

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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOMOHIRO IKEDA

Appeal No. 1999-2047
Application No. 08/837,350

HEARD: OCTOBER 25, 2000

Before COHEN, McQUADE, and LAZARUS, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 3. Claims 4 through 13, the only other claims in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

Appellant's invention pertains to a shield-plated corrugated tube. A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of

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which appears in the APPENDIX to the brief (Paper No. 14).

As evidence of obviousness, the examiner has applied the documents listed below:

Takagi et al. 1994 (Takagi)	5,325,893	Jul. 5,
Kijima et al. (Kijima)(Japanese Kokai Patent Application) ¹	HEI 6-[1994]286053	Oct. 11, 1994

The following rejections are before us for review.

Claims 1 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takagi.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Takagi in view of Kijima.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer

¹ Our understanding of this document is derived from a reading of a translation thereof prepared for the United States Patent and Trademark Office. A copy of the translation is appended to this opinion.

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(Paper No. 15), while the complete statement of appellant's argument can be found in the main and reply briefs (Paper Nos. 14 and 16).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification² and claims, the applied teachings,³ and the respective viewpoints of appellant and the examiner.

² Appellant's disclosure informs us that, at the time of the present invention, a conventional shielded corrugated tube (Fig. 7) employed electroless plating but that "bubbles generated during a plating process are collected in concave portions in the corrugated tube, or a plating solution remains, so that it is easy to produce a failure in plating." (specification, pages 3 and 4)

³ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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As a consequence of our review, we make the determination which follows.

We cannot sustain any of the examiner's rejections under 35 U.S.C. § 103.

Independent claim 1 is drawn to a shield plated corrugated tube for covering an electric wire to mechanically protect and electromagnetically shield the electric wire accommodated therein comprising, inter alia, a flexible tube body including a tube wall corrugated by repetition of convex-concave portions having a plurality of inner and outer grooved portions, wherein the size of the tube body is set at least so that each of the inner grooved portions satisfies a condition of $0.5 < D/W < 1.6$ (D and W being respectively the depth and width of each inner grooved portion), and an electromagnetic shielding metal layer formed on the inner surface of the tube wall by electroless plating.

The examiner applies the patent to Takagi as the basis for rejecting independent claim 1 under 35 U.S.C. § 103.

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Takagi teaches a spiral air duct (Fig. 6) wherein paper 23 is disposed on the outer periphery thereof to prevent condensation dripping.

The Takagi document does not teach or suggest a shield-plated corrugated tube, the invention being claimed. Further, this patent provides drawings that are not to scale and makes no mention whatsoever of any relationship between the width and depth of the inner grooves of the spiral tube. See In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 9 (CCPA 1977). It is quite apparent to us that the examiner has focused upon width and depth as it pertains to the inner grooves of the spiral tube of Takagi only because of appellant's teaching in this application. The circumstances before us exemplify a classic case of inappropriate reliance upon an appellant's own teaching as a basis for concluding obviousness. Only appellant has informed us as to the importance of a specifically claimed condition that addresses the width and depth of inner grooved portions of a shield-plated corrugated tube to overcome the disclosed bubble and plating problems that accrue during electroless plating. Since the Takagi

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reference does not teach and would not have been suggestive of the shield-plated corrugated tube of claim 1, the rejection thereof must be reversed. As to the Kijima reference, also relied upon by the examiner, we conclude that the teaching thereof clearly fails to overcome the deficiency of the Takagi document.

In summary, this panel of the board has not sustained the two obviousness rejections on appeal.

The decision of the examiner is reversed.

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REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
RICHARD B. LAZARUS)	
Administrative Patent Judge)	

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COHEN

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APJ COHEN

APJ McQUADE

APJ LAZARUS

DECISION: **REVERSED**

Prepared By:

DRAFT TYPED: 20 Dec 01

FINAL TYPED: