

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 HANS-PETER BOLLIN, HARTMUT SCHWETTMANN,
and UWE SUNDERMEIER

Appeal No. 2006-2789
Application No. 10/215,217

ON BRIEF

Before JERRY SMITH, BLANKENSHIP, and HOMERE, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 4, and 6-12, which constitute all the claims pending in this application.

The disclosed invention pertains to an RJ45 plug connector. The plug connector includes (1) a first plug connector part that receives an RJ45 female plug therein, and (2) a second plug connector part that receives an adapter therein. Two power contacts are arranged at the side of the adapter. The connector provides mechanical strength and fluid and dust tightness and is therefore useful in factory environments.

Representative claim 8 is reproduced as follows:

8. A plug connector comprising a first plug connector part, a female plug that is received in said first plug connector part, a second plug connector part and an adapter that is received in said second plug connector part, wherein said adapter is further provided with two power contacts that are arranged at the side of said adapter.

The examiner relies on the following references:

Clarke et al. (Clarke)	4,611,875	Sep. 16, 1986
German Utility Model Application ("DE '297")	201 06 297 U1	Aug. 9, 2001

The following rejection is on appeal before us:

Claims 1, 4, and 6-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over DE '297 in view of Clarke.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs¹ and the answer for the respective details thereof.

¹ Although an appeal brief was initially filed on Sept. 2, 2005, a substitute appeal brief was filed Jan. 19, 2006 in response to a notice of non-compliance under 37 CFR 41.37. Throughout this opinion, we refer to the substitute brief filed Jan. 19, 2006 (hereafter "brief").

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching,

motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of

presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

Regarding independent claims 1 and 8, the examiner's rejection essentially finds that DE '297 teaches every claimed feature except for the adapter 22 shown in the reference comprising two power contacts on the side of the adapter. The examiner further notes that it is unclear whether DE '297 discloses an RJ45 plug [answer, page 6]. The examiner cites Clarke as disclosing an adapter 10 with power contacts 62, 63 arranged at the bottom side of the adapter. The examiner further notes that Clarke teaches that the connection can be made using any type of plug/jack combination. In view of

Clarke, the examiner finds that it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the adapter 22 of DE '297 with the adapter 10 of Clarke to simplify “chang[ing] the association between any PBX (or CO) line and the station” [answer, pages 6 and 7].

Appellants argue that the cited prior art does not disclose a two-part connector set as claimed, but rather teaches a one-piece adapter [brief, pages 10 and 11; reply brief, page 7]. The examiner responds that the combination of DE '297 and Clarke shows a two-part connector set [answer, page 10]. The examiner further notes that the claims do not recite a two-part adapter, but rather only recite an “adapter” [answer, pages 10 and 11].

Appellants further argue that the plug connector 17 of DE '297 is not an adapter, but rather a male connector [reply brief, page 8]. The examiner notes that element 17/22 in DE '297 is structurally similar to the claimed adapter and nothing in appellants' specification precludes the examiner's interpretation [answer, page 9]. Appellants also contend that no motivation exists to mount the adapter 10 of Clarke into a housing as the examiner suggests since that would render Clarke inoperative for its intended purpose [reply brief, page 8].

We will sustain the examiner's obviousness rejection. Initially, we note that appellants have not separately argued independent claims 1 and 8, but instead have argued the independent claims (along with their respective dependent claims) as a group. Accordingly, we will select the broadest independent claim – claim 8 – as representative. See 37 CFR § 41.37(c)(1)(vii).

We find that the examiner's interpretation of DE '297 is reasonable. First, the scope and breadth of the limitations of claim 8 calling for the first and second plug connector parts are fully met by the separate structures in DE '297 indicated by the examiner. Significantly, claim 8 does not further limit the structure of the first and second connecting parts apart from receiving a female plug and adapter respectively.

Turning to the prior art, we agree with the examiner that the scope and breadth of the "first plug connector part" is fully met by the structure of electronic device 1 in Fig. 2 of DE '297 since that structure, at least in part, facilitates the insertion and removal of plug connecting devices 4 [see DE '297, Fig. 1]. In addition, an RJ45 female plug 2 is located within the electronic device 1 ("first plug connector part"). Furthermore, we agree with the examiner that the "second plug connector part" is fully met by protective housing 7 of DE '297. Moreover, in our view, the scope and breadth of the adapter limitation of claim 8 fully reads on DE '297. That is, the term "adapter" does not preclude the RJ45 plug 17 itself as well as associated structure within protective housing 7 that receives the plug (e.g., locking hook 53, locking projection 55, etc.).

We are not persuaded by appellants' argument that the term "adapter" must be interpreted more narrowly in light of appellants' disclosure that shows and describes an adapter 28 [reply brief, page 8]. During patent examination, the

pending claims must be “given their broadest reasonable interpretation consistent with the specification.” In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the structure of DE ‘297 identified as the “adapter” does not match the adapter disclosed in appellants’ specification, the term “adapter” as claimed is not so limited. “[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments...[C]laims may embrace different subject matter than is illustrated in the specific embodiments in the specification.” Phillips v. AWH Corp., 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) (citations and internal quotation marks omitted).

Moreover, we find ample evidence on this record that the skilled artisan would have been motivated to apply the teachings of Clarke to the apparatus of DE ‘297. At the outset, we are not persuaded by the examiner’s creative use of graphics to illustrate the alleged feasibility of a wholesale replacement of the “adapter” of DE ‘297 with Clarke’s “adapter” essentially for the reasons noted by appellants [see answer, page 5]. We nonetheless conclude, however, that the skilled artisan would have reasonably been motivated to provide power contacts on the side of the “adapter” of DE ‘297 in view of the teachings of Clarke, particularly in the event that electrical power is needed in addition to the adapter connections. In this regard, Clarke teaches the advantage of providing power

contacts 62, 63 on adapter 10 that could mate with any jack so that electrical power is provided in addition to receiving a plug [Clarke, col. 1, line 49 – col. 2, line 6; Figs. 1, 2, and 7]. In our view, such a teaching would have been readily combinable with the adapter of DE '297 so that electrical power was provided via the adapter in the event that electrical power is needed in addition to the adapter connections.

For the above reasons, the examiner's obviousness rejection of independent claim 8 is therefore sustained. Since appellants have not separately argued with particularity the patentability of independent claim 1 or dependent claims 4, 6, 7, and 9-12, these claims fall with independent claim 8. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). See also 37 CFR § 41.37(c)(1)(vii).

In summary, we have sustained the examiner's rejection with respect to all claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 4, and 6-12² is affirmed.

² As an ancillary observation, we note that claim 12 merely duplicates claim 1. Because the parties did not raise this issue on appeal, it is therefore not before us. In an ex parte appeal, "the Board is basically a board of review – we review...rejections made by patent examiners." Ex parte Gambogi, 62 USPQ2d 1209, 1211 (B.P.A.I. 2001). Consequently, we leave the issue of whether the appellants have satisfied the requirements of MPEP § 706.03(k) to the examiner and the appellants.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
HOWARD B. BLANKENSHIP)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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