

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 51

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT M. CARIDEI

Appeal No. 1996-4111
Application 08/311,902¹

ON BRIEF

Before PAK, LIEBERMAN, and DELMENDO, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 15 and 16, which are all of the claims pending in the above-identified application.

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We have carefully reviewed the claims, specification and applied prior art, including all of the arguments and evidence advanced by both the examiner and appellant in support of their respective positions. This review leads us to conclude that the examiner's § 103 rejection is well founded. Accordingly, we will sustain the examiner's § 103 rejection. Our reasons for this determination follow.

In our decision entered August 23, 2000, we determined that the combined teachings of the admitted prior art and Davidson would have rendered the claimed subject matter *prima facie* obvious within the meaning of 35 U.S.C. § 103. See the earlier decision, pages 5-7. The factual findings and conclusions set

²(...continued)
referred to as "the earlier decision"), the examiner's rejection of claims 15 and 16 under 35 U.S.C. § 112, first paragraph, was reversed. See the earlier decision, page 3. This application, however, was remanded to the examiner to provide complete analyses of the evidence of unobviousness relied upon by appellant. See the earlier decision, pages 4-9. We deferred the

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forth in that earlier decision are provided below for
convenience:

The novelty of the claimed subject matter lies in providing a non-conductive material (plastic) coating to all of the surface of conventional battery terminal connectors, except for anticipated electrical contact areas, to prevent their corrosion. See Specification in its entirety.

Appellant acknowledges that such conventional battery terminal connectors are known. See Specification, page 1. These conventional battery terminal connectors are also known to have corrosion problems, due to their proximity to battery vent caps and their contact with road salts and water. *Id.* These battery terminal connectors are sometimes provided with a plastic or rubber sheath to protect them from corrosion. See Specification, page 2. The use of a plastic or rubber sheath, however, is known to be ineffective since it does not form "a tight seal which will prevent liquids and other foreign materials from touching the battery terminals." *Id.*

However, we find that Davidson teaches using a plastic insulating coating (non-conductive material) to all surfaces of a safety battery connector, except for "regions of anticipated direct electrical connection" to prevent corrosion. See column 5, lines 5-35. We also find that the safety battery connector described in Davidson is analogous to the claimed battery terminal connectors since it, like the claimed battery terminal connectors, connects an electrical cable to a battery terminal post and is exposed to the same environment and the same problem, i.e., corrosion,

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coating of the type described in Davidson, we agree with the examiner that it would have been *prima facie* obvious to employ such coating, in lieu of a plastic sheath, to all the surfaces of conventional battery terminal connectors, except for regions of anticipated direct electrical contacts, i.e., a battery post contact area and a battery cable contact area, with a reasonable expectation of successfully minimizing or preventing corrosion.

Having determined that the *prima facie* case of obviousness is established, we look to a Rule 132 declaration executed by Richard R. Randles on January 4, 1995 (hereinafter referred to as "the Randles declaration"). See, e.g., *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). According to appellant (Brief, pages 5-7), the Randles declaration demonstrates commercial success, long-felt need and failure of others, and copying.

With respect to commercial success, appellant must provide sufficient proof to establish (1) that the claimed battery terminal connectors are commercially successful and (2) that such a success is directly resulted from the unique characteristics (merits) of the claimed battery terminal connectors. *In re*

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First, Exhibits A and B referred to in the Randles declaration show that between 1991 and 1994, the number of battery terminal connectors having a color coded, protective plastic coating (red and black paints) sold were greater than the number of uncolored, unprotected battery terminal connectors sold. However, nowhere do those exhibits, or any other exhibits of record, show that the battery terminal connectors having a color coded, protective plastic coating were sold in a greater number than those battery terminal connectors closely resembling them (e.g., battery terminal connectors having a protective plastic or rubber sheath or protective metal coated battery terminal connectors). We simply cannot find any evidence showing an actual market share of the battery terminal connectors having a color coded, protective plastic coating. Under these circumstances, we cannot conclude that the Randles declaration demonstrates commercial success of the claimed invention.

Secondly, the Randles declaration does not demonstrate that the alleged commercial success was substantially due to the

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success. The Randles declaration clearly does not refer to any evidence that commercial tools, such as the pricing and/or advertising, were not responsible for obtaining the alleged commercial success. This lack of nexus between the claimed invention and the alleged commercial success is further buttressed by the fact that claim 15, as recited, does not require battery terminal connectors to have a color coded coating.

With respect to the alleged fulfillment of a long-felt need and failure of others, the Randles declaration refers to the advertisements designated in the Invention Disclosure Statement as "AR", "AS", and "AT". These advertisements indicate that certain metal plated battery terminal connectors have increased corrosion resistance. However, the advertisements do not indicate that these metal plated battery terminal connectors were not useful for solving the existing corrosion problem. *In re Mixon*, 470 F.2d 1374, 1377, 176 USPQ 296, 299 (CCPA 1973). Nor

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Moreover, as indicated by the examiner, we find that Davidson teaches that a protective plastic coating is known to be used for providing increased corrosion resistance. The protective plastic coating is specifically taught to be useful for safety battery connectors which are subjected to substantially the same corrosive environment as the battery terminal connectors. We also note that the safety battery connectors serve a similar function as the battery terminal connectors in a similar environment. Thus, we conclude that the Randles declaration fails to demonstrate that others have failed to solve the corrosion problem faced by appellant with a protective plastic coating. *Id.*

With respect to copying, the Randles declaration indicates that there are at least two companies which may have copied the invention embraced by claim 15. However, it does not demonstrate that there were widespread acceptance and adoption of the claimed invention. *Cable Electric Prods. v. Genmark, Inc.*, 770 F.2d 1015, 1028, 226 USPQ 881, 889 (Fed. Cir. 1985). Nor

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proffered by appellant. Thus, we affirm the decision of the examiner rejecting all of the appealed claims under 35 U.S.C. § 103.

As a final point, we note that the examiner did not indicate whether the formal drawings filed on April 2, 1992 meet the written description requirement of the first paragraph of 35 U.S.C. § 112. In the event of further prosecution of this application, the examiner is advised to determine whether the newly introduced formal drawings violate the written description requirement of 35 U.S.C. § 112, first paragraph.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Chung K. Pak)
Administrative Patent Judge)
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) BOARD OF PATENT

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