

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN DUMSTORFF and JOHN SIMPSON

Appeal No. 2005-1413
Application No. 09/935,983

ON BRIEF

Before WARREN, OWENS and WALTZ, **Administrative Patent Judges**.
WALTZ, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claim 5, which is the sole claim remaining in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to an injection mold for molding an integral key fob, where the injection mold has a mold portion defining a mold blank recess

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and a mold portion cavity, with several mold blanks defining corresponding differently shaped mold cavities, with the mold blank inserted into the mold blank recess, and the mold blank recess and the mold portion cavity together forming a unified molding cavity for molding the key fob (Brief, page 5). The sole claim on appeal is reproduced below:

5. An injection molding machine comprising:

an injection mold having a mold portion defining a mold blank recess and a mold portion cavity, the mold portion cavity being adapted to mold an extending tab of a key fob and the mold blank cavity being adapted to accept a mold blank, to mold a base portion integrally of the key fob;

a plurality of mold blanks, each defining a mold blank cavity of varying size and shape, and provided for selective molding of a base portion of the key fob integrally with its extending tab of the size and shape from the selected mold blank cavity;

wherein the mold blank recess is adapted to accept one of a plurality of said mold blanks, the mold blank cavity and the mold portion cavity together forming a unified molding cavity for molding the integral key fob; and

wherein the unified molding cavity is adapted to receive a melted polymer to form the one-piece integral key fob.

The examiner relies on Hendrickson et al. (Hendrickson), U.S. Patent No. 6,328,552 B1, issued Dec. 11, 2001, as the sole evidence of obviousness. Accordingly, claim 5 stands rejected

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under 35 U.S.C. § 103(a) as unpatentable over Hendrickson (Answer, page 3, referring to the final Office action dated Jan. 5, 2004). We reverse the rejection on appeal essentially for the reasons stated in the Brief and those reasons set forth below.

OPINION

The examiner finds that Hendrickson teaches an apparatus having a mold base (14) which can accommodate different mold inserts (36) that would have different cavity features, allowing for different parts production (final Office action dated Jan. 5, 2004; see the Answer, page 3, paragraph (10)). The examiner further finds that the inserts are the mold blanks that are placed into the recesses provided by the mold base (*id.*).

The examiner finds that Hendrickson fails to teach "mold blanks and the cavities adapted to form an extending tab and base portion of the key fob, and cavities of different sizes and shapes." *Id.* The examiner concludes that different cavity shapes and sizes are inferred by Hendrickson's teaching regarding the production of different parts, and it would have been obvious to one of ordinary skill in the art to "have different shapes and sizes of the cavity shapes to be used" (*id.*).

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The examiner bears the initial burden of establishing a *prima facie* case of obviousness based on the disclosures of the applied prior art references. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In this appeal, we determine that the examiner has not established that every limitation in claim 5 on appeal has been disclosed or suggested by the sole evidence of obviousness (Hendrickson). The burden rests with the examiner to establish that the parts of the injection molding machine of Hendrickson correspond to the claimed parts of appellants' injection molding machine, or the claimed parts were suggested by Hendrickson, and we determine that the examiner has not met this burden. As correctly argued by appellants (Brief, page 8), Hendrickson only discloses a generic mold base in which other mold inserts (mold blanks) may be located, in order to vary production of a sized part from the same mold base (see Figure 10; col. 1, ll. 45-59; and col. 5, ll. 64-66). Appellants disclose and claim a dual cavity injection molding device where one cavity is provided for forming one segment, such as the extending tab of a key fob, while the other mold portion is designed for receiving a selected mold blank (from a variety of such blanks) in order to vary the size or

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shape of the base portion of the same key fob (e.g., see appellants' Figures 6 and 7). Accordingly, the examiner has failed to establish that parts of the Hendrickson injection molding machine correspond to the mold blank cavity and the mold portion cavity that together form a unified molding cavity (see claim 5 on appeal; see also Hendrickson, col. 7, ll. 7-9). The examiner's conclusion that it would have been obvious to have different sizes and shapes of the cavity, or that any change in the mold cavity size and shape is a "design choice," have no basis in the evidentiary record. See *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).

For the foregoing reasons and those stated in the Brief, we determine that the examiner has failed to establish a *prima facie* case of obviousness in view of the reference evidence. Therefore we cannot sustain the examiner's rejection of claim 5 under section 103(a) over Hendrickson.

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The decision of the examiner is reversed.

REVERSED

CHARLES F. WARREN)	
Administrative Patent Judge)	
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TERRY J. OWENS)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

TAW:hh

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