

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL G. JONES

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Appeal No. 1999-0431  
Application 08/541,135

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ON BRIEF

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Before THOMAS, KRASS and JERRY SMITH, 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 1-21, which constitute all the claims in the application.

The disclosed invention pertains to a protective cover for a cable connector. More particularly, the protective cover uses a material which is expandable by contact with an

expanding chemical and shrinkable upon removal of the chemical.

Representative claim 1 is reproduced as follows:

1. A protective cover for a cable connector, said connector being affixed to an end of a cable and having an outside diameter greater than an outside diameter of said cable, said cover comprising:

an outer elongated annular sleeve formed from a material expandable by contact with an expanding chemical and shrinkable upon removal of said contact with said chemical;

an inner elongated annular sleeve formed from a material expandable by contact with an expanding chemical and shrinkable upon removal of said contact with said chemical, said inner elongated annular sleeve disposed within said outer sleeve;

said cover with said sleeves in chemically expanded state being moveable into disposition covering said connector and a portion of said cable attached thereto, with said inner sleeve covering at least said portion of said cable but not said connector;

whereby when said cover is so disposed over said connector and said portion of said cable and removed from contact with said chemical, said chemical evaporates from said sleeves and said sleeves thereupon shrink to diameters wherein wall thickness of said inner sleeve fills the space between the outside diameters of said connector and said attached portion of said cable sufficiently to permit shrinkage of said outer sleeve to form a tightly fitted and substantially immovable covering secured around said connector and at least a portion of said inner sleeve, thereby preventing said connector from coming into contact with adverse ambient components.

The examiner relies on the following references:

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Clemence et al. (Clemence)	4,419,322	Dec. 06, 1983
Guzay, Jr. (Guzay)	4,506,430	Mar. 26, 1985
Feitzelmayer	4,976,796	Dec. 11, 1990

Claims 1-21 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Guzay in view of Clemence with respect to claims 1-11, and Feitzelmayer is added with respect to claims 12-21<sup>1</sup>.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief 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 appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

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<sup>1</sup> Although the "Issues" section of the examiner's answer has moved claim 14 from the second group of claims to the first group of claims, the "Grounds of Rejection" section of the answer rejects the claims as indicated in this decision.

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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 not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-21. Accordingly, we reverse.

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 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,

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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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1-11 based on the teachings of Guzay and Clemence. These claims stand or fall together as a single group [brief, page 7]. With respect

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to representative, independent claim 1, the examiner cites Guzay as teaching an elastic cover for a cable connector which has an inner sleeve and an outer sleeve. The examiner notes that Guzay does not teach the sleeves being expandable by contact with an expanding chemical and shrinkable upon removal of the chemical. The examiner cites Clemence as teaching the cold shrinking of elastomeric materials by allowing a swelling agent to vaporize. The examiner finds that it would have been obvious to the artisan to apply the sleeves of Guzay to a cable connection using a volatile swelling agent and allowing its evaporation to shrink the sleeves because Clemence teaches this technique for adhering a cover to a cable connection [answer, pages 4-5].

Appellant argues that the examiner has selectively chosen portions from Guzay and Clemence and ignored the complete teachings of these references. Appellant argues that the teachings of Guzay and Clemence are incompatible because Guzay relates to mechanical or physical stretching of material while Clemence relates to a chemical swelling process. Appellant argues that combining the teachings of Guzay and Clemence would render both covers ineffective for their

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intended uses [brief, pages 8-14]. The examiner disagrees with these arguments [answer, pages 6-7].

We agree with the position argued by appellant. Although Guzay recognizes that covers using physical elasticity may have uses in common with elastic sleeves which are chemically shrinkable, we can find no reason why the artisan would start with the two sleeves of Guzay if the covering were to be done using a chemical shrink. The cover in Guzay uses an inner sleeve and an outer sleeve only to permit the outer sleeve to be pulled relative to the inner sleeve to achieve its final form. This final form does not have two sleeves. There would be no point to starting with two sleeves in Guzay if the sleeves are not going to be pulled relative to each other. Since a chemical shrink cover would have no use for the sleeves of Guzay, we can find no reason for using the two sleeves of Guzay in the manner proposed by the examiner. The most that might be suggested by Guzay and Clemence is that a single sleeve of shrinkable material could be used in place of Guzay's sleeve 12 in its final form as shown in Figures 8 and 11.

Thus, we agree with appellant that the invention of

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claim 1 can only result from the teachings of Guzay and Clemence if one is attempting to reconstruct the claimed invention in hindsight. Such a hindsight reconstruction of the invention is improper. Therefore, we do not sustain the rejection of claims 1-11 as formulated by the examiner.

We now consider the rejection of claims 12-21 based on the teachings of Guzay, Clemence and Feitzelmayer. These claims stand or fall together as a single group [brief, page 7]. The examiner cites Feitzelmayer to teach certain details of the claimed inner and outer sleeves. The examiner acknowledges that Feitzelmayer was not cited to overcome any deficiencies in the combination of Guzay and Clemence. Appellant argues that Feitzelmayer has no relationship to the claimed invention and does not overcome the deficiencies in the basic combination of Guzay and Clemence.

We agree with appellant. Since Feitzelmayer does not overcome the basic deficiencies in the combination of Guzay and Clemence discussed above, we do not sustain the rejection of claims 12-21 for the same reasons discussed above with respect to claim 1.

In summary, we have not sustained either of the

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examiner's rejections of the appealed claims. Therefore, the  
decision of the examiner rejecting claims 1-21 is reversed.

REVERSED

	JAMES D. THOMAS	)	
	Administrative Patent Judge	)	
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	ERROL A. KRASS	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	JERRY SMITH	)	
	Administrative Patent Judge	)	

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Brown, Martin, Haller and McClain  
1660 Union Street  
San Diego, CA 92101

JS/ki