

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUYA AKASHI, KAZUO ENOMOTO, NAOKI GOSHIMA,
KENICHIROU TAKAHASHI, HIDEKI KAWAMURA,
TAKESHI HASEGAWA, YASUO TAKEMURA,
HIDETAKA YAMAZAKI
and ATSUSHI HAMADA

Appeal No. 2001-1454
Application 08/412,118

ON BRIEF

Before JERRY SMITH, FLEMING and SAADAT, 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 18-21, 23, 24 and 26-37, which constitute all the claims remaining in the application. An amendment after final rejection was filed on April 18, 2000 and was entered by the examiner.

The disclosed invention pertains to a wire harness that facilitates the routing of electrical wires through a structure to electrically connect a plurality of electrical devices.

Representative claim 18 is reproduced as follows:

18. A wire harness comprising:

a substantially flat cable including a plurality of parallel electric wires covered with an insulating coating for insulating said wires and for maintaining said wires substantially parallel, said cable including a trunk portion separating into at least first and second branch portions;

a connector provided at a distal end of said trunk portion; and

a joint device spaced from said connector and electrically connecting at least two wires, including a first wire extending from said joint device into said first branch portion and a second wire extending from said joint device into said second branch portion, said joint device thereby short circuiting said first and second branch portions;

wherein said first and second wires are electrically disconnected from said connector between said joint device and said connector.

The examiner relies on the following references:

Plummer	3,627,903	Dec. 14, 1971
Fry (Fry '428)	3,733,428	May 15, 1973
Fry (Fry '848)	3,819,848	June 25, 1974
Kosugi et al. (Kosugi)	GB 2,141,593	Dec. 19, 1984

The following rejections are on appeal before us¹:

1. Claims 18, 24, 26, 30, 35 and 37 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Plummer in view of Fry '848.

2. Claims 19-21, 23 and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Plummer in view of Fry '848 and Fry '428.

3. Claims 27, 29, 31, 33 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Plummer in view of Fry '848 and further in view of Kosugi.

4. Claims 28 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Plummer in view of Fry '848 and Fry '428 and further in view of Kosugi.

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

¹ The rejection of the claims under 35 U.S.C. § 112, first paragraph, made in the final rejection was not repeated in the examiner's answer and is presumed to have been withdrawn based on the amendment filed after the final rejection.

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consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's 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 not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims on appeal. 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, 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

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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 appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 18, 24, 26, 30, 35 and 37 based on the teachings of Plummer and Fry '848. The examiner finds that Plummer teaches the claimed invention except for the insulating coating covering the wires and the explicit disclosure of connectors. The examiner cites Fry '848 as teaching the use of an insulating coating for a wire harness, and the examiner asserts that it would have been obvious to the artisan to apply this insulating coating to the wire harness of Plummer. The examiner also notes that Fry '848 teaches the use of wires having different

diameters, and the examiner finds that it would have been within the level of ordinary skill in the art to employ wires having different diameters with different thicknesses of insulation. Finally, the examiner asserts that it was well known to use connectors for a wire harness and that it would have been obvious to use connectors with the wire harness of Plummer [answer, pages 4-5].

With respect to independent claims 18 and 30, appellants argue that the references cited by the examiner do not disclose or suggest the use of a connector as claimed. Specifically, appellants argue that since the references cited do not teach the use of a connector, then the references also fail to teach the specific connections claimed which relate to this connector. Appellants argue that the examiner has found obviousness of the claimed invention based on the examiner's own unsupported statements rather than on evidence [brief, pages 9-11].

The examiner responds that Plummer clearly suggests the use of connecting means between the branchout groups of conductors and the various subgroups of electrical components, and the examiner asserts that it would have been "common sense" to employ connectors to facilitate the connection of the claimed wire harness and the electrical components [answer, pages 7-9]. Appellants repeat their assertion that the examiner's findings are based on the unsupported opinion of the examiner [reply brief].

We do not sustain the examiner's rejection of independent claims 18 and 30 because the examiner has failed to establish a prima facie case of obviousness. As noted above, the examiner has the burden of initially presenting a prima facie case of obviousness. The examiner cannot satisfy this burden by simply dismissing differences between the claimed invention and the teachings of the prior art as being obvious or well known. The examiner must present us with an evidentiary record which supports the finding of obviousness. It does not matter how strong the examiner's convictions are that the claimed invention would have been obvious, or whether we might have an intuitive belief that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103. Neither circumstance is a substitute for evidence lacking in the record. Whether there is prior art available which would render these appealed claims unpatentable we cannot say. We can say, however, that the record presently before us does not support the rejection as formulated by the examiner. We agree with appellants that the evidentiary record before us does not teach or suggest the use of a connector of any kind, much less the use of a connector connected to the remaining components as specifically set forth in the claims. The examiner's assertion that Plummer suggests a connector as claimed is unsupported by the reference.

With respect to independent claim 24, appellants argue that although Fry '848 does disclose a wire harness having different sized wire diameters and insulating coating thicknesses, Fry '848 does not disclose the particular wire diameter

configuration recited in claim 24. Appellants again argue that the examiner has found obviousness of the claimed invention based on the examiner's own unsupported statements rather than on evidence [brief, pages 11-12].

The examiner responds that the claimed thicknesses of the insulation and the wires would have been an obvious matter of design choice [answer, page 9].

We do not sustain the examiner's rejection of independent claim 24 because the examiner has again failed to establish a prima facie case of obviousness for the same reasons discussed above. The particular relationship of the thicknesses of the wires and the insulation recited in claim 24 cannot simply be dismissed by the examiner as an obvious matter of design choice. The examiner should not, in general, rely on per se rules of obviousness such as a change in size is always obvious. The examiner should consider the specific recitations of the claims and the specific teachings of the applied prior art and provide a cogent analysis as to why the proposed modification of the prior art would have been obvious within the meaning of 35 U.S.C. § 103.

We now consider the rejection of claims 19-21, 23 and 26 based on the teachings of Plummer, Fry '848 and Fry '428. Plummer and Fry '848 are applied as noted above. The examiner cites Fry '428 as teaching the use of wires having different diameters for a wire harness. The examiner again asserts that the specific claimed thicknesses of the wires and the insulation would have been within the level of ordinary skill in the art [answer, pages 5-6].

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With respect to independent claim 19, appellants argue that the combination of Plummer and Fry '848 does not teach or suggest the wire diameter configuration recited in claim 19. They also argue that Fry '428 does not overcome the deficiencies in the basic combination [brief, pages 14-15].

We do not sustain the examiner's rejection of independent claim 19 because the examiner has failed to establish a prima facie case of obviousness for reasons discussed above.

In summary, we have not sustained the examiner's rejection of any of the independent claims on appeal. Since the rejection of the independent claims is unsupported by the applied prior art, and since the additionally applied references do not overcome the deficiencies discussed above, we also do not sustain the examiner's

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rejection of any of the dependent claims on appeal. Therefore, the decision of the examiner rejecting claims 18-21, 23, 24 and 26-37 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

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