

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 George Y. Huang

Appeal No. 2006-2187
Application No. 10/642,413
Technology Center 2800

HEARD: December 12, 2006

Before HAIRSTON, DIXON, and SAADAT, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the Examiner's final rejection of claims 1, 3-12, and 14-16, which are all of the claims pending in this application. We note that this appeal is related to a prior appeal in Appeal No. 2002-1175 where we affirmed all of the rejections under 35 U.S.C. §§ 102 and 103(a).

We AFFIRM.

BACKGROUND

Appellant's invention relates to an electrical connector and adapter structure with raised portion. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. An electrical connector structure comprising:

a housing with an outer surface and at least one end adapted to hold an electrical connector plug, wherein the housing has a raised portion that is above the outer surface of the housing,

a covering formed over the outer surface of the housing, wherein the covering is further formed around the raised portion so that an exposed part of the raised portion is not covered by the covering, wherein the exposed part of the raised portion further comprises a background surface and a design surface, and

wherein the design surface is formed as part of the background surface and is not level with the background surface.

PRIOR ART

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

Wiebe	4,164,725	Aug. 14, 1979
Biche	4,202,351	May 13, 1980
Williams	4,256,159	Mar. 17, 1981

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Riggs et al. (Riggs)	4,275,768	Jun. 30, 1981
Owens et al. (Owens)	4,704,091	Nov. 3, 1987
Beinhaur et al. (Beinhaur)	4,960,391	Oct. 2, 1990
Tan	5,735,699	Apr. 7, 1998

REJECTIONS

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellant regarding the above-noted rejections, we make reference to the Examiner's answer (mailed Feb. 28, 2006) for the reasoning in support of the rejection, and to Appellant's brief (filed Dec. 14, 2005) and reply brief (filed Apr. 28, 2006) for the arguments thereagainst.

Claims 1 and 12 stand rejected under 35 U.S.C. § 102 as being anticipated by Tan. Claims 1 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens. Claims 3 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens in view of Williams. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens and Williams, as applied to claim 3 above, and further in view of Biche. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens and Williams, as applied to claim 3 above, and further in view of Riggs. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens and Williams, as applied to claim 3 above, and further in view of Beinhaur. Claims 7, 8 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens in view of Biche. Claim 9 stands rejected under 35 U.S.C. § 103(a) as being

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unpatentable over Owens in view of Biche, as applied to claim 7 above, and further in view of Riggs. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens and Biche, as applied to claim 7 above, and further in view of Beinhaur. Claims 11 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens in view of Wiebe.

OPINION

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

35 U.S.C. § 102

A claim is anticipated only if 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). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to “‘read on’ something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or ‘fully met’ by it.” While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its

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meaning, particularly to those skilled in the art at the relevant time. See Studiengesellschaft Kohle v. Dart Indus., Inc., 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

We must point out, however, that anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

From our review of the Examiner's rejection in the Answer, we cannot agree with the Examiner's formulation of the rejection based upon anticipation over the Tan reference. We agree with Appellant that Tan does not teach that covering 12 is "formed over" housing 16 with outer surface 29 being the raised portion with both design and background surfaces which are not level. We find the Examiner's correlation to be unclear and unreasonable in light of Appellant's disclosed invention. Therefore, we cannot sustain the rejection of claims 1 and 12 based upon Tan alone.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d

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1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing In re Fritch, 972 F.2d 1260,

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1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” Dembiczak, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” In re Hiniker Co., 150 F.3d 1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 1.

From our review of our prior decision on appeal in this application and the claims on appeal, we again agree with the Examiner’s claim interpretation as applied with the Owens reference and application of the prior art (Answer at pages 5-6 and 13-16). We find that the Examiner has established a prima facie case of obviousness and look to Appellant to show error in the prima facie case of obviousness or to adequately rebut the Examiner’s rejection. We find that the Examiner summarizes the proper interpretation and response to Appellant’s main argument at page 11 of the answer stating “[h]owever, the language such ‘later manufacturing step’ or similar language never appeared in the claims 1 and 12. Also, none of the claims disclose how many steps these surfaces were formed.” We agree with the Examiner that Appellant’s arguments are not supported by the

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express limitations in the claim language and Appellant has not identified how the specification defines or limits the interpretations of the claim limitations.

Appellant argues that the invention overcomes a problem in the prior art and that the present invention provides “a structure that could be formed in a single step.” (Reply Br. at 8). The Examiner has relied upon the teachings of Owens at column 3, lines 55-56 which indicates that the raised portion of the raised planar informative plaque member 26 and that etching and appliqués are both commonly used methods for applying information. (Answer at page 5). We agree with the Examiner’s analysis and reasoning and do not find that Appellant has shown error therein. We agree with the Examiner that if etched, the surface of the information would be below the remainder of the background surface and if an appliqué were applied to the surface then the final “formed” product would have the design surface raised above the background surface.

Appellant argues that Owen’s two-step member is the very problem that Appellant’s invention seeks to solve (Br. 19 et seq.). With that said, it is the invention as recited in the claim language which we must limit our review to. This argument emphasizes the difficulty which we had in this appeal and the prior appeal that Appellant tries to distinguish a physical article by the manner in which it was made. While this can be done, it is the structural limitations which must distinguish the article. The arguments to the mechanical advantages, the two step process, and the problem of transparent plastics are not expressly set forth in the claim language and

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arguments thereto are not commensurate in scope and supported by the claim language. Therefore, Appellant's argument is not persuasive.

Here, we find the use of the term "formed" in the article of manufacture claim to be quite broad and not specifically defined in the specification or developed in the prosecution history. We find no temporal limitation as to the time of being "formed" or limitation that the surfaces are made of the same material so as to distinguish over the Examiner's reasonable claim interpretation and application of the prior art of Owens. Appellant maintains that the Examiner has made a "leap based on unsupported factual speculation . . . such as etching and appliqués" (Reply Br. at page 9). We disagree with Appellant and find that Appellant's specification discloses use of labels or appliqués at page 2, lines 18-19, "Or, a label (not shown) can be affixed in the recess 20 after molding" in the admitted prior art. Additionally, in the record, U.S. Patent 5,449,302 to Yarbrough indicates that angled label portion includes printed information about the electrical rating at column 8 and U.S. Patent to Englemann in the abstract and the Summary of the Invention disclose the application of information to electrical components. Therefore, we cannot agree with Appellant that the Examiner has based the rejection upon mere speculation. Therefore, Appellant's argument is not persuasive, and we will sustain the rejection of independent claims 1 and 12.

With respect to dependent claims 3 and 14, Appellant argues that the Examiner does not understand the problem of the prior art and solving the problem in a single step (Br. 24). As discussed above, we do not find the

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argument to the single step process to be well supported in the claim language and does not distinguish the claimed invention. Therefore, Appellant's argument is not persuasive, and we will sustain the rejection of dependent claims 3 and 14.

With respect to dependent claims 1, 3-10, and 15, Appellant argues that none of the references disclose a structure that eliminates the multi-step manufacturing process of the prior art as disclosed by Appellant. As discussed above, we do not find the argument to the single step process or elimination of multi-step processes to be well supported in the claim language, and we find that this argument does not distinguish the claimed invention. Therefore, Appellant's argument is not persuasive, and we will sustain the rejection of dependent claims 1, 3-10, and 15.

Appellant additionally subdivides the above grouping into claims 4, 7, 8, and 15, and we select dependent claim 7 as representative. We find that Owens teaches an appliqué which we find to be above the surface of the background surface and also agree with the Examiner that the molding of Biche would have suggested that a separate step of molding could be used with Owens to apply information to the information plaque. Therefore, Appellant's argument is not persuasive, and we will sustain the rejection of dependent claims 4, 7, 8, and 15.

Appellant additionally subdivides the above grouping into three additional groupings of claims 5 and 9; claims 6 and 10; and claims 11 and 16. Appellant presents the same argument as above that the references do not disclose the claimed structure and process of manufacturing (Br. 26-27).

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As discussed above, we do not find this argument persuasive and we will sustain the Examiner's rejection.

With respect to dependent claims 11 and 16, we find that any surface that can be contacted is a gripping surface as recited in the claims, and we do not find that the claims recite any structure to accomplish or improve the gripping of the connector, such as, texture. Therefore, Appellant's argument is not persuasive, and we will sustain the rejection of dependent claims 11 and 16.

CONCLUSION

To summarize, we have reversed the rejection of claims 1 and 12 under 35 U.S.C. § 102 and affirmed the rejection of claims 1, 3-12 and 14-16 under 35 U.S.C. § 103.

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

AFFIRMED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

JLD/rwk

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LAW OFFICE OF DUNCAN PALMATIER
530 SOUTH ASBURY
SUITE 5
MOSCOW, ID 83843