

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 D. WAYNE LEIDY
and FRANK J. DIFRANK

Appeal No. 2006-0465
Application 10/445,707

ON BRIEF

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

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the grounds of rejection advanced on appeal: claims 1 through 8 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (answer, page 12); claims 1 through 8 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (answer, pages 10-11); claims 1 through 5 and 9 through 16 under 35 U.S.C. § 103(a) as being unpatentable over Duga et al. (Duga) (answer, pages 3-9), and claims 1 through 5 and 9 through 16 under 35 U.S.C. § 103(a) as being unpatentable over Duga in view of Dorman (answer, page 10).¹

¹ Claims 1 through 16 are all of the claims in the application.

We refer to the answer and to the brief² and reply brief for a complete exposition of the positions advanced by the examiner and appellants.

The grounds of rejection under § 112, first and second paragraphs, are directed to the sixth clause of representative claim 1 to which we add other language of the claim for context:

each said [spaced] arm [having one end from which an associated one of said plungers is suspended,] being connected at its other end to one of said servo controlled actuators [mounted adjacent to each other on one side of said forehearth for movement linearly in directions parallel to said axes of said plungers,] such that said arms are parallel to each other as viewed from a horizontal direction and remain parallel to each other as viewed from a horizontal direction throughout movement of said actuators, said arms and said plungers.

With respect to the rejection under § 112, second paragraph, the examiner contends that the language “arms are parallel to each other as viewed from a horizontal direction” is “unclear as to whom is doing the viewing and from what distance” (answer, page 12). With respect to the rejection under § 112, first paragraph, written description requirement, the examiner contends that the same language is not explicitly supported, and that while “there is support for the arms being parallel, there is no suggestion of this ‘viewing’ limitation,” through which the claim encompasses “arms that are not parallel, even though they might appear to be so,” and excludes “arms that are parallel even though one cannot view” all (*id.*, page 11).

Appellants submit, with respect to both of these grounds of rejection, that the component arms **15** are described in the written description in specification, including the Figures, as horizontal, and this disclosure further describes this component and the component actuators **17** and plungers **12** to be “parallel” as this term is commonly used in context (brief, pages 7-9). The examiner responds that the “claims do not require the arms to be actually parallel” only to be viewed as such (answer, pages 18-19). Appellants reply that “parallelism is a matter of geometry” and not “eyesight” (reply brief, page 4).

We first consider the ground of rejection of appealed claims 1 and 13 under 35 U.S.C. § 112, second paragraph. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). The initial burden of establishing a *prima facie* case on any ground under the second paragraph of § 112 rests with the Examiner. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443,

² We consider the brief filed March 14, 2005.

1444 (Fed. Cir. 1992), citing *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (“As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.”). In making out a *prima facie* case of non-compliance with this statutory provision on the basis that a claim is indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention, the examiner must establish that when the language of the claim is considered as a whole as well as in view of the written description in the specification as it would be interpreted by one of ordinary skill in the art, the claim in fact fails to set out and circumscribe a particular area with a reasonable degree of precision and particularity. See *Moore*, 439 F.2d at 1235, 169 USPQ at 238. In other words, for a claim to comply with this statutory provision, “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” See *The Beachcombers, Int’l. v. WildeWood Creative Prods.*, 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994) (quoting *Orthokinetics, Inc v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)); see also *Exxon Research and Eng’g Co. v. United States*, 265 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001); *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

It is further well settled that the examiner has the burden of making out a *prima facie* case that the appealed claims do not comply with § 112, first paragraph, written description requirement, by setting forth evidence or reasons why, as a matter of fact, the written description in appellants’ disclosure would not reasonably convey to persons skilled in this art that appellants were in possession of the invention defined by the claims, including all of the limitations thereof, at the time the application was filed. See generally, *In re Alton*, 76 F.3d 1168, 1172, 1175-76, 37 USPQ2d 1578, 1581, 1583-84 (Fed. Cir. 1996), citing *In re Wertheim*, 541 F.2d 257, 262-64, 191 USPQ 90, 96-97 (CCPA 1976). In order to establish a *prima facie* case, the examiner need only establish that as a matter of fact, the claim encompasses “embodiments of the invention that are completely outside the scope of the specification.” See *Alton*, 76 F.3d at 1175-76, 37 USPQ2d at 1583.

We agree with appellants’ position and thus, determine that the examiner has not established a *prima facie* case under either statutory provision. We are of the opinion that one

skilled in this art, upon considering the language of the sixth clause of claim 1 in the context of the claim language as a whole and in light of the written description in the specification including the Figures, would have reasonably understood the claim to require that the arms and specified associated components are parallel to each other and remain parallel when in operation as viewed from a horizontal perspective, wherein the term “parallel” has its well known, common meaning in context. In this respect, this person would have reasonably understood that that a “horizontal direction” is a perspective in which the movement of the individual arms can be reasonably observed when viewed horizontally. The examiner has not identified any embodiment encompassed by the claim language which is outside of the scope of the written description in the specification and the Figures.

Accordingly, we reverse the grounds of rejection of claims 1 through 8 under 35 U.S.C. § 112, first paragraph, written description requirement, and second paragraph.

We next consider the teachings of Duga which issue is dispositive to the grounds of rejection under 35 U.S.C. § 103(a). The disclosure at issue involves a possible alternative embodiment and reads “[f]or example, a separate electric plunger may be operatively associated with each plunger via appropriate support brackets, etc.” (col. 11, ll. 25-28). It is well settled that the teachings that one of ordinary skill in this art would have found in a reference is a question of fact. Thus, we agree with appellants that this disclosure must be considered for what it would have disclosed to this person in light of the teachings of the reference as a whole (brief, page 17; reply brief, page 3).

We find that Duga would have disclosed to one of ordinary skill in this art an electronic glass feeder plunger operating device wherein, in the embodiment described, “in a feeder plunger operating mechanism for use with at least one feeder plunger . . . attached to a common support,” “a reversible electric motor operatively connected to positively drive said common support in a cyclically reciprocating manner” associated with a “programmable control means” to cause the “common support to move in a predetermined manner” (col. 3, ll. 23-37). In the preferred embodiment, the common support includes a cantilevered plunger support bracket for one or more plungers attached to a vertical support shaft (col. 3, ll. 37-56). As illustrated by Duga, in feeder plunger operating mechanism **10**, plunger carrier disk **40** to which three plungers **12,14,16** for the respective orifices are attached, is at the end of lateral plunger support bracket

44 connected to shaft **106** that is connected to frame **102**, and vertically reciprocated by electric motor **100** connected to control system **600** (e.g., col. 4, ll. 28-68; **FIGs. 1-4** and **6**). In the illustrative embodiment, “the outer plungers [**12,16**] in a triple gob mechanism could be adjusted by remote plunger height adjusting knobs **204** and **206**” and “[t]he center plunger [**14**] may be adjusted by setting motor **100** to a different ‘height’ and then aligning the outer plungers manually” (col. 6, ll. 8-42, particularly ll. 27-32).

We find that one of ordinary skill in the art when considering the subject disclosure at col. 11, ll. 25-28, in light of this disclosure with respect to the preferred, illustrative embodiment, would have reasonably recognized that “a separate electric plunger . . . via separate support brackets” is an “electric plunger” for each orifice, wherein each plunger is used with its own plunger support bracket vertically attached to a shaft such that it is separately cyclically reciprocated by an electric motor with electrical height adjustment through a control system.

In comparing the disclosure of Duga in this respect with appealed claim 1, we determine that the reference electric plunger components include a plunger attached to a bracket or arm, which is attached to a motor or actuator, and motion controlled through a system. However, the location of these assemblies relative to each other and to the forehearth, and the location and movement of the arm or bracket so as to align each “electric plunger” with its orifice is not described in the reference, as appellants point out (reply brief, page 3). The examiner submits that the claimed spatial relationships “would be met by keeping them in the protective housing 50 (see figure 1 and col. 4, lines 51-58)” (answer, page 8).

We find that Duga would have disclosed that housing **50** serves as protection for the mechanism **10** and does not confine the components therein to any configuration. We further find that this person would have been led by Duga to use a mechanism **10** illustrated in **FIGs. 1-4** for each “electric plunger” and would have arranged the mechanisms **10** with respect to the orifices of the forehearth. However, on this record, we find no teaching in Duga alone or as explained by the examiner which would have led this person to an arrangement of the mechanisms **10** that results in the arrangement of the actuators, arms and plungers required by independent claims 1 and 9. “Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of the reference. *See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314,

1318 (Fed. Cir. 1996).” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

We further find that one of ordinary skill in the art would not have been led to the claimed arrangement by the combined teachings of Duga and Dorman. Indeed, as appellants point out, Dorman has actuators on different sides of the forehearth. Thus, we determine that one of ordinary skill in this art reasonably following the combined teachings of these references would have placed Duga’s mechanisms **10** on opposite sides of the forehearth, and thus, would not have arrived at the claimed invention encompassed by the appealed claims. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988).

Accordingly, in the absence of a *prima facie* case of obviousness established over Duga alone or combined with Dorman, we reverse the grounds of rejection of claims 1 through 5 and 9 through 16 under 35 U.S.C. § 103(a).

The examiner’s decision is reversed.

Other Issues

The examiner has withdrawn the grounds of rejection of appealed claims 1 through 5 and 9 through 16 under the judicially created doctrine of obviousness-type double patenting over certain claims of United States Patent 6,622,526 (final action mailed August 13, 2004, pages 8-11), because the same were not advanced in the answer apparently on the basis of the terminal disclaimer filed by appellants that was accepted by the USPTO (brief, page 6).

We find no evidence in the official electronic files of the USPTO that the examiner considered whether the appealed claims constitute obviousness-type double patenting under the judicially created doctrine over the claims of United States Patent 5,885,317, and suggest that the examiner address this matter upon further consideration of the claims subsequent to the disposition of this appeal.

Reversed

CHARLES F. WARREN
Administrative Patent Judge

THOMAS A. WALTZ
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

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