

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAMUEL F. DOWDING

Appeal No. 2004-1153
Application No. 09/927,140

HEARD: July 14, 2004

Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 34, all of the claims pending in this application.

Appellant's invention relates generally to long firearms, such as rifles and shotguns, and, more particularly, to a method of attaching the stock of a long firearm to the frame and barrel assembly in such a manner that the stock can be easily and quickly disassembled from the frame. Independent claims 1, 16,

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27 and 30 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellant's brief.

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

Browning	3,380,182	Apr. 30, 1968
Koon, Jr.	3,739,515	Jun. 19, 1973
Harley	5,284,401	Feb. 8, 1994
Robinson et al. (Robinson)	6,012,246	Jan. 11, 2000

Notwithstanding the examiner's statement of the rejection of claims 1 through 34 set forth on page 2 of the final rejection (Paper No. 5), we share appellant's view expressed on page 4 of the brief concerning the ISSUES for review in this appeal. As is generally apparent from the examiner's comments on pages 2 through 5 of the final rejection, the rejections for review are as follows:

Claims 1 through 8, 12 through 22 and 25 through 34 under 35 U.S.C. § 103(a) as being unpatentable over Browning in view of Harley;

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Claims 9, 10 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Browning in view of Harley and Koon; and

Claims 11 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Browning in view of Harley and Robinson.

Rather than attempt to reiterate the examiner's commentary with regard to the above-noted § 103 rejections and the conflicting viewpoints advanced by appellant and the examiner regarding those rejections, we make reference to the final rejection (Paper No. 5, mailed June 26, 2002) and the examiner's answer (Paper No. 17, mailed July 29, 2003) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 11, filed November 25, 2002) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the above-noted

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§ 103 rejections will not be sustained. Our reasons follow.

In the rejection of claims 1 through 8, 12 through 22 and 25 through 34 under 35 U.S.C. § 103(a), the examiner urges that Browning discloses the invention "substantially as claimed" and identifies certain elements of the long firearm shown therein, including a frame (i.e., receiver and barrel assembly 11, 12), a locking member (bolt 45) extending rearwardly from the frame, and a stock (13) having a longitudinal bore extending from the forward end of the stock to receive the locking member (45). In the examiner's view, the only aspect the Browning patent does not disclose is a cam lock disposed in the stock (13) and rotatable between a locked position and an unlocked position for engaging locking member (45) when the cam lock is rotated to the locked position to secure the stock to the frame. To account for this difference, the examiner points to the cam lock furniture panel fastening device of Harley, which the examiner characterizes as being "in the same field of endeavor" (final rejection, page 2), and concludes that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to have used the two-part fastener of Harley in order to modify "the locking member 45 of Browning to be a cam lock in order to fasten

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two members together." With regard to method claims 27 through 29, the examiner further contends that in view of the structure resulting from combining Browning and Harley as applied to claim 1, "the method of operating the device would have been inherent since it is the normal and logical manner in which the device could be used" (final rejection, page 5).

Appellant argues, and we strongly agree, that the examiner's attempted combination of the disparate subject matter of Browning and Harley is an improper exercise in hindsight reconstruction of the claimed invention based on appellant's own teachings. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), that it is impermissible for the examiner to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

In the context of the present application, we also note that the mere fact that the applied prior art could be modified in the manner urged by the examiner would not have made such a

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modification obvious unless the prior art suggested the desirability of the modification. See, for example, In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, it is our opinion that the prior art relied upon by the examiner does not contain such a suggestion and that the examiner has impermissibly drawn from appellant's own teaching in searching through the prior art for elements of the claimed subject matter and, in attempting to combine those elements together, has fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Contrary to the examiner's apparent belief, the mere fact that cam lock fasteners are known in the prior art for attaching furniture panels together, in and of itself, provides no motivation or suggestion for modifying the particular receiver-stock assembly of the long firearm shown in Browning to use or include such a fastener.

Since we have determined that the teachings and suggestions found in Browning and Harley would not have made the subject matter as a whole of independent claims 1, 16, 27 and 30 on

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appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 2 through 8, 12 through 15, 17 through 22, 25, 26, 28, 29 and 31 through 34 under 35 U.S.C. § 103(a) on the basis of the combined teachings of Browning and Harley will likewise not be sustained.

We have also reviewed the patents to Koon and Robinson applied by the examiner against claims 9, 10, 11, 23 and 24 on appeal, but find nothing therein which overcomes or provides for the deficiencies we have identified above with regard to the basic combination of Browning and Harley. Moreover, we agree with appellant's assessment of the Koon and Robinson references and appellant's commentary regarding the examiner's rejections based on those references (brief, pages 14-17). Accordingly, the examiner's rejections of dependent claims 9, 10, 11, 23 and 24 under 35 U.S.C. § 103(a) will likewise not be sustained.

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In light of the foregoing, the decision of the examiner to reject claims 1 through 34 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JOHN P. MCQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JENNIFER D. BAHR)	
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