

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERNEST J. DEL MONTE

Appeal No. 95-4866
Application 08/179,770¹

ON BRIEF

Before GARRIS, WARREN and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 38-46 and 48 and refusal to allow claims 32-37 and 47 as amended after final rejection. These are all of the claims

¹ Application for patent filed January 10, 1994. According to appellant, the application is a continuation of Application 07/888,916, filed May 26, 1992, abandoned.

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remaining in the application.

THE INVENTION

Appellant claims a portable concrete molding apparatus which includes, *inter alia*, 1) a first fixed wall affixed to a portable trailer, wherein the wall has an outer substantially planar mold surface and a second plenum surface, 2) a second fixed wall affixed to the trailer parallel to the first fixed wall and spaced apart therefrom, wherein the second fixed wall has an outer substantially planar mold surface which opposes the plenum surface of the first fixed wall, and has a second plenum surface, and 3) first and second movable walls connected to the trailer and movable, respectively, relative to the first and second fixed walls between a casting position adjacent to the mold surface of the respective fixed walls and a discharging position remote from the respective fixed walls. Claim 46 is illustrative and reads as follows:

46. A portable concrete molding apparatus, comprising;
- (a) a portable trailer having a longitudinal axis;
 - (b) a first fixed wall affixed to the trailer, the first fixed wall including an outer substantially planar mold

surface and a second plenum surface;

(c) a second fixed wall affixed to the trailer parallel to the first fixed wall and spaced apart from the first fixed wall by a given distance, the second fixed wall including an outer substantially planar mold surface and a second plenum surface,

wherein the plenum surface of the second fixed wall opposes the plenum surface of the first fixed wall;

(d) a housing extending between the first fixed wall and the second fixed wall to form a furnace plenum therebetween, the furnace plenum including a return duct the furnace plenum having an inlet exposed to the first plenum surface and the second plenum surface, and an outlet exposed to the return duct;

(e) a heater having an inlet and an outlet, wherein the heater outlet is fluidly connected to the furnace plenum inlet and the heater inlet is fluidly connected to the furnace plenum outlet to form a substantially closed fluid circuit between the heater and the furnace plenum;

(f) a plurality of transverse channels connected to the trailer transverse to the longitudinal axis;

(g) a first set of transverse beams slideably disposed within the transverse channels;

(h) a second set of transverse beams slideably disposed within the transverse channels;

(i) a first movable wall connected to the first set of transverse beams for movement relative to the first fixed wall between a casting position adjacent the mold surface of the first fixed wall for forming a first mold therebetween and a discharging position remote from the first fixed wall, the first mold including a first concrete inlet for introducing concrete into the first mold; and

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(j) a second movable wall connected to the second set of transverse beams for movement relative to the second fixed wall between a casting position adjacent the mold surface of the second fixed wall for forming a second mold therebetween and a discharging position remote from the second fixed wall, the second mold including a second concrete inlet for introducing concrete into the second mold.

THE REFERENCES

Therneau 1971	3,604,455	Sep. 14,
Rossetti 1972	3,689,022	Sep. 5,
Johnstone et al. (Johnstone) 1973	3,770,016	Nov. 6,
Hummelshoj 1974	3,822,855	Jul. 9,
Sontag 1974	3,837,613	Sep. 24,
Botting et al. (Botting) 1977	4,042,659	Aug. 16,
Welden 1979	4,147,323	Apr. 3,
Willingham 1981	4,244,682	Jan. 13,
Bogenschutz 1985	4,548,237	Oct. 22,
Lowndes, III et al. (Lowndes) 1989	4,884,958	Dec. 5,
Rost 1910	224,665	Jul. 27,

(German Patentschrift)

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SOMECAL² 2,306,058 Oct. 29,
1976
(French patent application)

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 46 and 48 over Willingham, Hummelshoj and either Rossetti or SOMECAL, in view of Botting; claims 32, 36-39, 44, 45 and 47 over these references, further in view of Rost; claims 33-35 and 41-43 over the references applied to claims 32, 36-39, 44, 45 and 47, further in view of Sontag, Welden and Lowndes; claim 40 over the references applied to claims 32, 36-39, 44, 45 and 47, further in view of any one of Bogenschutz, Johnstone and Therneau.

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the aforementioned rejections are not well founded. Accordingly, these rejections will be reversed.

Willingham discloses a portable concrete molding

²Our consideration of this reference is based on an English translation thereof, a copy of which is provided to appellant with this decision.

apparatus having a rectangular first mold (39) which is fixed to the bed of a trailer (col. 3, lines 54-55; Figs. 1 and 2). This mold has a plenum therein (col. 9, lines 39-65; Fig. 16). Thus, the first mold (39) has, attached to the trailer, a first fixed wall having an outer substantially planar mold surface (outer surface of first mold face 41 in Fig. 16) and a second plenum face (inner surface of first mold face 41 in Fig. 16). The Willingham apparatus does not have a second fixed wall which is parallel to the first fixed wall and has an outer substantially planar mold surface and a second plenum surface, as required by all of appellant's independent claims. Both of Willingham's second and third molds (71 and 103; Fig. 16) are movably attached to the bed of the trailer (col. 4, lines 8-9 and 35-36).

Hummelshoj discloses a concrete molding apparatus having a number of molds (5) assembled into a battery such that spaces between the molds are filled with concrete to form plate-shaped building elements (col. 2, line 65 - col. 3, line 7). The molds rest on wheeled bogies (6) which are displaceable along a wheel track which may serve for transport or as a production line (col. 3, lines 8-11).

Rossetti discloses an apparatus for making cast polymer sheets (col. 1, lines 11-13). The apparatus includes a housing having therein a number of hollow metal plates which are in a substantially vertical, parallel orientation and are laterally moveable (col. 2, lines 32-41; col. 4, line 64 - col. 5, line 10). Each pair of hollow metal plates has therebetween a pair of glass plates, wherein each glass plate is detachably attached to a surface of a hollow metal plate (col. 2, lines 45-51; col. 5, lines 11-16). The hollow metal plates have spacers to facilitate adjustment of the distance to the next metal plate and thereby adjust the distance between the glass plates (col. 3, lines 9-12; col. 6, lines 55-58). After the spacers have been adjusted and casting liquid pored into the glass molds, the entire assembly is pushed together in the manner of a filter press (col. 3, lines 13-17; col. 6, line 55 - col. 7, line 15). During polymerization, fluid flows through the hollow metal plates to maintain a uniform temperature distribution (col. 3, lines 28-36).

SOMECAL discloses a molding apparatus for making concrete beams, which includes a number of vertical walls which move

laterally to form mold cavities therebetween (page 2, figure). Fluid flows in closed circulation through the walls (see *id.*).

The examiner argues that it would have been obvious to one of ordinary skill in the art to modify Willingham by providing a plenum between two fixed mold walls, as indicated by Hummelshoj, in order to simultaneously mold two planar concrete panels with a single heating means, thereby increasing productivity, and to provide a return duct for the heat exchange medium, as disclosed in either Rossetti or SOMECAL, to use residual heat and thereby provide a more economical apparatus (answer, page 5).

The examiner does not explain, and we do not independently find, where Hummelshoj discloses simultaneously molding two planar concrete panels with a single heating means. In Hummelshoj's Fig. 2, each concrete panel is heated by two heaters, one on each side of the panel.

The examiner asserts that "plural molds formed by two movable mold walls cooperating with a fixed mold member located between the movable mold walls is well known in the concrete casting art as shown by the applied prior art"

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(answer, page 9), and relies upon Hummelshoj in support of this assertion (answer, page 11). The examiner argues that Hummelshoj's first, third and fifth molds in his Fig. 2 are movable and cooperate with intermediate mold members (answer, page 11). Hummelshoj, however, as indicated by appellant (brief, page 10), does not disclose which of his molds are fixed or movable.

To establish a *prima facie* case of obviousness, an examiner must explain why the teachings from the prior art itself appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritsch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The motivation relied upon by the examiner for combining the teachings of the references to arrive at appellant's claimed invention comes from the disclosure of appellant's apparatus in his specification rather than from the prior art.

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Thus, the examiner used impermissible hindsight when rejecting the claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

The references applied by the examiner other than those discussed above are relied upon for teachings of features of appellant's claimed apparatus other than the fixed and movable walls.

For the above reasons, we find that the examiner has not set forth a factual basis which is sufficient to support a conclusion of obviousness of the invention recited in any of appellant's claims.

DECISION

The rejections under 35 U.S.C. § 103 of claims 46 and 48 over Willingham, Hummelshoj and either Rossetti or SOMECAL, in view of Botting, claims 32, 36-39, 44, 45 and 47 over these references, further in view of Rost, claims 33-35 and 41-43 over the references applied to claims 32, 36-39, 44, 45 and 47, further in view of Sontag, Welden and Lowndes, and claim

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the references applied to claims 32, 36-39, 44, 45 and 47,
further in view of any one of Bogenschutz, Johnstone and
Therneau, are reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES F. WARREN)	
Administrative Patent Judge)	APPEALS AND
)	
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)	

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TERRY J. OWENS)
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