

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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKATATSU YAMAMOTO, SHIGEHIKO KOBAYASHI, and
TOMOHIRO IKEDA

Appeal No. 1999-0426
Application No. 08/247,894¹

ON BRIEF

Before KRASS, LALL, 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 1-4, 6, 8-10 and 16, which are all of the claims pending in this application.

We REVERSE.

¹ Appellants' representative was notified by telephone of the panel's intent to reverse the examiner's rejection. Therefore, the hearing scheduled for March 8, 2001 was canceled.

BACKGROUND

The appellants' invention relates to a waterproof structure for wire harness. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A system for a waterproof wire harness structure, comprising:
 - a) at least one instrument;
 - b) a plurality of electric wires connected to the instrument;
 - c) a plurality of wire connecting parts at which the electrical wires are bundled; and
 - d) a sealant retained by a specified wire connecting part of said wire connecting parts, said sealant having a viscosity less than about 40000 CPS and a hardness after solidification of less than about 50 on the Shore-D scale;

wherein the specified wire connecting part is arranged in a position nearest to the instrument positioned at a tail end of an intruding course of water into said harness.

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

Koblitz et al. (Koblitz)	4,714,801	Dec. 22, 1987
Jervis	4,859,809	Aug. 22, 1989

Claims 1-4, 6, 8-10, and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koblitz in view of Jervis.

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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. 26, mailed Jul. 6, 1998) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 25, filed April 17, 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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is not sufficient to establish a **prima facie** case of obviousness with respect to claims 1, 6, and 16. Accordingly, we will not sustain the examiner's rejection of claims 1, 6, and 16 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a **prima facie** case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A **prima facie** case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to

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make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is **prima facie** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968).

Appellants argue that neither Koblitz nor Jervis teaches or suggests the claim limitation that “a sealant retained by a specified wire connecting part of said wire connecting parts, said sealant having a viscosity less than about 40000 CPS and a hardness after solidification of less than about 50 on the Shore-D scale; wherein the specified wire connecting part is arranged in a position nearest to the instrument positioned at a tail end of an intruding course of water into said harness.” We agree with

appellants. The examiner admits that Koblitz does not teach this limitation. (See answer at page 5.) We agree with the examiner that this is not taught by Koblitz. The examiner states that the “differences between Koblitz’s structure and the subject matter sought to be patented do not render the claimed construction patentable, since various sealing materials including the sealing material with the claimed properties are known in the art, and the selection of any of these known sealants for a waterproof structure of the sort here involved would have been within the level of ordinary skill in the art.” (See answer at pages 3-4.) The examiner further relies upon appellants’ Declaration to show “various sealing materials are known in the art including the sealing material with the claimed properties and the selection of any of these known sealants for a waterproof structure of the sort here involved would have been within the level of ordinary skill in the art.” (See answer at page 4.) While the examiner relies upon the Declaration, the examiner has not set forth any statement by the declarant, Mr. Tomohiro, which supports the examiner’s conclusion. Mr. Tomohiro merely sets forth the array of sealants which were tested and the results of the tests which lead appellants to the claimed invention. Appellants argue that the examiner “has failed to establish even a **prima facie** case of obviousness . . . The examiner simply asserts without citation of any reference that one of ordinary skill in the art would know to use a sealant with the properties recited in the claims.” (See brief at pages 7-8.) We agree with appellants. Appellants argue that there is no motivation to use the

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sealant of Jervis in the case of Koblitz and that the examiner has offered no motivation “other than his unsupported conclusion that it would be obvious to do so.” (See brief at page 8.) We agree with appellants that the examiner has not supported his conclusion that it would have been obvious to one of ordinary skill in the art at the time of the invention to select sealants with the claimed properties. Therefore, we cannot sustain the examiner’s rejection of claims 1-4, 6, 8-10, and 16.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4, 6, 8-10 and 16 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
PARSHOTAM S. LALL)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JOSEPH L. DIXON)	
Administrative Patent Judge)	

JD/RWK

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