

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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WILLIAM A. McMOORE

Appeal No. 2004-0910
Application No. 09/756,632

ON BRIEF

Before FRANKFORT, STAAB, and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13 to 16, which are all of the claims pending in this application. Claims 1 to 12 have been cancelled.

The appellant's invention relates to a method for avoiding accidental discharge of a firearm or other trigger-activated device having a trigger guard. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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The prior art

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

Tito	3,631,621	Jan. 04, 1972
Strayer	5,293,708	Mar. 15, 1994

The rejections

Claims 13 to 16 stand rejected under 35 U.S.C. § 112, first paragraph as not being supported by an enabling disclosure.

Claims stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tito or Strayer.

OPINION

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. 23, mailed Nov. 17, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 20, filed Jun. 12, 2003) and reply brief (Paper No. 24, filed Jan. 22, 2004) for the appellant's arguments thereagainst.

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

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respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection under 35 U.S.C. § 112, first paragraph. It is the view of the examiner that the specification does not contain a description that enables one skilled in the art to make and/or use the invention. The examiner states:

The specification does not enable the applicant's claim limitations directed to the "providing" and "positioning" of a tactile cue just prior to gripping the firearm [page 4].

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785,

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8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 490 U.S. 1046 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)(examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure).

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973).

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving

this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done.

The examiner argues that the specification does not describe how to perform the positioning and providing step of the invention recited in claim 13, from which claims 14 to 16 depend. This is not so. The step of providing at least one tactile stimulating cue positioned laterally and situated on at least one side of the forward portion of the trigger guard is described in the specification at page 4 as forming a groove or a notch 22 on the lateral side of the forward portion of the trigger guard. The cue is also clearly depicted in Figures 2 and 3. The description in the specification along with the depicting in Figures 2 and 3 would clearly enable a person, without undue experimentation, to place a notch or groove on the lateral side of the forward position of the trigger guard. Therefore, in our view, the disclosure clearly enables this step of the invention.

In regard to the step of positioning a cue to provide a stimulus to a user's trigger finger when the firearm is gripped is discussed on page 1 of the specification:

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The invention provides a safety reminder in the form of a tactile cue which can be felt by the user's trigger finger when the finger is in a "safe" or "off trigger"

Figures 2 and 3 depict the use of the cue and show one position in which a user's hand is positioned on the cue and one position in which the user's hand is positioned off the cue. In our view, a person of ordinary skill would have been enabled, informed by the depiction in the figures, to utilize the cue described in the specification and depicted in the figures without undue experimentation.

To the extent that the examiner is arguing that the disclosure does not enable a user to provide and position the cue just prior to gripping the firearm, we note that the claim does not require the user to perform these steps. All that the claim requires is that the cue be provided and positioned prior to being gripped by a user. Thus the providing and positioning step need not be done by the user nor just prior to gripping the firearm but could be done by the manufacturer, for instance, when the trigger activated device is manufactured.

We will not sustain this rejection as it is directed to claim 13 or claims 14 to 16 dependent therefrom.

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We turn next to the examiner's rejections of claims 13 to 16 under 35 U.S.C. § 102(b) as being anticipated by Tito and Strayer.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

The examiner is of the opinion that both Tito and Strayer describe although neither Tito or Strayer disclose the step of "intentionally using the stimulus of the tactile stimulating surface cue as a reminder....", both references include a notch or bump which could inherently act as a reminder cue for the user.

We will not sustain either rejection as neither Tito nor Strayer disclose the method recited in claim 13 from which claims 14 to 16 depend. There is no discussion in either reference of performing the steps required by claim 13. Neither reference includes a discussion of utilizing a cue to remind a user of the safe position to use the firearm and therefore these references contain no description of the positioning of such a cue. In addition, there is no discussion in either reference of the step

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of gripping the firearm so that a user can move between a safe position and a position in which the finger is on the trigger without changing the user's grip. While it may be true that it may be possible to use a groove or notch which is disposed on the firearms disclosed in Tito and Strayer as a reminder cue, such is not disclosed in the references themselves. As neither reference discloses the steps of the method recited in claim 13 from which claims 14 to 16 depend, the anticipation rejection can not stand.

The examiner has also provided a list of references which the examiner asserts describe some sort of safety button or stimulating surface located on the forward portion of the trigger guard, however, these references were cited when making the rejection and therefore, we will not consider these references. In re Hoch, 428 F.2d 1341, 1342, 166 USPQ 406, 407 (CCPA 1970).

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

MEC/jrg

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JAMES C. EAVES JR.
GREENEBAUM DOLL & MCDONALD PLLC
3500 NATIONAL CITY TOWER
101 SOUTH FIFTH STREET
LOUISVILLE, KY 40202