

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 1996-3597
Application No. 08/050,825

ON BRIEF

Before, KIMLIN, WALTZ, 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 1-5, 10-12 and 20 as amended after final rejection, which are all of the remaining claims in this application.

Appellant's invention is drawn to a method of making a flexible mold useful in producing a molded article that is a replica of a model. All of the appealed method claims include

the steps of; (1) inserting a model into a container so that the lower portion of the model contiguously overlays a floor member of the container; (2) pouring a curable liquid polymer composition into the container for encapsulating the model; (3) inserting a pair of handle members into the curable liquid composition; (4) curing the liquid polymer composition having the handle members embedded therein to form a solid flexible mold; (5) removing the so formed solid flexible mold from the container; and (6) displacing the handle members to release the model from the solid flexible mold to form a cavity therein having a reverse image of the outer contour of the model. A further understanding of the invention can be derived from a reading of exemplary claims 1 and 20, which are reproduced in an Appendix to the brief.

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

Hyde 29, 1957	2,779,058	Jan.
Mutch 1972	3,674,302	Jul. 04,
Frahme 1982	4,313,789	Feb. 02,
Adiletta 1986	4,578,826	Apr. 01,

Waller et al. (Waller)	4,683,028 ¹	Jul. 28, 1987
Kaisha	GB 2187995	Sep. 23,

1987 Claims 1-5, 10-12 and 20 stand rejected under 35

U.S.C.

§ 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as invention. Claims 1-5, 10-12 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Frahme and Adiletta in view of Hyde, Kaisha, Mutch and Waller.

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

¹ Waller is not a listed applicant of U.S. Patent No. 4,683,020, the patent number cited by the examiner and applicant in the brief and answer, respectively. Accordingly, we consider the references of appellant and the examiner to U.S. Patent No. 4,683,020 to represent an obvious and harmless error in that the underlying described teachings of the Waller reference are consistent with U.S. Patent No. 4,683,028, the patent cited on the Notice of References Cited (Form PTO-892, sheet 3) that accompanied the first office action (Paper No. 2) mailed January 24, 1994. For purposes of this appeal, any reference to Waller will be considered as a reference to U.S. Patent No. 4,683,028.

founded. Accordingly, these rejections will be reversed for substantially the reasons set forth by appellant in the brief.

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 appellant's 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 term predetermined is unacceptable" and makes reference to the mold, article, polymer composition and the "flexible and liquid impervious layer" (claim 1) as not being identified.² At page 5 of the answer, the examiner further attempts to explain that "... the term 'predetermined' is unacceptable because it does not further define the claim" and

² We note that the examiner's additional references to claim 15 and the "resulting article" language of claims 2-5 and 10-12 (answer, page 3) are not germane since claim 15 has been canceled and claims 2-5 and 10-12 have been amended to remove any reference to a "resulting article."

"... appellant has not defined the claims in terms that the article and its composition may be defined or determined in terms of its chemical and physical structure."

While we recognize that the variously recited limitations of the appealed claims do not circumscribe a narrowly defined mold composition or shape, 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 appellant's specification, including the claims, and the relevant prior art, it is clear that the claimed method is reasonably definite albeit broad in encompassing a method for making a mold of a suitable composition and shape that would be useful for the suggested applications. Accordingly, we shall not sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 103

In our view, the examiner has not set forth a prima facie case of obviousness of the claimed method. Since we are in substantial agreement with appellant for the reasons set forth in the brief (pages 16-25), we will not burden the record by repeating all of the deficiencies in the examiner's rejection.

We note that it is the burden of the examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. See In re Sernaker, 702 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983).

The examiner has not adequately explained how a skilled artisan would have arrived at the claimed invention from the collective prior art teachings assembled by the examiner even if all of the references were combinable as alleged. As indicated above, all of the claims on appeal herein are drawn to a method requiring at least six specifically enumerated steps in fashioning a flexible mold structure having a cavity therein defined by a reverse image of the outer contour of a model that was used in forming the mold and subsequently removed therefrom. Indeed, we find the examiner's explanation (answer, pages 3-7) as to why or how a skilled artisan would have been led to modify the method of forming a block burner of Frahme and the protective hand covering manufacturing method of Adiletta to arrive at the claimed method herein with

the additional teachings of Hyde, Mutch, Waller and Kaisha rather difficult to follow. In our view, the proposed combination of the disparate teachings of these references falls significantly short of establishing a prima facie case of obviousness of appellant's method.

We note that it is incumbent upon the examiner to give weight to all of the method limitations that are specifically recited in the appealed claims, setting forth how a particular applied reference meets specified limitation(s) that are claimed as well as noting all of the differences in the appealed claims over that applied particular reference, the proposed modification(s) of that applied reference necessary to arrive at the claimed subject matter, and an explanation why such proposed modification(s) would have been obvious to one of ordinary skill in the art from the combined teachings of all of the applied reference(s) without resort to appellant's specification.

This the examiner has not done by suggesting that "Frahme teaches basic process steps..." and "Adiletta teaches a similar process..." which may be modified by other dissimilar applied prior art (answer, pages 3-5) without specifically

identifying all of the particular and herein claimed method steps identically disclosed by Frahme and those not so disclosed, and further showing how the disparate teachings of all of the applied references including Frahme would have led a skilled artisan to modify the process of Frahme to a process corresponding to appellant's claimed method as a whole. Here, the examiner has not even identified where Frahme teaches any method of making a mold having a cavity therein defined by a reverse image of the outer contour of a model that was used in forming the mold and subsequently removed therefrom, let alone appellant's method. The portions of Frahme identified by the examiner (answer, page 3) are not even directed to a mold making method involving the curing of a polymer embedding a model that is subsequently removed therefrom but rather the use of a particularly assembled mold with inner and outer members to form a burner block. Based on this record, we find ourselves in substantially complete agreement with appellant's views with respect to the lack of merit in the examiner's stated position (brief, pages 16-25).

From our perspective, the examiner simply has not established a factual basis upon which to establish the prima

facie obviousness of the claimed invention as a whole, including each and every limitation of the claims. In re Fine, 837 F.2d 1071, 1075, 5 USPQ 1596, 1600 (Fed. Cir. 1988); In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1967). Accordingly, we shall not sustain the examiner*s rejection of the appealed claims under 35 U.S.C. § 103.

CONCLUSION

The decision of the examiner to reject claims 1-5, 10-12 and 20 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention and to reject claims 1-5, 10-12 and 20 under 35 U.S.C. § 103 as being

unpatentable over Frahme and Adiletta in view of Hyde, Kaisha,
Mutch and Waller is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
PETER F. KRATZ)	
Administrative Patent Judge)	

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