Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte GARY W. DiTROIA

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Appeal No. 2004-2024
Application No. 10/138,716

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ON BRIEF
REQUEST FOR REHEARING

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Before ABRAMS, McQUADE, and BAHR, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

This case comes before us on request for rehearing of our decision of September 9, 2004, wherein we affirmed the examiner's rejections of claims 1-10, 17, 20, 22, 23 and 25.

While we have considered the arguments set out by the appellant, we have decided not to modify our decision, and therefore the Request for Rehearing is DENIED.

BACKGROUND

The appellant's invention relates to an electrical connector. An understanding of the invention can be derived from a reading of exemplary claim 1. Before us were two rejections under 35 U.S.C. § 102(b), claims 1-10 and 22 as being anticipated by Alvarez and claims 17 and 25 as being anticipated by O'Loughlin, and two rejections under 35 U.S.C. § 103(a), claim 20 as being unpatentable over Alvarez in view of Dillon, and claim 23 as being unpatentable over O'Loughlin in view of Dillon.

OPINION

The objective of the invention is to provide improvements in connectors for connecting together at least two angled electrical conductors. As recited in independent claims 1 and 17, the connector comprises first and second sections which are "comprised of a single extruded metal member." Independent claim 1 was rejected as being anticipated by Alvarez, and independent claim 17 as being anticipated by O'Loughlin. The only argument advanced by the appellant with regard to either of these rejections in the briefs was that neither reference discloses or teaches that the electrical connector is an "extruded" metal member and thus they could not anticipate the claims. For the reasons set forth on pages 4-8 of our decision, we found this argument not to be persuasive, and we sustained both of the rejections. The essence of our decision was that the claimed connector is a product by process in that it is manufactured by the process of extrusion and therefore the claim is, in fact, a product by process claim, and

that the appellant failed to provide evidence that there was a structural difference between the connectors disclosed in the two anticipatory references. This was basic to the decision to sustain all four rejections.

The appellant has set forth four alleged errors committed by this panel of the Board in the Request for Rehearing. The first of these is that we erred in failing to review the matter "as a person skilled in the art," who would have known that an extruded member "comprises less stress than a non-extruded member which is bent into a formed shape" (page 2). However, from our perspective there is no evidence in the record to support such a conclusion. The appellant has referred us to two portions of the text on page 10 of the specification for such support. The first (lines 10 and 11) is that "[d]ue to the use of compression technology, the first and second sections 14, 16 can be range taking." There is no correlation between this statement and the process of extrusion, and we thus are at a loss to appreciate its relevance to the error on our part that the appellant is alleging here. The second (lines 20-31) begins by stating "[b]ecause of the extrusion process, the present invention can provide a connector which can provide a very high-quality connection," and goes on to explain that "because only two connections are being made rather than four, installed connectors can be more resistant to mechanical stress and long-term corrosion with a connector incorporating features of the present invention." This passage fails to support the appellant's argument that one of ordinary skill in the art would have understood that there is a

structural difference between an extruded connector and a connector formed by other methods. Moreover, neither passage constitutes evidence that there is a structural difference between an extruded connector and one made by another process, such as stamping, for example. In this regard, we note in passing that the appellant has stated on page 8 of the specification that "[t]he one-piece member 12 is preferably comprised of a one-piece extruded member 34" (lines 23 and 24; emphasis added), which would seem to indicate that it was contemplated that the connector can be formed by processes other than extrusion.

It also is worthy of mention that even if we were to accept the appellant's proposition that one of ordinary skill in the art would have known that an extruded member has less internal stress than a member that is bent into shape, this does not, in and of itself, establish that there is a structural difference between a member that is extruded into shape and one that is bent into shape. Moreover, the appellant's position in the Request for Rehearing regarding the knowledge to be imparted to of one of ordinary skill in the art would appear to support a conclusion that, as a general concept, it would have been within the skill of the artisan to extrude a member or to form it by other known applicable methods.

The second error alleged by the appellant is that case law, as evidenced by In re Steppan and In re Garnero, establishes that limitations such as "extruded" "are considered structural limitations not subject to the product-by-process rules" (Request,

page 3). We do not agree. In the former case the issue was whether the phrase "condensation product" as used in claim 25 should be interpreted as a product-by-process limitation, as the examiner had urged, in which case the claim would be an improper product-by-process claim, or merely as a definition what the acid phosphate which is the subject of the claim is, as the appellant argued. For several reasons, the court did not sustain the examiner's position. However, the appellant here has not directed us to precisely where the court stated in their decision "that words such as 'condensation product' . . . are not purely process limitations; they are also structural," as the appellant contends on page 3 of the Request for Rehearing.

In Garnero the question was whether in a claim to a composite, porous, thermal insulation panel the recitation of perlite particles as being "interbonded to one another by interfusion between the surfaces of the perlite particles" was a structural limitation. The court found that it was, in the same manner as were the terms intermixed, ground in place, press fitted, etched and welded, "all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations" (emphasis added). In the case at bar, the court found the claim terminology to be so capable, that is, as reciting a structural rather than a process limitation. However, the issue before us here is not the means by which separate elements are joined together, as was the situation in Garnero, but the process by which a single element is formed, and therefore we find Gareno not to persuasive.

However, In re Dike[1] considered a situation like that before us in the present case. In Dike, claim 3 recited "[a]n integral one-piece, blow-molded plastic container" (emphasis added). The examiner took the position that "blow-molded" related only to the process by which the plastic container was manufactured and did not add a structural limitation that patentably defined over the prior art structure, which was not blow-molded. In affirming the examiner's position, the court stated that the claim was directed to the article rather than the method of making it, and "this is a case where the product itself is not patentably distinguished over the prior art, and process limitations cannot impart patentability to it" (157 USPQ at 585).

The third error alleged by the appellant is that we ignored the adjective "extruded" in our analysis of the patentability of the claims. We did not, for, as we explained in our decision, we agreed with the examiner that it was a process recitation that did not patentably distinguish the claim over the prior art.

The fourth alleged error was that we redrafted the claim language "from extruded metal member" to "metal member as a product of the process of extrusion." That is not the case. We merely interpreted the claim in the light of the guidance provided by our reviewing court.

The fact of the matter is, as we stated on pages 5 and 6 of our decision, that the examiner provided a reasonable rationale for the rejection, thus shifting the burden to

[1]394 F.2d 584, 157 USPQ 581 (CCPA 1968).

the appellant, and the appellant failed to provide evidence establishing that the claimed connector differed in structure from those of the two anticipatory references in such a manner as to cause the claims to be patentably distinct. The extent to which the appellant replied is to argue that an extruded member "would have less internal stresses than sheet metal that has been formed (Brief, page 6), "has properties" that a non-extruded member would not have, which "could provide the advantage" of increased range taking capability (Brief, page 6; Reply Brief, page 2).

CONCLUSION

While we have reconsidered our decision in the light of the arguments presented in the Request for Rehearing, we have decided not to alter our decision. This being the case, the Request for Rehearing is denied.

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

DENIED

NEAL E. ABRAMS Administrative Patent Judge	)	
JOHN P. McQUADE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

NEA/lbg

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