

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 JEAN-PIERRE DOUCHE and PHILIPPE ARMAND

Appeal No. 1996-2972
Application No. 07/928,784

HEARD: February 07, 2000

Before, KIMLIN, GARRIS, and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1, 3-6, and 13-17 as amended after the final rejection, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to a process of duplicate molding wherein first and second glazings are each positioned, respectively, in a separate mold associated

therewith while the respective molds are each in a separate auxiliary station. The molds are alternately and independently moved into a pressing station from their respective auxiliary stations that are located on different sides of the pressing station. A further understanding of the invention can be derived from a reading of exemplary claims 1 and 3, which are reproduced below.

1. Process of duplicate molding on at least one part of a monolithic or laminated transparent glazing taken from at least one of the group consisting of glass and transparent plastic, the process comprising the steps of:

positioning a first glazing in a first mold at a first auxiliary station at one side of a pressing station having a press and plastic injecting means;

positioning a second glazing in a second mold at a second auxiliary station at another side of said pressing station, so that said first mold moves into said pressing station in a direction opposite to a direction by which said second mold moves into said pressing station;

alternately and independently moving said first and second molds into and out of said pressing station such that one of said first and second molds may remain stationary while the other of said first and second molds is moving;

pressing and injecting plastic in a respective one of said first and second molds in said pressing station while the other of said first and second molds is in a respective auxiliary station; and

removing a duplicate molded glazing in the other of said first and second molds in the respective auxiliary station.

3. The process of Claim 1, including a mold closing device for each of said first and second molds for applying an intermediate pressure, lower than a pressure applied by said press in said pressing station, to the respective mold, including the step of applying said intermediate pressure during said moving step.

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

Strauss	2,864,124	Dec. 16,
1958		

Huckvale (United Kingdom)	2 039 463,	Aug. 13, 1980
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Admitted prior art, (Appellants' specification, pages 1 and 2)

Claims 1, 3-6, 13-17 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failure to particularly point out and distinctly claim that which applicants regard as invention. Claims 1, 3-6, and 13-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Huckvale in view of the admitted prior art at pages 1 and 2 of appellants' specification and Strauss.

OPINION

We refer to the appellants' briefs and to the answer for the opposing viewpoints expressed by the appellants and the

examiner concerning the above noted rejections. For the reasons which follow, we cannot sustain the examiner's stated § 112, second paragraph, rejection as applied to claims 1, 6 and 16 and the examiner's § 103 rejection as expressed in the answer. However, we shall summarily sustain the examiner's §112, second paragraph rejection as it separately pertains to claims 3-5, 13-15, and 17. An explanation follows.

Rejection under 35 U.S.C. § 112, second paragraph

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of appellants' specification and the prior art, sets out and circumscribes a particular area with a reasonable degree of precision and particularity. See *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

In rejecting the appealed claims under 35 U.S.C. § 112, second paragraph, the examiner (answer, page 3) urges that the language of the fourth paragraph of claim 1 is indefinite "in that the use of the term 'may' renders the claims unclear...." At page 7 of the answer, the examiner further explains that

"...it is unclear whether the limitation(s) following the phrase are part of the claimed invention or not, and the resulting claim does not clearly set forth the metes and bounds of the patent protection desired."

We recognize that the recited permissive phrase "may" as utilized in claim 1 does not require the limitation that follows must occur; i.e., that one of the molds is stationary while the other of the two molds is moving. However, such breadth does not equate with indefiniteness. *See In re Gardner*, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970). From our reading of appellants' specification, including the claims, and the relevant prior art, it is clear to us that appellants are correct in asserting, in essence, that one mold need not be stationary while the other moves (brief, page 11). Accordingly, we shall not sustain the examiner's rejection of the appealed claims under 35 U.S.C.

§ 112, second paragraph on the above-noted basis.

However, our ultimate disposition of the examiner's 35 U.S.C. § 112, second paragraph rejection of claim 3, as well as the claims depending therefrom (i.e., claims 4, 5, 13-15,

and 17) is another matter. Here, the examiner has advanced an additional basis for asserting the lack of definiteness of the latter claims based on the "a pressure" language appearing in claim 3 (answer, page 3). Our review of the briefs reveals that appellants have not contested this latter basis for the examiner's rejection under 35 U.S.C. § 112, second paragraph. Accordingly, on this record, while we do not sustain the examiner's § 112, second paragraph rejection as it pertains to claims 1, 6 and 16, we summarily sustain the examiner's uncontested § 112, second paragraph rejection as it pertains to claims 3-5, 13-15 and 17.

Rejection under 35 U.S.C. § 103

The examiner essentially acknowledges (answer, pages 3-5) that Huckvale (G.B. 2 039 463) does not disclose (1) a duplicate molding process with the application of a glazing to the molds in auxiliary stations, and (2) moving the molds of Huckvale independently into and out of the pressing station as required by all of the claims on appeal. According to the examiner, however, it would have been obvious to one of ordinary skill in the art to use the injection molding machine of Huckvale for duplicate molding rather than for molding shoe

components as disclosed therein since duplicative molding processes wherein glazing is placed in a mold and plastics injected thereafter was admittedly well-known and one skilled in the art would have recognized economic advantages in duplicative molding via use of the molding techniques of Huckvale. The examiner also opines that one of ordinary skill in the art would have further modified the method of Huckvale to provide for independent movement of each of the molds to and from the injection station in light of the combined teachings of the applied references including Strauss to improve the versatility of the process. The examiner notes that Strauss teaches the independent movement of mold assemblies to and from a central injection molding station.

In our view, however, there is no suggestion in the combined teachings of the applied references to modify the shoe component molding process of Huckvale as proposed by the examiner. This is so since the admitted prior art duplicative molding process is described as taking place in a single station or in a dissimilar turntable type process involving four stations and four molds (specification, pages 1 and 2). The examiner has not pointed to any teaching or suggestion in

Huckvale's shoe component molding process using a common carrier (62) for moving both molds together without the positioning of glazing in each mold in auxiliary stations and/or in Strauss' blow molding process for forming hollow articles such as bottles that suggests the process modifications contemplated in the examiner's rejection for a duplicative molding process using glazings as claimed herein.

Accordingly, we agree with appellants (brief, page 10) that the § 103 rejection advanced by the examiner appears to rely on the description of appellants' invention in their specification for the suggested modifications. Thus, the present record indicates that 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), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we will not sustain the examiner's § 103 rejection of the appealed claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 3-5, 13-15 and 17 under 35 U.S.C. § 112, second paragraph is summarily affirmed. The decision of the examiner to reject claims 1, 6 and 16 under 35 U.S.C. § 112, second paragraph and to reject claims 1, 3-6, and 13-17 under 35 U.S.C. § 103 as being unpatentable over Huckvale in view of the admitted prior art at pages 1 and 2 of appellants' specification and Strauss is reversed.

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

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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Appeal No. 1996-2972
Application No. 07/928,784

Page 11

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