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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RUDOLF HILDEBRAND

Appeal 2014-005184
Application 11/607,084¹
Technology Center 3600

Before MURRIEL E. CRAWFORD, CYNTHIA L. MURPHY, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

SCHOPFER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing of the decision entered August 8, 2016 (“Decision”), which, *inter alia*, affirmed the Examiner’s rejection of claims 1–11 and 14–19 as unpatentable over Ohno.² Appellant contends that we “committed error by shifting the burden to [Appellant] to show why it would not have been obvious to modify Ohno to include the particular claimed structural relationship between the plug connector and other elements” of the

¹ According to Appellant, the real party in interest is Kathrein-Werke KG. Appeal Br. 1.

² Ohno et al., US 2006/0038729 A1, pub. Feb. 23, 2006.

claims. Req. Reh’g 4 (emphasis omitted). We find no point of law or fact that we overlooked or misapprehended in arriving at our Decision.

DISCUSSION

Appellant argues that we erred in our Decision because we:

placed the burden upon applicant to respond to contentions the Examiner never made as to HOW to structurally modify Ohno to use a plug connector, in particular to obtain a structure in which (1) the plug connector is arranged wholly or partially in a region of the fitting opening, and (2) the screw head applying pressure to the tensioning structure is further structured to be located closer to the fitting wall than the insertion plane defined by the insertion opening of the at least one plug connector.

Req. Reh’g 4–5. Additionally, Appellant argues:

there is no basis on this record supporting a conclusion that if Ohno’s structure were modified to include a plug connector, it would have been obvious under 35 USC 103 to provide the screw head applying pressure to the tensioning structure being further structured to be located closer to the fitting wall than the insertion plane defined by the insertion opening of the at least one plug connector.

Id. at 5. Appellant concludes that there was no prima facie case of obviousness presented with respect to Ohno alone, and thus, our Decision should have reversed “the rejection on that basis instead of insisting on an incorrect legal standard that turns 35 USC 103 upside down.” *Id.* at 7.

For the reasons discussed below, we are not persuaded of error in our Decision.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to Appellant. *See*

Oetiker, 977 F.2d at 1445; *see also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *Id.*

Our reviewing court has set forth the following standard for determining the sufficiency of an Examiner's rejection:

[T]he PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in “notify[ing] the applicant . . . [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” That section “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”

In re Jung, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (citations omitted) (alterations in original).

Further, an Appellant may attempt to overcome an examiner's obviousness rejection on appeal to the Board by: (A) submitting arguments and/or evidence to show that the examiner made an error in either (1) an underlying finding of fact upon which the final conclusion of obviousness was based or (2) the reasoning used to reach the legal conclusion of obviousness; or (B) showing that the prima facie case has been rebutted by evidence of secondary considerations of nonobviousness. *See Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

In our Decision, we found that the use of a plug connector Ohno would have been obvious for the reasons provided by the Examiner. *See* Decision 5. We also found that the Examiner provided a sufficient basis to conclude that Ohno teaches or suggests each element of the claims. *Id.* at 5–6. In particular, our Decision was not only based on the Examiner's finding

that it would have been obvious to use a plug connector in Ohno, but it was also based on the Examiner's findings regarding the relationship of parts in Ohno's device, including the Examiner's findings regarding Ohno's connector, defined as elements 14 and 10a by the Examiner. Thus, the Examiner met the burden of establishing a prima facie case of obviousness. As noted above, once a prima facie case was established, the burden of coming forward with evidence or argument shifted to Appellant. As such we are not persuaded that the Decision erred in shifting the burden to Appellant to produce arguments or evidence showing error in the rejection or to produce evidence of secondary considerations. *See Ex parte Frye*, 94 USPQ2d at 1075.

Further, in our Decision, we found that the arguments and evidence presented by Appellant in response to this prima facie were not sufficient to show error in the Examiner's findings or conclusions. Appellant's arguments regarding the sufficiency of the prima face case, raised for the first time here, are untimely. *See* 37 CFR § 41.52.

CONCLUSION

We have carefully reviewed the original Decision in light of Appellant's request, but we find no point of law or fact that we overlooked or misapprehended in arriving at our decision. Therefore, Appellant's request for rehearing is denied.

DENIED