dependency on claim 13.

#### *Dependent Claims 16 and 18–20*

The Examiner further rejects each of claims 16, 18, and 19 under 35 U.S.C. § 112(b) as indefinite for reasons distinct than the reasons discussed above for the rejection of claim 13. Final Act. 5. The Examiner does not reject claim 20 for a separate reason. Although the Examiner states, “[c]laim 20 similarly recites ‘one or more,’ which is better recited as --at least one--” (*id.*), the statement does not provide a reason why claim 20 is indefinite, i.e., unclear. *Ex parte McAward*, Appeal No. 2015-006416, 2017 WL 3669566, at \*5 (PTAB Aug. 25, 2017) (precedential) (explaining that the USPTO considers a claim indefinite when it “contains words or phrases whose meaning is unclear”); *see* MPEP § 2173.02, Determining



Whether Claim Language is Definite. Claim 20, depends from claim 19, and therefore, is rejected for being based on a rejected claim.

The Appellant does not argue that the Examiner erred in rejecting claims 16, 18, or 19 in the Appeal Brief. For the first time on appeal, the Appellant argued against the reasons for the rejections of claims 16 and 19 in the Reply Brief at page 5. The arguments presented are not responsive to an argument raised in the Examiner's Answer. *See also* Ans. 8 (stating, "There were no arguments with respect to the rejections under 35 U.S.C. 112(b)."). The Appellant fails to show good cause for not presenting this argument in the opening brief, i.e., the Appeal Brief. Therefore, we will not consider this argument. *See* 37 C.F.R. § 41.41(b)(2) (2018) ("Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the examiner's answer, including any designated new ground of rejection, will not be considered by the Board for purposes of the present appeal, unless good cause is shown."); *id.* at § 41.37(c)(1)(iv) ("Except as provided for in §§ 41.41, 41.47 and 41.52, any arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal.").

Therefore, we summarily sustain the Examiner's rejection of claims 16, 18, and 19 as indefinite. We likewise sustain the rejection of dependent claim 20 due to its dependency on claim 19.

CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
13	112(a)	Enablement		13
13–20	112(b)	Indefiniteness	13–20	
<b>Overall Outcome</b>			13–20	

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).

AFFIRMED