

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VAL MANDRUSOV and DUANE FRIESEN

Appeal 2008-0114
Application 10/235,221
Technology Center 2800

Decided: July 23, 2008

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY, and CARLA M. KRIVAK, *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-20.¹ We have jurisdiction under 35 U.S.C. § 6(b).

¹ The drawings were objected to and claims 6-15 were rejected under 35 U.S.C. § 112, second paragraph. The Examiner withdrew this objection and rejection in the Answer mailed July 12, 2007 (Ans. 5), the most recent Answer, to which we refer throughout this opinion.

We reverse.

STATEMENT OF CASE

Appellants' claimed invention is an electromagnetic interference (EMI) backshell assembly suitable for applications prone to high levels of radiated electromagnetic emissions (Spec. 1:11-13). The invention is directed to a method, system, and device having an electrical connector, an insulative shell, a housing, and a threaded fastener. Appellants' invention allows for separate movement of electrical conductors and shielding components to allow each to be adjusted for desired performance and for the signal carrying components to float relative to the shielding or housing (Spec. 2:24-27).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A device comprising:

an electrical connector having a plurality of electrical conductors adapted to mate with a matching connector;

an insulative shell encasing a portion of the electrical connector,

a housing having an interior adapted to receive the electrical connector, the housing having a channel adapted to permit independent movement of the electrical connector relative to the housing, the housing including an electrically conductive material; and

a threaded fastener coupled to the housing and adapted to mate with a corresponding fastener of the matching connector.

REFERENCES

Karir	US 6,017,245	Jan. 25, 2000
Imai	US 6,588,937 B2	Jul. 8, 2003
		(Filed Mar. 27, 2002)
Komenda	US 6,592,387 B2	Jul. 15, 2003
		(Filed Dec. 26, 2000)

The Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as obvious based upon the teachings of Karir and Komenda (Ans. 3). The Examiner rejected claims 1-4, 16, and 18-20 under 35 U.S.C. § 103(a) as obvious based upon the teachings of Karir and Imai (Ans. 4).

Appellants contend that claims 1-20 were improperly rejected and that the Examiner has not provided a *prima facie* case of obviousness (Br. 7 and 10)

ISSUES

Did the Examiner err in rejecting claims 1-20 under 35 U.S.C. § 103(a) as obvious based upon the teachings of Karir and Komenda?

Did the Examiner err in rejecting claims 1-4, 16, and 18-20 under 35 U.S.C. § 103(a) as obvious based upon the teachings of Karir and Imai?

PRINCIPLES OF LAW

We note that the Court of Appeals for the Federal Circuit has determined that the motivation to combine under § 103 must come from a teaching or suggestion within the *prior art*, within the *nature of the problem to be solved*, or within the *general knowledge of a person of ordinary skill* in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. *Ruiz v. A.B.*

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Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000) (emphasis added). Further, our reviewing court has recently reaffirmed that:

an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the ‘improvement’ is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient . . . In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.

DyStar Textilsfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1368 (Fed. Cir. 2006).

The Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellants to overcome the *prima facie* case with argument and/or evidence. *In re Mayne*, 104 F.3d 1339, 1342 (Fed. Cir. 1997).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734 (2007).

The Examiner’s “articulated reasoning . . . in the rejection must possess a rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The Supreme Court, reiterating this reasoning by citing *In re Kahn*, 441 F.3d at

988, stating that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. at 1741.

One important indicium of nonobviousness is “teaching away” from the claimed invention by the prior art. *In re Dow Chemical Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988).

As to the specific question of “teaching away,” our reviewing court in *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) stated:

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

ANALYSIS

Karir and Komenda

The Examiner asserts that Karir teaches all the features of Appellants’ invention except that it “is not slidably coupled to the housing” (Ans. 3). The Examiner further asserts that Komenda discloses a spring providing a force that keeps two connectors together and provides them with freedom of movement within a tray while maintaining connection (Ans. 3). It is the Examiner’s position that it would thus be obvious to a person having ordinary skill in the art to modify Karir such that the connector would be slidably coupled to a housing using the spring taught by Komenda “because the spring would help make the connection by pushing the two mating connectors toward each other and provide a force that keeps the two

connectors together and gives the connectors freedom of movement within a housing while still maintaining connection” (Ans. 4).

Appellants contend that the principles of operation of Karir and Komenda differ (Br. 9). According to Appellants, Karir allows no movement between the connector and the housing (col. 4, ll. 55-67) — an argument the Examiner concedes as correct (Ans. 5)). Appellants emphasize, however, that unlike Karir, Komenda allows the connector freedom to move in all directions (col. 5, ll. 21-23) (Br. 9). Thus, Appellants contend that these references teach away from each other and combining them would render one or the other unsatisfactory for its intended purpose (Br. 9). The Examiner disagrees and asserts that the combination of Karir and Komenda “show a device with a movable electrical connector within a housing of the device is known in the art at the time the invention was made” (Ans. 6).

In our view, the Examiner has provided no reasonable basis to combine Karir and Komenda aside from what is taught by Appellants’ disclosure. That is, the Examiner has merely cited a secondary reference that permits independent movement with respect to a housing using a spring and asserted that the base reference can somehow be modified to arrive at the claimed invention in light of this teaching. However, modifying Karir in the manner proposed by the Examiner must not frustrate the principles of operation of the respective references. In this regard, we agree with Appellants that the Examiner has failed to show how the proposed combination would not frustrate “the principle of operation delineated by Karir” and show “how the connector of Komenda can be made rigid without frustrating the principles of operation delineated by Komenda” (Br. 10). As

such, we agree with Appellants that combining these teachings in the manner proposed by the Examiner runs counter to the references' principles of operation. We also find the combination is tantamount to impermissible hindsight reconstruction of the invention using Appellants' disclosure as a blueprint.

Furthermore, we are not persuaded by the Examiner's arguments and agree with Appellants that “[t]he Office has not set forth reasoning to explain the desirability of modifying the non-sliding connector of Karir for use in a structure having a sliding connector, as in Komenda” (Br. 10). For these reasons, we find the Examiner did not establish a *prima facie* case of obviousness over the teachings of Karir and Komenda with respect to claims 1-20.

Karir and Imai

The Examiner rejected claims 1-4, 16, and 18-20 as obvious over Karir and Imai. The Examiner asserts that the housing structure of Imai is the same as Appellants (Ans. 4). The Examiner further asserts that connectors include coil springs that press ferrules toward mating connectors to provide a force that keeps the two connectors together and gives the connectors freedom of movement within the housing while maintaining connection (Ans. 4). It is the Examiner's position that it would thus be obvious to modify the device taught by Karir to have a connector slidably coupled to a housing of the device taught by Imai to provide a force that keeps two connectors together and provide “freedom of movement within the housing while still maintaining connection” (Ans. 5).

Appellants contend that Karir teaches away from “‘independent movement’ of the connector relative to the housing” and further, the nature

of Karir negates a need for independent movement of the connector relative to the housing (Br. 10). It should be further noted that Imai teaches that after the locking of the two connections, the fiber returns to its pre-compression state and the compressive force no longer works (col. 9, ll. 25-29; ll. 51-57).

We agree with Appellants that the Examiner has not provided a reasonable basis for “modifying the non-sliding connector of Karir for use in a structure having a sliding connector, as in Imai” (Br. 11). As with the previous rejection, we find the Examiner’s combination of references is untenable and tantamount to impermissible hindsight reconstruction of the invention. For these reasons, we find that the Examiner did not establish a *prima facie* case of obviousness over the teachings of Karir and Imai with respect to claims 1-4, 16, and 18-20.

CONCLUSION

We therefore conclude that the Examiner erred in rejecting claims 1-20 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner rejecting claims 1-20 is reversed.

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REVERSED

tdl/gw

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402