

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KLAUS POTING

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Appeal No. 1999-1408  
Application No. 08/809,629

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ON BRIEF

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Before CALVERT, COHEN, and ABRAMS, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 31-59, at which point, claims 1-30 had been canceled. Subsequent to the final rejection, claim 45 was amended and claims 46-48 were canceled. Claims 31-45 and 49-59 remain before us on appeal.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a method and apparatus for producing molded glass bodies. An understanding of the invention can be derived from a reading of exemplary claims 31 and 36, which appear 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:

|                                           |           |               |
|-------------------------------------------|-----------|---------------|
| Hofmann                                   | 1,852,570 | Apr. 5, 1932  |
| Bittner <u>et al.</u> (Bittner)           | 4,225,331 | Sep. 30, 1980 |
| Leweringhaus <u>et al.</u> (Leweringhaus) | 5,236,485 | Aug. 17, 1993 |

Claims 31-33, 36-45 and 49-54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hofmann in view of Leweringhaus.

Claims 34, 35 and 55-59 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hofmann in view of Leweringhaus and Bittner.<sup>1</sup>

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) and the final rejection (Paper No. 7) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 13) for the appellant's arguments thereagainst.

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<sup>1</sup>A rejection of claim 45 under 35 U.S.C. § 112, second paragraph, was overcome by amendment and was withdrawn in the Answer.

### OPINION

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.

Both of the rejections are under 35 U.S.C. § 103. It is worthy, at the outset, to set forth the guidance provided by our reviewing court for evaluating a rejection under 35 U.S.C. § 103. A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references, rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see, for example, Cable Elec. Prods. v. Genmark, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see In re Bozak, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it

fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom (see In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

We first shall consider independent method claim 31, which stands rejected as being unpatentable over Hofmann in view of Leweringhaus. It is the examiner's view that all of the subject matter recited in this claim is disclosed or taught by Hofmann except for pressing the molding plug into the molten glass according to a predetermined temporal dependence on force and feed. This, according to the examiner, is taught by Leweringhaus, and it is the examiner's view that it would have been obvious to one of ordinary skill in the art to add the servo-drive of Leweringhaus to the Hofmann apparatus "to make it more adaptable to various materials and desired final products" (Paper No. 7, page 3).

As we understand the appellant's arguments, three theories are presented in rebuttal to the examiner's position. The first is that Hofmann does not disclose a "press-molding" method or apparatus. We agree with the appellant that Hofmann moves the molten glass into pressure contact with the stationary molding plug, whereas in the appellant's disclosure the molding plug is moved into pressure contact with the stationary molten glass. However, no explicit definition of "press-molding" has been set forth in the

specification, and there is no evidence of record to support a conclusion that “press molding” should be interpreted in any manner other than the literal meaning of the words, which is that the molten glass and the molding plug are pressed into contact with one another. Albeit that it is induced in a different manner, the Hofmann system produces the molded product by pressing the glass against the mold and the mold plug, which is all that the claim requires. We therefore find this argument not to be persuasive.

The second of the appellant’s arguments is that the Hofmann method does not press the plug into the glass “according to a predetermined temporal dependency on force and feed.” This phrase does not appear in the specification or the original claims, having been added to the claims in the response to the first office action (Paper No. 5). It has not explicitly been defined in the record. However, since Hofmann discloses a glass molding apparatus that operates in an assembly line manner, and in the absence of evidence to the contrary, it is our view that the Hofmann machine inherently must operate in accordance with this requirement of the claim, that is, at predetermined forces and rates.

The appellant’s third argument is that there is no suggestion for one of ordinary skill in the art to combine the teachings of Hofmann and Leweringhaus in the manner set out by the examiner. We disagree. In our view, one of ordinary skill in the art would have recognized from Leweringhaus, especially columns 1 and 2, the advantages of utilizing microprocessors and the like in the operation of glass forming systems to continuously

monitor and adjust the various functions so that the machine can be operated in the most efficient manner. Therefore, to the extent that this is not inherently accomplished in Hofmann, it would have been obvious in view of Leweringhaus to modify Hofmann by installing a system that presses the plug and the glass together according to predetermined temporal dependency on force and feed for the self evident advantages of causing the system to operate effectively and efficiently, which would have been known to the artisan.<sup>2</sup>

For the foregoing reasons, it is our conclusion that the teachings of the applied references establish a prima facie case of obviousness with regard to the subject matter recited in claim 31, and we will sustain the rejection of this claim as well as that of claim 33, the separate patentability of which was not argued before this Board. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

Claim 32 adds to claim 31 the requirement for a “supply line” that is connected to the molten glass feeder and is displaced from a feeding position when the press-molding take place. Such structure is not disclosed or taught in either of the references, and we therefore will not sustain the rejection of this claim.<sup>3</sup>

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<sup>2</sup>Skill is presumed on the part of the artisan, rather than the lack thereof. See In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985).

<sup>3</sup>There is no antecedent basis for “the feeder chute” recited in line 4 of claim 32. This defect is worthy of correction.

Independent apparatus claim 36 stands rejected on the basis of the combined teachings of Hofmann and Leweringhaus, and we also will sustain this rejection. The Hofmann apparatus produces molded glass bodies in accordance with a molding method in which a press mold that determines the external shape of the molded glass body, and into which a predetermined quantity of molten glass can be poured, operates in conjunction with a molding plug that determines the internal shape of the molded glass body. In the molding operation molten glass held in the mold is pressed against the molding plug. The molding plug (97) is mounted on a piston in an air motor cylinder carried by a bracket (102) that pivots about an axis extending transversely to the center axis of the molding plug. After the molten glass has been placed in the mold, the mold plug is pivotally moved from an initial position outside of the press mold into the operating position.<sup>4</sup> Pressurized air from beneath and vacuum from above cause the molten glass to be pressed into contact with the plug, thus forming the desired object. Applying the same rationale with regard to the term “press-molding” and the phrase “predetermined temporal dependency on force and feed” that was set forth above in conjunction with method claim

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<sup>4</sup>We note that while the appellant has recited these two elements in means-plus-function form, he has not argued under the sixth paragraph of 35 U.S.C. § 112 that the structure relied upon by the examiner is not the same as that disclosed in his specification or the equivalent thereof (see Valmont Indus. Inc. v. Reinke Mfg. Co.,

983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir 1993)), and we therefore presume that he concedes this issue.

31, we conclude that a prima facie case of obviousness has been established with regard to independent apparatus claim 36, and we will sustain the rejection.

Claim 37 adds to claim 36 a displaceable “feeder chute.” We agree with the examiner that the Hofmann “funnel guides” 72 meet this requirement. The rejection of claim 37 is sustained.

The rejection of dependent claims 38, 43, 45 and 49-54 also is sustained, in that the appellant chose not to argue before this Board that these claims were separately patentable.

Clearly, the pivoting bracket and associated rail arrangement and carriage structure set forth in dependent claim 39 are not disclosed or taught by either of the two references applied against this claim. We do not agree with the examiner that such structure would have been an obvious matter of design choice, in view of the advantages of such a structure pointed out by the appellant. This being the case, we will not sustain the rejection of claim 39 or of claims 40-42 and 44, which depend therefrom.

Dependent method claims 34 and 35 and dependent apparatus claims 55-59 stand rejected as being unpatentable over Hofmann in view of Leweringhaus and Bittner, which was cited by the examiner for its teaching of forming parts of an item separately and then joining them together. Method claims 34 and 35 depend from claim 31, and their patentability apart from claim 31 was not argued. This being the case, the rejection of

these two claims is sustained. As for claims 55-59, the appellant has chosen to group them with claim 36, from which they depend (Brief, page 16), and they fall therewith.

With regard to those rejections which we have sustained, we have carefully considered all of the arguments presented by the appellant. However, they have not persuaded us that, as to these rejections, the decision of the examiner was in error. Our position with regard to each of these arguments should be apparent from the explanations we have offered. In addition, we wish to point out that some of the arguments presented by the appellants fail from the outset because they are predicated upon limitations that are not present in the claims. See In re Self, 671 F.2d 1344, 1350, 213 USPQ 1, 5 (CCPA 1982).

#### SUMMARY

The rejection of claims 31, 33, 36-38, 43, 45 and 49-54 as being unpatentable over Hofmann in view of Leweringhaus is sustained.

The rejection of claims 32, 39-42 and 44 as being unpatentable over Hofmann in view of Leweringhaus is not sustained.

The rejection of claims 34, 35 and 55-59 as being unpatentable over Hofmann in view of Leweringhaus and Bittner is sustained.

The decision of the examiner is affirmed-in-part

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

AFFIRMED-IN-PART

|                             |                   |
|-----------------------------|-------------------|
| IAN A. CALVERT              | )                 |
| Administrative Patent Judge | )                 |
|                             | )                 |
|                             | ) BOARD OF PATENT |
| IRWIN CHARLES COHEN         | )                 |
| Administrative Patent Judge | ) APPEALS AND     |
|                             | )                 |
|                             | ) INTERFERENCES   |
| NEAL E. ABRAMS              | )                 |
| Administrative Patent Judge | )                 |

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APPEAL NO. 1999-1408 - JUDGE ABRAMS  
APPLICATION NO. 08/809,629

APJ ABRAMS

APJ CALVERT

APJ COHEN

**DECISION: AFFIRMED-IN-PART**

Prepared By:

**DRAFT TYPED:** 18 Oct 01

**FINAL TYPED:**