

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOHN J. GREGEL, LOUIS J. COLARUSSO
and LAWRENCE GENE GATTON

Appeal No. 2005-0326
Application No. 10/081,376

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 13, 20 to 22 and 26.¹ Claims 14 and 15 have been withdrawn from consideration. Claims 16 to 19 and 23 to 25 have been canceled.

We REVERSE.

¹ Claims 3 and 26 were amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates generally to a reinforcing bar connection, and more particularly to a high strength reinforcing bar splice which provides not only high tensile and compressive strengths, but also has the dynamic or fatigue characteristics to qualify as a Type 2 coupler approved for all earthquake zones in the United States (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Dobell	US 2,781,658	Feb. 19, 1957
Lande	GB 2 034 857 A	June 11, 1980
Schade et al. (Schade)	DD 222 374 A1 ²	May 15, 1985
Kadota	GB 2 192 210 A	Jan. 6, 1988

Claims 1 to 3 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schade in view of Dobell.

² In determining the teachings of Schade, we will rely on the translation provided by the appellants as Appendix C to their brief.

Claims 4, 5, 9 to 12 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schade in view of Dobell and Lande.³

Claims 6 to 8, 11, 12 and 20 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schade in view of Dobell, Lande and Kadota.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed August 25, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed June 3, 2004) and reply brief (filed October 27, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to

³ We note that claim 9 which is included in this ground of rejection depends from claim 8 which is included in the next ground of rejection.

the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 13, 20 to 22 and 26 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Independent claim 1 reads as follows:

A reinforcing bar connection for joining two reinforcing bars end-to end for use in reinforced concrete construction, comprising:
a sleeve, and
spring finger washers mounted in said sleeve,
wherein the washers each have a flexible inner edge adapted to expand around reinforcing bar ends projecting into each end of said sleeve and to bite into and grip the bar ends to prevent withdrawal.

In the rejection of claim 1 (answer, pp. 4-6) the examiner (1) set forth the pertinent teachings of Schade and Dobell; (2) ascertained that Schade does not

expressly disclose spring washers having a flexible inner edge for biting and gripping the reinforcing bar ends; and (3) concluded that it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the spring finger washers taught by Dobell, modifying the metal rings of the reinforcing bar connection of Schade, thus allowing biting and gripping the reinforcing bar ends.

The appellants argue (brief, pp. 6-10; reply brief, pp. 2-4) that Schade's crimped or pressed socket is a totally different type of connector than that recited in the claims, and there would be no motivation to use Dobell's pronged plates in Schade's socket, since to do so would provide no advantage, and because the crimping of Schade's socket would destroy the integrity of Dobell's pronged plates, rendering them useless for their intended purpose.

When it is necessary to select elements of various teachings in order to form the claimed invention, we must ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In our view, the applied prior art provides no teaching, suggestion or incentive that would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified Schade so as to arrive at the claimed invention. The mere fact that the prior art could be modified in the manner set forth in the rejection does not make such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, there is no such suggestion for the reasons set forth by the appellants in their briefs. The only possible suggestion for modifying Schade in the manner proposed by the examiner to arrive at the claimed invention would stem from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2, 3 and 13 dependent thereon, under 35 U.S.C. § 103 is reversed.

We have also reviewed the references to Lande and Kadota but find nothing therein which makes up for the deficiencies of Schade and Dobell discussed above

regarding claim 1.⁴ According, the decision of the examiner to reject claims 4 to 12, 20 to 22 and 26 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 13, 20 to 22 and 26 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

⁴ The rejection of independent method claim 20 is deficient for the reasons set forth above regarding claim 1.

Appeal No. 2005-0326
Application No. 10/081,376

Page 8

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