

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL BRUNN

Appeal No. 2000-2016
Application No. 09/209,837

ON BRIEF

Before CALVERT, ABRAMS, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 1, which is the only claim pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a grenade launcher. Claim 1 has been reproduced in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Cox	3,307,283	Mar. 7, 1967
Soussloff	4,202,644	May 13, 1980

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claim 1 also stands rejected under 35 U.S.C. § 102(b) as being anticipated by Soussloff.

Claim 1 further stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cox in view of Soussloff.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 7) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 6) and the Reply Brief (Paper No. 8) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The Rejection Under Section 112

The examiner's position is that the claim is indefinite because certain of the claimed elements are described in a manner that relates them to elements that are not positively claimed. We do not agree with this conclusion. The second paragraph of Section 112 is directed to insuring that the public is apprised of exactly what the patent covers, so that those who would approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). It is our view that one of ordinary skill in the art would have no difficulty determining the metes and bounds of the invention from the claim language as presently expressed, considering that the opening words of the claim are “[f]or a grenade launcher . . . to be attached . . . about . . . a firearm barrel . . . an adapter for providing an attachment to said firearm barrel” (emphasis added). We do

believe, however, that the additional language suggested by the examiner would be an improvement.

This rejection is not sustained.

The Rejection Under Section 102

Claim 1 stands rejected as being anticipated by Soussloff. Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994). We find ourselves in agreement with the examiner that the subject matter recited in claim 1 is anticipated by Soussloff. Our reasoning follows.

We initially wish to point out that claim 1 recites "an adapter" for attaching a grenade launcher to the barrel of a firearm; the claim does not positively set forth the grenade launcher or the firearm barrel. This is important, for anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference (Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987)) nor what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference (Kalman v. Kimberly-Clark Corp, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed.

Cir. 1983)). Thus, the fact that Soussloff discloses a different use for the disclosed structure than the particular use mentioned by the appellant in the claim does not cause the rejection to be defective on its face, which seems to be the essence of the appellant's argument (see Brief, page 5 and Reply Brief, pages 1-3). From our perspective, the structure disclosed by Soussloff for use in attaching a machine element to a cylindrical shaft in such a manner as to lock the two together not only meets all structural limitations that are positively recited in the claim, but is capable of performing the use envisioned by the appellant for the claimed structure.

Using the language of the claim as a guide, Soussloff discloses an adapter comprising a cylindrical body (21) having a longitudinally oriented wall (25) bounding an inner cylindrical bore of a diameter slightly oversized with respect to a specified outside diameter of a cylindrical element so as to be adapted to receive in projected relation said cylindrical element with said inner cylindrical bore as permitted by a fitting clearance provided by the diameter size differences of the cylindrical element and the inner cylindrical bore (see column 3, lines 24-29), in the cylindrical body of the adapter at select circumferential locations are a cooperating pair of adjacent walls bounding therebetween an open ended positioning slot (27) and having delimited by and between the slots element-engaging legs (26), an externally threaded length portion (31) along the adapter cylindrical body adjacent an end of each slot, and a hollow sleeve (22, 23) having an

internally threaded length portion (38) adapted to have an operative position disposed in encircling relation about said adapter cylindrical body with said internal and external threaded length portions thereof in threaded engagement with each other. There is no evidence to establish that the Soussloff adapter is incapable of receiving the aiming sight of a firearm in one of the slots 27, or is incapable of being used to encircle and be clamped down to grip a cylindrical firearms barrel and attach a grenade launcher thereto, in accordance with the intended use set out in the last six lines of the appellant's claim.

In arriving at the conclusion that Soussloff anticipates the claim, we have considered all of the appellant's arguments. Our position with regard to them should be apparent. With regard to the argument regarding the problem of accommodating different barrel diameters of firearms, we point out that the claim merely requires that the adapter bore be "slightly oversized" with respect to the specified outside diameter of the cylindrical element to which it is being attached, and that such is the case in the Soussloff adapter.

The Rejection Under Section 103

In this rejection, the examiner concludes that the subject matter of claim 1 is unpatentable over Cox in view of Soussloff. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to

provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Cox discloses a grenade launcher (11) for attachment to the barrel of a firearm by means of an adapter (12). The adapter comprises a cylindrical body having a central bore sized to fit over the barrel of the firearm and a plurality of radially oriented slots extending along a substantial portion of its length. The launcher has at its proximal end a slotted cylindrical casing that fits around the adapter, and a clamping band (29) that acts to tighten down on both the adapter and the surrounding casing to cause the adapter to be clamped to the barrel. The aiming sight on the barrel is received in one of the slots in the adapter.

Soussloff has been described above with regard to the Section 102 rejection. It is the examiner's view that Cox discloses all of the structure recited in claim 1 except for the particular means for clamping the device onto the barrel of the firearm. However, it is the examiner's position that such is disclosed by Soussloff and it would have been obvious to

one of ordinary skill in the art to modify the Cox device by replacing the clamping band with the screw-on system of Soussloff “in order to provide a secure axial connection that cannot readily fall apart unless all the threads are disengaged from one another” (Answer, page 4).

We do not agree. The fact that the prior art structure could be modified does not make such a modification obvious in the absence of the prior art suggesting the desirability of doing so (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 984)). Here, the examiner has provided no clue as to where support is found for the reasoning set forth as the suggestion to combine the references, and therefore it stands merely as the examiner’s unsupported opinion. This being the case, the question arises as to why one of ordinary skill in the art would have been led to substitute one means for clamping a hollow cylindrical body to a cylindrical sleeve for another, that is, what advantage would be gained by replacing the clamping band system disclosed by Cox with the screw and tapered clamping sleeve system of Soussloff. We find none in expressed in the references, and it thus would appear that the only motivation for doing so is found in the hindsight afforded one who first viewed the appellant’s disclosure. This, of course, is not a proper basis for a rejection under Section 103.

It is our conclusion that the combined teachings of Cox and Soussloff fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we therefore will not sustain this rejection.

SUMMARY

The rejection of claim 1 under 35 U.S.C. § 112, second paragraph, is not sustained.

The rejection of claim 1 under 35 U.S.C. § 102(b) is sustained.

The rejection of claim 1 under 35 U.S.C. § 103(a) is not sustained.

A rejection of the claim having been sustained, the decision of the examiner is affirmed.

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

AFFIRMED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JOHN P. McQUADE)	
Administrative Patent Judge)	

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APJ McQUADE

APJ CALVERT

DECISION: **AFFIRMED**

Prepared By:

DRAFT TYPED: 27 Mar 02

FINAL TYPED: