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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NIKLAS VESTLING and TOBIAS VESTLING¹

Appeal 2019-004157
Application 29/538,604
Reissue of US Patent D651,681²
Technology Center 2900

Before RAE LYNN P. GUEST, JILL D. HILL and CYNTHIA L. MURPHY,
Administrative Patent Judges.

GUEST, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s decision to reject the claimed design under 35 U.S.C. § 112(a), for lack of written descriptive support.³ *See* Examiner’s Final Office Action, dated April 11, 2018 (“Final Act.”); Examiner’s Answer, dated March 4, 2019 (“Ans.”). We have jurisdiction under 35 U.S.C. § 6(b).

¹ The Appellant/Applicant in this case is the real party in interest Nitoves AB. *See* Appellant’s Appeal Brief 2, filed December 11, 2018 (“Appeal Br.”).

² US Patent D651,681, issued January 3, 2012, to Niklas Vestling et al (“the ’681 patent”).

³ The Examiner has expressly stated that the claims distinguish over the closest prior art of record. Final Act. 6–7.

We AFFIRM.

The application on appeal seeks reissue of US Patent D651,681 (“the ‘681 patent”). The ‘681 patent issued from U.S. Application 29/362,505, filed May 26, 2010 (“the ‘505 application”), claiming priority to a European Union application filed November 26, 2009. Appellant’s design is for a “Gun Sight.” ‘681 patent, Title. The originally filed drawings of the ‘505 application included Figures 1–7, directed to a “single barrel” embodiment, for which we reproduce below Figures 3 and 5 as representative figures, and Figures 8–14, directed to a “double barrel” embodiment, for which we reproduce Figures 10 and 12 as representative figures.

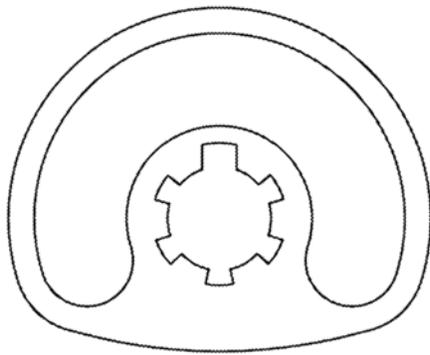


Figure 3

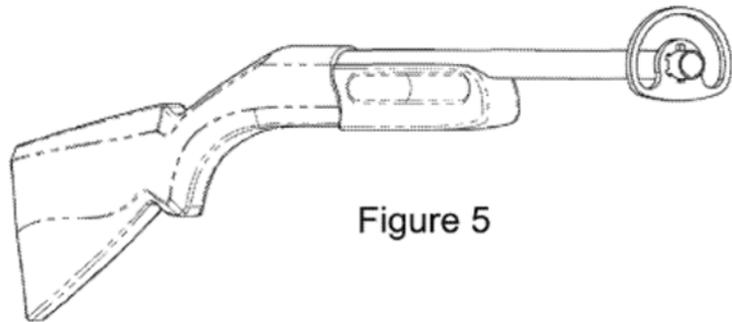


Figure 5

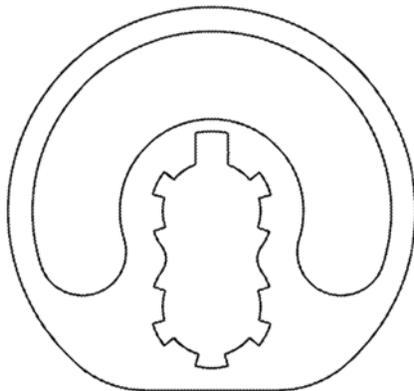


Figure 10

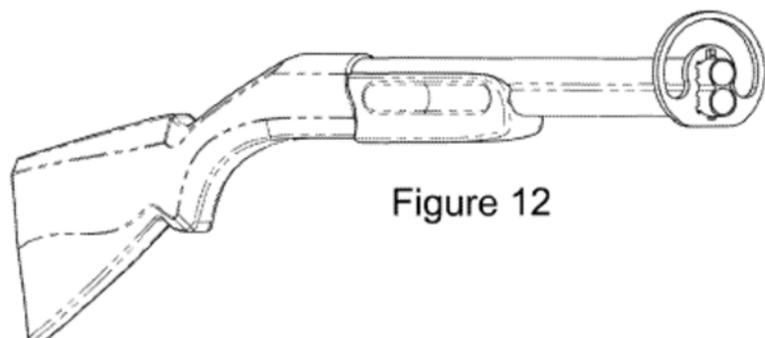


Figure 12

Original Figure 3 depicts a rear elevation view of a single barrel embodiment of a gun sight having a U-shaped aperture and a second aperture with a spoke appearance positioned within the U-shaped aperture. Original Figure 5 depicts, in a perspective view, the gun sight of original Figure 3 positioned on the distal end of a single barrel shotgun-style gun with the barrel placed in the second aperture and the U-shaped aperture partially surrounding the shotgun's barrel. Original Figure 10 depicts a rear elevation view of a double barrel embodiment of a gun sight having a substantially similar U-shaped aperture to that of original Figure 3, but with a spoked-figure 8-shaped aperture with an upper-portion of the 8-shape positioned within the U-shaped aperture, and the lower-portion of the 8-shape positioned outside of the U-shaped aperture. Original Figure 12 depicts, in a perspective view, the gun sight of original Figure 10 positioned on the distal end of a double barrel shotgun-style gun with both barrels placed in the second aperture and the U-shaped aperture partially surrounding only shotgun's upper barrel.

During prosecution of the '505 application, these drawings were subject to a restriction requirement between the single barrel figures and double barrel figures, with the double barrel figures, original Figures 8–14, elected for prosecution and with the single barrel figures, original Figures 1–7, withdrawn and eventually cancelled. The '681 patent issued with the only amendments to elected original Figures 12–14 being that the solid lines representing the shotgun-style gun shown in original Figure 12 above were amended to be depicted in phantom dotted lines to indicate that the gun's particular shape was environmental and not part of the claimed design of the "gun sight." Patented figures 3 and 5 are reproduced below for comparison.

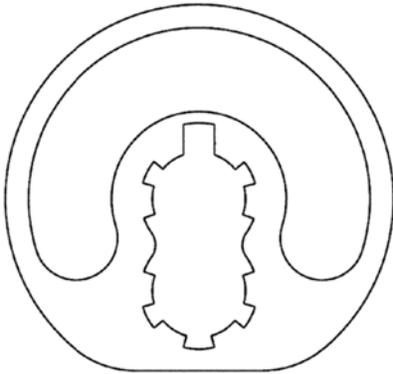


Figure 3

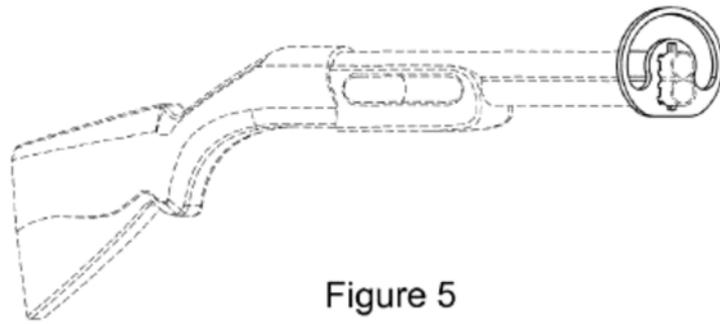


Figure 5

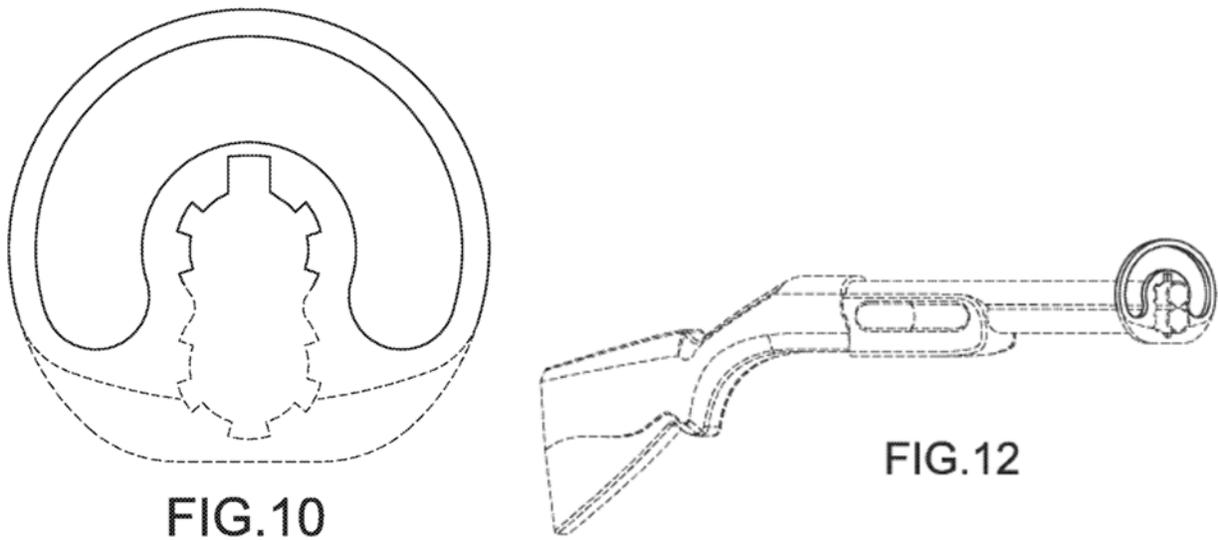
Patented Figure 3 depicts a rear elevation view of a double barrel embodiment identical to that of original Figure 8 reproduced above. Figure 5 depicts, in a perspective view, the gun sight of patented Figure 3 positioned on the distal end of a double barrel shotgun-style gun, substantially identical to that of original Figure 12 reproduced above, but with the entire shotgun-style gun shown in phantom dotted lines.

Reissue of the '681 patent was sought in a first reissue application 29/456,164, filed May 29, 2013 ("the '164 application"), which was less than two years from issuance of the '681 patent. The '164 application added drawings that were broader in scope than those issued in the '681 patent, but were subject to a restriction requirement between the issued drawings and the added drawings with the constructive election of the issued drawings and the constructive withdrawal and later cancellation of the added drawings. The added drawings were subsequently filed in this application as a divisional reissue application of the '681 patent. The '164 application issued as US Patent RE45,740 with the drawings identical to those in the '681 patent and some minor corrective amendments to the specification that does not significantly affect the scope of the claimed design vis-

à-vis the '681 patent. The present reissue application, being a divisional reissue application, is characterized also as a reissue of the underlying '681 patent and not as a reissue of the RE45,740 patent.

Oral argument was heard for the present reissue application on August 7, 2019, the transcript of which will be mailed in due course.

The drawings at issue in this appeal are reissue Figures 8–14, of which reissue Figures 10 and 12 are reproduced below as representative.



Reissue Figure 10 is a rear elevation view of an embodiment of a gun sight, similar to that of patent Figure 3 reproduced above, but with (i) a lower-portion of the spoked-figure 8-shaped second aperture, (ii) a lower-portion of the outer surface of the gun site, and (iii) an additional “boundary line” drawn under the U-shaped aperture and on either side of the lower-portion of the spoked-figure 8-shaped second aperture, all depicted in phantom dotted lines. Reissue Figure 12 is a perspective view similar to that of patent Figure 5 reproduced above, but with the same portions of the gun sight of Figure 10 depicted in phantom dotted lines.

II. DISCUSSION

We review the appealed rejections for error based upon the issues identified by Appellant and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (*cited with approval in In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.”)).

The Examiner rejects the claimed figures under 35 U.S.C. § 112(a) for lack of written descriptive support. Final Act. 2–4. According to the Examiner, “in removing only a portion of a claimed component, the applicant provided an appearance that was not originally described and consequently did not comply with the written description requirement.” *Id.* at 4.

Appellant contends that the claim is genus claim encompassing both the single barrel and double barrel embodiments and only expressly recites “the common or generic elements of these two embodiments” (App. Br. 6) and that “the claim includes *a broken line boundary line* that separates the portions of the two designs that are common from the portions of the designs that are not common.” (App. Br. 12) (emphasis added). Accordingly, Appellant contends that a claim drawn to a generic design is not new matter, based on the well-known doctrine that the written description requirement for a genus may be satisfied through sufficient description of a representative number of species. App. Br. 7 (citing MPEP § 2163.05(I)(B)).

The Examiner’s rejection appears to be based on a finding that the drawings are not directed to a generic embodiment to both the original single barrel embodiment and the double barrel embodiment, as argued by Appellant. Indeed,

the Examiner suggests that rather than a genus claim, Appellant is “designating boundaries to the second embodiment based upon the first embodiment.” Ans. 7. Specifically, the Examiner objects to the addition of the lower boundary line from the single barrel embodiment into the design of the double barrel embodiment and that “[o]ne viewing the two designs would not have contemplated that the bottom edge of the first embodiment was ever envisioned to be a possible boundary for the second embodiment.” Ans. 8.

Thus, we start our written description analysis by first construing the claim and discerning if the claimed invention is indeed a generic claim or not. In particular, we determine that the claimed invention is not directed to a genus, but rather must be directed to a double barrel embodiment.

Initially, the Examiner points to the “numerous differences in the notched aperture at the center” between the single barrel and double barrel embodiments. Ans. 9. The Examiner’s claim interpretation primarily focuses on the differences in the lengths of the notches between the two designs and “the claimed areas between the notched apertures and the U-shaped channels also differ.” Final 7. Indeed, the Examiner finds that the notches of the single barrel and double barrel embodiments have differences in length that “create[] a drastically different appearance.” Ans. 12.

Appellant presents the following annotated figure, overlaying original Figures 3 in lighter lines and original Figure 10 in darker lines, in arguing that “the designs are mostly identical.” App. Br. 8.

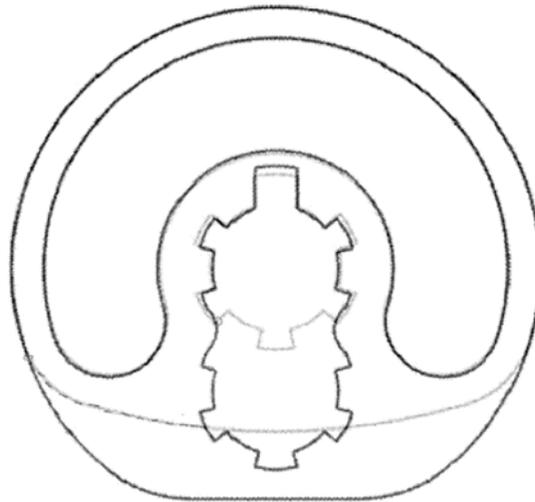


Figure 3

Figure 10

App. Br. 8. Of particular note, Appellant argues that this overlay shows “the same top portion of the central [second] aperture that accommodates the gun barrel.”

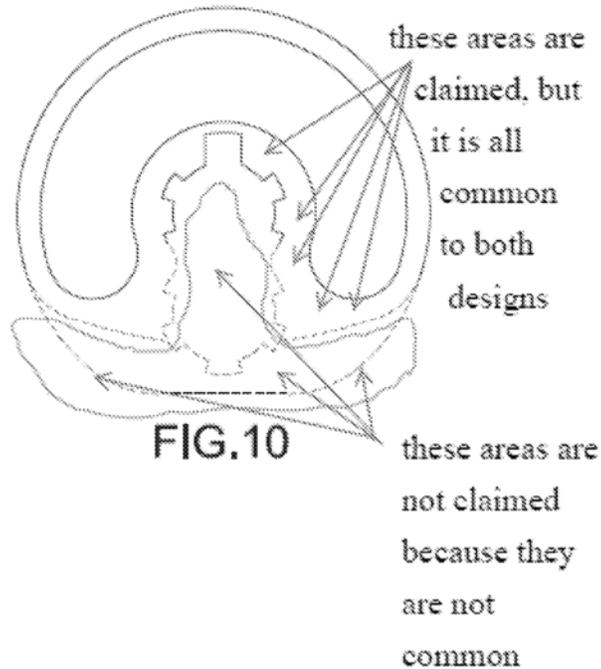
App. Br. 9. Appellant notes the differences being “in the double barrel design, the central aperture necessary extends lower to accommodate the second barrel” and that “[t]he outer peripheral edge is also lower to accommodate the larger central aperture,” which, according to Appellants, “do not introduce differing design elements or motifs.” App. Br. 9. Appellant further acknowledges that the length and height of the notches appears slightly different in the two designs, but contends that there is no difference in overall spacing or shape of the two apertures. App. Br. 10.

Even setting aside the differences in the notches,⁴ we agree with the Examiner that the claim is not generic, but rather must be directed to a double

⁴ We generally agree with the Appellant that the variations in the length and spacing of the notches between the notched aperture of the single barrel embodiment and the upper half of the figure 8-shaped notched aperture of the double barrel embodiment are very small, and, alone, do not contribute to a

barrel embodiment. As the Examiner notes, “[t]he claimed embodiment includes a considerably longer aperture that extends into the space where the [single barrel lower external] boundary has been added. Therefore, the bottom edge is interrupted at the center and the edges of the longer aperture are used as substitute boundaries.” Ans. 10.

Appellant has provided the following annotated reissue Figure 10, with an added irregularly-shaped enclosed area and with arrows and captions, to attempt to clarify where the claimed and unclaimed portions exist.



substantially different overall look to the uppermost portions of the two gun sights. Nonetheless, the fact that the notches are (i) different, (ii) admittedly “a function of their use on either single barrel or over/under double barrel shotguns” (App. Br. 7), and (iii) consistent with the notches of only the double barrel embodiment, rather than some genus representing some common portions of both (see the Examiner’s suggestion of a “range” rather than an exact location for the notches), further supports our interpretation that the claim is not generic, but rather recites only a double barrel embodiment.

App. Br. 16. We cannot agree with Appellant's interpretation of what is claimed versus unclaimed subject matter in the design drawings.

In particular, on the interior of the notched aperture, where there is air or open space, the Appellant has drawn an artificial boundary line, this one being an irregular-shaped line suggesting that some of the air or open space within the notched aperture is claimed and some of the air or open space within the notched aperture is not claimed. Appellant provides no reason or support for this arbitrary line, or any other arbitrary line, to define the claimed scope of the interior air or open space of the notched aperture.

In *In re Owens*, 710 F.3d 1362 (Fed. Cir. 2013), the Federal Circuit quoted the language of our Manual of Patent Examining Procedure (MPEP) in stating that “when an unclaimed boundary line is introduced via amendment or continuation, it is ‘understood that the claimed design extends to the [unclaimed] boundary but does not include the [unclaimed] boundary.’” *Owens*, 710 F.3d at 1367 (quoting MPEP § 1503.02(II)). MPEP § 1503.02(II) describes two “common uses of broken lines” either “to disclose the environment related to the claimed design” or “to define the bounds of the claim.” MPEP § 103.02(II). The MPEP further indicates that “environmental” is “structure that is not part of the claimed design” and “includes any portion of an article in which the design is embodied, or applied to, that is not considered part of the claimed design.” *Id.* However, also “[a] boundary line may be shown in broken lines if it is not intended to form part of the claimed design. Applicant may choose to define the bounds of a claimed design with broken lines when the boundary does not exist in reality in the article embodying the design.” *Id.*

The Federal Circuit stated that “when an unclaimed boundary line divides a previously claimed area, it indicates that the applicant has disclaimed the portion beyond the boundary *while claiming the area within it*. Where permissible, unclaimed boundary lines allow the patentee to adjust his patent coverage and encompass embodiments *that differ slightly but insignificantly from the originally-filed design.*” *Owens*, 710 F.3d at 1367 (emphasis added).

In the original drawings for both embodiments (i.e., the drawings originally filed in the ‘505 application), the notched line defined the air or open space of the notched aperture as well as the solid portion of the gun sight adjacent thereto, with both the solid portion and the air or open space being claimed subject matter. In a similar way, the U-shaped outline defined the air or open space of the U-shaped aperture and the solid portion of the gun sight adjacent thereto, as it does in the present claim. In the reissue claim on appeal, only the top portion outlining the notched aperture of the double barrel embodiment is solid and the bottom portion outlining the notched aperture of the double barrel embodiment is dotted.

The Appellant argues that the claimed portion of the design extends up to but does not include dotted line *only on the solid portion of the gun sight*. App. Br. 15-18; Oral Argument Transcript 5:22-6:9. Yet, simultaneously, Appellant argues that the claimed air or open space portion of the notched aperture does not similarly extend throughout the open space and up to the dotted line, but is rather cut off at some arbitrary point. App. Br. 16. Yet, we find no boundary within the interior air or open space of the aperture other than the lower dotted boundary line that defines a lower boundary for that air or open space. Within the meaning of boundary lines as stated in *Owens* and in the MPEP discussed above, we understand that the claimed portion of the air or open space of the notched aperture

also extends up to but does not include the dotted notched aperture boundary line, as it would for the solid portion of the gun sight. Accordingly, the claimed air or open space of the notched aperture extends to encompass most of the figure 8-shaped notched aperture of the double barrel embodiment. The dotted boundary line between the air or open space of the notched aperture and the solid portion of the gun sight adjusts patent coverage only to encompass a slightly different but insignificantly shaped boundary between these two otherwise claimed areas from the originally filed design. For example, the dotted boundary portion encompasses a smooth or jagged boundary as opposed to the formerly claimed notched boundary, but otherwise a boundary between the two claimed areas still exists.

This interpretation must be correct because no lower boundary to the air or open space portion of the notched aperture other than the broken dotted line is provided. The solid line upper portion of the notched aperture suggests, and Appellant similarly argues, that at least some of the air or open space is similarly claimed herein, just as the original design claimed both the solid structure and the aperture air or open space in its design. Without the dotted boundary line of the notched aperture functioning as the unclaimed boundary line of both the claimed solid portion of the gun sight and the claimed air or open space, there would be no way to determine clearly a distinction between the claimed portion and the unclaimed portion of the air or open space of the aperture.⁵ Nor are we inclined, as suggested by Appellant, to read into the claim an artificial boundary somewhere (where?) within the air or open space of the notched aperture, as no such other boundary line, solid or dotted, is depicted in the drawings within the notched

⁵ In other words, the claim would be indefinite under 35 U.S.C. § 112(b) for failure to distinctly claim the subject matter regarded as the invention.

aperture.⁶ Appellant’s proposed claim interpretation does not consider both the interior and exterior aspects of the now partially dotted boundary line that, in both original embodiments, defined the line between the air or open space of the notched aperture and the solid portion of the gun sights.

We find the interior aspect of the notched aperture particularly relevant as to whether or not the claim is directed to a genus. Indeed, we interpret the dotted boundary between the air or open space of the notched aperture and the solid portion of the gun sight, such that both the air or open space of the notched aperture and the solid portion of the gun sight are claimed and extend up to but do not include the actual boundary therebetween. Thus, the claim is not generic, but rather directed to a double barrel embodiment because the air or open space of the notched aperture extends lower into the gun sight beyond the notched aperture of the single barrel embodiment and generally has the figure-8 shape of the double barrel embodiment, notwithstanding the unclaimed exact shape of the boundary line there between. The lower half of the air or open space of the figure 8-shaped notched aperture is not present in the single barrel embodiment.

Based on this claim interpretation, we next consider the Examiner’s rejection under 35 U.S.C. § 112(a) for lack of written description support.

“The test for sufficiency of the written description, which is the same for either a design or a utility patent, has been expressed as ‘whether the disclosure of

⁶ Even if another dotted or solid line were present as an arbitrary boundary line, such as the irregular one suggested by Appellant in their Brief (App. Br. 16), it would not reflect a boundary that existed in the original disclosure, per the Federal Circuit’s guidance in *Owens*. *Owens*, 710 F.3d at 1369 (“unclaimed boundary lines typically should satisfy the written description requirement *only if they make explicit a boundary that already exists*, but was unclaimed, in the original disclosure.”) (emphasis added).

the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.’ In the context of design patents, the drawings provide the written description of the invention.” *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013) (quoting *In re Daniels*, 144 F.3d 1452, 1455 (Fed. Cir. 1998)).

We agree with Appellant that, in considering written description support, we look to the application as originally filed, i.e., in the ’505 application, which includes a “single barrel” embodiment (original Figures 1–7) and a “double barrel” embodiment (original Figures 8–17). However, we disagree that the claimed design is a generic design to both embodiments, but rather find that the figures are directed to a double barrel embodiment similar to the original double barrel embodiment but with slightly broadened scope with respect to the actual lower boundaries of the notched aperture. Thus, the inclusion of the lower boundary line from the single barrel embodiment, which is not present in the double barrel embodiment, is, as the Examiner finds, incorporating a feature of the single barrel embodiment into the double barrel embodiment.

While we agree that the skilled artisan would have understood that there are some common features to both the single barrel and double barrel design, this reasoning does not support the addition of the lower exterior boundary line of the single barrel embodiment into a double barrel embodiment, such that it intersects with the unclaimed boundary between air or open space of the aperture and the solid portion of the gun sight.⁷ Because the claim is directed to a double barrel

⁷ While we decline to add a new ground of rejection under 35 U.S.C. § 112(b), as we interpret the notched boundary line as being an interior, exterior aperture boundary, albeit with an undefined exact shape, the addition of the single barrel embodiment exterior line boundary renders indefinite the scope outside of that line

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embodiment, and not a generic embodiment as argued by Appellant, we agree with the Examiner, that the skilled artisan would not have contemplated a double barrel embodiment with the lower boundary of the single barrel embodiment.

We decline to opine on what a skilled artisan would or would not have included in a generic embodiment encompassing both a single barrel and a double barrel gun sight, or if a generic design is even possible when constrained by the original disclosure presented herein. We need not do so because the claim before us at this time is not a generic design for the reasons discussed above.

IV. CONCLUSION

On the record before us and for the reasons discussed above, we affirm the rejection maintained by the Examiner, namely the rejection of the reissue claimed design under 35 U.S.C. § 112(a), for lack of written descriptive support.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

as well as the scope outside of the dotted notched aperture boundary. Appellant contends that the dotted double barrel exterior boundary line, which is still present, is environmental only, but its presence and the relationship between it and the single barrel exterior boundary line and/or the double barrel notched aperture line is unclear.