

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(2) is not binding precedent of the Board.

Paper No. -31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte SHOHEI MASUI, KANEMITSU OISHI  
and KIYOSHI MITSUI

MAILED

JAN 27 1997

PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 94-4353  
Application 07/793,329<sup>1</sup>

HEARD: January 14, 1997

Before FRANKFORT, LEE and WEIFFENBACH, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 3, 7, 8, 14-17, 19 and 20.

References Relied on by the Examiner

U.S. Patent No. 3,857,658	Muzsnay	Dec. 31, 1974
Japanese Kokai 60-31929	Masui et al.	Feb. 18, 1985

<sup>1</sup> Application filed November 15, 1991. According to the examiner, the application is a continuation of application 07/206,304, filed June 14, 1988, now abandoned, which is a continuation of application 06/829,114, filed February 14, 1986, now abandoned.

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The Rejections on Appeal

Claims 3, 7, 8, 14-17, 19 and 20 have been rejected under 35 U.S.C. § 103 as being unpatentable over Japanese Kokai 60-31929. Claims 3, 7, 8, 14-17, 19 and 20 have also been rejected under 35 U.S.C. § 103 as being unpatentable over Japanese Kokai 60-31929 and Muzsnay (final Office action, Paper No. 14). The examiner's answer at 3 stated the first rejection twice and neglected to state the second rejection. However, the record as a whole makes it clear that the second rejection is made over the combined teachings of Japanese Kokai 60-31929 and Muzsnay.

No other claims are pending in this application.

The Invention

The invention is directed to a method for press molding. During the molding process and while the mold is closing, supply of resin melt to the mold is commenced and stopped when the cavity clearance of the mold is within certain specified ranges. Independent claim 15 reads as follows:

A method for press molding in [sic] a thermoplastic resin comprising:

    providing an unclosed mold having upper and lower halves,

    initiating closing of said upper and lower halves of said mold,

    interrupting said mold closing,

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supplying a resin melt of said thermoplastic resin to a cavity of said unclosed mold comprising said upper and lower halves through at least one passage formed in a wall of said mold, said upper and lower halves being respectively attached to upper and lower platens of a vertically movable press such that introduction of said resin melt to said cavity is started when clearance of said cavity is not greater than 50 mm and completed when the clearance reaches a distance of  $(t + 0.1)$  mm or larger when  $t$  is not less than 5.0 mm, or  $(t + 1/2t)$  mm or larger when  $t$  is less than 5.0 mm and not less than 1.0 mm, or 1.5 mm or larger when  $t$  is less than 1.0 mm, " $t$ " being the thickness of said molded article,

pressing said resin melt in said mold by restarting the closing of said upper and lower halves of said mold, before the supplying of the resin is finished, until completion of mold closing without further interruption of said closing of said mold following completion of the supplying of said resin melt, and

cooling the molded article in said mold.

#### Opinion

At the outset, it should be noted that the Paper Nos. listed on the official file wrapper jump from Paper No. 40, filed on February 24, 1992, to Paper No. 8, filed on April 24, 1992, which is an Office action. The Office action dated April 24, 1992, however, identifies itself as Paper No. 41. The papers thereafter are marked beginning with Paper No. 9, a declaration filed on October 26, 1992, under 37 CFR § 1.132 concerning the inventive contributions of each original named inventor.

The first rejection of claims 3, 7, 8, 14-17, 19 and 20 is based on Japanese Kokai 60-31929 alone. The second rejection of

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the same claims is based on the combined teachings of Japanese Kokai 60-31929 and Muzsnay. Key to this appeal is the question whether Japanese Kokai 60-31929 is proper prior art under 35 U.S.C. § 102(a). We hold that it is not.

Accordingly, neither rejection will be sustained.

Evidently, based on parent applications, the accorded effective filing date for this application is February 14, 1986. Japanese Kokai 60-31929 (Japanese '929 reference) has a publication date of February 18, 1985, less than one year prior to the effective filing date of the appellants' application. Therefore, the Japanese '929 reference is manifestly not prior art under 35 U.S.C. § 102(b). The examiner contends, however, that the Japanese '929 reference is proper prior art under 35 U.S.C. § 102(a), which provides that a person shall be entitled to a patent unless:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent,

The Japanese '929 reference was published in Japan, and the examiner pointed to no evidence in the record that any of the named authors of that reference resided in the United States. Accordingly, the first part of 35 U.S.C. § 102(a) clearly does not apply. The second part of 35 U.S.C. § 102(a) requires that there be a printed publication in this or a foreign country,

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which the Japanese '929 reference is. However, a further requirement must be met before the Japanese '929 reference can properly be regarded as applicable reference under 35 U.S.C. § 102(a), i.e., that it be published "before the invention thereof by the applicant for patent."

Implicit in 35 U.S.C. § 102(a) is the principle that an inventor's own work cannot be used against himself or herself. That is necessarily so because the inventor's own work cannot possibly precede the invention thereof by the inventor. The Court of Customs and Patent Appeals embraced this view in In re Katz, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982). In In re Katz, 687 F.2d at 455, 215 USPQ at 18, the Court stated:

Since the publication in this case occurred less than one year before appellant's application, the disclosure comes within the scope of § 102(a) only if the description is not of appellant's own work.

This application as originally filed named four co-inventors, Masui, Oishi, Mitsui and Omura. However, together with a preliminary amendment filed on February 24, 1992, which canceled claims 6, 9, 18 and 21, a petition to correct inventorship was filed which sought under 37 CFR § 1.48(b) to remove Omura as an inventor. The petition stated that Omura's invention "is no longer being claimed in the present application in view of the cancellation of claims 6, 9, 18 and 21."

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It appears that the petition was never "formally" acted on by the examiner. We can find no paper in the official file .. denominated as a decision on petition to correct inventorship. Nor have we found any statement by the examiner expressly stating that the petition to correct inventorship has been granted or denied. Nonetheless, it appears that the examiner has granted the petition to correct inventorship. In the first paper from the examiner subsequent to the petition to correct inventorship, the examiner stated (Paper No. 41; April 24, 1992) at pages 3-4:

JP '929 has four listed inventors, namely, Masui, Oishi, Mitsui and Omura while the present application has three applicants, namely Masui, Oishi and Mitsui.

Again, in an Office action mailed January 12, 1993, at page 5, the examiner reiterated that in this application, there are three named inventors, Masui, Oishi and Mitsui. Furthermore, the entire § 102(a) issue before us assumes that Omura is no longer a named inventor in the involved application on appeal.

For the foregoing reasons, and in light of the fact that a primary examiner does have authority to grant a petition to correct inventorship under 37 CFR § 1.48, Manual of Patent Examining Procedure (Sixth Ed., Rev. 1, Sept. 1995), Section 1002.02(e), we presume that the petition to correct inventorship has been granted.

The Japanese '929 reference has four co-authors who are the same as the four inventors originally named in this application.

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Before the examiner, the appellants submitted a declaration under 37 CFR § 1.132, by Masui, Oishi and Mitsui, three of the four co-authors of the Japanese '929 reference. It identified "all of the contributions made by Omura" in the Japanese '929 reference by underlining the corresponding text in an English translation of the reference. It also identified the inventive contribution of each of the four individuals for all claims in this application. It is represented that Omura contributed only to the subject matter of claims 6, 9, 18 and 21. Those claims, of course, have already been canceled by amendment.

The examiner did not disbelieve the appellants' representations. She also did not require that a declaration be obtained from Omura, whose inventive contribution was at issue. We are not suggesting that such a declaration should have been required, but are merely noting that the matter is not an issue before us in this appeal. It is evident that the examiner accepted the representations of the appellants insofar as what the inventive contributions were of each individual concerned.

The examiner is of the view that so long as Omura made any inventive contribution to the subject matter disclosed in the Japanese '929 reference, regardless of whether or not that inventive subject matter is now claimed in this application, the Japanese '929 reference is applicable prior art under 35 U.S.C. § 102(a). In the examiner's answer at page 5, it is stated:

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Appellant argues that JP'929 is not a "publication" under 35 USC 102(a) because Omura is merely a co-author, not a co-inventor in JP'929. The Examiner disagrees because Omura clearly contributed subject matter of his own invention to the JP '929 publication, as marked on page 8 of Appellant's submitted translation. This is unlike the situation in In re Katz, 215 USPQ 14, wherein the co-authors were "students working under the direction and supervision of appellant" and who were "involved only with assay and testing features of the invention".

The position taken by the examiner is erroneous. While Omura did indeed contribute to certain features disclosed in the Japanese '929 reference, the examiner does not dispute the appellants' position that those features are not claimed by the current applicants, Masui, Oishi and Mitsui. The principle represented by Katz is not just that when applicants are co-authors with other individuals in a prior publication, if the additional co-authors did not invent "any" subject matter, then the publication is not prior art against the applicants under 35 U.S.C. § 102(a). Rather, it is broader. We hold that so long as the additional co-author(s) did not make inventive contribution to that subject matter which is now claimed by the applicants, the publication is not prior art against the applicants who are co-authors to the publication.

If Omura did not make inventive contribution to that disclosed subject matter in the Japanese '929 reference which corresponds to what is now claimed, the disclosure, insofar as the claimed invention is concerned, is that of Masui, Oishi and

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Matsui themselves. Therefore, the pertinent disclosure could not have been prior to the invention thereof by the applicants, under 35 U.S.C. § 102(a). The fact that Omura did make inventive contribution to additional features disclosed in the reference is irrelevant, because the examiner evidently has accepted the applicants' representation that that material has not been claimed in any claim on appeal.

The examiner has not articulated an adequate basis, on this record, to maintain the Japanese '929 reference as applicable prior art under 35 U.S.C. § 102(a).

To the appellants' contention that Muzsnay does not disclose the claimed method, the examiner replies (Answer at page 5) simply that it is the combined teachings of the Japanese '929 reference and Muzsnay which is relied on for the rejection based in part on Muzsnay. Thus, this § 103 rejection must fall if the Japanese Kokai is not applicable prior art.



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