

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIGETO KAWAMURA and ATSUSHI FUJISAWA

Appeal No. 1998-0501
Application No. 08/518,997

HEARD: February 23, 2000

Before HAIRSTON, FLEMING, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5, 7-13 and 20, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a semi-transparent protective construction for splice portions using semi-transparent hot melt. An understanding of the invention can be derived from a reading of exemplary claim 5, which is reproduced below.

5. A protective construction for spliced portions of a plurality of wires, comprising:

an at least partially transparent cap for enclosing said portions; and

at least a portion of said cap being filled with at least partially transparent hot melt;

wherein an object placed in said hot melt is visible through said cap and hot melt, and

wherein said object does not contact an inner periphery of said cap.

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

Berbeco	4,662,514	May 05, 1987
Preissler ¹ (France Patent Publication)	1,433,716	Feb. 21, 1966

Claims 5, 7-13 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Preissler in view of Berbeco and appellants' own disclosure at page 7.

¹A copy of the translation by S.T.I.C. Translation Branch, dated January 13, 1988, is attached.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 19, mailed Dec. 8, 1997) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 18, filed Oct. 20, 1997) and reply brief (Paper No. 20, filed 1998) 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 references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that Preissler does not disclose or suggest the use of transparent hot melt in the wiring cap which is also transparent. (See brief at page 4.) We agree with appellants. Appellants argue that the examiner used impermissible hindsight in combining the transparent materials of Berbeco and the disclosed hot melt mentioned in the specification. (See brief at page 5.) We agree with appellants. Furthermore, the appellants argue that the examiner has not provided a teaching or suggestion which would motivate a skilled artisan to want to see inside a cover for splice portions of wires. **Id.** Again, we agree with appellants.

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Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." **In re Keller**, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." **ACS Hosp. Sys., Inc. v. Montefiore Hosp.**, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." **Id.** Here, the prior art contains none. In fact, the advantages of utilizing a transparent material in both the bonding of wires and the cap has not been taught or suggested in the prior art applied by the examiner, and the examiner has not provided a convincing line of reasoning why one skilled in the art would have been motivated to use these transparent materials.

The examiner maintains that "the cap of Preissler is considered to be a storage tube which contains the spliced portions." (See answer at page 5.) We disagree with the examiner. Here, the examiner is manipulating the prior art in an attempt to meet the language of the claim. This is not a reasonable interpretation of the prior art as a whole. In our view, the examiner's analysis of the claimed invention and the application of the prior art applied against the claimed invention lacks an analytical linkage to combine the teachings.

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Instead, the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13

(Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984). It is essential that :

the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art. **W.L. Gore**, 721 F.2d at 1553, 220 USPQ at 313.

Since the limitations concerning the use of transparent materials in both the cap and hot melt are not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claims 5 and 20, and of dependent claims 7-13.

CONCLUSION

To summarize, the decision of the examiner to reject claims 5, 7-13 and 20 under 35 U.S.C. § 103 is reversed.

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REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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