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Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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GEORGE PREPUTNICK, JAMES LEE FEDDER,
SCOTT K. MICKIEVICZ and RICHARD N. WHYNE

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Junior Party
(Patent No. 5,795,191)¹,

v.

DANIEL B. PROVENCHER, and
PHILIP T. STOKOE,

Senior Party
(Application 09/225,439)²

Patent Interference No. 104,693

Before LEE, TORCZON and SPIEGEL, Administrative Patent Judges.

LEE, Administrative Patent Judge.

MEMORANDUM OPINION AND JUDGMENT

¹ Based on Application 08/882,795, filed June 26, 1997. Accorded the benefit of Application 08/714,024, filed September 11, 1996. The real party in interest is Tyco International, Ltd.

² Filed January 5, 1999. The real party in interest is Teradyne, Inc.

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Introduction

Junior party Preputnick's preliminary statement does not allege a date of invention prior to senior party Provencher's accorded benefit date and junior party has not attacked senior party's accorded benefit date. Thus, Provencher's preliminary motions are moot and judgment as to the subject matter of the count will be entered against Preputnick.

Preputnick, however, has filed three preliminary motions, each alleging unpatentability of all Provencher claims corresponding to the count. We exercise our discretion to take up these preliminary motions despite the absence of dispute on priority.

Because all of Provencher's claims corresponding to the count are unpatentable over prior art, judgment as to the subject matter of the count will also be entered against Provencher.

Findings of Fact

1. This interference was declared on April 30, 2001.
2. Junior party Preputnick is involved on the basis of its Patent No. 5,795,191, based on application 08/882,795, filed on June 26, 1997.
3. Senior party Provencher is involved on the basis of its application 09/225,439, filed January 5, 1999.

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4. There is only one count in this interference, Count 1; it reads as follows:

Claim 17 of Application 09/225,439
or
Claim 12 of Patent No. 5,795,191

5. Junior party Preputnick's claims 9-14 were designated as corresponding to Count 1 and senior party Provencher's claims 17-19 were designated as corresponding to Count 1.

6. Junior party Preputnick was accorded the benefit of application 08/714,024, filed September 11, 1996.

7. Senior party Provencher was accorded the benefit of application 08/977,285, filed November 24, 1997, now Patent No. 5,860,816, issued January 19, 1999, and application 08/623,582, filed March 28, 1996, now Patent No. 5,702,258, issued December 30, 1997.

8. Junior party Preputnick's real party in interest is Tyco International, Ltd.

9. Senior party Provencher's real party in interest is Teradyne, Inc.

10. The subject matter of Count 1 relates to an electrical connector assembly and a method for making an electrical connector terminal module.

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11. Junior party Preputnick filed preliminary motions 1, 2 and 3: (1) Preliminary Motion 1 alleging that senior party Provencher's claims 17-19 are unpatentable under 35 U.S.C. § 102(b) for anticipation by Japanese Utility Model Application 6-88065 (Hashiguchi); (2) Preliminary Motion 2 alleging that senior party Provencher's claims 17-19 are unpatentable under 35 U.S.C. § 103 over various combinations of prior art references; and (3) Preliminary Motion 3 alleging that senior party's claims 17-19 are unpatentable under 35 U.S.C. § 112, first paragraph, as lacking written description in the specification.

12. Junior party Preputnick has not filed any preliminary motion to attack the benefit accorded senior party Provencher at the commencement of this interference.

13. Senior party Provencher filed preliminary motions 1 and 2: (1) Preliminary Motion 1 attacking the benefit accorded junior party's involved patent; and (2) Preliminary Motion 2 alleging that junior party Preputnick's claims 12-14 are unpatentable under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,702,258, and that junior party Preputnick's claims 9-11 are unpatentable under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,702,258 in view of U.S. Patent Nos. 4,705,332 and 5,224,867.

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14. Junior party Preputnick filed no opposition or any other response to Senior party Provencher's preliminary motions 1 and 2.

15. Junior party Preputnick's preliminary statement states that the invention of the count was conceived as early as June 10, 1996.

16. Junior party Preputnick's alleged date of conception is subsequent to the accorded benefit date of senior party Provencher.

17. On page 8, lines 3-5 of Provencher's specification, it is stated: "The same contacts 410A . . . 410F can be used to make [e]ither wafers 112 or 114. The only difference is in the housing molded around the contacts." That means each physical set of contacts 410A - 410F can be used to make either, not both, wafers 112 and 114.

18. The level of ordinary skill in the art with respect to the subject matter of the count is represented by that comparable to a Bachelor degree in electrical engineering, mechanical engineering, or physics, and 3 to 8 years of actual experience in developing electrical connectors.

19. Provencher's claim 17 includes the step of: "securing said first and second half-modules together by engaging complementary fastening portions to define said terminal module."

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20. Hashiguchi does not disclose complementary fastening portions on its modules 1 and 2 which engage each other to secure the modules together. See explanation in the discussion section of this opinion.

21. Provencher's specification describes the following features of Provencher's claim 17 (see explanation in the discussion section of this opinion):

providing a first lead frame having said first contacts;

providing a second lead frame having said second contacts;

overmolding said intermediate portions of said first contacts in said first lead frame with insulating material,

overmolding said intermediate portions of said second contacts in said second lead frame with insulating material;

22. Hashiguchi's disclosure does not "teach away" from having complementary fastening portions on its modules 1 and 2 which act to engage each other to secure the modules together. See explanation in the discussion section of this opinion.

23. U.S. Patent No. 5,171,161 ("the Kachlic patent") discloses complementary fastening portions on contiguous modules, which act to engage each other to secure the modules together. See explanation in the discussion section of this opinion.

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24. The placement of a conduction ground shield along one side of a terminal module to define a shielded terminal module was well known to one of ordinary skill in the art by March 1995. See ¶ 22 of the Granitz declaration.

Discussion

A. Preputnick's Preliminary Motion 3

By this preliminary motion, Preputnick seeks to have all of Provencher's claims corresponding to the count, claims 17-19, held unpatentable under 35 U.S.C. § 112, first paragraph, as lacking written description in the specification.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). One shows that one is "in possession" of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

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Preputnick argues that Provencher's specification does not describe "a plurality of first and second contacts" as is recited in Provencher's independent claim 17. Preputnick takes that position despite the fact that Provencher's specification discloses a plurality of contacts that is molded in its intermediate portion one way to form a first half-module and another plurality of contacts that is molded in its intermediate portion a different way to form a second half-module. Preputnick's reasoning is that because the one set of plurality of contacts used to make the first half-module is identical in structure in every respect to the other set of plurality of contacts used to make the second half-module, the two sets of plurality of contacts cannot be regarded as "first and second" contacts. According to Preputnick, the first and second contacts cannot, by their own terms, be identical in structure to each other.

We reject Preputnick's argument.

Provencher does not assert that its specification sets forth a special definition for any term. Therefore, we read its disclosure and claims according to the ordinary meaning and usage of words in the English language. During proceedings before the USPTO, claims are properly construed according to their broadest reasonable interpretation consistent with the specification. In

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re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); see also In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Pearson, 494 F.2d 1399, 1404, 181 USPQ 641, 645 (CCPA 1974); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Note the following passage in In re Priest, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978):

It is clear that the board did not consider the claimed invention to be allowable, but instead found some other non-claimed invention containing "inferential limitations" to comply with the statute. . . .

* * *

Thus, the board was in error when it added an "inferential limitation" to the claims. That error requires corrective action by this court.

What Preputnick would have us do is to add the qualifier "type of" or "kind of" between the words "first and second" and the word "contacts" to arrive at the reformed term -- first and second **type of** contacts --, or -- first and second **kind of** contacts --. The evidence in the record does not support such a contortion of the English language. Preputnick's contention not only does not reflect the broadest reasonable interpretation of the claim term "first and second contacts" but urges an interpretation that is patently unreasonable.

Preputnick refers to U.S. Patent No. 5,174,770 ("the Sasaki patent") as illustrating real or genuine "first and second

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contacts" inasmuch as the first contacts in the Sasaki patent are of a different configuration as the second contacts in the Sasaki patent. But the fact that the first and second contacts in the Sasaki patent are different in configuration does not mean that all first and second contacts, wherever found, must always have different structure and configuration. The gap in logic is huge. The fact that the two cars of A's family are of different make and model does not mean the two cars of B's family must also be different from each other.

If Provencher wanted to limit its claims so that the first and second contacts are of different type, it easily could have added the word "type" or "kind" to the claim. If it does not want to so limit its claim, then it validly would not add the limiting term "type" or "kind." If Preputnick's view is adopted, Provencher would have to add to its claim 17 the lengthy narrative "said first and second contacts may or may not have the same structure and configuration" to set forth a broader scope. That is both unreasonable and unnecessary. Merely stating "first and second contacts" does the job.

Preputnick's motion cites to Paragraph 37 of the declaration of Richard F. Granitz for support. That paragraph of the declaration states as follows:

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37. According to Provencher, the first and second contacts are defined by the configuration of the overmolded plastic web formed about the contacts and not by the provision of two different types of contacts. This definition is contrary to the understanding of one of ordinary skill in the art. An ordinarily skilled artisan would understand "first contacts" and "second contacts" by the configuration of the contacts and not the overmolded plastic web that surrounds the lead frame. An example of this common understanding by those of ordinary skill in the art is the Sasaki '770 patent, which discloses signal contact blocks 11 and grounding contact blocks 12 that one of ordinary skill in the art would consider half-modules, inasmuch as the teaching of this patent is to combining blocks 11 and 12 side by side to reduce cross-talk, and the contacts of block 11 are clearly of a different configuration from the second contacts of block 12. Similarly, an ordinarily skilled artisan would understand "first lead frame" and "second lead frame" to denote a difference in shape or construction between lead frames. (Preputnick Exhibit 2030, Sasaki '770 patent, col. 4, ll. 3-26, 40-59, Figs. 3C, 4-6C).

Mr. Granitz states his opinion in a conclusory manner, that "[a]n ordinary skilled artisan would understand 'first contacts' and 'second contacts' by the configuration of the contacts and not the overmolded plastic web that surrounds the lead frame." The reference to U.S. Patent No. 5,174,770, as an example does not support that conclusion. That there are first contacts which are different in structure or configuration from second contacts does not mean there can be no first contacts which are identical in structure with second contacts. Mr. Granitz does not explain why one with ordinary skill in the art would necessarily assume that first contacts are different in structure and configuration

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from second contacts and not recognize a generic term when no special condition or qualification is recited.

Mr. Granitz does not explain why where the contacts are all identical in structure one with ordinary skill in the art would not accept or comprehend that if certain ones are labeled, marked, or tagged in some way as Group 1, and the rest are labeled, marked, or tagged in some way as Group 2, then there are two groups of contacts, i.e., a plurality of first and second contacts, even though all contacts are identical in structure. Merely stating an opinion in a conclusory manner, without revealing the underlying basis for that opinion, and where the opinion is on its face illogical, Mr. Granitz has not provided meaningful support for Preputnick's argument. We do not credit the conclusory testimony Mr. Granitz with any meaningful weight. Note that paragraph no. 42 of the Standing Order attached to the Notice Declaring Interference states:

§ 42 Affidavits of expert witness

Affidavits expressing an opinion of an expert must disclose the underlying facts or data upon which the opinion is based. See Fed. R. Evid. 705 and 37 CFR §§ 1.639(b) and 1.671(b).

Opinions expressed without disclosing the underlying facts or data may be given little, or no, weight. See Rohm and Haas Co. v. Brotech Corp., 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462 (Fed. Cir. 1997) (nothing in the Federal Rules of Evidence or Federal Circuit jurisprudence requires the fact finder to

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credit the unsupported assertions of an expert witness).

We credit more the testimony of Mr. John L. Grant who states (Exhibit 1015 at 12): "To one of ordinary skill in the art, having differentiating characteristics is certainly a sufficient condition for characterizing two similar items as 'first' and 'second', however, it is not a necessary condition." Mr. Grant refers to front and rear tires as an example. Front and rear tires can certainly be referenced as first tires and second tires, even though all tires may have identical structure. Thus, as in ordinary use of the English language, location as well as any other kind of label, marking, or tag, may serve to differentiate a first set of an item from a second set of the same item. As Mr. Grant further states with regard to the contacts disclosed in Provencher's involved application (Exhibit 1015, at 13): "These two sets of contacts have the **same** size, shape, and dimensions, but they are still two complete separate sets of contacts (Emphasis in original)."

As is pointed out by Provencher, a plurality of first and second contacts are illustrated on the half-modules 112 and 114 by first and second columns of contact elements in Fig. 1 of Provencher's involved application. Also, first contacts are illustrated in Figure 4B and second contacts are illustrated in Figure 4C, each surrounded by a different style of overmolding.

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For the foregoing reasons, we reject Preputnick's argument that Provencher's specification does not have written description for a plurality of first and second contacts.

Preputnick further argues that Provencher's specification does not describe the claim feature of "providing a second lead frame having said second contacts." Preputnick cites to the following disclosure of Provencher as providing just the opposite (Emphasis in original quotation by Preputnick) (at 8, lines 3-5):

FIG. 4C shows a similar molding operation for wafer 112. The same contacts 410A . . . 410F can be used to make wither [sic, either] wafers 112 or 114. The only difference is in the housing molded around the contacts (Preputnick Ex. 2003, '285 application, p.8, ll. 3-5) (Emphasis added).

Also, Preputnick relies on Paragraph No. 41 of Mr. Granitz' declaration which states, in pertinent part:

Here too, Provencher attempts to find **two different types** of lead frames by pointing to the differences of the overmolded plastic and not to a difference in the lead frame. This disclosure, however, would not have reasonably conveyed to one of ordinary skill in the art the use of "a second lead frame having said second contacts" as required by Provencher claim 17. To the contrary, an ordinarily skilled artisan would understand that this disclosure teaches that only one lead frame having a plurality of contacts is used to make both wafers 112 and 114, as expressly stated above [page 8 of Provencher's specification, lines 3-5]. (Emphasis added.)

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This is essentially the same argument as that presented by Preputnick with respect to the rejected argument that Provencher's specification does not describe first and second contacts, only applied to first and second lead frames, and is no more persuasive than that argument for the same reasons we have discussed. Preputnick would have us read into Provencher's claim 17 the limiting term "type of" so that the reference to "first lead frame" becomes -- first type of lead frame --, and the reference to "second lead frame" becomes -- second type of lead frame --. We decline. There is no basis for such contortion of the English language. The references in Provencher's claim 17 to a first lead frame and a second lead frame do not require that the first and second lead frame be different in structure or configuration. Preputnick's position is contrary to the ordinary meaning and usage in the English language. Mr. Granitz makes a contrary statement in his declaration but his statement is conclusory. Mr. Granitz does not explain why where two lead frames are identical in structure one with ordinary skill in the art would not accept or comprehend that if one of them is labeled, marked, or tagged in some way as a first lead frame, and the other is labeled, marked, or tagged in a different way as a second lead frame, then there is a first lead frame and a second lead frame. Mr. Granitz does not explain why one with ordinary

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skill in the art would assume that a references to a first lead frame and to a second lead frame necessarily means that the two lead frames do not have the same structure or configuration. To the same extent that we do not credit Mr. Granitz's testimony with regard to first and second contacts, we do not credit his testimony with regard to a first and a second lead frame.

The way Preputnick has presented its argument has caused confusion that made the job of its opposing counsel as well as this panel more difficult than it needed to be. In connection with its argument that the reference to first and second lead frame must mean different types of lead frame, Preputnick dropped the word "type" in immediate subsequent discussion on page 12 of its motion, leading to this statement (page 12, lines 8-9): "However, the Provencher applications disclose that the same blank is used to make each of the two half modules. (Fact 4(d))." Despite what it appears to say, the reference to "same blank" does not mean the same actual physical blank, but an identical version of the same blank. Note that the last sentence in Fact 4(d) cited by Preputnick reads: "The blanks used to make wafers (112, 114) are identical as shown in Figures 2, 3 and 4 (citations omitted)."

The same confusion is generated by Paragraph No. 41 of the declaration of Mr. Grantiz, wherein first he refers to a requirement for "two different types of lead

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frames" and in two sentences thereafter while providing a contrast, drops the word "type" and states that only one lead frame having a plurality of contacts is used to make both wafers 112 and 114. To whatever extent Preputnick might be arguing that the same actual and physical piece of blank or lead frame is used to make both half modules 112 and 114, the argument is rejected for failing to provide sufficient proof.

The portion of Provencher's specification cited by Mr. Granitz, page 8, lines 3-5, actually indicates two different molding operations, one for wafer 112 and one for wafer 114 and that the same material can be used to make "either" wafer 112 or 114, not both at once. Moreover, Provencher's Figure 4B illustrates the lead frame immediately surrounding wafers 114 and Figure 4C illustrates the lead frame immediately surrounding wafers 112. The illustrated frame portions are not the same physical components. In Provencher's brief description of the drawings, it is stated:

FIG.4B illustrates the molding around **the blank of FIG. 4A** used to form a wafer as illustrated in FIG. 3;

FIG. 4C illustrates the molding around **the blank of FIG. 4A** used to form a wafer as illustrated a wafer as illustrated in FIG. 2; (Emphasis added.)

That description is consistent with the description in Provencher's specification that the same blank is used to make

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either wafers 112 and 114 and does not support any argument that the same physical blank is used to make both wafers 112 and 114.

For the foregoing reasons, we reject Preputnick's argument that Provencher's involved specification does not describe providing a first lead frame and also providing a second lead frame.

Finally, Preputnick argues that Provencher's specification does not describe the claimed overmolding step performed on second contacts in the second lead frame. This argument is dependent on Preputnick's two arguments already rejected above. Preputnick's notion is that because Provencher's specification does not describe second contacts or a second lead frame having the second contacts, there is no description for an overmolding step which overmold the intermediate portions of the second contacts on the second lead frame. We have rejected Preputnick's two underlying arguments and we have also already rejected Preputnick's assertion that in Provencher's specification the same physical blank is used to make both wafers. Accordingly, the argument about there being no description for overmolding second contacts on the second lead frame is without merit.

Preputnick's preliminary motion 3 alleging that Provencher's claims 17-19 are unpatentable under 35 U.S.C. § 112, first

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paragraph, for lack of written description in the specification .
is denied.

B. Preputnick's Preliminary Motion 1

By this preliminary motion, Preputnick seeks to have all of Provencher's claims corresponding to the count, claims 17-19, held unpatentable under 35 U.S.C. § 102 as being anticipated by Japanese Utility Model Application 6-88065 (Hashiguchi).

Exhibit 2009 is a copy of Hashiguchi. Exhibit 2010 is an English translation of Hashiguchi, provided by Preputnick. Hereinafter, our references to Hashiguchi are intended as references to Exhibit 2010 except as otherwise indicated.

To establish anticipation under 35 U.S.C. § 102, each and every element in a claim, arranged as is recited in the claim, must be found in a single prior art reference. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Glaxo, Inc. v. Novopharm, Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995).

On the issue of anticipation, only one feature of Provencher's independent claim 17 is in dispute, i.e., the step of "securing said first and second half-modules together by engaging complementary fastening portions to define said terminal module." The key to resolving this issue lies in the question -- does the claim feature require that something on the first half-

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module and something on the second half-module be complementary to and engage each other. In our view, it does.

Note that the recitation of the feature uses the term "portions." Nothing has been defined in claim 17 to which a fastening means can reasonably be deemed as a portion, except the first and the second half-module. It makes no sense for "portions" to refer to something that is not yet defined, and the closest items in the claim to the term "fastening portions" in the recitation are the first and second half-modules. Indeed, "said first and second half-modules" is a part of the same recitation and is separated from "engaging complementary fastening portions" by only two words. The sentence structure of the recitation, according to ordinary English, is that the term "fastening portions" modifies "first and second half-modules." Provencher's specification also does not provide any basis to say that the fastening portions are not a part of the first and second half-modules. Thus, in this circumstance, the only reasonable interpretation is that the fastening portions are located on the first and second half-modules. Additionally, the requirement that the fastening portions are complementary and engaged for securing the first and second half-modules together means there is direct engagement between the fastening portions. If there is no direct engagement between fastening portions, the

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characterization of the fastening portions as being "complementary" makes little sense. Note that the word "complementary" is located immediately next to the word "engaging" in the feature at issue, which also leads us to conclude that the complementary portions engage each other.

Preputnick argues (Motion at 13):

Hashiguchi teaches that the first and second half-modules are inserted in a mutually superposed state into a housing. Thus, the two half-modules are combined to form a module and are inserted, as a module, into the housing. (Fact 4(e)). Once the combined half-modules are inserted into the housing, the forked pieces on each half-module engage a protrusion on the housing to secure the module within the housing 4. (Fact 4(f); Preputnick Ex. 2020, Decla. Granitz, para. 53, 54,). Thus, the two piece, modular connector taught by Hashiguchi inherently meets the securing limitation of claim 17 under the "principles of inherency." Verdegaal, *supra*, 814 F.2d at 631, 2 USPQ2d at 1053 (Fed. Cir. 1987).

The argument is without merit. The fact that modules 1 and 2 in Hashiguchi are inserted in a mutually superposed state does not mean that there is some fastening portion on module 1 and some fastening portion on module 2 which engage each other.

Hashiguchi does not describe anything that fastens the two modules together during the process of inserting them into the housing. The two parts may simply be pressed together.

On page 14 of its motion, Preputnick relies on Mr. Granitz' opinion that the complementary fastening portions feature is

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necessarily shown in Hashiguchi. However, Mr. Granitz's opinion is evidently based on the mistaken assumption that the fastening portions on the first and second half-modules need not directly engage each other. Note Paragraph No. 54 of Mr. Granitz's declaration which is reproduced below:

54. It is my opinion that the Hashiguchi 6-88065 application inherently discloses to one of ordinary skill in the art the step of "securing the first and second half-modules together by engaging complementary fastening portions" required by Provencher claim 17. As seen in figures 1-3, 5(a) and 6(a), it discloses that first and second half-modules 1, 2 comprise forked pieces 15 and 25, which engage protruding part 41 of connector housing 4 (Preputnick Exhibit Nos. 2009 and 2010, Hashiguchi 6-88065, p.8, para. 14, ll. 1-10; p.9, para. 20, ll. 1-5). An ordinary skilled artisan would recognize that the forked pieces 15, 25 are complementary in that they align with one another when the half-modules 1 and 2 are paired together to thereby form a channel that is engaged by protruding portions 41 of housing 4 to define terminal modules.

It is not enough that each half-module contains a fastening portion which engages the same member 41 on a housing 4. The fastening portions of Hashiguchi do not directly engage each other and do not have a structure dependent on that of each other. Rather, they engage an element on the housing and have a structure complementary to that of the element on the housing. Mr. Grant, the technical expert of Provencher also recognizes that Hashiguchi teaches securing each of modules 1 and 2 to the housing but not directly to each other. (Exhibit 1015, ¶ 14).

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We find that Hashiguchi's modules 1 and 2 are each attached to the housing 4 in a mutually aligned manner but are not directly fastened to each other.

In its reply, Preputnick asserts that one with ordinary skill in the art would have understood that "the first and second half modules **could be** secured together either to each other directly or via the housing. (Emphasis added)." But the ground of unpatentability alleged in this preliminary motion is anticipation, not obviousness. Preputnick provides no citation to any portion of Hashiguchi which discloses an alternative embodiment in which modules 1 and 2 are secured directly to each other rather than separately to a common housing element.

For the foregoing reasons, Hashiguchi does not anticipate Provencher's claim 17. Furthermore, according to Preputnick, Provencher's claims 18 and 19 each includes the securing step feature of claim 17. Consequently, it has not been shown that Hashiguchi anticipates Provencher's claims 18 and 19.

Preputnick's preliminary motion 1 is denied.

C. Preputnick's Preliminary Motion 2

By its preliminary motion 2, Preputnick asserts that all of Provencher's claims corresponding to the count, claims 17-19, are unpatentable under 35 U.S.C. § 103 for obviousness over prior art. According to ¶ 26 in the Standing Order issued together

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with the Notice Declaring Interference, a motion shall begin with a section setting forth the precise relief requested. In Preputnick's statement of the precise relief requested, no less than five, six if the connector "and/or" is counted as setting forth two grounds, grounds of alleged unpatentability are listed, one of which is hopelessly ambiguous -- "obvious in view of the same in combination with" ³ (Emphasis added.)

It appears that the grounds of unpatentability are divided into two groups, one based on Hashiguchi as a primary reference, and one based on any one of three catalogues collectively referred to as AMPMODU catalogues as a primary reference. With this understanding, we proceed, but not without further frustration. One of the grounds of unpatentability relying on Hashiguchi as the primary reference also relies on U.S. Patent No. 4,729,727, referred to by Preputnick only as the '727 patent. This reference, however, has not been furnished as an exhibit, and does not appear to have been discussed with meaningful specificity in Preputnik's motion with a citation to column and line numbers. When we obtained a copy of this patent from the database of the USPTO, we see that it is directed to a gear pump, and evidently has nothing to do with electrical connectors.

³ Six prior art references have been previously noted in the same paragraph.

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Preputnick might have meant U.S. Patent No. 4,729,744 (Exhibit 2017), but we are not reasonably certain. U.S. Patent No. 4,846,727 is also listed as evidence relied upon by Preputnik. Both patent numbers substantially overlap "4,729,727."

Furthermore, Preputnick mis-identified U.S. Patent No. 4,729,744 as being issued to Glover et al. when none of the named inventors in that patent is named Glover. U.S. Patent No. 4,846,727 (Exhibit 2016) is issued to Glover et al., but Preputnick mis-identified that exhibit as Patent No. 4,846,747 in the section of the motion entitled "Evidence Relied Upon" and also mis-identified it as a patent to Bet et al., the inventors of U.S. Patent No. 4,729,744. The situation is confusing.

Central to the conclusion of obviousness is a finding of differences between the claimed invention and the prior art reference on which the obviousness conclusion is based. See, Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). The question to be answered is whether despite such differences, the claimed invention as a whole still would have been obvious to one with ordinary skill in the art. The established differences serve as the focus of the obviousness analysis. If, in ex parte prosecution, an examiner rejects an applicant's claim for obviousness without first establishing and focusing on differences between the claimed invention and the

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applied reference, the rejection should be reversed on appeal. Likewise, when filing a motion attacking the patentability of an opponent's claim on the ground of obviousness, it is incumbent upon the moving party to establish differences between an attacked claim and the prior art reference being applied and to focus on such differences in discussing obviousness of the claimed invention.

Without a specific identification of differences, an examiner or a moving party frequently performs unfocused hand-waving about what a reference shows and then concludes that a certain claim would have been obvious. Such a presentation leaves much in doubt about whether the proper analysis under Graham v. John Deere for a determination of obviousness has been made. As an aid for moving parties to not forget their need to focus on differences between a prior art reference and the claim under attack, ¶ 26(e) in the Standing Order, in no uncertain terms, states with regard to preliminary motions attacking claims on the ground of obviousness:

Any difference [from each primary prior art reference] **shall be explicitly identified.**

We searched, in vain, through the entirety of Preputnick's preliminary motion 2, for any statement that reasonably can be viewed as setting forth what Hashiguchi does not disclose

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relative to Provencher's claims 17-19 or relative to what the three AMPMODU catalogues do not disclose relative to Provencher's claims 17-19. Preputnick's failure to explicitly identify differences between each Provencher claim under attack and Hashiguchi and between each Provencher claim under attack and any AMPMODU catalogue renders its preliminary motion 2 a bear to read and understand insofar as how the conclusion of obviousness is reached. Counsel for Provencher, at oral argument, expressed a similar sentiment.

Counting the AMPMODU catalogues as three different references, there are nine different references discussed in Preputnick's preliminary motion 2. With no differences explicitly identified, which Preputnick is required to do under ¶ 26 of the Standing Order, the preliminary motion presents an exhibition of hand-waving, which somehow leads to its obviousness conclusion.

Neither Provencher nor this panel should have to guess at what Preputnick regards as the difference between each Provencher claim and Hashiguchi or the difference between each Provencher claim and an AMPMODU catalogue. Neither Provencher nor this panel should have to interpret what difference Preputnick must have meant in its preliminary motion, because interpretations are prone to disagreement and uncertainties and the Standing Order

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expressly requires the moving party, in this case Preputnick, to explicitly identify the differences.

During oral argument on April 17, 2002, counsel for Preputnick was asked by the panel, repeatedly, to point out where in Preputnick's preliminary motion 2 is there an explicit identification of the differences between Provencher's claim 17 and the prior art references. The exchange between the panel and counsel for Preputnick lasted approximately ten to fifteen minutes, with counsel for Preputnick all the while insisting that there is in Preputnick's papers an explicit identification of the differences but also all the while unable to point to any such explicit identification.⁴ To each pointed question from the panel in this regard, counsel for Preputnick was consistently evasive by resorting to generalities. Counsel for Preputnick was advised that what we were asking about is not something from which Preputnick's intended differences might be interpreted, but an "explicit" statement identifying the differences.⁵ Still, counsel's evasiveness persisted, despite his inability to point to anything explicit in the preliminary motion.⁶

⁴ See transcript of oral argument from page 11, line 17 through page 23, line 12.

⁵ See transcript of oral argument at page 17, lines 8-15.

⁶ See transcript of oral argument at page 17, lines 16-21, from page 18, line 9 through page 19, line 7, and from page 20,

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When the panel instructed counsel for Preputnick to read for the court reporter whatever it is that he regards as an explicit statement identifying differences between Provencher's claim 17 and the prior art, counsel read, instead, what the Hashiguchi reference discloses rather than what it does not disclose.⁷ It was apparent that counsel for Preputnick had made up his mind that whatever it is that the Standing Order requires to be present in Preputnick's motion he will say is present, no matter how clearly contrary are the underlying facts. Such an attitude is deplorable. Having observed counsel's demeanor, we find that counsel's steadfast insistence on a fact so patently untrue and for which he can provide no support was not based on ignorance or inadvertence, but on specific intent to deny an omission or mistake regardless of the facts. Such conduct is sanctionable.

Denials without support do not persuade. All Preputnick's counsel managed to do is to add to the damage by losing his own credibility with this panel.

We dismiss Preputnik's preliminary motion 2, insofar as it is based on any of the AMPMODU catalogues as a primary reference, on two separate and independent grounds either of which would

line 17 through page 21, line 9.

⁷ See transcript of oral argument at page 17, lines 16-21, and from page 18, line 9 through page 19, line 7.

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support the dismissal: (1) the motion's procedurally failing to comply with the requirement of ¶ 26(e) of the Standing Order for such a motion to explicitly identify the differences between the claim under attack and the prior art reference being applied; and (2) as sanction for the persistent and wholly baseless assertions by Preputnick's counsel during oral argument that Preputnick's motion contains an explicit statement identifying the differences between Provencher's claim and the applied prior art reference.

We will, however, consider Preputnick's preliminary motion 2 insofar as it is based on Hashiguchi as a primary reference.

Despite the failure of its preliminary motion 2 to explicitly identify and focus on differences between Provencher's claims and Hashiguchi, Preputnick is saved by the unique posture in which we find this case, insofar as obviousness over Hashiguchi is concerned. Preputnick filed preliminary motion 1 alleging that Provencher's claims 17-19 are each anticipated by Hashiguchi. Provencher responded to Preputnick's preliminary motion 1 by specifically identifying a difference between Provencher's claim 17 and Hashiguchi, i.e., that Hashiguchi's modules 1 and 2 do not engage each other through complementary fastening portions on the modules as is required by Provencher's claim 17. In connection with Preputnick's preliminary motion 1, we specifically found that there is such a difference, as is

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explained by Provencher, between Preputnick's claim 17 and Hashiguchi. Preputnick's preliminary motion 2 will be considered in light of this difference between Provencher's claim 17 and Hashiguchi.

According to Preputnick, it would have been well within the skill of an ordinary artisan to fasten Hashiguchi's modules 1 and 2 together for securing them because "this is merely a reversal of disclosed securing features in Hashiguchi" (Motion at 20). The rationale is unpersuasive. The mere reverse of an action is not automatically obvious. A reversal of the teachings of a reference still requires a justifiable motivation on the part of one with ordinary skill in the art, and does not itself serve as an automatic motivation.

Preputnick next argues that "by 1994, the use of complementary fastening pieces to secure modules and half-modules together was well known in the art and the suggestions in the art would have been combined with Hashiguchi's teachings to the extent Hashiguchi is deficient in this regard." (Motion at 20). From the bottom of page 20 to the top of page 21, Preputnick's preliminary motion 2 discusses how each of the AMPMODU catalogues, U.S. Patent No. 5,171,161 ("the Kachlic patent"), U.S. Patent No. 4,846,747 ("the Bet patent"), U.S. Patent No. 4,701,138 ("the Key patent"), and U.S. Patent No. 4,820,169 ("the

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Weber patent) discloses use of complementary fastening portions on modules or half-modules to secure two modules or half-modules together. We note, in particular, the Kachlic patent, which discloses a corresponding notch and recess on contiguous modules which are each attached to a common housing. The notch and recess form complementary fastening portions on modules, which engage each other to secure the modules together. As is stated in the Kachlic patent in column 8, lines 59-68:

Specifically, as seen in FIGS. 9 and 10, one side of each encasement 110 is provided with a projecting boss 124 and the opposite side of each encasement is provided with a complementarily shaped indented recess 126 (FIG. 10). The bosses and detents are rectangularly shaped such that when the terminal modules are juxtaposed in their side-by-side relationship, the bosses of the modules project into the recesses of adjacent modules, thereby locking all the modules together.

Since modules 1 and 2 of Hashiguchi are inserted into the housing in a mutually superposed state and remain superposed in a contiguous relationship with the housing, Kachlic's teachings about complementary fastening portions on contiguous modules within a common housing provides motivation for doing the same with Hashiguchi's modules 1 and 2. A prima facie case of obviousness has been made with respect to Provencher's claim 17.

Provencher responds by arguing that Hashiguchi actually teaches away from the step of securing the first and second modules together by engaging complementary fastening portions.

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According to Provencher, it is an innovation of Hashiguchi and a solution provided by Hashiguchi that the modules 1 and 2 are not fastened to each other. Provencher cites to Paragraph 22 of Hashiguchi, entitled "Effects of the Innovation," which states:

. . . . Because of this, connector assembly can be carried out with increased efficiency and accuracy, and also, even if one of the contacts in a module is damaged in assembly of the connector, **there is the advantage that a module of the damaged type can be easily substituted.** (Emphasis added.)

Provencher argues (Opp. page 11, line 18 to page 12, line 3):

[I]f module No. 1 and module No. 2 were secured to one another and then inserted into the housing as opposed to simply being interlocked to the housing in a superposed state, then both module No. 1 and module No. 2 would have to be removed from the housing in order to fix only one of the two modules. [Footnote omitted.] Furthermore, if the two modules were firmly secured to one another, it would be difficult to separate the damaged module from the undamaged module without damaging the otherwise damaged module. Exhibit 1015 ¶¶ 21-23.

Although everything noted in the immediately preceding quotation of Provencher's argument is true and also contrary to the idea in Hashiguchi to provide for easy substitution of any single damaged module, we reject Provencher's assertion that Hashiguchi "teaches away" from fastening two modules together. Provencher too narrowly focuses the concept of "teaching away" on the point of innovation of a prior art reference or the invention

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the prior art patent is attempting to protect. The concept of "teaching away" is much broader than and is based on the entire technical disclosure of a prior art reference.

As is indicated by the Court of Appeals for the Federal Circuit in EWP Corp. v. Reliance Universal, Inc., 755 F.2d 898, 907, 225 USPQ 20, 25 (Fed. Cir.), cert. denied, 474 U.S. 843 (1985), a reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. Likewise, a reference must be evaluated for all its teachings and is not limited to its specific embodiments. In re Bode, 550 F.2d 656, 661, 193 USPQ 12, 17 (CCPA 1977); In re Snow, 471 F.2d 1400, 1403, 176 USPQ 328, 329 (CCPA 1973).

According to Hashiguchi, an advantage for not securing the two modules together is that any one damaged module can be more easily substituted. But it nowhere indicates that that particular advantage is necessary or required for the connector to have practical utility as a connector. While the advantage is desirable and a part of the innovation of Hashiguchi, Hashiguchi as a whole also indicates the operability of connectors made without its particular innovation, albeit such connectors would be without the advantage of easy single module substitution.

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Considering the entire technical disclosure of Hashiguchi and not simply the innovation Hashiguchi is attempting to protect, the prior art reference does not "teach away" from fastening two half-modules together as is required by Provencher's claim 17, in the sense that the teachings of the Kachlic patent is not combinable with that of Hashiguchi. The point Provencher misses is that reasonable combinations of teachings from two references does not necessarily preserve the particular innovation of either reference. That is because a reference is good for everything it discloses in technical content and is not limited to the invention it seeks to protect. For example, if a publication describes a fishing rod with a bell that rings when a fish is hooked, its teachings about the structure of the disclosed rod itself without the bell can also be used as prior art in combination with other references. Note also that an improvement invention is not a "teaching away" from the basic invention from which the improvement arose.

On pages 12 of its opposition, Provencher discusses the benefits of modularity in the making of a product. Generally speaking, it is true that modularity reduces manufacturing costs by allowing production of the same parts in higher volumes. Provencher notes that in Hashiguchi, the structure of modules 1 and 2 are different, and argues on page 13 of its opposition:

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If you secure together modules having different configurations such as disclosed in Hashiguchi, then the total number of each of the half modules is cut in half contrary to the whole idea behind a modular product. In addition, two sets of expensive molding and stamping tools (plus the tooling required to assemble and secure the modules together) would be required. Exhibit 1015 ¶ 26. (Emphasis in original).

At the outset, we note that Provencher's claim 17 does not specify whether the first and second half-modules must be the same or different in configuration, and also does not require any particular degree of modularity. Moreover, securing two half-modules of different configuration together after they have been produced does not reduce the number of each type of half-modules made. Even assuming that the number of each type of half-modules would be reduced, Provencher does not account for the benefits that would be achieved by securing two half-modules together. The issue involves a balancing costs and benefits depending on the applicable goals. Provencher's argument is further undermined by the Kachlic patent which discloses modules which are different in structure and which are fastened together through complementary means on the modules.

For the foregoing reasons, with regard to Provencher's claim 17, we grant Preputnick's preliminary motion 2 but only on the ground of obviousness over Hashiguchi in combination with the Kachlic patent (U.S. Patent No. 5,171,161), and dismiss

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Preputnick's preliminary motion 2 with respect to Provencher's claim 17 on all other grounds of obviousness.

As for Provencher's claim 18 and claim 19, Provencher's response to Preputnick's preliminary motion 2 insofar as any ground of unpatentability is based on Hashiguchi as a primary reference is only that Hashiguchi "teaches away" from including complementary fastening portions on the half-modules. See Provencher's Opposition at page 16. We have, however, already rejected Provencher's "teach away" argument. Consequently, in patent parlance, Provencher's claims 18 and 19 stand or fall with Provencher's claim 17. Accordingly, because Provencher's claim 17 is deemed obvious over Hashiguchi and Kachlic, Provencher's claims 18 and 19 are also unpatentable over Hashiguchi and Kachlic. In that connection, note that Provencher has not disputed Preputnick's assertion (Motion at 22), with regard to Provencher's claim 18, that "[t]he use of ground shields along one side of a terminal module to define a shielded terminal module was notoriously well known in the art by 1994." Preputnick's assertion, insofar as it represents that the idea was well known by March 1995, is supported by the declaration of Mr. Richard F. Granitz who stated in ¶ 22 of his declaration:

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22. The placement of a conduction ground shield along one side of a terminal module to define a shielded terminal module was well known to one of ordinary skill in the art long before March 1995 and is explained repeatedly in the patent literature, as shown in the Soes '183 patent and the Gilissen '341 patent.

Based on the foregoing, we find that the placement of a conduction ground shield along one side of a terminal module to define a shielded terminal module was well known to one of ordinary skill in the art by March 1995. See, for example, U.S. Patent No. 5,496,183 ("Soes") and U.S. Patent No. 5,104,341 ("Gilissen"), as is discussed in ¶ 22 of the Granitz declaration.

We note further that in its Request for Declaration of Interference (Exhibit 2019, page 3), regarding a connector having a conduction ground shield along one side of the terminal module, Preputnick stated that "[s]uch ground shields are well known and admitted prior art and it would have been obvious to use such a shield with the terminal module of Count 1."

For the foregoing reasons, with regard to Provencher's claims 18 and 19, we grant Preputnick's preliminary motion 2 but only on the ground of obviousness over Hashiguchi in combination with the Kachlic patent (U.S. Patent No. 5,171,161), and dismiss Preputnick's preliminary motion 2 with respect to Provencher's claims 18 and 19 on all other grounds of obviousness.

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D. Senior Party Provencher's
Preliminary Motions 1 and 2

Senior party Provencher's preliminary motion 1 attacking the benefit accorded junior party Preputnick is dismissed as moot, in light of junior party Preputnick's failure to allege a date of invention prior to the senior party's accorded benefit date.

Senior party Provencher's preliminary motion 2 alleging unpatentability of junior party Preputnick's claims corresponding to the count is dismissed as moot, in light of junior party Preputnick's failure to allege a date of invention prior to the senior party's accorded benefit date.

Conclusion

Provencher's preliminary motion 1 is dismissed.

Provencher's preliminary motion 2 is dismissed.

Preputnick's preliminary motion 1 is denied.

Preputnick's preliminary motion 2 is granted, but on only one alleged ground of unpatentability, i.e., obviousness over Hashiguchi and Kachlic, and is otherwise dismissed.

Preputnick's preliminary motion 3 is denied.

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Judgment

It is

ORDERED that judgment as to the subject matter of the count is herein entered against junior party GEORGE PREPUTNICK, JAMES LEE FEDDER, SCOTT K. MICKIEVICZ, and RICHARD N. WHYNE;

FURTHER ORDERED that junior party GEORGE PREPUTNICK, JAMES LEE FEDDER, SCOTT K. MICKIEVICZ, and RICHARD N. WHYNE are not entitled to their patent claims 9-14 which correspond to the count;

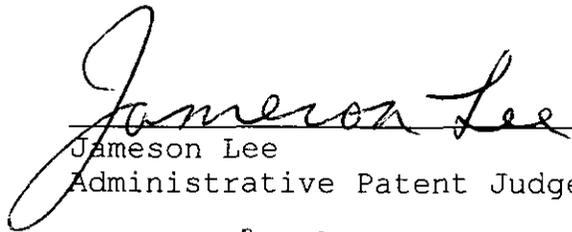
FURTHER ORDERED that judgment as to the subject matter of the count is herein entered against senior party DANIEL B. PROVENCHER and PHILIP T. STOKOE;

FURTHER ORDERED that senior party DANIEL B. PROVENCHER and PHILIP T. STOKOE are not entitled to their application claims 17-19 which correspond to the count;

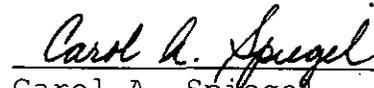
FURTHER ORDERED that a copy of this paper will be entered in the involved application or patent file of the respective parties; and

FURTHER ORDERED that if there is an agreement between the parties facilitating or leading toward the termination of this interference, the parties' attention is directed to 35 U.S.C. § 1.135(c) and 37 CFR § 1.661.

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Jameson Lee)
Administrative Patent Judge)


Richard Torczon)
Administrative Patent Judge)


Carol A. Spiegel)
Administrative Patent Judge)

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By Federal Express

Counsel for junior party:

312-321-4299 (Fax)
Raymond W. Green, Esq.
BRINKS HOFER GILSON & LIONE
NBC Tower
455 Cityfront Plaza Drive, Suite 3600
Chicago, IL 60611-5599

Counsel for senior party:

703-413-2220 (Fax)
Charles L. Gholz, Esq.
OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, Va 22202