

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 JOSE H. CHAVEZ JR, GARY M. COMSTOCK, ARVIND PATEL,
TIMOTHY E. PURKIS and YEW TECK YAP

Appeal No. 2001-0141
Application No. 09/016,851

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge
COHEN and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 12 which are all the claims pending in the application.

Appellants' invention relates to a method of manufacturing a terminal module. An understanding of the invention can be derived from a reading of exemplary claim 7 which appears in the appendix to the brief.

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The prior art

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Capp et al. (Capp)	5,060,372	Oct. 29, 1991
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The rejection

Claims 1 through 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Capp.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 8) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 7) and reply brief (Paper No. 9) for the appellants' arguments thereagainst.

Opinion

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the

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respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Before considering the merits of the matter, it is necessary to address the grouping of the appealed claims under 37 CFR § 1.192(c)(7) as amended effective April 21, 1995. In the brief, the appellants state that all the claims stand or fall together (brief at page 9). Therefore, we select claim 7 as the representative claim so that claims 1 through 6, and 8 through 12 stand or fall with claim 7.

The rejection in the case is made under 35 U.S.C. § 102(b). We initially note that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court

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in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

In the instant case, the appellants argue that the Capp reference does not disclose the following shearing step recited in claim 7:

shearing said blank to separate said terminal portions forming edges immediately adjacent one another, **each edge sharing the same shear line with an immediate adjacent edge;** (emphasis added)

The appellants argue that the phrase "each edge sharing the same shear line with an immediate adjacent edge" means that no material is removed during the shearing process. The examiner argues that the claims do not recite that no material is removed during the shearing process and thus the lack of removal of material during the shearing process can not form the basis for patentability.

We agree with the appellants. In our view, it is inherent in a shearing process in which each edge shares the same shear line that no material is removed in the shearing process.

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In regard to Capp, appellants concede (reply brief at page 2) that some "shearing" takes place presumably in the cutting process discussed at col. 2, lines 58 to 59). In addition, it is our view that finger 13 and adjacent contact 9 share the same shear line prior to the pivoting of finger 13. As such, in our view, Capp does indeed disclose the shearing step of claim 7 quoted above. Therefore, we will sustain the examiner's rejection of claim 7 and claims 1 through 6 and 8 through 12 which stand or fall with claim 7. However, as our rationale is somewhat different from that on which the examiner based his rejection, we designate this rejection as a new rejection under 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

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(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

AFFIRMED § 1.196(b)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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))	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
))	INTERFERENCES
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MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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