

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUO MORIKITA

Appeal No. 96-2640
Application No. 08/069,273¹

ON BRIEF

Before CALVERT, STAAB, and MCQUADE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 8, all the claims remaining in the application.

¹ Application for patent filed May 28, 1993.

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The claims on appeal are drawn to a glass compression molding apparatus, and are reproduced in the appendix to appellant's brief filed on August 8, 1995 (Paper No. 22).²

² Appellant's second brief, filed October 10, 1995 (Paper No. 24), states in part III that a copy of the claims "is attached hereto," but no such attachment is found. All references herein to appellant's brief are to this second brief.

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The references applied in the final rejection are:

Webb 5, 1946	2,410,616	Nov.
Anderson 1959	2,888,316	May 26,
Copeland 1966	3,244,497	Apr. 5,
Angle et al. (Angle) 1974	3,844,755	Oct. 29,
Kubo et al. (Kubo) 1993	5,250,099	Oct. 5,
		(filed Mar. 29, 1991)
Yoneya et al. (Yoneya) 1988 (Japanese Kokai)	63-222021	Sep. 14,
Hosoe et al. (Hosoe) 1991 (Japanese Kokai)	3-187931	Aug. 15,

The admitted prior art teaching on pages 1 to 5 of appellant's specification³ and drawing Figs. 1 to 5 (PAT).

An additional reference, of record, applied herein pursuant to 37 CFR § 1.196(b), is:

Marechal et al. (Marechal)	4,854,958	Aug. 8, 1989
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The appealed claims stand rejected on the following grounds:

³ References herein to appellant's specification are to the substitute specification filed on July 15, 1994.

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(1) Claims 3 and 8, unpatentable for failure to comply with the second paragraph of 35 U.S.C. § 112;⁴

(2) Claims 1, 2 and 4, unpatentable over PAT, under 35 U.S.C. § 103;

(3) Claims 1, 3 and 4, unpatentable over Copeland, under 35 U.S.C. § 103;

⁴ This was a new ground of rejection first made in the examiner's answer (pages 12 and 13).

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(4) Claim 2, unpatentable over Copeland in view of PAT, under 35 U.S.C. § 103;

(5) Claim 5, unpatentable over Copeland or PAT in view of Webb, under 35 U.S.C. § 103;

(6) Claim 6, unpatentable over Copeland or PAT in view of Webb and Angle or Kubo, under 35 U.S.C. § 103;

(7) Claim 7, unpatentable over Copeland or PAT in view of Webb and Yoneya or Hosoe, under 35 U.S.C. § 103;

(8) Claim 8, unpatentable over Copeland in view of Anderson, under 35 U.S.C. § 103.

Rejection (1)

The examiner asserts that claims 3 and 8 are indefinite, and thus do not comply with the second paragraph of § 112, because the expression "said mating fit" in claim 3 indicates that the mating fit referred to is the same as the "mating fit" recited in parent claim 1, part(b)(i). According to the examiner, the mating fit recited in claim 1 is between the lower hollow cylinder and the upper core, while the mating fit in claim 3 refers to a different mating fit, namely, "a mating fit between the lower hollow cylinder and said upper cylinder"

(supplemental answer, page 1).⁵ Appellant, on the other hand, contends that the claim language is correct, and that "said mating fit" in claim 3 is the same mating fit recited in claim 1.

Considering the embodiment shown in appellant's Figs. 11 to 16, which includes an upper hollow cylinder 13 with an upper core 12 mounted therein, the upper core is in a mating fit with the lower hollow cylinder 33. However, the lower hollow cylinder 33 is not in a mating fit with the upper cylinder 13, which merely rests on top of the lower cylinder, as shown in Fig. 14. Thus, claim 3 appears to be accurate as written, in that the lower cylinder is aligned with the upper cylinder due to the mating fit of the upper core and the lower cylinder. This is borne out by page 7, lines 1 to 6 of the specification, where appellant discloses (emphasis added) that "the cylinder of the lower molding die is aligned with the upper core by a mating fit . . . the cylinder of the lower

⁵ In effect, the examiner's rejection is on the ground that claim 3 is not supported by the disclosure, and might well have been based on § 112, first paragraph (written description).

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molding die is aligned with the cylinder of the upper molding die by the [i.e., the previously described] mating fit."

Since the term "said mating fit" in claim 3 is not incorrect, rejection (1) will not be sustained.

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Rejection(2)

In this rejection, the examiner takes particular note of the fact that, in describing the operation of a conventional (prior art) compression molding machine, the appellant states on page 2, lines 11 to 15,⁶ that (emphasis added):

Then, an upper platen (omitted from illustration) is moved downwards closing the die cavity and clamping upper and lower molding dies 6 and 7 together. The preform 5 is then heated and compressed so that the molding 8 is obtained as shown in Fig. 2.

From the term "then," the examiner infers the suggestion "that clamping and compressing are occurring independently of one another using clamping and compressing means" (answer, page 6).

We do not agree with the examiner. Regardless of whether the dies 6 and 7 of appellant's disclosed prior art device are designated upper and lower, or vice versa, the above-quoted statement from page 2 of the specification must be read in context. The thrust of appellant's disclosure is that the

⁶ Although the examiner entered the substitute specification, the rejection cites pages and lines of the original specification. We have transposed these citations to the corresponding pages and lines of the substitute specification.

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non-parallelism problems experienced using the prior art
apparatus (as illustrated in Fig. 3) may be avoided by
clamping the upper

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and lower dies together and then compressing the preform using a separate compression device (see, e.g., page 13, line 22, to page 14, line 6). It is clear from appellant's description of the prior art that in the prior art, the dies are clamped and the preform is compressed by moving one die relative to the other (i.e., from the Fig. 1 position to the Fig.2 position), and no separate means for clamping the dies and compressing the preform are described or suggested. As we read page 2, lines 11 to 15 (quoted above), appellant there discloses that in the prior art apparatus, the dies are moved together a certain distance to "clamp" them together, and then are moved further together in order to compress the preform. We find no suggestion therein that any additional means (not shown in "prior art" Figs. 1 to 5) should be provided to compress the preform, nor would we expect to, since that is what appellant discloses as being at least a major aspect of his invention.

The examiner alternatively argues that if one were not to interpret the PAT as disclosing independently operable clamping and compression means,

then it can be considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the

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clamping and compression means independently
operable, since it has been held that
constructing a

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formerly integral structure in various elements only involves routine skill in the art. Nerwin v. Erlichman, 168 USPQ 177, 179 [(Bd. Pat. Int. 1969)]. (answer, page 7)

We do not consider this argument to be well taken. Certainly, as Nerwin states, "the mere fact that a given structure is integral does not preclude its consisting of various elements" (id.), but what the examiner is proposing in this case is not merely making die 6 or 7 out of a plurality of elements, but rather adding to die 6 or 7 elements operable independently therefrom to compress the preform 8. Such a reconstruction of appellant's disclosed prior art apparatus would not constitute simply an obvious change in its constituent number of elements, but instead would involve modifying its elements and including other elements so that it could perform one of its functions in a different way. We find no evidence which would suggest such a modification to one of ordinary skill in the art, and therefore will not sustain the rejection.

Rejection (3)

The examiner sets forth the basis of this rejection on

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pages 7 and 8 of the answer. Appellant contends that claim 1 is unobvious over Copeland, because Copeland does not disclose (I) "a lower hollow cylinder defining an interior bore of constant diameter which receives said upper core with a mating fit" (claim

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1, part (b)(i)) or (II) "compression means, operable independently of said clamping means, . . . [etc.]" (claim 1, part (d)).

With regard to argument (I), the examiner identifies Copeland's sleeve 16 as the "lower hollow cylinder" and elements 23, 60 and 20 as the "lower mold die," which is aligned with the upper mold die by spigot 29 having a mating fit in the socket. However, as appellant points out, Copeland's "lower hollow cylinder" 29 does not have "an interior bore of constant diameter which receives the upper core with a mating fit," because the "upper core" (11) is not even received within the bore of cylinder 29, as shown in Fig.2 of Copeland. The examiner responds that Copeland's element 29 inserts into an indentation in element 10 (answer, page 18), but element 10 is not an upper core, nor is it received in an interior bore of cylinder 29, as required by claim 1. Therefore, Copeland does not meet part(b)(i) of claim 1.

As for argument (II), we agree with appellant that Copeland's "clamping means" and "compression means" do not operate independently, because the same downward movement of

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ram 20 is required to both clamp the dies (engage 10 and 16)
and to compress molten glass 52. As with rejection (2),
supra, we

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consider Nerwin to be inapplicable here and find no suggestion in Copeland that the clamping and compression functions of the apparatus be made independently operable.

We will accordingly not sustain rejection (3).

Rejection (4)

This rejection will not be sustained, since the combination of Copeland and PAT does not overcome the deficiencies of each as discussed above with regard to rejections (2) and (3).

Rejections (5) to (8)

The secondary references applied in these rejections do not render obvious what we have found above to be lacking in Copeland and/or PAT. Rejections (5) to (8) will therefore not be sustained.

Rejection Under 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 1, 2 and 5 are rejected under 35 U.S.C. § 103 as unpatentable over Marechal alone, or in view of Hosoe. Marechal discloses a glass compression molding apparatus having a first molding die with a cylindrical core 1, a second molding die having a hollow cylinder 3 and core 2, both cores fitting within the cylinder,

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and each mold being attached to a hydraulic cylinder (col. 6, lines 3 to 9). In operation, the first hydraulic cylinder clamps the first mold 1 and cylinder 3 against frame 8, and the other hydraulic cylinder forces mold 2 against glass preform 9 (col. 6, lines 7 to 13); thus, the Marechal apparatus has a clamping means and an independently operable compression means, as recited in claim 1.⁷ As for claim 5, Marechal provides inactive gas to the region between the dies (col. 7, lines 4 to 10; col. 7, line 68 to line 2).

While Marechal discloses that core 1 is the lower core and core 3 the upper core, such designation appears to be

⁷ On page 15 of the brief, appellant argues that In re Donaldson Co., Inc., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), requires that the means-plus-function language of his claims be construed to cover his corresponding disclosed structure and equivalents thereof (§ 112, sixth paragraph). However, since appellant does not disclose any particular structure for the recited "clamping means" or the recited "compression means" (except for rods 60, which would be equivalent to the piston rod of Marechal's hydraulic cylinder), it is not apparent how appellant can argue that the apparatus disclosed in the prior art is not the equivalent of the "means" disclosed by him, nor does he explain why it would not be.

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somewhat arbitrary, and it would have been obvious to operate the apparatus inverted, as this would have no effect on its functioning. Alternatively, it would have been obvious to use Marechal's core 2 in the lower position in view of Hosoe, which discloses a glass molding apparatus in which the lower core 19 is driven upwardly into the upper mold 18 by plunger 7, and further discloses at page 9, lines 9 to 14, that the plunger may pass

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either through the ceiling wall or the floor wall of the molding chamber. This would have suggested to one of ordinary skill in the art positioning core 2 of Marechal at the lower end instead of at the upper end of the apparatus.

Remand to the Examiner

Pursuant to 37 CFR § 1.196(a) and MPEP § 1211, this application is remanded to the examiner to consider whether claims 3, 4 and 6 to 8 should be rejected under 35 U.S.C. § 103 as unpatentable over Marechal alone, or in view of Hosoe, further in view of other prior art.

Conclusion

The examiner's decision to reject claims 1 to 8 is reversed. Claims 1, 2 and 5 are rejected pursuant to 37 CFR § 1.196(b). The application is remanded to the examiner under 37 CFR § 1.196(a).

This application, by virtue of its "special" status, requires immediate action, MPEP § 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

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This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

Reversed & Remanded; 37 CFR § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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REVESED

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