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 KAREN EASTMAN

Appeal No. 2005-1435
Application No. 09/906,564

ON BRIEF

Before PAK, WARREN and TIMM, ***Administrative Patent Judges***.

PAK, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 6 and 8 through 12. Claims 13 through 17, the other claims pending in the above-identified application, stand withdrawn from consideration by the examiner as being directed to a non-elected invention.

APPEALED SUBJECT MATTER

Claims 1, 3, 4 and 8 are representative of the subject matter on appeal and read as follows[1]:

1. A process for utilizing purged resin discharged from an injection molding machine comprising the steps of:

discharging said purged resin through a port located spaced above a collecting surface so that streams of discharged resin collect in a puddled mass on said surface;

allowing cooling and solidification of said discharged resin;

preparing said solidified resinous mass for use as a decorative article; and

selling said decorative article.

3. The method according to claim 1 wherein said preparing step includes the step of trimming projecting appendages from said solidified mass.

4. The method according to claim 1 wherein said step includes the step of reheating at least a portion of said solidified resinous mass and reshaping said reheated portion.

8. A method of constructing a decorative article comprising the steps of:

discharging a stream of molten resin out of a port elevated above a collecting surface while allowing said resin stream to descend down onto a said collecting surface to form a randomly contoured, irregular puddled resinous mass;

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[1] We limit our consideration to only those claims which have been separately argued in the Brief in accordance with 37 CFR § 41.37(c)(1)(vii)(2004).

allowing cooling of said molten resin to solidify into a preform having one or more appendages formed by a solidifed stream of resin; and

preparing a decorative article from said preform.

PRIOR ART REFERENCES

The prior art references relied upon by the examiner are:

Lanyon, Jr. (Lanyon)	Des. 21,497	Apr. 26, 1892
Ito et al. (Ito)	5,505,606	Apr. 9, 1996
Kastl et al. (Kastl)	6,103,173	Aug. 15, 2000 (filed Jun. 16, 1998)

THE 35 U.S.C. § 103(a) REJECTIONS

The appealed claims stand rejected as follows[2]:

1) Claims 1 through 3, 5, 6, 8, 11 and 12 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Ito and Lanyon; and

2) Claims 4, 6, 9, 10 and 12 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Ito, Lanyon and Kastl.

OPINION

We have carefully reviewed the claims, specification and prior art, including all of the arguments advanced by both the examiner and the appellant in support of their respective

[2] See the Answer, pages 3-5 and the Brief, page 5.

positions. This review has led us to conclude that the examiner's Section 103 rejections are well founded. Accordingly, we will sustain the examiner's Section 103 rejections for essentially those findings of fact and conclusions set forth in the Answer. We add the following primarily for emphasis and completeness.

Under 35 U.S.C. § 103, to establish a *prima facie* case of obviousness, explicit and/or implicit teachings in the applied prior art references and/or knowledge generally available to a person having ordinary skill in the art that would have suggested the claimed subject matter are required. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (*Nies, J., concurring*); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981; *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The knowledge generally available to a person having ordinary skill in the art includes the appellant's admission regarding what was known in the art at the time of the appellant's invention. *See In re Nomiya*, 509 F.2d 566, 570-71, 184 USPQ 607, 611-12 (CCPA 1975)(the admitted prior art in an

applicant's specification may be used in determining the patentability of a claimed invention); *See also In re Davis*, 305 F.2d 501, 503, 134 USPQ 256, 258 (CCPA 1962).

With these precedents in mind, we turn to the examiner's section 103 rejections. The examiner finds that Ito teaches "an injection molding machine for discharging purged resin through a port located above a collecting surface so that streams of discharged resin [are] collect[ed] [as] a puddle mass on the surface, see Fig. 13 and col. 8, lines 18-20." See the Answer, page 3. Consistent with this finding, the appellant states (Specification, page 4) that:

> An injection machine ***normally*** has a purge port from which there is a discharge of plastic during a purge cycle required to clear the internal chambers when shutting down or changing over resins. According to one aspect of the invention, such purge resin is utilized as a preform for constructing a decorative article to gain value from the material and avoid the need to regrinding to recycle the material or to dispose of the same in a landfill. [Emphasis added.]

The appellant also acknowledges that clear and tinted high strength polycarbonates of the type used for automotive glazing are known to be purged from an injection molding machine. See the specification, pages 1 and 2. Implicit in these statements is that the appellant's invention lies in using the preform resulting from conventionally discharged and collected purged

resin to construct a decorative article. In other words, discharging, collecting and allowing cooling and solidifying of a puddled mass of purged resin to form randomly shaped masses of clear and tinted plastic waste are admittedly known.

Thus, with respect to claims 1, 2, 3, 4, 6 and 8 through 12, the dispositive question is whether one of ordinary skill in the art would have been led to employ the randomly shaped masses of plastic as decorative articles, i.e., “preparation” and “selling” of the randomly shaped masses of clear and tinted plastic as decorative articles. On this record, we answer this question in the affirmative.

As correctly found by the examiner (Answer, page 4), Lanyon teaches mounting irregular body shapes, especially lustrous irregular body shapes, on rectangular bases (fitting them into holes of the rectangular bases) to make aesthetic paper-weights. See also Lanyon in its entirety. These lustrous irregular body shapes taught in Lanyon encompass the randomly shaped masses of clear and tinted plastic produced in an admittedly known purging process. Since these desired lustrous irregular body shapes (plastic waste) useful for paperweights are known to be readily and economically available, we concur with the examiner that one of ordinary skill in the art would have

been led to use such plastic waste (randomly shaped masses of clear and tinted plastic) as paper-weight materials (decorative articles).[3] *See In re Clinton*, 527 F.2d 1226, 1229, 188 USPQ 365, 367 (CCPA 1976)("Economics alone would [have] motivate[d] a person of ordinary skill in the art" to arrive at the claimed invention). To form the paperweights that can be sold, as indicated by the examiner (Answer, page 4), the randomly shaped mass of clear and tinted plastic (polycarbonate) must necessarily be prepared (bent and trimmed) so that at least a portion thereof can form a shape that can be fitted into the hole of the rectangular base as taught by Lanyon.

Moreover, with respect to claims 4, 5, 9 and 10, as correctly found by the examiner (*Id.*), combining and/or bending the randomly shaped masses of clear and tinted plastic to produce an another aesthetically pleasing irregular shaped paper-weight is well within the ambit of one of ordinary skill in the art.[4] *See In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir.

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[3] An old adage "one's trash is another's treasure" is relevant in this case, especially since the popularity of abstract art is well known.

[4] An old adage "beauty is in the eye of a beholder" holds true in this case. With the advent of abstract art, beauty has always been in the eye of a beholder.

1985)(Skill is presumed on the part of those practicing in the art); *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969) (the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art). As is apparent from Kastl, bending plastics in general, including polycarbonate plastics, via heating is conventional.

CONCLUSION

For the factual findings set forth in the Answer and above, we are not persuaded by the appellant's arguments. Thus, on this record, we concur with the examiner that one of ordinary skill in the art armed with the knowledge indicated *supra* would have been led to the claimed subject matter. Accordingly, we affirm the examiner's decision rejecting the claims on appeal under 35 U.S.C. § 103(a).

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHUNG K. PAK Administrative Patent Judge	)	
CHARLES F. WARREN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CATHERINE TIMM Administrative Patent Judge	)	

CKP:hh

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