



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,196	01/26/2007	6521831	IE-831	3931
30010	7590	01/31/2013	EXAMINER	
The Jackson Patent Group, LLC 1500 Forest Avenue, Suite 212 RICHMOND, VA 23229			GELLNER, JEFFREY L	
			ART UNIT	PAPER NUMBER
			3993	
			MAIL DATE	DELIVERY MODE
			01/31/2013	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEALS BOARD

BRIDGEPORT FITTINGS, INC.
Third Party Requester, Respondent, Appellant

v.

ARLINGTON INDUSTRIES, INC.
Patent Owner, Respondent, Appellant

Appeal 2011-009135
Inter partes Reexamination Control 95/000,196
United States Patent 6,521,831 B1
Technology Center 3900

Before RICHARD TORCZON, SCOTT R. BOALICK, and
KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Patent Owner and Appellant (hereinafter “Patent Owner”) requests that we reconsider the Panel’s Decision of December 16, 2011 (hereinafter “Decision”), in Patent Owner’s Request for Rehearing (hereinafter “Request”), filed January 17, 2012 (“Req. Reh’g.”), wherein we affirmed the Examiner’s decision to reject claims 1, 5, and 6 under 35 U.S.C. § 103(a) as unpatentable over Grindle, Schnittker, and Roeder (Grounds B, T, and U). (Decision 43.)

Third Party Requester urges that the Board deny Patent’s Owner’s Request for Rehearing in a Response to Request for Rehearing, filed February 17, 2012.

Based on the discussion which follows, the request for rehearing is denied.

DISCUSSION

At the outset, we note that a majority of Patent Owner’s request for rehearing fails to comply with 37 C.F.R. § 41.52(a)(1) since it fails to “state with particularity the points believed to have been misapprehended or overlooked by the Board.” *See* 37 C.F.R. § 41.52(a)(1). Rather than argue the points of law or fact which Patent Owner feels were overlooked or misapprehended in the Decision, Patent Owner now attempts to reargue and remake its case with new arguments, not raised in their original Brief.

In particular, Patent Owner now argues that the modified connector taught by the combination of Grindle, Schnittker, and Roeder requires “twisting for locking,” which is not the same as the '831 patent, which

“snap[s] into place.” (Req. Reh’g. 6-7.) However, the instant argument was not made by Patent Owner in their Appeal Brief filed November 3, 2010, and as such we find that the argument was neither overlooked nor misapprehended.

Alternatively, the aspect of “snap[ping] into place” is not set forth in independent claim 1, and as such, cannot serve to distinguish the claim from the prior art. *See CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir. 2005) (while the specification can be examined for proper context of a claim term, limitations from the specification will not be imported into the claims). Nor does Patent Owner’s contention that the modified connector taught by the combination of Grindle, Schnittker, and Roeder “twist[s]for locking” serve to distinguish claim 1 from the prior art, as its use of the open-ended transitional phrase “comprising” allows for additional unrecited elements. *See CIAS, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1360-61 (Fed. Cir. 2007). Thus, Patent Owner’s belated argument is not persuasive.

Additionally, Patent Owner argues in their Request that the combination of Grindle, Schnittker, and Roeder fails to teach or suggest a tubular grounding ring since the grounding ring in Schnittker is “initially a flat configuration . . . [and] then rolled into the shape.” (Req. Reh’g. 8-9.) Again, Patent Owner’s argument fails to persuade us that the Decision overlooked or misapprehended any points of law or fact with respect to this argument, as the argument was not made upon appeal.

Nevertheless, on rehearing, we do not find Patent Owner’s argument to be persuasive. While Schnittker’s grounding ring may initially be flat,

this does not change the fact that it is made annular when inserted into the tubular body depicted by Figure 4 of Schnittker, (*See* Schnittker Col 5, ll. 21-35) or into the bore of Grindle's housing in the combination asserted by the Examiner. (*See* Decision 23-25; *See also* Grindle Fig. 1.)

While we acknowledge that Schnittker's grounding ring does include a small gap, Patent Owner does not point to any definition of "tubular" in their Specification which would otherwise prevent the "tubular spring steel cable retainer" of claim 1 from reading on Schnittker's grounding ring. "During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification." *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1259 (Fed. Cir. 2010) (quoting *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007)). Thus, Patent Owner's untimely argument is not persuasive.

Moreover, Patent Owner argues that the combination of Grindle, Schnittker, and Roeder fails to teach or suggest an "[a]nalogous [c]able [r]etainer" since Schnittker's grounding ring requires thirteen parts compared to the '831 patent which only requires five. (Req. Reh'g. 9.) Specifically, Patent Owner asserts that Schnittker's grounding ring is located in the middle to outbound end, rather than the inbound end and includes an armor stop which prevents the armored cables from being guided to the single outbound end. (Req. Reh'g. 9-10.)

We are not persuaded by Patent Owner's argument and, as discussed *supra*, determine that independent claim 1 uses the open-ended transitional term "comprising," which does not exclude additional, unrecited elements.

See CIAS, Inc. v. Alliance Gaming Corp., 504 F.3d at 1360-61. While we acknowledged in the Decision that Schnittker's grounding ring must also include additional "parts" (i.e., grommet (18), gland nut (22)), we stated in the Decision that there is no language in the claims that limits or otherwise distinguishes the claimed cable retainer from reading on Schnittker's grounding ring, as modified by the combination asserted by the Examiner. (*See* Decision 27-28.)

Equally unpersuasive is Patent Owner's assertion regarding Schnittker's armor stop, as it attacks the references separately, even though the rejection is based on the combined teachings of the references. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). As the Decision pointed out, the Examiner does not rely on Schnittker's armor stop, but instead relies on the combination of Grindle, Schnittker, and Roeder. (Decision 26-28.) Thus, Patent Owner's argument has not shown that we misapprehended or overlooked any points of law or facts.

Patent Owner next reargues that the asserted combination "is not actually possible because the individual components (which reflect the teachings) cannot be physically combined while meeting the '831 claim limitations," and thus, no motivation exists to combine the references. (Req. Reh'g. 11-12.) We are not persuaded by Patent Owner's argument as the criterion for combining references is "not whether the references could be physically combined but whether the claimed inventions are rendered

obvious by the teachings of the prior art as a whole.” *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985). As such, Patent Owner’s argument fails to demonstrate any misapprehension by the Board.

In the Decision, we stated:

Schnittker’s teaching of a grounding ring component used in a metal clad cable connector to ensure ground and also function as a cable retainer would have reasonably suggested to one of ordinary skill in the art at the time of the invention that such a component would be useful for retaining the metal clad cables used in the multiple wire connector of Grindle and an appropriate substitute to the screw used to hold the armor cable within the connector

(Decision 29.)

In light of this finding and given that Patent Owner has not persuaded us otherwise, we maintain that each of the elements of the claim to be taught by the combination of Grindle, Schnittker, and Roeder. Furthermore, the Decision concluded that:

[a] person of ordinary skill in the art would have reasonably expected that this modification would provide Grindle’s duplex connector with an enhanced capability of preventing or restricting the cables from forces that would otherwise remove the cables from their inbound ends. This combination would maintain equal resistance on each inlet in a way that the single screw of Grindle could not.

(Decision 30.)

In a case such as this, where each of the elements of the claim is known to the art, the obviousness inquiry requires a finding that the combination of known elements was obvious to a person with ordinary skill

in the art. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007). Accordingly, in the absence of any persuasive evidence to the contrary, Patent Owner's argument fails to persuade us that the Decision misapprehended or overlooked any points of law or fact.

Further, Patent Owner argues the Board applied the wrong standard in considering Patent Owner's evidence of secondary considerations against obviousness in an *inter partes* reexamination "akin to a contested proceeding." (Req. Reh'g. 18-19.) Specifically, Patent Owner asserts that the Board erred by placing the burden on Patent Owner to establish a nexus between the claimed invention and evidence of secondary considerations, given that Requester failed to challenge Patent Owner's evidence with its own evidence. (Req. Reh'g. 18-19.)

We are not persuaded by Patent Owner's argument and in the absence of any persuasive evidence or precedent to the contrary, decline to modify our Decision based solely on attorney arguments.¹ Accordingly, we are not persuaded that the Decision misapprehended or overlooked any argument, or point of fact or law.

Lastly, to the extent Patent Owner's Request for Rehearing addresses the Decision's analysis of Patent Owner's evidence of secondary considerations of nonobviousness, these arguments simply reiterate what was already said in their Appeal Brief and fail to recite the points of law or

¹ *Cf. Lingamfelter v. Kappos*, No. 2011-1449, 2012 WL 3218529, at 6 (C.A. Fed., 2012) (secondary considerations of obviousness did not rebut prima facie case of obviousness in *inter partes* proceedings for reexamination where patent owner failed to sufficiently establish nexus between economic success and the claimed features).

fact which Patent Owner feels were overlooked or misapprehended in that analysis. (Req. Reh'g. 13-18.)

While we have already addressed these same arguments regarding commercial success (Req. Reh'g. 15-16) and long-felt need (Req. Reh'g. 16-18) in our Decision (Decision 34-42), we nevertheless will briefly revisit our reasons for maintaining our determination that Patent's Owner's evidence of nonobviousness is not commensurate in scope with the claims of the '831 patent, and as such, insufficient to establish the necessary nexus between the evidence of nonobviousness and the claimed invention.

With respect to commercial success, we noted that the declarations of R. Stella, K. Stella, and Wallis are not reasonably commensurate with the scope of the duplex connector recited by claim 1 or establish a nexus therein, but rather generally describe features and benefits of a generic duplex connector. (Decision 35-36.) With respect to the Declaration of Thomas J. Gretz, sole inventor, we stated:

the Gretz declaration states that there were three embodiments of the '831 patent sold by Patent Owner, between 1999-2007. (Gretz Decl. ¶ 3.) Gretz states that these models were the 3838AST, 3838ST, and the 4040AST. (Gretz Decl. ¶ 2.) Gretz describes that “[t]he AST suffix denotes an insulated throat” and “[t]he 4040AST accepts larger sized flexible metal cables.” (Gretz Decl. ¶ 2.) Gretz asserts that there were 16,727,840 units sold for the 3838AST model, 969,730 units sold for the 3838ST model, and 7,145,863 units sold for the 4040AST. (Gretz Decl. ¶ 3.) Based upon these data, we find the Gretz declaration demonstrates that 23,873,703 duplex connectors or 96% of the total 24,843,433 duplex connectors sold from 1999-2007 included the unclaimed feature of an insulated throat

designated by the AST in the model number. (Gretz
Decl. ¶¶ 2 and 3.)

(Decision 36-37.)

Based on these findings, the Decision generally concluded that “the sales data presented in the Gretz Declaration [along with the declarations of R. Stella, K. Stella, and Wallis] fails to demonstrate a nexus between the claimed invention and the evidence of commercial success.” (Decision 37.) Accordingly, since Patent Owner’s Request for Rehearing does not contest these findings, we are not persuaded that the Decision misapprehended or overlooked any argument, or point of fact or law.

Similarly, with respect to a long-felt need, we noted in the Decision that Patent Owner’s third-party declarations fail to “identify[]how the claimed features of the '831 patent satisfied the long-felt need or that the product was specifically purchased for a claimed feature.” (Decision 41.)

We also stated that we find:

the Declaration of Thomas J. Gretz, sole inventor, to be unpersuasive. (PO App. Br. 27-28.) Given Gretz’s interest in his own invention, we decline to give much weight to his opinion evidence identifying a “need to eliminate tools and to save on labor for the installation of duplex connectors” as it is vague and too general to be of probative value. (Gretz Decl. ¶ 6.) Equally unpersuasive is Patent Owner’s reliance on Ken M. Kiely’s testimony acknowledging customer demand for a “cross-product” (PO App. Br. 27-28; citing Kiely Dep. P. 215, ll. 7-18) since Patent Owner has not shown that the demand was for the product recited by the claims of '831 patent.

(Decision 41.)

Appeal 2011-009135
Reexamination Control No. 95/000,196
United States Patent 6,521,831 B1

Thus, we concluded that Patent Owner failed to show a nexus between its solution to their alleged long-felt need and the claimed invention of the '831 patent. Again, Patent Owner's Request for Rehearing fails to demonstrate that our Decision misapprehended or overlooked any point of fact or law in making this determination, and as such, is not persuasive.

Accordingly, while we have granted Patent Owner's request for rehearing to the extent that we have reconsidered our previous decision, the request is denied with respect to modifying our original Decision.

REHEARING DENIED

alw

cc:

PATENT OWNER:

THE JACKSON PATENT GROUP
1500 FOREST AVENUE, SUITE 212
RICHMOND, VA 23229

THIRD PARTY REQUESTER

MICHAEL J. STRAUSS
MORRISON & FOERSTER LLP
1650 TYSONS, BLVD., SUITE 400
MCLEAN, VA 22102