

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-1292
Application No. 10/314,742

ON BRIEF¹

Before THOMAS, RUGGIERO, and MACDONALD, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the board from the Examiner's final rejection of claims 1, 5, 7, 10, 12 through 21 and 23, claims 6, 8 and 9 having been withdrawn.

Representative claim 1 is reproduced below:

1. A bulkhead header for electrically connecting electrical connectors on first and second sides of an associated bulkhead having first and second surfaces and defining an opening therein, the header comprising:

a body configured for insertion into the associated bulkhead opening and having at least a pair of tangs for engaging the first surface of the associated bulkhead, the tangs being formed integral with the body;

¹ In a facsimile communication received on April 11, 2006, appellants have waived their attendance at the scheduled oral hearing for this appeal on May 9, 2006.

a plurality of pins disposed in the body, the pins extending from a flange side of the header through to a body side of the header;

a flange integral with the body for resting against the second surface of the associated bulkhead such that a portion of the associated is engaged between the tangs and flange to secure the header to the associated bulkhead, wherein the pins provide electrical connection across the first and second surfaces of the associated bulkhead;

a cover connected to the flange for overlying the pins at the flange side of the header, the cover being integrally formed with and connected to the flange by a living hinge, the cover including a latch to secure the cover in a closed position overlying the pins and, when in a closed position, defining a space between the cover and the flange for connecting electrical conductors to the electrical connectors; and

an interference member disposed at about the pins to permit connecting a connector to the pins in only one orientation.

The following references are relied on by the examiner:

Chrones	4,070,078	Jan 24, 1978
Revil et al. (Revil)	4,979,910	Dec 25, 1990
Hofmann et al. (Hofmann)	5,382,171	Jan. 17, 1995
Shinozaki	6,113,424	Sept. 5, 2000

Claims 1, 5, 7, 10, 12 through 21 and 23 stand rejected under 35 U.S.C. § 103.

As evidence of obvious, the examiner relies upon Hofmann in view of Chrones and Revil as to claims 1, 5, 7, 10, 12 through 14, 16 through 18, 20 and 21, with the addition of Shinozaki as to claims 15, 19 and 23.

Rather than repeat the positions of the appellants and the examiner, reference is made to the Brief and Reply Brief for appellants' positions, and to the Answer for the examiner's positions.

OPINION

For the reasons set forth by the examiner in the Answer, as expanded upon here, we sustain the rejections of all claims on appeal under 35 U.S.C. § 103.

At the outset, we note that appellants have grouped the subject matter of independent claims 1, 16 and 20 collectively as to their arguments presented as to the

first stated rejection of the claims on appeal. As such, we take claim 1 as representative of all the claims rejected within the first stated rejection.

In considering appellants' arguments beginning at page 5 of the principal Brief on Appeal, we come to the same conclusion the examiner observes in the Answer that appellants appear to be in some respects arguing the references in a piecemeal fashion. Moreover, the approach followed in the arguments at pages 5 and 7 of this Brief take the position that "because a combination of the Hofmann and Chrones patents would not render the invention of claims 1, 16 and 20 obvious, the addition of the Revil patent would not further support an obviousness determination." Their arguments which follow focus only on Hofmann and Chrones with only a passing mention of Revil at the top of page 7 of the principal Brief on Appeal. Thus, appellants do not appear to be arguing before us the actual stated rejection relying upon Hofmann and Chrones and Revil in combination.

To the extent that appellants seem to be arguing in the Brief and Reply Brief that the examiner's combination overlooks the purpose of the Hofmann socket cover is misplaced. Page 3 of the Answer sets forth the initial statement of the examiner's reasoning and combinability, by first recognizing that Hofmann does not teach a living hinge and an appropriate space for connecting an electrical conductor when the cover is closed. The examiner reasons that these deficiencies of Hofmann obviously would have been cured by the teaching in Chrones. The examiner's remarks with respect to the word "integral" to the extent used numerous times in each independent claim on appeal has not been challenged in the Brief. Moreover, appellants have not challenged

the examiner's characterization of Chrones teaching that a living hinge 74 is an art recognized equivalent structure to a conventional mechanical hinge.

The examiner's reasoning of combinability perhaps is best stated in the summary statement at page 7 of the Answer where the examiner notes that Chrones teaches a cover with a space to accommodate connecting electrical conductors of the mating plug to the electrical connectors when the cover is in a closed position, thus protecting the electrical conductors of the mating plug from tampering. The examiner has additionally urged the use of the living hinge of Chrones would have simplified the overall assembly process of the header/connector. From our perspective, these conclusions of the obviousness of combining the subject matter of Hofmann and Chrones are aptly based upon the teachings and suggestions of Chrones as modifying the teachings which have already been set forth in Hofmann.

To the extent appellants argue that the combination of Hofmann and Chrones completely overlooks the purpose of the Hofmann socket cover, we consider this view misplaced. To the extent appellants argues that the purposes of the references relied upon by the examiner are different from the appellant's disclosed purpose, this is not pertinent to the issue and is essentially irrelevant if the prior art teachings would have led the artisan to construct an arrangement having the claimed structural features. In re Heck, 699 F.2d 1331, 216 USPQ 1038 (Fed. Cir. 1983) and In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976). In re Heck also indicates that the use of patents as references is not limited to what the patentees described as their own invention. The law of obviousness does not require that references be combined for reasons contemplated by an inventor, but only looks to whether the motivation or suggestion to

combine references is provided by prior art taken as a whole. In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992). In an obviousness determination, the prior art need not suggest solving the same problem set forth by appellant(s). In re Dillon, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc)(overruling in part In re Wright, 848 F.3d 1216, 1220, 6 USPQ2d 1959, 1962 (Fed. Cir. 1988)), cert. denied, 500 U.S. 904 (1991).

The examiner has plainly applied the teachings and suggestions of Hofmann and Chrones within 35 U.S.C. § 103. We note also that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 414, 425, 208 USPQ 871, 881 (CCPA 1981); In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

Appellants' apparently more refined argument in the Reply Brief is that combining the Chrones cover with the device socket of Hofmann would completely defeat the purpose of Hofmann's approach. This again is a variation of the argument just treated. Carrying this line of reasoning to its full extent, appellants arguments' would not permit any modifying teachings of any reference and thus render ineffective 35 U.S.C. § 103.

Lastly, we briefly turn to the second stated rejection of dependent claims 15, 19 and 23 where the examiner additionally relies upon Shinozaki. Here, appellants apparently argue again (Brief, bottom page 7) the first stated rejection of independent claims 1, 16 and 20 and do not provide any challenge to the examiner's findings with

respect to Shinozaki's teachings and no arguments are presented against the combinability of that as a modifying reference to the three references relied upon in the first stated rejection. The same approach is followed at pages 2 and 3 of the Reply Brief. Therefore, the rejection of dependent claims 15, 19 and 23 is also sustained.

In closing, we note in passing that it appears that some arguments made by appellants in the Brief and Reply Brief relate to features that are problematic in nature as to their recitation in independent claims 1, 16 and 20 on appeal. There is a repeated use of recited elements "for" stated purposes but no positive present tense statement of the purpose. The end of the claims recites the feature of "to permit connecting," again a feature not necessarily positively recited since it relates to a future act that may never occur. Likewise with respect to the cover being secured in a closed position, the actual language utilized is "to secure..., when in a closed position." Again, this is not a positive statement that the cover is ever in a closed position. Reciting claimed features in this manner only enhances the meritorious value of the examiner's rejection within 35 U.S.C. § 103.

In view of the foregoing, the decision of the examiner rejecting all claims on appeal 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

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ELD

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