

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GYANENDRA GUPTA

Appeal No. 95-1711
Application No. 08/063,819¹

ON BRIEF

Before JOHN D. SMITH, WEIFFENBACH and PAK, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 17, 19, 21, 23 and 36-39.

Claim 17 is representative and reproduced below:

¹ Application for patent filed May 20, 1993. According to the appellant, the application is a division of Application No. 07/780,684, filed October 18, 1991, now abandoned.

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17. A method of degating molded parts comprising the steps of:

(a) providing an injection molding material capable of being molded in an injection molding apparatus;

(b) molding a solid configuration from said molding material comprising parts secured to a runner system by gates of said molding material, said gates having a cross-section substantially smaller than any cross-section of said molded configuration which is contacting and integral therewith;

(c) cooling the surfaces of said configuration to a temperature and for a time until only said gates become brittle; and

(d) applying an impact to said configuration while said gates are brittle to cause said configuration to sever at said gates and separate said runner system from said parts.

The references of record relied upon by the examiner are:

Jones et al. (Jones)	3,468,077
Sep. 23, 1969	
Oishi et al. (Oishi)	5,190,712
Mar. 2, 1993	

The appealed claims stand rejected for obviousness (35 U.S.C. § 103) as unpatentable over Oishi or certain admitted prior art in view of Jones. Additionally, claims 17, 19, 21 and 23 stand rejected under 35 U.S.C. § 112, first paragraph, "enablement requirement."

We reverse.

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The subject matter on appeal is directed to a process of degating molded parts by the steps of molding, cooling, and applying an impact to a solid configuration of molding material comprising parts secured to a runner system by gates, wherein the gates have a cross-section substantially smaller than any cross-section of the molded configuration.

With respect to his obviousness rejection of the appealed claims, the examiner broadly contends that it is well known and conventional to freeze and impact to remove flash in the molding art. To support this contention the examiner cites Jones as disclosing the removal of flash by cooling with liquid nitrogen and tumbling to apply impact. Thus, according to the examiner, it would have been obvious to one of ordinary skill in the art at the time of the invention to deflash a molded article with cryogenic deflashing as described in Jones.

On the other hand, appellant contends that the removal of flash as in the Jones process has nothing whatsoever to do with degating, the subject matter of the appealed claims. Thus the appealed claims require inter alia, cooling and application of impact (e.g. tumbling) to a specific solid

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configuration which is defined as the molded parts secured to a runners system by gates of the molding material to effect degating. Although the examiner has asserted in his answer at page 5 that an attached runner, sprue and gate to a molded part is commonly referred to in the art as "flash," the examiner has pointed to no objective evidence in the record to support this factual assertion. Thus, it is apparent that the examiner has failed to satisfy his burden of establishing a prima facie case of obviousness for the subject matter defined by the appealed claims. In contending that the appellant has provided no objective evidence that degating and flash removal are entirely different operations, the examiner has put the cart before the horse. It is well settled that it is the examiner's burden, in the first instance, to establish a prima facie case of obviousness. This he has not done.

Accordingly, we are constrained to reverse the examiner's rejection of the appealed claims for obviousness.

Claims 17, 19, 21 and 23 also stand rejected under 35 U.S.C. § 112, first paragraph, because, according to the examiner, the disclosure is enabling only for claims limited to polyvinyl alcohol resins. We also reverse this rejection.

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It is well established that the examiner has the "burden of giving reasons, supported by the record as a whole, why the specification is not enabling. . . . Showing that the disclosure entails undue experimentation is part of the PTO's initial burden. . . ." In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). In determining whether any given disclosure would require undue experimentation to make the claimed subject matter, the examiner must consider not just the breadth of the claims, as here, but also the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in the art, and the predictability or unpredictability of the art. Determining enablement is a question of law based on factual findings. In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991). Here, it is apparent that the examiner has not made the requisite factual findings to support a conclusion that the present disclosure would require undue experimentation to carry out the claimed process. While the examiner contends that injection molding compounds such as concrete, metallics,

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ceramics, and sugars would be inoperable in the instant invention, appellant points out that the claims require the provision of an injection molding material "capable of being molded in an injection molding apparatus." Moreover, the examiner should be aware that it is not the function of patent claims to specifically exclude possibly inoperative embodiments. In re Geerdes, 491 F.2d 1260, 1265, 180 USPQ 789, 793 (CCPA 1974). Accordingly, the examiner's rejection under 35 U.S.C. § 112, first paragraph, is also reversed.

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The decision of the examiner is reversed.

REVERSED

JOHN D. SMITH)
Administrative Patent Judge)
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CAMERON WEIFFENBACH)
Administrative Patent Judge)
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CHUNG K. PAK)
Administrative Patent Judge)

BOARD OF PATENT
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Serial No. 08/063,819

Judge JOHN D. SMITH

Judge PAK

Judge WEIFFENBACH

Received: 28 Oct 98

Typed: 28 Oct 98

DECISION: REVERSED

Send Reference(s): Yes No
or Translation(s)

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3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 1305

Index Sheet-2901 Rejection(s): _____

Acts 2: _____

Palm: _____

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