

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHIHARU INABA, HIDEO NAITO and
KIKUO WATANABE

Appeal No. 95-4878
Application No. 08/225,087¹

HEARD: April 8, 1999

Before KIMLIN, WARREN, and WALTZ, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed March 8, 1994. According to appellants, the application is a continuation of Application 07/817,956, filed January 8, 1992, which is a continuation of Application No. 07/457,779, filed January 11, 1990.

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This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 3, which are the only claims in this application.

According to appellants, the invention is directed to a two-platen, mold-clamping apparatus requiring neither tie bars nor rear platen (Brief, page 2). Appellants also state that the rejected claims stand or fall together (*Id.*).

Accordingly, we select independent claim 1 from the grouping of claims and decide the appeal as to the ground of rejection on the basis of this claim alone. See 37 CFR § 1.192(c)(7)(1995). Claim 1 is illustrative of the subject matter on appeal and a copy of claim 1 is attached as an Appendix to this decision.

The examiner has relied upon the following references as evidence of obviousness:

Inaba (§ 102(e) date of Oct. 21, 1986)	4,781,568	Nov. 1, 1988
Bluml et al. (Bluml) (U.S. filing date of Nov. 27, 1989) ²	5,110,283	May 5, 1992
Bluml et al. (WO '256)	WO 88/09256	Dec. 1, 1988

²At issue in this decision is the § 102(e) date of this reference.

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(Published PCT/DE88/00304)

Claims 1 through 3 stand rejected under 35 U.S.C. § 103 as unpatentable over Inaba taken together with Bluml (Answer, page 3, referring to the final rejection dated Dec. 1, 1994, Paper No. 34, page 2). We *affirm* this rejection for reasons which follow.

OPINION

Appellants present two arguments against the examiner's rejection. Appellants argue that Bluml is not prior art under § 103 via § 102(e) (Brief, pages 3-5). Furthermore, appellants argue that, even if Bluml is prior art via § 102(e), the combination of Inaba and Bluml "does not disclose or suggest the two-platen, mold-clamping apparatus of the present invention" (Brief, sentence bridging pages 5-6). Since the rejection of claims 1 through 3 under § 103 is not viable unless Bluml is available prior art under § 103 via § 102(e), we will first discuss the issue of the availability of Bluml as prior art and then discuss the merits of the rejection under § 103.

A. The Availability of Bluml as Prior Art

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The following facts are not contested by appellants or the examiner. The Bluml reference is U.S. Patent No. 5,110,283, which issued on May 5, 1992, from an Application No. 07/441,379 filed Nov. 27, 1989. Bluml claims priority from a continuation-in-part of PCT/DE88/00304 filed on May 19, 1988. The application on appeal (Application No. 08/225,087, filed on Apr. 8, 1994) is a continuation of Application No. 07/817,956, filed Jan. 8, 1992, which itself is a continuation of Application No. 07/457,779, filed Jan. 11, 1990. Application No. 07/457,779 claims priority from PCT/JP89/00679 filed on July 5, 1989, and Japanese Application 169118/1988 filed on July 7, 1988. A verified translation of this Japanese priority document was submitted in Application No. 07/817,956, thus giving appellants an effective filing date of July 7, 1988, under 35 U.S.C. § 119 for the claimed subject matter. See the *Manual of Patent Examining Procedure (MPEP)*, § 201.15 (7th ed., July 1998). Appellants also have not contested the examiner's determination that the subject matter in Bluml relied upon by the examiner as evidence of obviousness under § 103 is found in the disclosure of

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PCT/DE88/00304 (see *MPEP*, § 2136.03 (IV) (7th ed., July 1998), and the examiner's reliance on WO '256, the published PCT/DE88/00304 application, on page 4 of the final rejection).

Appellants and the examiner contest the availability of Bluml as prior art under § 103 via § 102(e) (Brief, pages 3-5, and the Answer, pages 3-4). Section 102(e) of 35 U.S.C.

(1975) states

A person shall be entitled to a patent unless-
....(e) the invention was described in a patent granted
(1) on an application for patent by another filed in the
United States before the invention thereof by the applicant
for patent, or (2) on an international application by
another who has fulfilled the requirements of paragraphs
(1), (2), and (4) of section 371(c) of this title before
the invention thereof by the applicant for patent....
[Numbers in italics added.]

Appellants argue that Bluml has not fulfilled the requirements of section 371(c)(1), (2), and (4) until the Nov. 27, 1989, filing date of the Bluml U.S. application (Brief, page 5).

Appellants' argument is not well taken since it is clear from the Bluml patent that it issued from a U.S. national application filed under 35 U.S.C. § 111(a) (i.e., Application No. 441,379), not a national stage application filed under §

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371. When a U.S. national application filed under § 111(a) becomes a U.S. patent, its effective date as a prior art reference against a pending application is its effective filing date. See our clause (1) of 35 U.S.C. § 102(e) above. Since the application of Bluml was *not* a U.S. national stage application under 35 U.S.C.

§ 371, the requirements of our clause (2) of § 102(e) above need not be considered. Thus if a § 111(a) application claims the benefit of a prior application, such as a continuation-in-part of a copending PCT international application under 35 U.S.C. §§ 120 and 365(c), its effective date as a reference is the filing date of the prior application. See 35 U.S.C. §§ 120, 365(c), and *MPEP*, §§ 1896 and 2136.03 (II)(7th ed., July 1998). See also Hoover, *Journal of the Patent and Trademark Office Society*, Vol. 80, No. 4, pp. 289-295, April 1998.

Therefore the effective date of the Bluml reference is May 19, 1988, the filing date of PCT/DE88/00304, and Bluml is available as a prior art reference under § 102(e) since it is "by another" and "filed before the invention thereof by the

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applicant for patent", i.e., before appellants' effective filing date under 35 U.S.C. § 119 of July 8, 1988.

For the foregoing reasons, we determine that Bluml is available as prior art under § 103 via § 102(e).

B. The Rejection under § 103

We affirm the rejection of claims 1 through 3 under 35 U.S.C. § 103 as unpatentable over Inaba taken with Bluml essentially for the reasons set forth by the examiner in the final rejection (Paper No. 34) and the Answer. We add the following comments primarily for emphasis.

Appellants argue that Bluml "discloses what in essence is a three-platen apparatus." (Brief, page 5). Appellants' argument is not persuasive since, as noted by the examiner on page 4 of the Answer, Bluml discloses and teaches only two mold plates or platens. Appellants provide no support for their argument that the structure in Figure 1 of Bluml (which is not numbered) between the mold clamping plate **2** and the belt **4** acts as a platen.

Appellants note that Inaba is directed to a three-platen mold-clamping apparatus (Brief, page 5) but have not contested

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the examiner's statement that Inaba discloses mold closing and clamping with ball nuts and ball screws can take place either by rotating the ball nuts or by rotating the ball screws (final rejection, page 3). Accordingly, we determine that the examiner has established that it would have been *prima facie* obvious to modify the apparatus of Bluml in view of the teachings of equivalency in Inaba (*Id.*).

For the foregoing reasons and those set forth by the examiner in the final rejection and the Answer, the rejection of claims 1 through 3 under 35 U.S.C. § 103 as unpatentable over Inaba taken with Bluml is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

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§ 1.136(a).

AFFIRMED

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

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APPENDIX

1. A two-platen mold-clamping apparatus, comprising:

a stationary platen;

a movable platen disposed for reciprocal motion relative to said stationary platen along a predetermined path to effect mold opening and closing;

a plurality of ball nuts;

a respective bearing mechanism rotatably mounting each said ball nut on said movable platen for rotation relative thereto about an axis extending longitudinally of the path,

said bearing mechanisms each being operable to prevent movement of the corresponding respective ball nut relative to the movable platen in a radial direction and in an axial direction relative to said axis;

a respective elongated ball screw continuously threadably engaged with each of said ball nuts, each ball screw having an end portion fixed to said stationary platen, the opposite ends of said screws extending through the movable platen and being supported by said ball nuts and including threaded portions of sufficient length to accommodate both mold-closing and mold-clamping operations;

a motor mounted on said movable platen for movement therewith and having an output shaft; and

operating structure operatively coupling said output shaft of said motor to said ball nuts for rotating the ball nuts to move said ball nuts and therefore the movable platen longitudinally of the ball screws during both mold-closing and mold-clamping operations to thereby generate a mold-clamping force.

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APJ KIMLIN

APJ WARREN

DECISION: AFFIRMED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: January 29, 2001

Draft Final

3 MEM. CONF. Y N

OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT