

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 DAVE FREDERICKSON, AL SUOPYS,
JIM NELSON, MAX ZIMBICKI,
CHRISTOPHER MERRITT and DENNIS ROCHELEAU

Appeal No. 2006-0463
Application 09/633,846¹

ON BRIEF

Before KIMLIN, PAK, and WALTZ, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 16 and 20 through 22. Claims 1 through 15 and 26 through 49, the other claims pending in the above-identified application, stand withdrawn from consideration by the examiner as being directed to a non-elected invention. We have jurisdiction pursuant to 35 U.S.C. § 134.

¹ Application for patent filed August 7, 2000.

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APPEALED SUBJECT MATTER

The subject matter on appeal is directed to a corrosion-resistant strap. See the specification, page 3. Claim 16 is representative of the appealed subject matter and reads as follows:

16. A corrosion-resistant coated and cured strap comprising:
an elongated metal strap base element, the metal strap base element having a width defining first and second sides and a thickness defining a pair of opposing edge regions; and
a melted and cured powder coating on the base element, the coating having a first substantially consistent thickness at the first and second sides and a second substantially consistent thickness at the edge regions, the first and second thickness being different from one another, wherein the coating has a greater thickness at about the pair of opposing edge regions and about regions of the first and second sides adjacent the pair of opposing edge regions than on the first and second sides to define a dog-bone profile.

EVIDENCE

As evidence of obviousness of the claimed subject matter, the examiner relies on the following sole prior art reference:

Lupinski et al. (Lupinski) 4,100,883 Jul. 18, 1978

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REJECTION

Claims 16 and 20 through 22 stand rejected under 35 U.S.C. § 103 as unpatentable over the disclosure of Lupinski.

DISCUSSION

We have carefully reviewed the claims, specification and prior art, including all of the arguments advanced by both the examiner and the appellants in support of their respective positions. This review has led us to conclude that the examiner's § 103 rejection is not well founded. Accordingly, we reverse the examiner's § 103 rejection for the reasons set forth in the Brief. We add the following primarily for emphasis.

We observe that Lupinski teaches an elongated electrical conductor which is formed by applying a powder coating of "uniform radial thickness circumferentially about electrically conductive wire." See column 1, lines 5-6 and column 3, lines 30-61. Lupinski does not mention the claimed dog-bone profile coating, which, according to page 1, lines 5-15 and page 2, lines 17-22, of the specification, is used to minimize the problems associated with the removal of a coating at the edges during the manufacture of strap useful for packaging, i.e., strapping, goods. Indeed, the examiner acknowledges that Lupinski "fails to

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disclose the [claimed] coating thickness having a greater thickness at about the pair of opposing edge regions and about regions of the first and second side adjacent the pair of opposing edge regions than on the first and second side to define a dog-bone profile." See the Answer, page 3.

The dispositive question is, therefore, whether one of ordinary skill in the art would have been led to change the shape of the coating thickness in Lupinski's electrical conductor to define a dog-bone profile. On this record, we answer this question in the negative.

It is well settled that the examiner has the initial burden of establishing a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). To meet this burden, the examiner must supply facts to support his or her conclusion of obviousness. In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002); In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177-78 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Here, the examiner asserts (the Answer, page 4) that:

[I]t would have been obvious to one of ordinary skill in the art . . . to change the shape of the coating thickness in Lupinski et al. to define a dog-bone

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profile. One skilled in the art would have been motivated to do so in order to form a corrosion-resistant coated and cured metal strap, since it has been held that a change in form or shape of the coating thickness would be an unpatentable modification in [the] absence of showing unexpected results.

However, the examiner does not explain why "a change in form or shape of the coating thickness[, especially in the form of a dog-bone profile,] would be an unpatentable modification" in the electrical conductor of the type described in Lupinski. Nor does the examiner point to any facts which would have suggested one of ordinary skill in the art to the claimed coating profile. In re Lee, 277 F.3d at 1343, 61 USPQ2d at 1433.

Moreover, our review of Lupinski indicates that one of ordinary skill in the art would have been led away from forming the claimed dog-bone (non-uniform) coating profile on the electrically conductive wire of the type described in Lupinski as urged by the appellants at page 5 of the Brief. In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicants. The degree of teaching away will of course depend on the particular

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facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant [Citations omitted]."). We find that Lupinski is directed to forming "a powder coating of uniform radial thickness circumferentially about electrically conductive wire [emphasis added]" as indicated supra. We find that Lupinski teaches that it is undesirable to form a non-uniform powder coating in the electrical conductor art. See column 6, lines 7-23.

Thus, for the reasons well articulated by the appellants at pages 5 and 6 of the Brief and set forth above, it cannot be said that the examiner has carried the initial burden of establishing a prima facie case of obviousness regarding the claimed subject matter. The examiner, by improperly taking a per se obviousness approach to the claimed coating profile, has failed to take into account facts discounting obviousness.

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CONCLUSION

In view of the foregoing, the decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	
CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

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