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3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			NGUYEN, CHAU N	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOUGLAS B. GUNDEL

Appeal 2018-005218
Application 14/442,744
Technology Center 2800

Before MARK NAGUMO, GEORGE C. BEST, and
JANE E. INGLESE, *Administrative Patent Judges*.

BEST, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–3, 5, 8–14, and 17–20 of Application 14/442,744. We have jurisdiction under 35 U.S.C. § 6(b).

For the reasons set forth below, we *reverse*.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real parties in interest as 3M Company and 3M Innovative Properties Co. Appeal Br. 2.

BACKGROUND

The '744 Application describes cables designed for use external to a metal enclosure. Spec. 1. In particular, the Specification describes cables that include a plurality of separate individual conductor sets extending along a length of the cable. *Id.* Each conductor set includes two or more insulated conductors and a pair of shielding films disposed on opposite sides of the conductor set; each shielding film includes a cover portion and pinched portions. *Id.* The shielding films are arranged so that their cover portions substantially surround the conductor set. *Id.* The pinched portions of the shielding films are located on either side of the conductor set and extend along the length of the cable. *Id.*

Claim 1 is representative of the '744 Application's claims and is reproduced below from the Claims Appendix of the Appeal Brief.

1. A cable comprising:

a plurality of separate individual conductor sets, each conductor set extending along a length of the cable and comprising:

two insulated conductors;

first and second conductive shielding films disposed on opposite first and second sides of the conductor set, the first and second conductive shielding films including cover portions and pinched portions arranged such that, in transverse cross-section, the cover portions of the first and second shielding films in combination substantially surround the conductor set, and the pinched portions of the first and second shielding films in combination formed pinched portions of the conductor set on each side of the conductor set, each pinched portion comprising an edge extending along the length of the cable; and

an insulating jacket surrounding the plurality of the conductor sets.

Appeal Br. 8.

REJECTIONS

On appeal, the Examiner maintains the following rejections:

1. Claims 1, 2, 5, 8, 9, and 11–14 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Kebabjian² and Prudhon.³ Final Act. 2.
2. Claims 1–3 and 11–14 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Kebabjian and Gundel.⁴ Final Act. 4.
3. Claims 10 and 17–20 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Kebabjian, Prudhon, and Laudenslager.⁵ Final Act. 6.

DISCUSSION

Rejection 1. For reasons that will become apparent, we limit our discussion of this rejection to claim 1, which is the only independent claim subject to this rejection.

“[W]hen determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.” *In re Rouffet*, 149 F.3d 1350, 1355–56 (Fed. Cir. 1998) (citations, internal quote marks, and brackets omitted). In making an obviousness rejection, an examiner must identify where the prior art

² US 6,452,107 B1, issued September 17, 2002.

³ US 6,043,434, issued March 28, 2000.

⁴ WO 2010/148157 A1, published December 23, 2010.

⁵ US 8,143,522 B2, issued March 27, 2012.

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suggests the desirability of making the combination. This identification must be explicit. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

In rejecting claim 1, the Examiner found that

It would have been obvious to one skilled in the art to modify the shield (18) of Kebabjian to comprise first and second shielding films with cover portions and pinched portions as taught by Prudhon since it has been held that constructing a formerly integral structure into various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179[(Bd. Pat. Interf. 1969)].

Final Act. 3; *see also* Answer 4–5.

This is not an adequate reason to combine the teachings of Kebabjian and Prudhon and arrive at a conclusion of obviousness.

First, the statement does not articulate a reason to make the proposed combination that demonstrates that it would have been regarded as desirable to do so. At most, the Examiner’s finding demonstrates that a person of ordinary skill in the art would have had a reasonable expectation of success in making the proposed combination. This is not a sufficient reason to combine references. A finding that something may be done is not equivalent to a finding that that thing is desirable to do. It is the latter finding that is required in an obviousness analysis. *See Rouffet*, 149 F.3d at 1355–56.

Second, the Examiner’s finding is not supported as a matter of law. The case the Examiner relies upon, *Nerwin v. Erlichman*, does not hold that “constructing a formerly integral structure into various elements involves only routine skill in the art.” As we have previously explained, the Examiner’s reliance on *Nerwin* to establish that “it is per se obvious to

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separate a single component into two components is misplaced.” *Ex parte Van Deer Meer*, Appeal 2012-011581, 2014 WL 1320885, at *2 (PTAB March 20, 2014) (citing *Ex parte Kawano*, Appeal 2011-002048, 2013 WL 603839, at *4 (PTAB February 14, 2013)); *see also Ex parte Grilliot*, Appeal 2011-000164, 2013 WL 1121948, at *2 (PTAB March 7, 2013); *Ex parte Van Oort*, Appeal 2011-001632, 2013 WL 1289460, at*4–*5 (PTAB March 25, 2013); *Ex parte Gruden*, Appeal 97-1147, 1997 WL 1883962, at *3 (BPAI 1997) (“The examiner’s reliance on and citation of *Nerwin v. Erlichman*, 168 USPQ 177, 179 (Bd. Pat. Int. 1969), which according to the examiner held that ‘constructing a formerly integral structure in various elements involves only routine skill in the art,’ appears to us to be misplaced. We find no such ‘holding’ in *Nerwin v. Erlichman*.”).

Because the Examiner has not identified a sufficient reason for a person of ordinary skill in the art to have made the modification proposed in the rejection, we are constrained to reverse the rejection of claim 1. Thus, we also reverse the rejection of claims 2, 5, 8, 9, and 11–14.

Rejection 2. The Examiner rejected claims 1–3 and 11–14 as unpatentable over the combination of Kebabjian and Gundel. Final Act. 4–6. For reasons that will become apparent, we limit our discussion to the rejection of claim 1.

In rejecting claim 1, the Examiner found that

[i]t would have been obvious to one skilled in the art to modify the shield (18) of Kebabjian to comprise first and second shielding films with cover portions and pinched portions as taught by Gundel since it has been held that constructing a formerly integral structure into various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Id. at 5–6.

This is the same statement of reasons to combine the teachings of two references that the Examiner made with respect to Kebabjian and Prudhon in Rejection 1. As we discussed above, this is not a sufficient statement of a reason to combine two references. We, therefore, reverse the rejection of claim 1 as unpatentable over the combination of Kebabjian and Gundel for the same reasons we reversed the rejection of claim 1 in Rejection 1. Accordingly, we also reverse the rejection of claims 2, 3, and 11–14 as unpatentable over the combination of Kebabjian and Gundel.

Rejection 3. The Examiner rejected claims 10 and 17–20 as unpatentable over the combination of Kebabjian, Prudhon, and Laudenslager. Final Act. 6–8.

This rejection relies upon the rejection of claim 1 as unpatentable over the combination of Kebabjian and Prudhon. *Id.* at 6. Because we have reversed this rejection, we also reverse the rejection of claims 10 and 17–20 as unpatentable over the combination of Kebabjian, Prudhon, and Laudenslager.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
1, 2, 5, 8, 9, and 11–14	§ 103(a) Kebabjian Prudhon		1, 2, 5, 8, 9, and 11–14
1–3 and 11–14	§ 103(a) Kebabjian Gundel		1–3 and 11–14

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Claims Rejected	Basis	Affirmed	Reversed
10 and 17-20	§ 103(a) Kebabjian Prudhon Laudenslager		10 and 17-20
Overall Outcome			1-3, 5, 8-14, and 17-20

REVERSED