

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 THOMAS A. DUNIFON and JENNIFER R. WOLFE

Appeal 2006-2998
Application 09/956,524
Technology Center 1700

Decided: September 29, 2006

Before KIMLIN, WALTZ, and FRANKLIN *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1 through 12.

A copy of claim 1 is set forth below:

1. An apparatus for press binding glass sheets comprising:
a male mold and a female mole positioned to press a glass sheet between them, said male mold having a pressing surface facing said female mold, said pressing surface having a contoured shape to press bend the glass sheet into a specific shape, wherein said contoured

surface of said male mold is curved in a first direction and in a second direction transverse to said first direction;

said male mold including a plurality of heating elements disposed through said male mold; and

each of said heating elements being disposed to substantially follow said contoured shape of said pressing surface to maintain a substantially constant distance from said pressing surface of said male mold.

Claims 1 through 12 stand rejected under 35 U.S.C. § 112, ¶ 1 (written description).

Claims 1, 2, 5 to 8, 11 and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Flaughner.

Claims 3 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Flaughner in view of Pickard.

Claims 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Flaughner in view of Woodward.

To the extent that the commonly rejected claims have been separately argued, they will be individually considered in our assessment of the respective rejections advanced on this appeal. *See In re Dance*, 160 F.3d 1339, 1340 n.2, 48 USPQ2d 1635, 1636 n.2 (Fed. Cir. 1998). *Also see* 37 C.F.R. § 41.37(c)(1)(vii)(Sep. 2004).

The Examiner relies upon the following references as evidence of unpatentability:

Pickard	US 3,753,673	Aug. 21, 1973
Flaughner	US 5,346,526	Sep. 13, 1994
Woodward	US 5,755,845	May 26, 1998

OPINION

We have carefully reviewed Appellants' Brief and Reply Brief and the Examiner's Answer and the evidence of record. This review has led us to the following determinations.

I. *The 35 U.S.C. § 112, ¶ 1 (written description) Rejection*

On page 3 of the Answer, the Examiner states that the disclosure as filed does not support a first longitudinal axis, a second axis transverse to the first axis, or a surface curvature both a first and second axis.

Beginning on page 10 of the Brief, Appellants point out how the figures, specifically how Figures 2 and 3, show a curvature in a first direction and a curvature in a second direction, transverse to the first direction, as depicted in Figure 3. Appellants argue that Figure 3 is a sectional view along line 33 of Figure 2, and also shows a curvature transverse to the curvature depicted in Figure 2.

We agree with the Appellants that the Figures support the claimed aspect regarding a male mold that is curved in a first direction and in a second direction transverse to the first direction.

On page 5 of the Answer, the Examiner responds and states that the drawing figures cannot be used to import specific structural limitations into the claims. This is an incorrect statement. It has been held that drawings can be sufficient to provide the "written description of the invention" required by § 112, first paragraph. Several cases support this conclusion. The issue in *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (CCPA 1962) was whether the specification of the applicant's utility patent

application disclosing a ball valve, and particularly the drawings thereof, supported a claim limitation that read: "having, in unextended condition, a mean diameter corresponding approximately to the mean diameter of said chamber and a radial width smaller than the radial width of said chamber" *Id.* at 952, 133 USPQ at 538. The court did not agree with the Board's conclusion that the "radial width" relationship was not supported by applicant's figure 5: The board's statement that "drawings alone cannot form the basis of a valid claim" is too broad a generalization to be valid and is, furthermore, contrary to well settled and long-established Patent Office practice Consider, for one thing, that the sole disclosure in a design patent application is by means of a drawing For another thing, consider that the only informative and significant disclosure in many electrical and chemical patents is by means of circuit diagrams or graphic formulae, constituting "drawings" in the case The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. . . . The issue here is whether there is supporting "disclosure" and it does not seem, under established procedure of long standing, approved by this court, to be of any legal significance whether the disclosure is found in the specification or in the drawings so long as it is there. *Id.* at 955-56, 133 USPQ at 541-42.

Employing a "new matter" analysis, the court in *In re Heinle*, 342 F.2d 1001, 145 USPQ 131 (CCPA 1965) reversed a PTO rejection of the applicant's claims to a "toilet paper core" as "including subject matter having no clear basis in the application as filed." *Id.* at 1003, 145 USPQ at 133. The claim limitation said to be without support required that the width of the apertures in the core be "approximately one-fourth of the circumference of

said core." *Id.* at 1007, 145 USPQ at 136. Having reviewed the application drawings relied upon for support, the court stated: it seems to us that [the drawings] conform to the one-fourth circumference limitation almost exactly. But the claim requires only an approximation. Since we believe an amendment to the specification to state that one-fourth of the circumference is the aperture width would not violate the rule against "new matter," we feel that supporting disclosure exists. The rejection is therefore in error.

Id.

In view of the above, we reverse the 35 U.S.C. § 112, ¶ 1 (written description) rejection of claims 1 through 12.

II. *The 35 U.S.C. § 102(b) Rejection*

The Examiner's position for this rejection is set forth on pages 3 through 4 of the Answer and we incorporate the position therein as our own.

Appellants' position is set forth on pages 13 through 16 of the Brief and page 8 of the Reply Brief. Appellants disagree with the Examiner's position that Figures 1 and 2 of Flaugher teaches a curvature along the longitudinal and transverse axis.

Appellants also point out that the male mold according to their invention includes a plurality of heating elements disposed through the male mold. Appellants state that each of the heating elements is disposed to substantially follow the contoured shape of the pressing surface to maintain a substantially constant distance from the pressing surface of the male mold. Br. 13-14.

Appellants argue on page 14 of the Brief that Flaugher does not show a curvature of the pressing surface in transverse directions as claimed.

Appellants argue that even if the surface of Flaughner showed curvature in a second direction transverse to a first direction, Flaughner would not anticipate the present claims because if there were curvature in this direction, the linear rods of Flaughner would, out of necessity, not be substantially of a constant distance from the pressing surface as the distance would vary in accordance with the curvature.

We are not convinced by Appellants' arguments for the following reasons.

First, Appellants' specification does not provide a specific description, e.g., measurements, for defining the term "substantially." Hence, we turn to the ordinary meaning of this word. As stated by the Examiner on page 5 of the Answer, the word "substantially" encompasses a relatively wide ranges of values. *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). In this light, referring to Figure 2 of Flaughner, heating elements 70 are disposed to substantially follow the contoured shape of the pressing surface to maintain a substantially constant distance from the pressing surface of the male mold. We see no difference between that depicted in Figure 2 of Flaughner and that claimed in the last paragraph of Appellants' claim 1, in light of the claim interpretation discussed herein.

Second, we agree with the Examiner's findings that the figures in Flaughner depict a curvature along the longitudinal axis and transverse axis. For example, both drawings of Figure 3 depict such a feature. We do note that the C.C.P.A. has recognized a subtle distinction between a written description adequate to *support* a claim under §112 and a written description sufficient to *anticipate* its subject matter under §102(b). The difference between "claim-supporting disclosures" and "claim-anticipating disclosures"

is discussed in *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971). The facts in the instant case differ from *In re Lukach* in that the facts before us support *both* (1) our determination that Flaughner's written description (e.g., the figures) anticipates Appellants' claims, and (2) our determination made, *supra*, regarding the reversal of the 35 U.S.C. § 112, ¶ 1 (written description) rejection.

In view of the above, we therefore affirm the 35 U.S.C. § 102(b) rejection of claims 1, 2, 5 through 8, 11 and 12.

III. *The 35 U.S.C. § 103 Rejections*

The 35 U.S.C. § 103 rejection of claims 3 and 9 as being unpatentable over Flaughner in view of Pickard and the 35 U.S.C. § 103 rejection of claims 4 and 5 as being unpatentable over Flaughner in view of Woodward are also affirmed for the reasons discussed above. That is, we note that Appellants only separately argue claim 1. For example, on page 16 of the Brief, Appellants state that claims 3 and 9 depend from what are believed to be allowable base claims and are therefore allowable. Likewise, on page 17 of the Brief, Appellants state that claims 4 and 10 depend from what are believed to be allowable base claims.

We therefore also affirm each of these obviousness rejections.

IV. *Conclusion*

The 35 U.S.C. § 112, ¶ 1 (written description) rejection of claims 1 through 12 is reversed.

The 35 U.S.C. § 102(b) rejection of claims 1, 2, 5 through 8, 11 and 12 as being anticipated by Flaughner is affirmed.

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The 35 U.S.C. § 103 rejection of claims 3 and 9 as being unpatentable over Flaucher in view of Pickard is affirmed.

The 35 U.S.C. § 103 rejection of claims 4 and 10 as being unpatentable over Flaucher in view of Woodward is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(iv)(effective Sept. 13, 2004).

AFFIRMED

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BAF/hh