

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS F. BURKE, PAT WHITE,
MATTHEW WILHITE, and MARY O'HALLORAN

Appeal No. 1998-2146
Application No. 08/660,482

ON BRIEF

Before THOMAS, HAIRSTON, and BLANKENSHIP, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-9.

We reverse.

BACKGROUND

The invention is directed to an electrical connector assembly. Claim 1 is reproduced below.

1. An electrical connector assembly for electrically terminating the conductors of a multi-conductor insulated cable, comprising:

a connector housing base having a plurality of terminal-receiving passages;

a connector housing cover positionable on the base to provide a cable-receiving passage therebetween, the cable-receiving passage traversing said terminal-receiving passages;

complementary interengaging latch means between the base and the cover to hold the base and cover together, after moving the base and cover toward each other, clamping the cable in the cable-receiving passage; and

a plurality of terminals movably mounted in the terminal-receiving passages for movement, independent from the movement of the base and cover toward each other, between inactive positions out of engagement with the conductors of the cable and engaging positions electrically engaging the conductors of the cable.

The examiner relies on the following references:

Stephenson	4,410,229	Oct. 18, 1983
Noda	5,498,172	Mar. 12, 1996

Claims 1-5 and 7 stand rejected under 35 U.S.C. § 102 as being anticipated by Noda.

Claims 6, 8, and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Noda and Stephenson.

Claims 11 and 12 have been withdrawn from consideration.

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We refer to the Final Rejection (Paper No. 5) and the Examiner's Answer (Paper No. 8) for a statement of the examiner's position and to the Brief (Paper No. 7) and the Reply Brief (Paper No. 9) for appellants' position with respect to the claims which stand rejected.

OPINION

The section 102 rejection of claims 1-5 and 7 over Noda is set forth on page 4 of the Answer. Initially, we note that the rejection points to structures in two separate embodiments of Noda's invention. The housing base, housing cover, complementary latch means, and terminals are pointed out in the first embodiment (Figs. 1-7). Movement, or capacity for movement, of the "plurality of terminals" is alleged to be shown in Figure 17, which is part of Noda's second embodiment, depicted in Figures 8-25.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). Although not supportive of an anticipation rejection, Noda discloses (column 7, lines 32-34) that contact members, provided by injection molding in the first embodiment, may instead be "fitted" with the housing 21. The reference thus contains express suggestion to combine a teaching from the second embodiment -- a teaching we will address infra -- with structures disclosed in the first embodiment.

In any event, in view of appellants' arguments in the Brief, and particularly the response submitted in the Reply Brief, appellants take the position that the examiner has effectively ignored the final portion of claim 1. We agree with appellants that Noda does not meet all the limitations of claim 1.

In the Answer (page 6) the examiner again refers to Figure 17 of Noda and stresses movement of "terminals" 47¹ as being independent from movement of the base and cover. "[T]hey could be moved into the terminal receiving passages after the cable is first gripped between the base and the cover."

Noda's second embodiment, which includes terminals 47, is described at column 7, line 45 through column 12, line 5. Contact members 47, during manufacture of the electrical connector, are press fitted into housing 37 (Figs. 8 and 17). As shown in Figures 17 and 24, contact member 47 is allowed to move slightly within housing 37 to account for any differences in pressing force between main cable 28 and branch cable 30 when the cables are crimped. However, as shown in the figures, and as described in particular at column 11, lines 25 through 44, the connector is designed such that movement of contact member 47 is limited by the depth of groove 51 in upper or lower cover 49. As made plain in Figures 17 and 24, the reference does not disclose a combination including terminals mounted for movement "between inactive positions out of engagement with the conductors of the cable [28 or 30] and engaging positions electrically engaging the conductors of the

¹ We again note, however, that the statement of the rejection refers to terminals 24 (Figs. 1-7).

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cable.” A variation of the second embodiment, shown in Figure 25, also limits movement between a housing, in one direction, and protrusions 47d, in the other direction.

Noda thus fails to disclose what is claimed. The rejection also fails to the extent of any basis on the view that structures disclosed by Noda would inherently be capable of performing the claim 1 “movement” function associated with the “plurality of terminals.” Our reviewing court has set out clear standards for establishing inherency, which are not satisfied on this record.

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

(citations omitted).

We therefore agree with appellants that Noda does not support a finding of anticipation of independent claim 1, nor of claims 2-5 and 7, depending from 1. The other independent claim at issue (claim 8) sets forth, inter alia, a “plurality of insulation displacement terminals” similar in scope to the terminals set forth in claim 1. Since Stephenson does not remedy the deficiencies we note in Noda, we cannot sustain the section 103 rejection of claims 6, 8, and 9 over Noda and Stephenson.

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CONCLUSION

The rejections of claims 1-9 are reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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