

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(2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK A. LEACH and DAVID I. LEACH

Appeal No. 1996-3738
Application 08/004,254

ON BRIEF

Before CALVERT, ABRAMS, and BAHR, Administrative Patent
Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 39
to 42, 44 to 48 and 52 to 54.¹ The other claims remaining in

¹ Although claims 39 to 54 were all rejected in the final
rejection, the examiner stated in a subsequent Advisory Action
(Paper No. 17) that upon filing an appeal, claims 43 and 49 to

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Before considering the rejection of any particular claim in detail, we note that on page 2 of the reply brief, second paragraph, appellants argue to the effect that Scott is nonanalogous art. In the view we take of this case it is unnecessary to resolve this issue, however, and we will assume for the purpose of discussion that Scott is analogous art.

We will first turn to the rejection of claim 39, the basis of which is set forth on pages 3 to 6 of the examiner's answer. In essence, the examiner finds that it would have been obvious, in view of the Handbook, to use a ring gate in the molding process of Tsuchiya, and, in view of Scott, to use a cavity (feed chamber) with tapered walls at its end so that excess resin can be trimmed away at the taper point.

We agree with the examiner that it would have been obvious to use a ring gate instead of the runner 13a disclosed by Tsuchiya, in view of the suggestion in the Handbook at page 185, col. 2, paragraph 7, that a ring gate be used when molding round or cylindrical parts. Also, using a gate (orifice) which has a relatively narrow width would have been obvious in view of the Handbook's disclosure at page 183, in the first sentence under

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"Gates," that the gate is given a smaller cross section than the runner to allow easy separation from the runner, and the showing in Fig. 7-16 (page 186) of a gate with a narrow width (depth).

The final step recited in claim 39 is:

separating the surround from a ring of solidified sprue formed of the elastomeric material remaining in the annular feed chamber by tearing the sprue from the surround at the narrow junction between the sprue and the surround formed by the annular orifice, the tearing being done while the elastomeric material is still hot from the injection step.

As the examiner seems to recognize, the only disclosure in the applied prior art concerning separation of the excess material from the molded part is in Scott, which discloses that the excess (flashing) is trimmed (col. 3, line 31) and "removed, as by a trim die" (col. 4, lines 27 to 29). The examiner argues at page 7 of the answer to the effect that the term "tearing" as used in claim 39 does not preclude the use of cutting tools, but, whatever may be the merit of that argument, we do not consider that any normal meaning³ of the

³ "The general rule is that terms in the claim are to be given their ordinary and accustomed meaning." K-2 Corp. v. Salomon S.A., 191 F.3d 1356, 1362, 52 USPQ2d 1001, 1004 (Fed. Cir. 1999).

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word "tearing" would include trimming with a trimming die. Moreover, Scott does not disclose trimming while the material is still hot, as called for by the claim. The examiner seems to believe that the "still hot" limitation should be given no weight, arguing that (answer, page 7):

With respect to the tearing being performed while the material is still hot, such language is deemed descriptive of the desired result and does not further limit the claim as "still hot" is relative and does not give metes and bounds to the claim.

In our view, this argument is not well taken. Although the word "hot" may itself be a relative term, the claim language "while the elastomeric material is still hot from the injection step" defines for one of ordinary skill in the art what is meant by "still hot." A specific limitation such as this cannot be ignored in determining whether the claim distinguishes over the prior art. In re Glass, 472 F.2d 1388, 1392, 176 USPQ 489, 491 (CCPA 1973).

Accordingly, we conclude that claim 39 is patentable over the applied prior art, and will not sustain the rejection of that claim under § 103. The rejection of dependent claims 40 to

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42, 44 to 48 and 52 will likewise not be sustained.

Next considering claims 53 and 54, each of these claims requires, *inter alia*, injecting elastomeric material into the mold cavity "through an annular, tapered, knife edge-shaped orifice." As we understand the examiner's position, it is that it would have been obvious to modify the process of Tsuchiya (modified in view of the Handbook) by providing a knife edge orifice at the gate in view of the knife edge 17 or 57 disclosed by Scott.

We will not sustain this rejection. "Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Here, Scott's disclosure of a knife edge orifice would not suggest the use of such an orifice in the gate of an injection mold, because Scott's orifice is located not where material is being injected into a mold, but rather where it is flowing in the other direction, namely, out of mold cavity 8 or 48 and into overflow cavity 9 or 49. Moreover, the disclosed purpose of Scott's knife edge orifice ("pinch bead") 17 or 57 is to hold the reinforcing fabric 16

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or 26 in the desired position (col. 3, lines 24 to 30; col. 4, lines 22 to 25). Since Tsuchiya does not disclose that any reinforcing fabric is used in molding surround 2, there would be no motivation for one of ordinary skill to use a knife edge as disclosed by Scott in the Tsuchiya process.

Conclusion

The examiner's decision to reject claims 39 to 42, 44 to 48 and 52 to 54 is reversed.

REVERSED

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IAN A. CALVERT)
Administrative Patent Judge)
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) BOARD OF PATENT
NEAL E. ABRAMS)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
JENNIFER D. BAHR)
Administrative Patent Judge)

IAC:lmb

NATHANIEL A. HUMPHRIES
701 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004