

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL MURPHY

Appeal No. 1998-1773
Application No. 08/609,303¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge,
ABRAMS and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 25 through 50, which are all of the claims pending in this application.²

¹ Application for patent filed March 1, 1996.

² Claim 27 was amended subsequent to the final rejection.

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We REVERSE.

BACKGROUND

The appellant's invention relates to a system for terminating the shield of a high speed cable. An understanding of the invention can be derived from a reading of exemplary claims 25, 31, 37 and 44 (the independent claims on appeal), which appear in the appendix to the appellant's brief.

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

Schantz 1975	3,916,139	Oct. 28,
Dohi 30, 1990	4,966,565	Oct.
Brunker et al. 19, 1994 (Brunker)	5,304,069	Apr.

Claims 25, 28, 29, 31, 34, 35, 37, 39 to 42, 44 and 46 to 49 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brunker in view of Schantz.

Claims 26, 27, 30, 32, 33, 36, 38, 43, 45 and 50 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bruncker in view of Schantz and Dohi.

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 (Paper No. 13, mailed January 12, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 11, filed December 19, 1997) and reply brief (Paper No. 14, filed March 13, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness

with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 25 through 50 under

35 U.S.C. § 103. Our reasoning for this determination follows.

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, 9 F.2d 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, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The appellant argues (brief, pp. 16-20 and reply brief, pp. 1-7) that the applied prior art does not suggest the subject matter set forth in the independent claims on appeal. We agree.

Independent claim 25 requires "a pair of loops . . . for receiving said exposed portion of said metallic shield . . . so that said metallic shield can be bonded to said ground member while said exposed portion is within said loop."

Independent claim 31 requires "a loop . . . for receiving said exposed portion of said metallic shield . . . so that said metallic shield can be bonded to said ground member while said exposed portion is within said loop." Independent claim 37 requires "a pair of loops . . . for receiving one of said cables at a location along said cable in registry with said exposed portion of said metallic shield." Independent claim 44 requires "positioning said exposed portion of said metallic shield . . . within one of a pair of loops . . .; and bonding said exposed portion of said metallic shield to said ground member while said exposed portion is positioned in said loop." However, these limitations are not suggested by the applied prior art. In that regard, while Schantz does teach utilizing a tab 16 to hold a conductor end 24 to a terminal 10 when soldering the conducting end to the terminal, Schantz would not have suggested using tabs to secure the metallic shields of Bruncker's cables 108 to the ground plate 104.

In our view, the only suggestion for modifying Bruncker in the manner proposed by the examiner (answer, p. 5) to meet the above-noted limitations stems from hindsight knowledge derived

from the appellant's own disclosure.³ In fact, we agree with the appellant's argument (reply brief, p. 5) that the combined teachings of Brunker and Schantz would have suggested modifying the connections between the inner conductors of the cables 108 and the terminals 106, not the connections between the metallic shields of Brunker's cables 108 and the ground plate 104.

We have also reviewed the Dohi reference but find nothing therein which makes up for the deficiencies of Brunker and Schantz discussed above.

For the reasons stated above, the decision of the examiner to reject claims 25 through 50 under 35 U.S.C. § 103 is reversed.

³ The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

CONCLUSION

To summarize, the decision of the examiner to reject claims 25 through 50 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/609,303

APJ NASE

APJ ABRAMS

SAPJ McCANDLISH

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 10 Mar 99

FINAL TYPED: