

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES P. McCALLION

Appeal No. 1997-1451
Application 08/145,974

ON BRIEF

Before JOHN D. SMITH, GARRIS and TIMM, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1, 2, 4, 5 and 16. The only other claims remaining in the application, which are claims 6-13 and 15, stand withdrawn from further consideration by the examiner as being directed to a non-elected invention.

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The subject matter on appeal relates to a corrosion-resistant structural member comprising first and second lengths of reinforcing rod physically connected with a joint, wherein the joint and the corrodible surfaces of the rods near the joint are covered with an open-ended sleeve. The inner layer of the sleeve comprises a thermoplastic polymer for softening and liquefying when heat is applied, and an outer layer of the sleeve comprises a heat-shrinkable polymer for shrinking when heat is applied. As a consequence of this heat application, the resulting liquefied thermoplastic polymer coats the corrodible surfaces and the joint and exudes from open ends of the sleeve thereby forming a bead and acting as barrier to corrosion-causing elements. Further details of this appealed subject matter are set forth in representative independent claim 1 which reads as follows:

1. A corrosion-resistant structural member comprising:

a first length of reinforcing rod having an anticorrosion coating and having a connecting end with a corrodible surface formed by removal of the anti-corrosion coating at the connecting end;

a second length of reinforcing rod having an anticorrosion coating and having a connecting end with a corrodible surface formed by removal of the anti-corrosion coating at the connecting end;

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a joint physically connecting the rods to one another at their respective connecting ends;

an open-ended sleeve sized to slide onto the connected rods and to cover the joint and the corrodible surfaces of the rods;

an inner layer of the sleeve comprising a thermoplastic polymer for softening and liquefying when heat is applied to the structural member; and

an outer layer of the sleeve comprising a heat-shrinkable polymer for shrinking when heat is applied to the structural member, and for forcing the liquefied inner layer into intimate contact with the corrodible surfaces, the liquefied thermoplastic polymer coating the corrodible surfaces and the joint, and exuding from open ends of the sleeve, forming a bead and acting as a barrier to corrosion-causing elements.

The references relied upon by the examiner as evidence of obviousness are:

Wetmore 1967	3,297,819	Jan. 10,
Weatherby 14, 1978	4,124,983	Nov.
Van Beersel et al. (Van Beersel) 1988	4,728,550	Mar. 1,

All of the appealed claims are rejected under 35 U.S.C. § 103 as being unpatentable over Van Beersel in view of Weatherby and Wetmore. On page 4 of the answer, the examiner expresses his position as follows:

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Van Beersel teaches protecting welded joints from corrosion by applying an open-ended sleeve having an inner layer of a first organic polymer and an outer layer of a second organic polymer. Van Beersel does not specifically teach the application to concrete reinforcement, nonetheless, he addresses the same problem of corrosion on joints as does appellants. Therefore, Van Beersel is reasonable pertinent to the particular problem to which appellants are involved, that problem being corrosion on joints. Moreover, it is the examiner's position that heat-shrinkable sleeves as contemplated by appellants were well known in the art at the time the invention was made and were equally known as a corrosion protection device. See Wetmore, Example II, relied upon not as prior art, but to show the state of the art at the time the invention was made. Weatherby, which is drawn to corrosion protection of rods, teaches at column 3, line 63 through column 4, line 6, that suitable tubing are heat-shrinkable polymeric materials lined with a meltable thermoplastic material that completely encapsulates the rod without leaving voids, further teaching that another acceptable tubing are those manufactured to protect pipe line joints and electrical splices from corrosion. This teaching would have provided direction to the skilled artisan to use the sleeve of Van Beersel to protect rod joints and suggests that the skilled artisan could do so with a reasonable expectation of success.

We refer to the brief and the answer for a complete exposition of the opposing viewpoints expressed by the appellant and the examiner concerning the above noted rejection.

OPINION

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For the reasons set forth below, we cannot sustain this rejection.

As correctly explained by the appellant, the structural member disclosed by Van Beersel relates to thermally insulated pipe joints and is totally unlike the here claimed corrosion-resistant structural member which involves protecting from corrosion-causing elements the joint that connects reinforcing rods. For example, the Van Beersel member does not include a sleeve having inner and outer layers whereby, when heat is applied to the structural member, the liquefied inner layer is forced "into intimate contact with the corrodible surfaces" of the reinforcing rod connecting ends (appealed claim 1). Similarly, Van Beersel contains no teaching or suggestion of the structural member defined by appealed claim 1 which results in "the liquefied thermoplastic polymer coating the corrodible surfaces and the joint, and exuding from open ends of the sleeve, forming a bead and acting as a barrier to corrosion-causing elements".

Moreover, as convincingly argued by the appellant, the Weatherby reference fails to remedy the above discussed deficiencies of Van Beersel. For example, while Weatherby

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relates to a structural member for protecting from corrosion the steel rod of an earth tieback, this member is not involved with the joint which connects reinforcing rods and correspondingly is unrelated to the problem addressed and solved by the appealed claim 1 structural member particularly with respect to covering the joint and the corrodible surfaces of the connected reinforcing rods.

These deficiencies of the applied prior art lead us to conclude that the examiner's above quoted conclusion of obviousness is not well taken. Indeed, this conclusion is not supported by any specific explanation by the examiner as to how or why one having an ordinary level of skill in the art would have so combined the applied reference teachings as to result in a structural member corresponding to the appealed claim 1 subject matter. Moreover, we independently perceive no way of so combining these reference teachings without the use of impermissible hindsight guidance provided by the appellant's own disclosure.

Under these circumstances, it is our determination that the rejection before us is based upon the unwitting

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application of impermissible hindsight derived from the appellant's own disclosure rather than upon some teaching, suggestion or incentive derived from the applied prior art. W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 220 USPQ 303, 312-313 (Fed. Cir. 1983). Accordingly, we cannot sustain the examiner's § 103 rejection of the claims on appeal as being unpatentable over Van Beersel in view of Weatherby and Wetmore.

This decision of the examiner is reversed.

REVERSED

JOHN D. SMITH)
Administrative Patent Judge)
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BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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CATHERINE TIMM))
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