

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 53

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

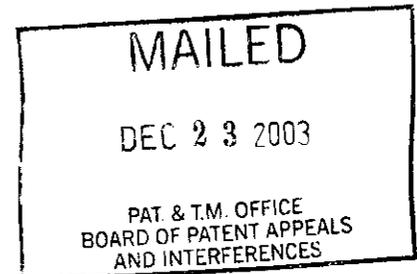
ROGER R. BOURBEAU and DAVID L. MORROW

Junior Party,
(Patent 5,647,119)

v.

ANDREW J. TARPILL

Senior Party,
(Application 09/065,192)



Patent Interference No. 105,082

Before: McKELVEY, Senior Administrative Patent Judge, LEE and MOORE,
Administrative Judges.

MOORE, Administrative Patent Judge.

MEMORANDUM OPINION AND JUDGMENT

Introduction

The parties hereto have filed a settlement agreement (Paper 51) in which they stipulate that Junior Parties Bourbeau and Morrow (hereinafter “Bourbeau” or “Junior Party” or “Junior Party Bourbeau”) have proven priority of invention of the Interference Count (Id., Paragraph 1.1).

Senior Party Tarpill (hereinafter “Tarpill” or “Senior Party” or “Senior Party Tarpill”) has requested entry of adverse judgment against himself. (Paper 52). Tarpill has also filed Miscellaneous Motion 5 (Paper 50) requesting withdrawal of Tarpill Preliminary Motions 1-4.

Tarpill Contingent Preliminary Motion 2 (Paper 26) sought to redefine the subject matter of the count by adding new claims. In light of the settlement agreement, we grant the request to withdraw this motion.

Tarpill Contingent Preliminary Motion 3 (Paper 27) sought to redefine the subject matter of the count by substituting a new count. In light of the settlement agreement, we also grant the request to withdraw this motion.

Tarpill Contingent Preliminary Motion 4 (Paper 28) sought the benefit of an earlier filing date for Senior Party Tarpill. We grant the request to withdraw this motion as well, in light of the settlement agreement.

However, since an issue of patentability was fully developed we exercise our discretion to take up Preliminary Motion 1, despite the absence of a dispute on priority.

Findings of Fact

1. This interference was declared on March 19, 2003 (Paper 1).

2. Bourbeau is involved on the basis of his Patent No. 5,647,119, based on application 08/506,660, filed on July 15, 1995.

3. Tarpill is involved on the basis of his application 09/065,192, filed April 23, 1998, which is said to be a continuation of its application 08/733,261, filed October 18, 1996, which is in turn said to be a continuation of its application 08/331,136, filed October 28, 1994.

4. There is only one count in this interference, Count 1.

5. Bourbeau's claims 1-14, 16, 18, 20-25 and 27 were designated as corresponding to Count 1 and Senior Party Tarpill's claims 9-11, 14-23, and 25-49 were designated as corresponding to Count 1.

6. Bourbeau was accorded, for purposes of priority, the benefit of the filing date of its application 08/506,660, filed July 25, 1995.

7. Tarpill filed Preliminary Motion 1 (Paper 25), which alleges that Bourbeau's claim 1 is unpatentable under 35 U.S.C. § 102(b) for anticipation by Nilsson U.S. Patent 5,040,288 (Ex. 2018) and/or under 35 U.S.C. § 103 as being obvious to one of ordinary skill in the art over Nilsson U.S. Patent 5,040,288 (Ex. 2018) in view of Bihler U.S. Patent 2,202,894 (ex. 2019), Nakamura U.K. Patent Application GB 2081629A (Ex. 2020) and/or Taylor U.S. Patent 1,813,971 (Ex. 2021).

8. Bourbeau has filed an Opposition to Tarpill's Preliminary Motion 1 (Paper 35).

9. Claim 1 of Bourbeau reads as follows:

A cable terminating tool for applying an electrical connector to an end portion of a cable and comprising a tool holder, cable retaining means for positioning and retaining a cable to be terminated and including a pair of cable retaining members having opposing arcuate jaws supported for movement away from each other and to a cable receiving position to receive therebetween an associated portion of a cable to be terminated and

toward each other and to a cable retaining position to restrain the associated portion of the cable to be terminated, said cable retaining members in said cable retaining position encircling the associated portion of the cable and defining an annular bearing surface for engaging a connector received on the end portion of the cable to be terminated, a plunger assembly including an axially elongated plunger supported on said tool holder for axial movement toward and away from said bearing surface, and manual operating means connected to said plunger assembly for moving said plunger relative to said tool holder and in a direction toward and away from said bearing surface.

10. Claim 4 of Bourbeau reads as follows:

A cable terminating tool as set forth in claim 1 wherein said cable retaining members are pivotally supported on said tool holder.

11. Nilsson, United States Patent 5,040,288, issued August 20, 1991 (hereinafter "Nilsson") describes a tool for crimping or pressing a connector onto a cable (column 1, lines 4-5).

12. Nilsson's cable retaining device (localizing device) 57 is mounted in a fitting 56 which functions as a stationary anvil exerting counterpressure (Nilsson; Fig. 5; column 5, lines 10-27).

13. Nilsson describes a crossmember 60 which is movable to exert pressure onto the cable (Nilsson; Fig. 5; column 5, lines 28-42).

14. Bihler, United States Patent 2,202,894, issued June 4, 1940 (hereinafter "Bihler") describes a piercing machine having clamps for securing a work piece.

15. Nakamura et al. UK Patent Application GB 2 081 629, published February 24, 1982 (hereinafter "Nakamura") describes a pipe gripping tool having a fixed jaw and a pivotable jaw.

16. Taylor, United States Patent 1,813,971, issued July 14, 1931 (hereinafter "Taylor") describes a method of forming tubing using a clamping die.

17. The parties have stipulated that the level of ordinary skill in the art with respect to the subject matter of the count is represented by that comparable to an A.S. or B.S. degree in mechanical engineering, two years of manufacturing work experience, and two years of work experience in actually designing such a tool; or no college degree, five years of manufacturing work experience, and three to four years of work experience in actually designing such a tool. (Paper 25, paragraph 14; see also Stipulation of Level of Skill in the Art, filed June 16, 2003).

Discussion

37 C.F.R. §1.637(a) provides that the party filing the motion has the burden of proof to show that it is entitled to the relief sought in the motion. Consequently, party Tarpill bears the burden of proof. That burden is a preponderance of the evidence. Bruning v. Hirose, 161 F.3d 681, 686, 48 USPQ2d 1934, 1937-38 (Fed. Cir. 1998).

I. The Parties' Positions on Anticipation by Nilsson

Tarpill urges that claim 1, when properly interpreted, would result in the claimed subject matter of claim 1 of Bourbeau's '119 patent being definitive of the disclosure of Nilsson's base portion pair. (Tarpill Preliminary Motion 1, Paper 25, page 9, last paragraph). The focus of this argument is on the cable retaining means recited in claim 1. This cable retaining means is described and claimed as "including a pair of cable retaining members having opposing arcuate jaws supported for movement away from each other and to a cable receiving position ... and toward each other and to a cable retaining position" (Bourbeau, column 6, lines 1-6). Tarpill interprets the claim language as requiring only relative movement toward and away from each other (Tarpill Reply 1, Paper 41, page 6, lines 11-12).

Bourbeau, on the other hand, urges that the plain meaning of claim 1 requires that the cable retaining elements requires that each of the pair of cable retaining members be supported for movement away from each other and toward each other (Bourbeau Opposition 1, Paper 35, page 7, lines 14-16)

Tarpill responds that Bourbeau has improperly added limitations to its interpretation of the claim, in that it does not require “each” or “both” cable retaining members to be supported for movement “with respect to the tool holder” (Tarpill Reply 1, Paper 41, page 6, lines 4-11).

II. Analysis of Anticipation by Nilsson

Claims being considered for patentability issues before the PTO are construed according to their broadest reasonable interpretation consistent with the specification. In 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).

We start with the language of the claim itself, as it is the claims that measure the invention. Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 619-20, 34 USPQ2d 1816, 1819 (Fed. Cir. 1995). First, although not raised by the parties, we note that claim 4, dependent from claim 1, recites that the cable retaining members are pivotally supported on the tool holder. (Bourbeau Claim 4, column 6, lines 23-25). Under the doctrine of claim differentiation, claim 1 therefore encompasses more than the preferred embodiment disclosed in Figure 8 and claimed in claim 4, i.e. the pivotable embodiment.

Second, claim 1 contains “means plus function” language in describing the cable retaining means. However, the parties agree that the cable retaining members are described with sufficient structural specificity so as not to implicate 35 U.S.C. § 112, sixth paragraph. (Bourbeau Opposition 1, Paper 35, page 7, last 2 lines; Tarpill Reply 1, Paper 41, page 4, line 15-18). We concur, noting that the simple recitation of cable retaining “means” does not implicate Section 112, sixth paragraph. York Products, Inc. v. Central Tractor Farm and Family Center, 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1623 (Fed. Cir. 1996).

The literal language of claim 1 requires that the opposing arcuate jaws be supported for movement away from each other and toward each other. The claim further literally requires the arcuate jaws be movable between cable receiving positions and cable retaining positions. (Bourbeau, column 6, lines 1-7). Without an express intent to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning Hoganas AB v. Dresser Industries, Inc., 9 F.3d 948, 951, 28 USPQ2d 1936, 1938 (Fed. Cir. 1993).

By the use of the words “jaws supported for movement away from each other” and “to a cable receiving position” we conclude that Bourbeau has described the condition where each jaw is supported for some form of reciprocating motion between the claimed cable receiving position and cable retaining position. This jaw structure and function is entirely consistent with the specification. For example in Figure 8, and as described at column 3, lines 10-21, all cable retaining members are described as pivotably movable between cable retaining positions and cable receiving positions.

A plain reading of the claim language at issue according to ordinary usage of the English language requires that there be movement on the part of each cable retaining member, for they are "supported for movement away from each other . . . and toward each other . . ." (Claim 1). The term "each other" implies mutuality or some form of reciprocal standing. Tarpill would have us interpret the claim language so broadly that the concept of mutuality and reciprocal standing is not included in the claim.

That is an unreasonably broad interpretation. Adding the word "relative" before "movement," as Tarpill apparently would have us do (Tarpill Reply 1, page 4, lines 9-13) unjustifiably broadens what Bourbeau has claimed. While Bourbeau's claim requires the two retaining members be supported for movement away from each other to a cable receiving position and toward each other to a cable retaining position, Tarpill evidently reads the claim as requiring only that the distance between the two members be decreased and increased without regard to whether both members move. (Id., page 6, lines 11-12).

That is an improper reading of the claim in that it overlooks the element of mutuality. The second member must also move. This is not a result of requiring the members to move with respect to the tool holder, as Tarpill apparently believes (Id., page 3, lines 21-22), but a necessary result of the members moving toward and away from "each other."

We therefore agree with Bourbeau's position that the device of Nilsson having the cable retaining means 63, 59 as represented in Figures 5 and 6 functioning as a stationary anvil to exert counterpressure do not meet these claimed elements. The stationary anvil is not supported for movement toward and away from the crosspiece 60, nor between cable receiving and cable retaining positions.

Anticipation under 35 U.S.C. Section 102(e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As a consequence, we conclude that Tarpill has failed to carry its burden of showing that Nilsson anticipates claim 1 of Bourbeau, as interpreted above. We shall deny Tarpill Preliminary Motion 1 as it pertains to anticipation.

III. The Parties' Positions on Obviousness

Tarpill's Preliminary Motion 1 alternatively urges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Nilsson's vertically movable and swingable base portion 63 by providing a vertically movable base portion with a pivot that allows for pivoting motion in a plane perpendicular to the workpiece so as to permit more ready access to the notches for insertion of the workpieces. (Tarpill Preliminary Motion 1, Paper 25, page 11, third paragraph). Such pivoting engagements are said to be shown by Bihler, Nakamura or Taylor (Id., page 11, first and second paragraphs).

As Tarpill's factual analysis is deficient, we need not belabor the record beyond pointing out that this argument fails to address the requirement of claim 1 that the cable retaining members are "supported for movement" away from and towards each other and away from and towards cable receiving and cable retaining positions.

We find no description in Bihler, Nakamura, or Taylor of the claimed cable retaining members supported for the claimed movement. Each of the cited "secondary" references is relied upon by Tarpill for describing upon for the pivotable closure of a

holding means or die (Bihler, Fig. 2, reference numerals 49 and 50; Taylor, Fig. 1, reference numerals 5, 6, and 7; Nakamura, Fig. 2, reference numerals 4 and 7).

Furthermore, it appears to us that each of the additional references describing a gripping tool have a fixed base portion (Nakamura, Fig. 2, reference numerals 4 and 7; page 1, lines 86-69; Bihler, Fig. 4, reference numerals 49 and 50).

Consequently, we find that Tarpill has failed to carry its burden to show that Bihler, Nakamura and Taylor cure the Nilsson deficiency. Accordingly, we shall deny Tarpill Preliminary Motion 1 as it pertains to obviousness.

IV. Conclusion

As the moving party Tarpill has failed to establish that the proffered references, either singly or in combination anticipate or render obvious the claimed subject matter of Bourbeau claim 1, we deny Tarpill Preliminary Motion 1.

V. Judgment

It is ORDERED that judgment as to the subject matter of Count 1 is herein entered against Senior Party ANDREW J. TARPILL.

It is FURTHER ORDERED that Tarpill Preliminary Motion 5 is GRANTED with respect to Tarpill's Preliminary Motion 2, Preliminary Motion 3, and Preliminary Motion 4, but is otherwise DENIED.

It is FURTHER ORDERED that Tarpill Preliminary Motion 1 is denied on the merits.

It is FURTHER ORDERED that Senior Party ANDREW J. TARPILL is not entitled to his application claims 9-11, 14-23, and 25-49 which correspond to Count 1.

Interference No. 105,082

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