

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLF W. BIERNATH, MARK S. KONINGS,
and ROBERT S. REYLEK

Appeal No. 1999-0493
Application No. 08/649,504

HEARD: November 28, 2001

Before PAK, WALTZ, and PAWLIKOWSKI, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 4, 6, 7, 9, 11 and 13 through 32 as amended subsequent to the final rejection (see the amendment dated Mar. 27, 1998, Paper No. 8, entered as per the

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Advisory Action dated Apr. 20, 1998, Paper No. 9).¹ Claims 1-4, 6, 7, 9, 11 and 13-32 are the only claims remaining in this application.

According to appellants, the invention is directed to an electronic assembly that includes a force bearing member that maintains contact between components in the assembly where this member is made from a specific elastomeric composition that is curable at room temperature in less than about 20 minutes (Brief, page 1). A copy of illustrative independent claim 1 is attached as an Appendix to this decision.

The claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over appellants' own admission (specification, page 1, line 22 to page 5, line 25) in view of Yoshino et al. (Yoshino), U.S. Patent No. 4,879,339, issued on Nov. 7, 1989. We reverse this rejection essentially for the

¹ The rejections of various claims under the first and second paragraphs of 35 U.S.C. § 112 as set forth in the final Office action (Paper No. 6, mailed Dec. 22, 1997) have been overcome in view of the entry of this amendment (Brief, page 1). All reference to and citation from the Brief is from the supplemental or amended Brief dated Aug. 12, 1998, Paper No. 14.

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reasons stated in the Brief (pages 4-11) and the reasons set forth below.

OPINION

The examiner finds that appellants admit that the claimed assemblies with force bearing members made from silicone rubber are known but that there is no admission that the specifically claimed room temperature-curable silicone rubber is known (Answer, page 3). Accordingly, the examiner applies Yoshino for the disclosure of a room temperature-curable organopolysiloxane composition which is "similar" to the composition claimed (*id.*). From these findings, the examiner concludes that it would have been obvious "to utilize [the] disclosure of Yoshino et al to produce known electronic assemblies at room temperature." Answer, page 4.

Even assuming *arguendo* that the room temperature-curable organopolysiloxane composition of Yoshino is the same as the claimed force bearing member composition, we determine that the examiner has not presented any convincing evidence or reasoning to make the proposed combination (see the Brief, pages 4-7). "We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art,

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or, in some cases, from the nature of the problem to be solved. [Citations omitted]." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teachings of the references are not "evidence" but the showing must be "clear and particular." *In re Dembiczak, supra*.

The examiner finds that the room temperature-curable organopolysiloxane composition of Yoshino is useful as "electric insulation," citing col. 6, ll. 15-16 (Answer, page 3).² The examiner makes no finding as to the utility of appellants' admitted prior art (Answer, pages 3-5), but implicitly the "known electronic assemblies" (Answer, page 4) use the room temperature curable silicone composition to produce a force bearing member, i.e., an electrical connector (see the specification, page 1, l. 22-page 2, l. 13). On this record, we find no "clear and particular" evidence or reasoning why one of

²We note that Yoshino teaches a room temperature-curable organopolysiloxane composition "suitable for use as a material for imprinting or blocking of form" (col. 1, ll. 10-11), specifically "useful as a material for imprinting or blocking of teeth forms and inserts of external auditory canals, criminal identification, electric insulation, and so on." See col. 6, ll. 13-16.

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ordinary skill in the electrical connector art at the time of appellants' invention would have substituted the room temperature-curable silicone composition of Yoshino, taught to be useful as electrical insulation, for the silicone composition of the admitted prior art which was useful as an electrical connector or force bearing member. Accordingly, we must conclude that the proposed combination is improper and the examiner has not met the initial burden of establishing a *prima facie* case of obviousness. Therefore the rejection of the claims on appeal under 35 U.S.C. § 103(a) over appellants' admission in view of Yoshino is reversed.

The decision of the examiner is reversed.

REVERSED

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CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
BEVERLY A. PAWLIKOWSKI)	
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APPENDIX

1. An electronic assembly comprising:
 - A. a first electronic component with a first contacting site;
 - B. a second electronic component with a second contacting site;
 - C. a force bearing member which maintains contact between the first contacting site on the first electronic component and the second contacting site on the second electronic component, wherein the force bearing member is made of a cured composition comprising:
 - a) an addition curable silicone polymer comprising an average of at least 2 unsaturated functional groups per molecule;
 - b) a crosslinker comprising an average of at least 2 silicone-hydrogen linkages per molecule, wherein, prior to cure, the ratio of Si-H linkages to functional groups on the silicone polymer (SiH:F ratio) is about 1:1 to about 20:1; and
 - c) a catalyst, wherein said catalyst is present in an amount sufficient to permit curing of the composition in less than about 20 minutes at a temperature of about 30°C.