

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PAUL C. BERG, HARRY N. ETTERS, ROBERT M. FUERST,  
TODD A. HESTER and FRED LOVE KREHBIEL

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Appeal No. 2001-1572  
Application 08/939,569

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ON BRIEF

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Before JERRY SMITH, DIXON and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 2, 4-9, 11-14 and 16-19, which constitute all the claims remaining in the application.

The disclosed invention pertains to a system for mounting electrical terminals, such as terminal pins, in a flat flexible substrate or flexible circuit.



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OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to

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modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this

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decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

With respect to each of the independent claims on appeal, the examiner finds that Scholz teaches the claimed invention except for the specific thickness of the substrate. The examiner finds that it would have been obvious to modify the substrate of Scholz by employing a thickness less than 0.050 inches because it would only have involved a change in size [answer, pages 3-4].

Appellants argue that Scholz relates to a rigid circuit board with plated-through holes rather than a flexible substrate as claimed. Appellants note that the interface created between a rigid circuit board and a pin is substantially different from that of a flexible circuit and a pin and requires the consideration of completely different technologies. Appellants argue that the rigid circuit structure of Scholz does not support the examiner's findings with respect to the claimed flexible circuit structure [brief, pages 5-9].

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The examiner responds that Scholz does not disclose whether circuit board 12 is rigid or flexible. The examiner notes that the term "flexible" is a relative term, and that any material is flexible if enough pressure is applied to it. Therefore, the examiner finds that the substrate of Scholz is flexible if enough pressure is applied. The examiner also notes that a change in size is generally deemed to be an obvious modification of the prior art [answer, pages 5-6].

We do not sustain the examiner's rejection of independent claims 1, 9 and 14 for the reasons argued by appellants in the brief. The examiner's position that Scholz teaches a flexible dielectric substrate is not supported by the disclosure of Scholz. Although Scholz does not state whether the substrate 12 is rigid or flexible, all the connections disclosed in Scholz lead to the conclusion that the substrate is rigid as argued by appellants. There is no suggestion within the disclosure of Scholz that the substrate 12 is or should be made of a flexible material. The examiner's position that any substrate is flexible if enough force is applied to it is not supported on this record and is not a reasonable interpretation of the term "flexible." As noted by appellants, it is the flexible nature of the substrate which gives rise to the electrical and mechanical

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interface which has the properties recited in the last clause of the independent claims on appeal.

The examiner is also incorrect in relying on a per se rule of obviousness that a change in size is not patentable. The examiner should consider the specific recitations of a claim and provide an evidentiary basis which supports the position that the specific recited size would have been obvious over the applied evidence. The examiner cannot simply find obviousness and seek to shift the burden to appellants to show secondary considerations of non-obviousness.

Since we do not sustain the rejection of any of the independent claims on appeal, we also do not sustain the rejection of any of the remaining claims which depend therefrom. We note for the record, however, that the examiner's reliance on what is deemed well known in the art in rejecting the dependent claims on appeal is insufficient to establish a prima facie case of obviousness.

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In conclusion, we have not sustained the examiner's rejection of any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 2, 4-9, 11-14 and 16-19 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	
	)	
JOSEPH L. DIXON	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

JS/ki

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