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14/810,527	07/28/2015	Tomoyasu MURAKAMI	MIY.001.0718.NP	4260
65181	7590	02/27/2020	EXAMINER	
METROLEX IP LAW GROUP, PLLC 900 17th Street, NW. Suite 320 WASHINGTON, DC 20006			TSO, STANLEY	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* TOMOYASU MURAKAMI

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Appeal 2018-006303  
Application 14/810,527  
Technology Center 2800

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Before BRADLEY W. BAUMEISTER, LINZY T. McCARTNEY,  
JASON M. REPKO, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> seeks review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 1, 2, 4, 5, 8–13, and 15–19. We have jurisdiction under 35 U.S.C. § 6(b). We heard oral argument on February 12, 2020.

We reverse.

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<sup>1</sup> Appellant identifies the real party in interest as YAZAKI CORPORATION. Appeal Brief 3, filed February 27, 2018 (Appeal Br.).

## BACKGROUND

This patent application concerns a grommet. *See* Specification 1, filed July 28, 2015 (Spec.). Claim 1 illustrates the claimed subject matter:

1. A grommet comprising:

a body portion configured to divide an inside and an outside of a mounting member;

an electric wire insertion portion extending from the body portion toward the outside of the mounting member and configured to insert an electric wire;

a seal portion provided at an outermost position of an end of the electric wire insertion portion to be in close contact with an outer circumference of the electric wire,

wherein the seal portion comprises a projected rim formed continuously on the outer circumferential surface of the electric wire insertion portion to ensure pressured contact between the inner circumferential surface of the seal portion and the outer circumferential surface of the electric wire; and

a protective portion disposed on the end of the electric wire insertion portion at the outermost position of the electric wire insertion portion where the seal portion is provided and configured to extend from the end of the electric wire insertion portion at the outermost position of the electric wire insertion portion away from the body portion along a length direction of the electric wire insertion portion and to cover an outer circumference of the electric wire exposed from the seal portion, wherein

the protective portion has the outside diameter on an opposite side of a seal portion side set smaller than the outside diameter on the seal portion side,

the protective portion has a wall thickness that continually decreases from the seal portion side to the opposite side of the seal portion side, and

the electric wire insertion portion has a constant wall thickness that is greater than the wall thickness of the protective

portion anywhere from the seal portion side to the opposite side of the seal portion side.

Appeal Br. 19.

#### REJECTIONS

Claims	35 U.S.C. §	Reference(s)/Basis
1, 2, 5, 8–13, 15	§ 103	Kumakura, <sup>2</sup> Schadow <sup>3</sup>
4, 16–19	§ 103	Kumakura, Schadow, Oga <sup>4</sup>
5	§ 103	Kumakura, Schadow, Moorhead <sup>5</sup>

#### DISCUSSION

The Examiner determined that it would have been obvious to replace part of Kumakura’s tubular portion 8 with only the tapered portion of Schadow’s body unit 10a to arrive at the grommet recited in claim 1. *See* Final Action 3–5, mailed September 8, 2017 (Final Act.); Examiner’s Answer 6–9, mailed April 2, 2018 (Ans.). Appellant argues that the Examiner failed to provide sufficient motivation for this modification. *See* Appeal Br. 17; Reply Brief 15, filed June 1, 2018.

We agree with Appellant. The Examiner determined that a person of ordinary skill in the art would have been motivated to replace part of Kumakura’s tubular portion 8 with just the tapered portion of Schadow’s body unit 10a “in order to dampen cable vibrations as suggested by Schadow.” Ans. 9; *see also* Final Act. 5. But Schadow’s device uses damping elements to dampen cable vibrations and these elements are not included within the tapered portion of Schadow’s body unit 10a. *See*

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<sup>2</sup> Kumakura et al. (US 7,434,814 B2; October 14, 2008).

<sup>3</sup> Schadow et al. (US 8,586,879 B2; November 19, 2013).

<sup>4</sup> Oga et al. (US 7,399,922 B2; July 15, 2008).

<sup>5</sup> Moorhead (US 2,800,526; July 23, 1957).

Schadow 2:23–34, 4:29–46, Fig. 1 (showing damping and sealing elements 14a, 15a to the left of electric device housing unit 12a and the tapered portion of body unit 10a to the right). As a result, replacing part of Kumakura’s tubular portion 8 with only the tapered portion of Schadow’s body unit 10a as proposed by the Examiner would not “dampen cable vibrations as suggested by Schadow.” We therefore agree with Appellant that the Examiner has not provided sufficient motivation to for the Examiner’s proposed combination of Kumakura and Schadow.

On this record, we do not sustain the Examiner’s obviousness rejection of claim 1. Because claims 2, 4, 5, 8–13, and 15–19 depend from claim 1, we also do not sustain the Examiner’s obviousness rejections of these claims.

### CONCLUSION

This table summarizes our decision for claims 1, 2, 4, 5, 8–13, and 15–19, the claims before us on appeal:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 2, 5, 8–13, 15	§ 103	Kumakura, Schadow		1, 2, 5, 8–13, 15
4, 16–19	§ 103	Kumakura, Schadow, Oga		4, 16–19
5	§ 103	Kumakura, Schadow, Moorhead		5
<b>Overall Outcome</b>				1, 2, 4, 5, 8–13, 15–19

REVERSED