

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIYOO MORITA

Appeal No. 1998-0812
Application No. 08/378,954¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge, NASE and LAZARUS, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 13, which are all of the claims pending in this application.

¹ Application filed January 26, 1995, for reissue of U.S. Patent No. 5,192,481 (Application No. 07/444,235, filed December 1, 1989) which issued March 9, 1993.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a method for molding an article in a plurality of colors in such a manner that the strength of a joint between primary and secondary molded pieces made of plastics of respective two different colors is enhanced. (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Mares 1981	4,275,030	June 23,
Halkerston et al. 1983 (Halkerston)	4,410,387	Oct. 18,
Neumeister 1983	4,416,602	Nov. 22,
Oishi 1989	4,840,760	June 20,

Claims 1 to 13 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in

the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellant, at the time the application was filed, had possession of the claimed invention.

Claims 10 to 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mares in view of Neumeister, Oishi and Halkerston.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 14, mailed October 2, 1997) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed June 30, 1997) for the appellant's arguments thereagainst.²

OPINION

² The rejection of claims 1 to 13 under 35 U.S.C. § 251 as being based upon a defective reissue declaration set forth in the answer was withdrawn by the examiner in the letter mailed August 4, 2000 (Paper No. 18).

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The written description rejection

We will not sustain the rejection of claims 1 to 13 under 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re

Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The examiner states (answer, p. 5) that the claimed subject matter which is not supported by the original disclosure "includes injection by means other than the slide core and the portions of the cassette halves being other than different plastics."

The appellant argues (brief, pp. 8-10) that it is not understood why claims 1 to 9 (the original patent claims) are subject to this rejection and that a person skilled in the art would have recognized that the inventor had possession of the subject matter of claims 10 to 13 (claims sought to be added by reissue) at the time the invention was filed.

With regard to claims 1 to 9, we find ourselves in agreement with the appellant. That is, we see no reason why these claims are included in this rejection. In that regard, claims 1 to 9 recite that the injection of the adhesive is through the slide core and the first and second portions of

the article being molded are formed of different plastic materials.

With regard to claims 10 to 13, it is our view that these claims by reciting injecting "a first plastic material" into a mold cavity and injecting "a second plastic material" into the mold cavity when read in light of the appellant's disclosure requires the first plastic material to be different (e.g., distinct) material from the second plastic material. In addition, the broadening of the language from original patent claim 1 does not violate the written description requirement of 35 U.S.C. § 112, first paragraph. Additionally, the appellant's amendment to the summary of the invention filed on September 16, 1996 (Paper No. 7) is not a proper basis for this rejection.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 13 under 35 U.S.C. § 112, first paragraph, is reversed.

The obviousness rejection

We will not sustain the rejection of claims 10 to 13 under 35 U.S.C. § 103.

The appellant argues (brief, p. 13) that the prior art as applied by the examiner (see pages 5-7 of the answer) does not suggest the claimed subject matter. We agree.

Claims 10 to 13 under appeal require injecting a first plastic material into a mold cavity, injecting a small amount of adhesive into the mold cavity, and injecting a second plastic material into the mold cavity. It is our view that these limitations are not suggested by the prior art as applied by the examiner. In that regard, while Halkerston does teach using an adhesive to join the inner core to the outer layer, Halkerston would not have suggested modifying Mares to provide adhesive in Mares' mold cavity.

In our view, the only suggestion for modifying Mares in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the

appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 10 to 13 under 35 U.S.C. § 103 is reversed.

REMAND

The application is being remanded to the examiner for consideration of whether or not a rejection of claims 10 to 13 under 35 U.S.C. § 251 as being an improper "recapture" of subject matter that was surrendered in an effort to obtain allowance of the original patent claims is appropriate in this application.

An attorney's failure to appreciate the full scope of the invention qualifies as an error under 35 U.S.C. § 251 and is correctable by reissue. In re Wilder, 736 F.2d 1516, 1519, 222 USPQ

369, 370-71 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985). Nevertheless, "deliberate withdrawal or amendment . . . cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. Section 251." Haliczer v. United States, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966). The recapture rule, therefore, prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims. See Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). Under this rule, claims that are "broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution" are impermissible. Id. at 996, 27 USPQ2d at 1525. In addition, to determine whether an applicant surrendered particular subject matter, one must look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).³

³ For further information on "recapture," we direct the examiner's attention to MPEP § 1412.02 (Seventh Edition, Rev. 1, Feb. 2000).

Since the "recapture" rule may apply to the facts of this case, the application is remanded to the examiner for consideration of whether or not a rejection of claims 10 to 13 under 35 U.S.C. § 251 is appropriate in this application.

Conclusion

To summarize, the decision of the examiner to reject claims 1 to 13 under 35 U.S.C. § 112, first paragraph, is reversed and the decision of the examiner to reject claims 10 to 13 under 35 U.S.C. § 103 is reversed. In addition, the application has been remanded to the examiner for further consideration.

REVERSED; REMANDED

BRUCE H. STONER, JR.)	
CHIEF ADMINISTRATIVE PATENT JUDGE)	
))	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
ADMINISTRATIVE PATENT JUDGE)	AND
)	INTERFERENCES
)	
)	
)	
RICHARD B. LAZARUS)	
ADMINISTRATIVE PATENT JUDGE)	

Appeal No. 1998-0812
Application No. 08/378,954

Page 12

EDWARD W. CALLAN
NO. 705 PMB 452
3830 VALLEY CENTRE DRIVE
SAN DIEGO, CA 92130

Appeal No. 1998-0812
Application No. 08/378,954

Page 13

JVN/dl