

1 The opinion in support of the decision being entered today was *not* written
2 for publication and is *not* binding precedent of the Board.
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4
5 UNITED STATES PATENT AND TRADEMARK OFFICE
6

7
8 BEFORE THE BOARD OF PATENT APPEALS
9 AND INTERFERENCES
10

11
12 *Ex parte* JONATHAN D. BUCKELY, TONY A. HANCOCK
13 and AUSTIN D. PYLE
14

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16 Appeal 2006-1668
17 Application 09/270,461
18 Technology Center 2600
19

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21 Decided: 27 February 2007
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24 Before BARRETT, LEE, and MEDLEY, *Administrative Patent Judges*.

25
26 MEDLEY, *Administrative Patent Judge*.

27 **DECISION ON APPEAL**

28 **A. Statement of the Case**

29 Applicants appeal from a final rejection of claims 25-29 under 35
30 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b).

31 The prior art relied upon by the Examiner in rejecting the claims on
32 appeal is:

2 Claims 25-29 stand rejected under 35 U.S.C. § 135(b)(1) on the ground that
3 the claims were not made prior to one year from the issue date of the Fuchs patent.

4 Claims 25-29 stand rejected under 35 U.S.C § 102(e) as being anticipated by
5 Fuchs.

6 **B. Findings of fact**

7 The record supports the following findings of fact as well as any other
8 findings of fact set forth in this Decision by at least a preponderance of the
9 evidence.

10 1. Applicants’ claims 25-29 are the subject of this appeal.

11 2. Claims 25-29 are reproduced as follows:

12 25. A pistol having a locking mechanism configured to lock a trigger
13 mechanism of the pistol if an attempt is made by an unauthorized
14 person to fire the pistol, the locking mechanism comprising:

15
16 an identification unit configured to detect an identification signal
17 inputted into the identification unit;

18
19 a control unit connected to the identification unit, the control unit
20 configured to compare the signal inputted into the identification unit
21 with a stored identification code;

22
23 an actuator device including a geared motor connected to the control
24 unit and connected by a threaded spindle and nut connection with a
25 mechanical locking element which is movable between a locked
26 position and an unlocked position, wherein in the locked position the
27 locking element locks a trigger tongue of the pistol;

28
29 a battery for supplying electrical power to the locking mechanism;
30 and

31 a plurality of display elements configured to display an operating
32 status of the locking mechanism.
33

1 26. A pistol as claimed in claim 25, wherein the locking element is
2 configured to engage a notch in the trigger tongue, and wherein the
3 locking element is guided for movement in a bolt and is spring-
4 loaded.

5
6 27. The pistol as claimed in claim 25, wherein at least the greater
7 portion of the locking mechanism is located in front of a trigger guard
8 and below the barrel of the pistol.

9
10 28. The pistol as claimed in claim 25, wherein the identification
11 unit comprises a keypad for the input of the code.

12
13 29. The pistol as claimed in claim 25, wherein the identification
14 unit comprises a finger-print scanner.

15
16 3. Applicants first presented claims 25-29 on **9 October 2003**.

17 4. Applicants copied claims 1-5 of the Fuchs patent and presented them as
18 Claims 25-29.

19 5. Claims 25-29 were first presented in the involved application over one
20 year after the Fuchs patent **25 September 2001** issue date.

21 6. Claims 25-29 are referred to as the “post-bar” claims since the claims
22 were not made during the “critical period”, i.e., prior to one year from the date on
23 which the Fuchs patent issued.

24 7. The Examiner argues that Applicants “post-bar” claims 25-29 are not the
25 same as Applicants’ original claims 1-14. Examiner’s Answer at 3.

26 Claims 25 and 28

27 8. Claim 28 depends directly from claim 25 and the rejection of it stands or
28 falls with the rejection of independent claim 25.

1 9. The Examiner argues that claim 25 is barred since the “plurality of
2 display elements” feature was not claimed in the application as originally filed
3 within one year of the patent date. Examiner’s Answer at 4.

4 10. Applicants acknowledge that there is not a “pre-bar” claim that recites
5 display elements configured to display an operating status of the locking
6 mechanism.¹ Appeal Brief at 22.

7 11. Applicants argue that the display elements limitation is not a material
8 limitation, and therefore post-bar claim 25 is not barred under 35 U.S.C. 135(b)(1).
9 Id. at 22-23.

10 12. In support of Applicants’ argument that the display elements limitation
11 is not material, Applicants argue that U.S. Patent 5,448,847 (“Teetzel”)
12 demonstrates that display elements indicating when the firearm is locked and when
13 the battery is low are common in prior art electronic locking mechanisms. Id.

14 13. Applicants argue that during the prosecution of the Fuchs patent, that
15 the display limitation was never the basis for patentability, since Teetzel
16 was cited as evidence, that display elements were known in the prior art and that
17 Fuchs did not argue otherwise. Id.

18 14. The Examiner responds and argues that:

19 “[B]ecause the element is known, is not evidence to suggest the element is
20 not material to the invention. The fact that the ‘plurality of display
21 elements’ are claimed in conjunction with the locking mechanism in the
22 [Fuchs] patent in order to show the status of the locking mechanism is
23 material to the claimed invention.” Examiner’s Answer at 5.

1 The plurality of display elements are described in Applicants’ application (see e.g., 09/270,461, page 11, lines 9-13, and Figs. 2 and 6, elements 26, 28 and 30).

1 Claim 26

2 15. The Examiner argues that “notch” recited in “post-bar” claim 26 is not
3 the same as “aperture” recited in “pre-bar” claim 5. Examiner’s Answer at 3.

4 16. Applicants’ argue that there is no material difference between a notch
5 and an aperture, since (1) both serve as a receptacle for an insert that prevents
6 rotation of the trigger (2) during the prosecution of the Fuchs patent the “notch”
7 limitation was not cited as the basis for patentability and (3) Applicants’
8 specification refers to “notches” and “apertures” interchangeably. Appeal Brief at
9 20.

10 17. The Examiner argues that a notch and an aperture are not the same,
11 since one restrains in one dimension, while the other restrains in two dimensions.
12 Examiner’s Answer at 5.

13 Claim 27

14 18. The Examiner argues that all of the limitations of claim 27 were not
15 claimed in the application within one year. Examiner’s Answer at 4.

16 19. Applicants argue that the “locking mechanism” limitation of claim 27
17 was presented in “pre-bar” claim 1, as the “blocking means,” “power supply
18 means” and “power control means.” Appeal Brief at 25.

19 20. Applicants further argue that since the limitations of pre-bar claim 1 are
20 in means-plus-function format that the corresponding structure in the specification
21 must be considered in construing pre-bar claim 1. *Id.*

22 21. Applicants argue that the structure disclosed in the specification
23 corresponding to the means-plus function limitations of pre-bar claim 1 is located
24 in front of the trigger guard and below the barrel of the gun, and therefore pre-bar

1 claim 1 must be construed as having a locking mechanism located in front of the
2 trigger guard and below the barrel. Id.

3 22. The Examiner argues that means plus function does not encompass
4 location, only structure. Examiner's Answer at 5.

5 23. Applicants also maintain that the limitation of claim 27 is not a material
6 limitation. Appeal Brief at 12. Reply Brief at 2 and 7-8.

7 24. During prosecution of the Fuchs patent application, the examiner of
8 record relied on U.S. Patent 5,946,841 ("Roper") to teach "at least the greater
9 portion of the locking mechanism is located in front of a trigger guard and below
10 the barrel of the pistol." (Application 09/246,050, paper no. 5 at 3).

11 25. In response to the rejection, Fuchs did not argue the patentability of the
12 location limitation.

13 26. Instead, Fuchs argued that the prior art did not teach the geared motor
14 with the threaded spindle and nut connection recited in Fuchs sole independent
15 claim. (Application 09/246,050, paper no. 8 at 3).

16 Claim 29

17 27. Claim 29 recites that the identification unit of claim 25 comprises a
18 finger-print scanner.

19 28. The Examiner argues that the limitation was not claimed in any pre-bar
20 claim. Examiner's Answer at 4.

21 29. Applicants argue that pre-bar claim 1 includes a "power control means"
22 which when properly construed under 35 U.S.C. § 112 ¶ 6 includes a biometric
23 identity device such as a fingerprint reader. Appeal Brief at 25.

24

1 30. On page 17 of Applicants' specification, it is described that the keypad
2 (said to be part of the power control means at page 12) may be replaced by a
3 biometric device such as a fingerprint reader.

4 31. The Examiner apparently does not disagree that pre-bar claim 1 includes
5 a fingerprint reader.

6 32. However, the Examiner argues that a fingerprint reader of pre-bar claim
7 1 is not the same as a fingerprint scanner of post-bar claim 29, since the former
8 collects image data and the latter merely scans the finger. Examiner's Answer at 6.

9 *The pre-bar claims*

10 33. For purposes of our discussion, the focus is on Applicants' original
11 claims 1 and 5 which were presented on 15 March 1999 when Applicants filed its
12 application.

13 34. Applicants' original claims 1 and 5 are as follows:

14 1. In combination:

15
16 a firearm; and an electromechanical locking apparatus for preventing the
17 unauthorized firing of said firearm; said electromechanical locking apparatus
18 including:

19
20 blocking means for blocking normal operation of said firearm;

21
22 power supply means for supplying power;

23
24 and power control means for controlling the supply of power to said
25 blocking means from said power supply means to enable activation of said
26 blocking means to prevent operation of said firearm.

27
28 5. The combination according to claim 4 in which:
29 said trigger of said firearm has at least one aperture;

1 and said preventing means of said axial moving means includes a pin for
2 disposition in said aperture in said trigger of said firearm when said axial
3 moving means is activated to prevent rotation of said trigger of said firearm.
4

5 35. Claims 1 and 5 were first presented in the application prior to one year
6 from the date on which the Fuchs patent issued.

7 36. Claims 1 and 5 are referred to as the “pre-bar” claims since the claims
8 were made prior to one year from the date on which the Fuchs patent issued.

9 **C. Principles of Law**

10 The provisions of 35 U.S.C. § 135(b)(1) (formerly 35 U.S.C. § 135(b)) are
11 as follows:

12 A claim which is the same as, or for the same or substantially the
13 same subject matter as, a claim of an issued patent may not be made in
14 any application unless such a claim is made prior to one year from the
15 date on which the patent was granted.

16 A copied claim that is made after the one year bar may be entitled to an
17 earlier effective date of a prior claim made, if the copied claim does not differ from
18 the prior claim in any material limitation. The analysis focuses on the copied claim
19 to determine whether all material limitations of the copied claim necessarily occur
20 in the prior claim. *In re Berger*, 279 F.3d 975, 981-982, 61 USPQ2d 1523, 1527
21 (Fed. Cir. 2002). Inclusion of a limitation in a claim to avoid prior art provides
22 strong evidence of the materiality of the included limitation. *Id.*

23 **D. Analysis**

24 To provoke an interference with Fuchs, Applicants copied Fuchs claims 1-5
25 and presented them as claims 25-29. The examiner finally rejected claims 25-29
26 under 35 U.S.C. § 135(b)(1) as not having been made prior to one year from the

1 date on which the Fuchs patent was granted. There is no dispute that claims 25-29
2 were presented a year after the Fuchs patent was granted. However, that does not
3 end the inquiry.

4 Applicants “post-bar” claims 25-29 may be entitled to the earlier effective
5 date of its earlier “pre-bar” claims. This analysis requires determining whether a
6 “post-bar” claim contains a material limitation, i.e., a limitation that is necessary to
7 patentability, which was not present in a “pre-bar” claim.

8 Claim 25

9 Claim 25 includes “a plurality of display elements configured to display an
10 operating status of the locking mechanism” (ff 2).² The Examiner and Applicants
11 agree that the limitation was not previously presented. The Examiner contends that
12 the limitation is “material” while Applicants contend that it is not.

13 Applicants have directed our attention to evidence of record in the Fuchs
14 patent application that demonstrates that the “plurality of display elements”
15 limitation is not a material limitation. Specifically, Applicants direct our attention
16 to Teetzel to demonstrate that display elements that indicate when the firearm is
17 locked and when the battery is low are common in prior art electronic locking
18 mechanisms (ff 12). Moreover, Applicants have sufficiently demonstrated that
19 during prosecution of the Fuchs patent, that the display limitation was never the
20 basis for patentability, since Teetzel was cited as evidence that display elements
21 were known in the prior art and that Fuchs did not argue otherwise (ff 13).

22

2 ff denotes finding of fact.

1 The Examiner’s response that the ‘plurality of display elements’ limitation is
2 material to the claimed invention (ff 14) is conclusory and not based on supporting
3 evidence or an articulated rationale.

4 For these reasons, the examiner’s rejection of claim 25 on the basis that a
5 “plurality of display elements” is a material limitation not previously presented in
6 any pre-bar claim cannot be sustained. The Examiner’s rejection with respect to
7 claims 25 and 28, which stands or falls with claim 25 (ff 8), is reversed.

8 Claim 26

9 Claim 26, which depends from independent claim 25, recites “wherein the
10 locking element is configured to engage a *notch* in the trigger tongue...” (ff 2).
11 Applicants and the Examiner focus on the difference between claim 26 with the
12 *notch* limitation and pre-bar claim 5, which recites that the trigger has at least one
13 *aperture*, in which a pin engages (ff 34).

14 The Examiner’s contention that the post-bar claim 26 notch limitation is *not*
15 *the same* as the pre-bar claim 5 aperture limitation (ff 15) does not demonstrate that
16 claim 26 differs from pre-bar claim 5 in any material limitation, e.g., that the
17 “notch” limitation is materially different from the “aperture” limitation. The test is
18 not whether the pre-bar claim is the same as the post-bar claim. Rather, the inquiry
19 is whether the post-bar claim includes any material limitations that were not
20 present in the pre-bar claim.

21 Based on the record, the Examiner has failed to direct our attention to
22 evidence, such as the inclusion of the notch limitation during *ex parte* prosecution
23 to avoid prior art, that would demonstrate that the notch limitation is materially
24 different from the aperture limitation. Applicants point to evidence that there is no

1 material difference between a notch and an aperture, since (1) both serve as a
2 receptacle for an insert that prevents rotation of the trigger (2) during the
3 prosecution of the Fuchs patent the “notch” limitation was not cited as the basis for
4 patentability and (3) Applicants’ specification refers to “notches” and “apertures”
5 interchangeably (ff 16). The Examiner does not direct our attention to supporting
6 evidence to the contrary. For these reasons, the rejection of claim 26 is reversed.

7 Claim 27

8 Claim 27 includes that “at least the greater portion of the locking mechanism
9 is located in front of a trigger guard and below the barrel of the pistol” (ff 2). The
10 Examiner argues that the limitation was never present in any pre-bar claim, while
11 the Applicants argue that the limitation was present in pre-bar claim 1.

12 Specifically, Applicants argue that pre-bar claim 1 includes “blocking
13 means,” “power supply means,” and “power control means” which are all part of
14 the “locking mechanism,” and which are described in Applicants’ specification as
15 at least the greater portion being located in front of the trigger guard and below the
16 barrel of the gun (ff 21).

17 The Examiner argues that a means limitation should not be interpreted to
18 include the location of the associated structure (ff 22). For purposes of this
19 decision, we assume without deciding, that the greater portion of the associated
20 structure for the “blocking means,” “power supply means,” and “power control
21 means” is not necessarily located in front of the *trigger guard* and below the barrel
22 of the gun. However, that does not end the inquiry.

23 While the Applicants contend that the claim 27 limitation was present in pre-
24 bar claim 1, Applicants also argue that in any event the limitation of that claim is

1 not material to patentability (ff 23). The Examiner fails to address the materiality
2 of the limitation. Instead, the Examiner’s position appears to be that since the
3 limitation of post-bar claim 27 was not in any pre-bar claim, that post-bar claim 27
4 with such limitation is automatically barred (ff 18). As reiterated above, the test is
5 not whether a pre-bar claim is the same as a post-bar claim. The test is whether the
6 post-bar claim differs from the pre-bar claim in any material limitation.

7 Applicants argue in both the Appeal Brief and again in the Reply Brief that
8 the limitation is not material because it is not necessary to patentability (ff 23).
9 The Examiner does not respond to the argument.

10 Moreover, during prosecution of the Fuchs patent, the examiner of record
11 relied on Roper to teach “at least the greater portion of the locking mechanism is
12 located in front of a trigger guard and below the barrel of the pistol” which
13 limitation was recited in dependent claims. In response to the rejection, Fuchs did
14 not argue the patentability of the location limitation. Instead, Fuchs argued that the
15 prior art did not teach the geared motor with the threaded spindle and nut
16 connection recited in Fuchs sole independent claim (ffs 24-26).

17 Thus, based on the record evidence, the location limitation was not the basis
18 for patentability of the Fuchs claims and has therefore not been shown to be a
19 material limitation. For these reasons, the Examiner’s rejection of claim 27 cannot
20 be sustained.

21 Claim 29

22 Claim 29 recites that the “identification unit comprises a finger-print
23 scanner” (ff 2). The Examiner apparently agrees with Applicants that the “power
24 control means” recited in pre-bar claim 1, includes an identification unit that can be

1 a finger print reader. The Examiner argues though that the post-bar “finger-print
2 scanner” is not the same as the pre-bar “fingerprint reader” (ff 32). A reader
3 implies scanning and recognizing, and therefore it would appear that a fingerprint
4 reader necessarily includes a finger-print scanner. In any event, even if a
5 fingerprint reader does not necessarily include a finger-print scanner, the
6 Examiner’s argument that a finger-print scanner is not the same as a fingerprint
7 reader misses the mark.

8 As discussed above, the law does not require that a pre-bar claim be the
9 same as a post-bar claim. Rather, the post-bar claim cannot differ from the pre-bar
10 claim in any material limitation. The Examiner has failed to sufficiently
11 demonstrate that a fingerprint scanner is a material limitation, especially since the
12 pre-bar claim 1 includes a fingerprint reader. The claim 29 fingerprint scanner has
13 not been shown to be a material limitation over the pre-bar claim 1 fingerprint
14 reader. For this reason, the rejection as to claim 29 is reversed.

15 102(e)

16 The Examiner rejected claims 25-29 under 35 U.S.C. § 102(e). An
17 interference is declared simultaneously with this decision to determine priority of
18 invention between Applicants and Fuchs. Therefore, the 35 U.S.C. 102(e)
19 rejection is dismissed as moot.

20

21 **E. Decision**

22 The Examiner’s rejection of claims 25-29 under 35 U.S.C. 135(b)(1) is
23 reversed.

24

