

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WALTER W. BACHLE  
and JEFFREY R. EDGERLY

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Appeal No. 1997-1358  
Application 07/874,651<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, JERRY SMITH and HECKER, 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 20-39, which  
constitute all the claims remaining in the application.

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<sup>1</sup> Application for patent filed April 27, 1992.

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Amendments after final rejection were filed on March 26, 1995 and August 31, 1995, and each amendment was entered by the examiner.

The disclosed invention pertains to a connector for armored electrical cable apparatus.

Representative claim 20 is reproduced as follows:

20. A connector for armored electrical cable apparatus which comprises:

a body having a central bore, said body having a generally cup shaped seat disposed in generally aligned relationship to said bore, said body having threads disposed on a surface 12d thereof;

a dual finger member comprising a generally cylindrical member having an axial midsection, a first plurality of axially extending fingers disposed about the circumferential extent of said generally cylindrical member and a second plurality of axially extending fingers disposed about the circumferential extent of said generally cylindrical member, the free ends of all of said first plurality of axially extending fingers being disposed at a first axial extremity of said generally cylindrical member and the free ends of all of said second plurality of axially extending fingers being disposed at a second axial extremity of said generally cylindrical member, said first plurality of axially extending fingers and said second plurality of axially extending fingers not extending past said axial midsection, each of said first plurality of fingers have a notched portion thereof proximate to the free end thereof; and

a nut dimensioned and configured for engagement with said threads on said body.

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The examiner relies on the following references:

Bawa et al. (Bawa)	4,549,037	Oct. 22, 1985
Schnittker	4,885,429	Dec. 05, 1989
Binder (German application)	DE 3512578	Oct. 16, 1986

Claims 20-39 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Binder in view of Schnittker with respect to claims 20-23 and Schnittker in view of Bawa with respect to claims 24-39.

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

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. 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

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rationale in support of the rejections 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 claims 20-23. We reach the opposite conclusion with respect to claims 24-39. Accordingly, we affirm-in-part.

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), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having

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ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In response to a rejection made under 35 U.S.C. § 103, an applicant must present arguments and/or evidence which successfully rebut the examiner's case for obviousness or which demonstrate that a prima facie case of obviousness has not been established. For purposes of deciding this appeal, 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 [see

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37 CFR § 1.192(a)].

We consider first the rejection of claims 20-23 as being unpatentable over the teachings of Binder in view of Schnittker. Since appellants only address this rejection with respect to independent claim 20, claims 20-23 will stand or fall together, and we will consider independent claim 20 as the representative claim. With respect to this first rejection, the examiner essentially determines that Binder discloses all the features of these claims except for the use of a grommet within the first plurality of fingers. The examiner observes that Schnittker teaches a grommet within tabs, and the examiner asserts that it would have been obvious to the artisan to use Schnittker's grommet in Binder's connector [answer, page 3].

We note that there is no grommet recited in independent claim 20. The grommet first appears in dependent claim 21. Thus, the examiner has not identified anything in claim 20 which is not disclosed by Binder. Appellants focus their attention only on the portion of claim 20 which recites that "each of said first plurality of fingers have a notched

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portion thereof proximate to the free end thereof." Although the examiner has pointed to the ridges or notches 9 near the free ends of fingers 3 and 4 of Binder as meeting the "notched portion" of claim 20, appellants argue that the elements 9 of Binder are not notched portions as that term was used in their specification. Appellants argue that they are allowed to be their own lexicographer, and the term "notched portion" should be interpreted as intended in the disclosure [brief, pages 9-10; reply brief, page 1].

In view of the positions of appellants and the examiner, the only question presented to us with respect to claim 20 is whether the ridges 9 of Binder can be considered to be notched portions within the meaning of claim 20. We follow the general rule that claims are to be given their broadest reasonable interpretation during prosecution. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). It is improper to narrow the scope of the claim by implicitly reading in disclosed limitations from the specification which

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have no express basis in the claims. See Id. Although appellants are correct that they are entitled to be their own lexicographer, where an inventor chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change. Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992).

On the record before us, we find that the present specification does not define the term "notched portion" in a manner which would alert the artisan that a specific definition is assigned to that term. We agree with the examiner that the artisan would ordinarily assume that the ridges 9 proximate to the free end of Binder's fingers 3 and 4 would be considered "notched portions" as that term is ordinarily interpreted. Therefore, we agree with the examiner that the broad interpretation of "notched portion" as used in claim 20 reads

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on the notched portions 9 as shown in Binder. It is appellants' responsibility to either provide a specific definition for "notched portion" in the disclosure or to recite the structure of the notched portions within the claims so as to distinguish the invention from the prior art.

Since the examiner has essentially found all the elements of independent claim 20 within the disclosure of Binder, and since appellants' argument with respect to claim interpretation has been decided adversely to them, we sustain the rejection of claims 20-23 as being unpatentable over the collective teachings of Binder and Schnittker.

We now consider the rejection of claims 24-39 as being unpatentable over the teachings of Schnittker in view of Bawa. With respect to these claims, the examiner asserts that Schnittker teaches all the features of these claims except for three specific features. The examiner finds that some of these features are taught by Bawa and others of these features are obvious design choices [answer, pages 3-4]. The examiner concludes that the invention of claims 24-39 would have been obvious to the artisan in view of the combined teachings of

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Schnittker and Bawa. Although appellants challenge the propriety of the examiner's use of design choice in rejecting these claims, the examiner simply reiterates this position.

With respect to the general arguments made by appellants with respect to independent claim 24 [brief, pages 11-15], we agree with appellants that the examiner has failed to make a persuasive case that the collective teachings of Schnittker and Bawa would have led to the invention as recited in claim 24. There is no suggestion in these references that Bawa's O-ring should be added to Schnittker's connector in the precise manner recited in claim 24. We also agree with appellants that the examiner has improperly relied on design choice as a basis to ignore the argued differences between the claimed invention and the prior art.

Appellants also make a specific argument with respect to claim 24 regarding the lack of a teaching of the claimed axial extent of the free ends of the fingers of the dual finger member. The examiner has ignored this argument, and we agree with appellants that the dual finger member shown in

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Schnittker's Figure 3 does not teach or suggest the recitations of claim 24.

Therefore, the examiner has failed to establish a prima facie case of the obviousness of independent claim 24. Accordingly, we do not sustain the rejection of claim 24 or of claims 25-32 and 39 which depend therefrom.

With respect to independent claim 33, appellants argue that no ring of any kind is shown in the applied references and there is especially no teaching of a split ring armor stop member as recited in claim 33 [brief, page 17]. The examiner has not addressed this argument other than to dismiss the split ring stop member as an obvious design choice. As we noted above, the examiner cannot substitute the bald observation of design choice for evidence specifically lacking in the record. Thus, the examiner has failed to provide a prima facie case of the obviousness of independent claim 33. Therefore, we do not sustain the rejection of claim 33 or of claims 34-38 which depend therefrom.

In summary, we have sustained the examiner's rejection with respect to claims 20-23, but we have not sustained the

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examiner's rejection with respect to claims 24-39.  
Accordingly, the decision of the examiner rejecting claims 20-39 is affirmed-in-part.

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

AFFIRMED-IN-PART

	KENNETH W. HAIRSTON	)	
	Administrative Patent Judge	)	
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	JERRY SMITH	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES

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STUART N. HECKER  
Administrative Patent Judge

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