

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE DESANTIS

Appeal No. 98-2177
Control No. 90/004,336¹

HEARD: AUGUST 5, 1998

Before MCCANDLISH, **Senior Administrative Patent Judge**, and
COHEN and MEISTER, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-

¹ Reexamination proceeding of U. S. Patent No. 5,170,919, filed August 20, 1996 to Eugene Desantis, entitled "Simulated Pouch With Interior, Concealed Holster", issued December 15, 1992, based on Application No. 07/603,396, filed October 26, 1990; which is a continuation of Application 07/435,172, filed November 13, 1989, now Patent No. 4,966,320, issued October 20, 1990.

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14, the only claims present in the application.

We REVERSE.

The appellant's invention pertains to a simulated carrying pouch and a holster for a handgun mounted within the pouch in such a manner that it is completely concealed thereby. Independent claim 1 is further illustrative of the appealed subject matter and reads as follows:

1. A simulated carrying pouch assembly comprising:

a backing having a top, bottom, and two ends;

means defining a flexible material container standing out from said backing, to define a volume, and having a top;

fastener means at the top of the container for allowing access to the backing:

means for mounting said back [sic, backing] on a wearer;

means for mounting a holster, capable of holding a handgun, on said backing completely within the volume defined by said container;

said container, when said fastening means is opened, allowing ready access to said holster;

wherein said container simulates a carrying pouch so as to fully conceal the fact that a gun is mounted therein; and

wherein said fastener means also extends along at least one end of said container to allow access to said backing at the top and at least one end of said backing.

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The references relied on by the examiner are:

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| Zerobnick et al. (Zerobnick) 1977 | 4,029,243 | June 14, |
| Perkins | 4,262,832 | Apr. 21, 1981 |
| McSorley | 4,724,791 | Feb. 16, 1988 |

"Tactical Enterprises, Inc." brochure, the item labeled as "BT110", March 1, 1988.

Claims 1, 4, 6, 8, 10 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over item BT110 in view of Zerobnick.

Claims 2, 3 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over item BT110 in view of Zerobnick and Perkins.

Claims 1, 4, 6, 8, 10, 12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zerobnick in view of item BT110.

Claims 5, 7, 11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zerobnick in view of item BT110 and McSorley.

The examiner's rejections are explained on pages 4-8 of the answer. The arguments of the appellant and examiner in support of their respective positions may be found on pages 4-

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25 of the brief filed May 9, 1997 (Paper No. 13), pages 1-3 of the reply brief filed August 13, 1997 (Paper No. 16), the supplemental brief filed on January 23, 1998 (Paper No. 19), pages 1-10 of the reply filed on April 6, 1998 (Paper No. 21) and pages 8-12 of the examiner's answer mailed March 27, 1998 (Paper No. 20).² The various declarations and documents relied on by the appellant as evidence of nonobviousness are listed on pages 12-14 of the brief (Paper No. 13). Two declarations by the appellant's counsel (Vanderhye) have been submitted in support of the appellant's position that (1) item BT110 is not admitted prior art and (2) that no relevant information could be obtained concerning the possible sale of this item.

OPINION

Each of the above-noted rejections is based on the examiner's view that item BT110 is available as prior art.

² Although a new final rejection (Paper No. 18) and new answer (Paper No. 20) were issued subsequent to the filing of the brief (Paper No. 13) and the reply brief (Paper No. 16), both the appellant and the examiner have considered the arguments in both of these briefs to be applicable to rejections before us for consideration.

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In support of this position the answer states that:

It is further noted that the Tactical Enterprises Inc. brochure [item BT110] cited by the appellant would appear to have a date of at least 01 March 1988 (see price sheet on page 5 of the brochure). In paper No. 5 filed by the appellant on 28 March 1991 in U.S. patent application 07/603,396 which matured into U.S. Patent No. 5,170,919, appellant admits that the BT110 was "offered for sale as a new product sometime after March 1, 1988, the effective date of the original Price Sheet" which is more than one year prior to the effective filing date of appellant's originally filed application (filed 13 November 1989) now under re-examination. Furthermore, in appellant's Appeal Brief (Paper No. 13) at page 10, lines 15-19, appellant states that the price sheet appears to be an "addendum" that includes "New Items." In light of appellant's argument that the price sheet is an addendum, it would appear that the appellant clearly suggests that the BT110 device was being sold prior to 01 March 1988 since an addendum is added after publication of the original. Considering the facts at hand, it would clearly appear as though the BT110 device was described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the date of appellant's application for patent in the United States. . . . Appellant's admission, the fact that the brochure was cited by appellant collectively as one reference which included an effective filing date as discussed above, and the exact text and contents of the brochure strongly indicate that the brochure is a published sales aid and is properly considered as prior art against appellant until proven otherwise by the appellant (*In re Epstein*, 31 USPQ2d 1817 (CAFC 1994)). [Pages 4 and 5.]

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We must point, however, that as the court in *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) stated, in quoting with approval from *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 4 (Fed. Cir. 1985):

"[P]reponderance of the evidence is the standard that must be met by the PTO in making rejections" Here, examiner has not satisfied this burden.

As the examiner recognizes, item BT110 was included in the Tactical Enterprises brochure on a page with the heading "NEW ITEMS PRICE LIST." While the Tactical Enterprises brochure contains a sheet entitled "PRICE SHEET - Effective 3-1-88," this sheet, together with the descriptive portions of the brochure (which contain no reference whatsoever to item BT110), is in a printed format. On the other hand, the "NEW ITEMS PRICE LIST" (1) is typewritten, (2) has higher code numbers thereon than the printed price sheet, with the exception of item ME781 (which was changed from a "Rifle/Shotgun Sling" to a "Stun Gun Case, Fully Padded Large for Omega, Ballistic") and (3) has no effective date. Particularly in view of the typewritten higher code numbers,

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it appears more than likely that the "NEW ITEMS PRICE LIST" was an addendum which was added sometime **subsequent to** the printing of the Tactical Enterprises brochure (including the printed price sheet). In any event, in view of the above-noted facts, there is insufficient evidence to conclude that the "NEW ITEMS PRICE LIST" (and hence item BT110) has the same effective date as the printed "PRICE SHEET" (i.e., 3-1-88) or, for that matter, any other date which is prior to November 13, 1989 (the effective filing date of the instant reexamination application).

As to the examiner's assertion that the appellant has admitted that item BT110 is prior art, we must point out that, contrary to such an assertion: (1) on page 4 of the response filed March 28, 1991 (Paper No. 5 of the patented file), wherein item BT110 was first brought to the attention of the PTO, it was expressly stated that "[t]he Tactical Enterprises brochure [item BT110] is not admitted to be prior art," (2) the PTO-1449 which accompanied (Paper No. 5) included the notation "(not admitted to be prior art)(no date)" after the citation of item BT110, (3) a first declaration by the

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appellant's counsel Vanderhye (attached to the reply brief filed August 13, 1997 (Paper No. 16)) noted the facts (1) and (2) set forth above and further stated that there was at no time an intent to admit that item BT110 was prior art and (4) a second declaration by the appellant's counsel Vanderhye (attached to supplemental brief filed January 23, 1998 (Paper No. 19)) stated that attempts were made on (once in 1991 and twice in January of 1998) to obtain relevant information as to the sale of item BT110, but that no such information could be obtained. In light of these facts, and the arguments made throughout the various briefs to the effect that item BT110 is not prior art, we are at a complete loss to understand the examiner's assertion that the appellant has admitted that item BT110 is prior art.

In an attempt to shift the burden to the appellant to prove that item BT110 is not prior art, the examiner has cited *In re Epstein, supra*; however, the examiner's reliance upon this decision is misplaced. In *Epstein*, the Patent and Trademark Office (PTO) established by a preponderance of the evidence that the articles in question (i.e., particular

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software products) were on sale as of a specified date and the appellant failed to provide any evidence to the contrary.

That is, the PTO established by a preponderance of evidence that various software products were on sale as of the critical date by providing abstracts, about which the court in *Epstein*, 32 F.3d at 1565,

31 USPQ2d at 1820-21 stated:

Each abstract contains a description of its particular software product, including the various features relied upon by the examiner in rejecting appellant's claims. Each abstract identifies the software vendor by name and provides the vendor's address and phone number. Each abstract provides information useful to potential buyers, including who to contact, price terms, documentation, warranties, training and maintenance. Each abstract states the date that the product was first released or installed, which dates range from 1977 to January 1987. Finally, all the abstracts, excepting only the abstract of Pro-Search 1.08, disclose the number of current users; these range in number from ten to fifty-eight.

Here, however, the examiner has provided no convincing evidence that item BT110 appeared in a printed publication (i.e., the Tactical Enterprises brochure) prior to the critical date of November 13, 1989.

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Since item BT110 is not available as prior art, no *prima facie* case of obviousness has been established with respect to the subject matter defined by the claims on appeal. This being the case, we need not consider the appellant's evidence of nonobviousness. *See In re Fine*, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

All of the examiner's rejections are reversed.

REVERSED

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|--------|--------------------------------|---|---------------|
| | HARRISON E. MCCANDLISH, Senior |) | |
| | Administrative Patent Judge |) | |
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| | IRWIN CHARLES COHEN |) | BOARD OF |
| PATENT | Administrative Patent Judge |) | APPEALS AND |
| | |) | INTERFERENCES |
| | |) | |
| | JAMES M. MEISTER |) | |
| | Administrative Patent Judge |) | |

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Robert A. Vanderhye
NIXON & VANDERHYE
1100 North Glebe Road
Eighth Floor
Arlington, VA 22201

Ross F. Hunt, Jr.
LARSON & TAYLOR
Transpotomac Plaza
1199 North Fairfax Street
Suite 900
Alexandria, VA 22314

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JMM/cam