

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2005-0255
Application No. 10/190,475

ON BRIEF

Before McQUADE, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13, 14 and 16 to 21, which are all of the claims pending in this application.¹

We AFFIRM.

¹ Claim 13 was amended subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to a method of establishing an electrical connection between at least one connecting piece of a workpiece and at least one conductor or wire, to an apparatus for carrying out the method and to a contact piece for attachment to the end of the wire (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Travis	3,777,302	Dec. 4, 1973
Swengel, Jr. et al. (Swengel)	4,298,243	Nov. 3, 1981

Claims 13, 14, 16 and 18 to 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Swengel.

Claims 17 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Swengel in view of Travis.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer

(mailed May 7, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed March 11, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We sustain the rejection of claims 13, 14, 16 and 18 to 20 under 35 U.S.C. § 102(b) as being anticipated by Swengel.

Anticipation under 35 U.S.C. § 102(b) requires that each and every element as set forth in the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence must make clear that the missing descriptive

matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Claim 13 reads as follows:

A contact piece comprising a first portion (3) for establishing a connection to a wire (6) and a second portion (5) which is bent in a sleeve-like manner so that it can be plugged onto a connecting piece (9) wherein the end of the bent portion of the second portion (5) is not fixed to the opposite part of the second portion (5), neither when the first portion (3) is connected to a wire (6), and wherein the first portion (3) is connected to the second portion (5) via a flexible web (7) so that the second portion (5) can be bent perpendicularly to its center axis out of the line of alignment with the wire (6).

Swengel's invention relates to flag-type pre-insulated terminal devices for the type which are intended for crimping onto the end of an insulated wire to produce a fully insulated termination of the wire end. Figure 3 is a plan view of a sheet metal blank from which a terminal 6 is formed. Terminals in accordance with Swengel's invention are produced by stamping and forming of a continuous strip so that each terminal is integral with a continuous carrier strip 3 and connected thereto by means of a connecting section 5, as shown in Figure 3. Figure 2 is a perspective view of a housing

8 having the terminal 6 exploded therefrom. Figure 1 is a perspective view of a pre-insulated flag-type terminal device 2 with a wire 4 crimped thereto.

Swengel's terminal 6 comprises a contact receptacle portion 10, a flat transition portion 12, and a crimp portion 14 in the form of a tubular ferrule which is at the opposite end of the terminal from the end of the contact portion. The contact portion 12 comprises a web 16 having sidewalls 18 extending from its marginal side portions. These sidewalls are curled inwardly towards each other and towards the surface of the web so that the edges 20 of the sidewalls are spaced from the surface of the web. Slots 22 extend transversely across the web and the section of the web material between these slots is upwardly formed to provide a contact spring. Contact receptacles of this type are commonly used and are dimensioned to receive a flat tab-type terminal which is inserted into the outer end 15 and moved into the gap between the web and the edges 20.

Swengel's centrally located flat transition section 12 and the tubular ferrule 14 are formed from an arm 40 (see Figure 3) having side edges 32', 34'. A rectangular opening 28' is provided in this arm which extends (see Figure 6) up to the ferrule portion of the terminal. This opening has a transversely extending edge 30' and the opening receives a projecting ear 42 extending from the end of the arm 40 so that the ferrule has

a seam, as shown in Figure 6, at the end of the opening 28. The portions 44, 38 on the end of the arm 40 are disposed against the surface of the transition section 12 on each side of the opening 28 so that the ferrule extends the full width of the terminal as is apparent from Figure 4.

The appellant argues (brief, pp. 4-5) that:

In Applicants' invention, the sleeve of the contact piece is not closed, i.e. the end of the bent portion is not fixed to the opposite portion and the open sleeve enables the contact piece to fit different shapes and forms and the flexible web of Applicants' invention permits easy bending of the first portion with respect to the second portion with the advantages set forth in the second paragraph on 7 of the application as filed and these advantages are in no way taught by the Swengel et al patent.

As pointed out in the second paragraph on page 6 of the application, Applicants' construction has a first portion 3 and a second portion 5, which two portions are connected by a connecting web 7. This connecting web permits the bending of the second portion 5 relative to the first portion 3 through up to 90° opposite to the opening direction of the U-shaped first portion 3. As pointed out in the paragraph bridging pages 10 and 11, angling of the second portion with respect to the first portion is infinitely effected with ease, and this is not possible with the connection portion 12 of Swengel et al. The flat transition portion 12 of Swengel et al is not "inherently flexible" and, therefore, is not capable of performing Applicants' easy bending of the second portion with respect to the first portion so as to form an angle. Therefore, Swengel et al does not anticipate Applicants' invention.

In our view, claim 13 is met by Swengel. In that regard, claim 13 is readable on Swengel's terminal 6 as follows:

A contact piece (Swengel's terminal 6) comprising a first portion (Swengel's crimp portion 14 in the form of a tubular ferrule) for establishing a connection to a wire (4) and a second portion (Swengel's contact receptacle portion 10) which is bent in a sleeve-like manner so that it can be plugged onto a connecting piece wherein the end of the bent portion of the second portion is not fixed to the opposite part of the second portion, neither when the first portion is connected to a wire, and wherein the first portion is connected to the second portion via a flexible web (Swengel's flat transition portion 12) so that the second portion can be bent perpendicularly to its center axis out of the line of alignment with the wire.

We find the appellant's specific arguments for patentability of claim 13 unpersuasive for the reasons that follow. First, like in the appellant's invention, the sleeve of Swengel's contact receptacle portion 10 is not closed, i.e., the end of the bent portion is not fixed to the opposite portion and the open sleeve enables the contact receptacle portion to fit different shapes and forms. Second, the claimed "flexible web" which permits the second portion to be bent perpendicularly to its center axis out of the line of alignment with the wire is readable on the flat transition portion 12 of Swengel's terminal 6 for the reasons set forth by the examiner on page 5 of the answer.

As taught by Swengel, his contact receptacle portion 10 and crimp portion 14 in the form of a tubular ferrule are formed by stamping a sheet metal blank. Thus, it is inherent that the metal blank has sufficient flexibility to form the contact receptacle portion 10 and the crimp portion 14 from the sheet metal blank. As such, the flat transition portion 12 of Swengel's terminal which connects the contact receptacle portion 10 and crimp portion 14 would also inherently possess the same flexibility. Given the fact that portions of the sheet metal blank have sufficient flexibility to bend into the shape of both contact receptacle portion 10 and the crimp portion, we find that this extrinsic evidence makes clear that the missing descriptive matter (i.e., the claimed "flexible web" which permits the second portion to be bent perpendicularly to its center axis out of the line of alignment with the wire) is necessarily present in Swengel's terminal 6, and that it would be so recognized by persons of ordinary skill.

For the reasons set forth above, the decision of the examiner to reject claim 13 under 35 U.S.C. § 102(b) is affirmed.

The appellant has grouped claims 13, 14, 16 and 18 to 20 as standing or falling together.² Thereby, claims 14, 16 and 18 to 20 fall with claim 13. Thus, it follows that

² See page 4 of the appellant's brief.

the decision of the examiner to reject claims 14, 16 and 18 to 20 under 35 U.S.C. § 102(b) is also affirmed.

The obviousness rejection

Claims 17 and 21 which depend from claim 13 have not been separately argued by the appellant. Accordingly, we have determined that these claims must be treated as falling with their respective independent claim. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). Thus, it follows that the decision of the examiner to reject claims 17 and 21 under 35 U.S.C. § 103 as being unpatentable over Swengel in view of Travis is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 13, 14, 16 and 18 to 20 under 35 U.S.C. § 102(b) is affirmed and the decision of the examiner to reject claims 17 and 21 under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 2005-0255
Application No. 10/190,475

Page 11

CHARLES A. MUSERLIAN
C/O BIERMAN, MUSERLIAN AND LUCAS
600 THIRD AVENUE
NEW YORK, NY 10016

JVN/jg