

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte W. HARRY SMITH

Appeal No. 1998-1569
Application 08/485,081

ON BRIEF

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

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief, and based on our review, find that we cannot sustain the rejection of appealed claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Gomersall or Higuchi et al. (Higuchi) in view of Bohne; the rejection of appealed claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Gomersall or Higuchi in view of Bohne and Stubbe et al. (Stubbe) or Tanighchi et al. (Tanighchi); the rejection of appealed claims 5 through 8, 10, 11 and 13 through 16 under 35 U.S.C. § 103(a) as being unpatentable over Gomersall or Higuchi in view of Bohne and Pistor; and the rejection of appealed claims 8, 9 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Gomersall or

Higuchi in view of Bohne and Pistor and Stubbe or Taniguchi.^{1,2} For the reasons pointed out by appellant in the brief, the examiner has failed to make out a *prima facie* case with respect to these grounds of rejection.

A *prima facie* case of obviousness is established by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Warner*, 379 F.2d 1011, 1014-17, 154 USPQ 173, 175-78 (CCPA 1967).

Upon carefully considering the combined teachings of Gomersall, Higuchi and Bohne as explained by the examiner, which is the common core of the prior art applied in each of the grounds of rejection, it appears that the examiner's position is that these teachings would have reasonably suggested to one of ordinary skill in this art that the Al-Si alloy of Gomersall and of Higuchi would be used to coat the underground pipe of Bohne even though the examiner finds that the latter reference "discloses an underground pipe being protected by an anode layer, which can be of Al alloy . . . because it would have been obvious to apply the conventional coating technique to any metal substrate vulnerable to corrosion" and "[a]n underground pipe, as shown by Bohne, is clearly vulnerable to corrosion" (answer, pages 4-5). We determine that while one of ordinary skill in this art would certainly have expected an underground pipe to be vulnerable to corrosion as the examiner states, as appellant points out in the brief (pages 12-14), the prior art as applied by the examiner does not provide a factual foundation establishing that this person would have used the Al-Si alloy of Gomersall and of Higuchi, which are disclosed to be useful in other environments, to coat the pipe of Bohne. Indeed, that portion of Bohne on which the examiner relies, would have taught one of ordinary skill in this art that the Al alloy is used in a

¹ The appealed claims 5 through 19 are all of the claims in the application. See specification, pages 16-18 and 20 and October 15, 1996 (Paper No. 6) and May 12, 1997 (Paper No. 12).

sacrificial anode that is separated from the surface of the pipe by protective coatings (col. 2, line 51, to col. 4, line 12; see answer, page 4), and thus, at best, the combined teachings of the references would have reasonably suggested the use of the Gomersall and Higuchi alloys in the sacrificial anode rather than in a coating *on* the pipe, which is not the claimed invention. *See Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988). Accordingly, because the examiner has not shown that the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, we are constrained to reverse the grounds of rejection.

The examiner's decision is reversed.

REMAND TO THE EXAMINER

The examiner should consider the issue of whether the claimed invention as a whole would have been obvious over the state of the prior art as acknowledged by appellant in the specification, including the United States Patents cited in support of the acknowledgment (pages 2-4). *Cf. In re Nomiya*, 509 F.2d 566, 570-71, 571 n.5, 184 USPQ 607, 611, 611 n.4 (CCPA 1975) (“We see no reason why appellants’ representations in their application should not be accepted at face value as admissions that Figs. 1 and 2 may be considered “prior art” for any purpose, including use as evidence of obviousness under § 103. [Citations omitted.] By filing an application containing Figs. 1 and 2, labeled prior art, *ipsissimis verbis*, and statements explanatory thereof, appellants have conceded what is to be considered as prior art in determining obviousness of their improvement.”). We note that appellant states that the problem of protecting iron pipes used for transportation of materials in different environments from corrosion was known in the art, see *Nomiya*, 509 F.2d at 574, 184 USPQ at 613 (“The significance of evidence that a problem was known in the prior art is, of course, that knowledge of a problem provides a reason or motivation for workers in the art to apply their skill to its solution.”), and acknowledges the following solutions to such problems (specification, pages 2-3):

² Answer, pages 4-6.

Various methods and materials have been developed to create protective coatings for pipes. A typical method for protecting pipe involves providing an aluminum coating which is applied to an iron pipe, as exemplified by U.S. Patent Nos. 4,755,224, 4,878,963 and 3,881,880. Aluminum is typically used as a pipe coating because it is noted for its ability to resist corrosion. In these patents, a thin layer is applied to an iron pipe before installation in a harsh environment, such as in or near salt water. Many of the protective aluminum coatings and their methods of application were even developed to enable the pipe to be used in high temperature environments.

The prior art also discloses protective pipe coating that employ alloys so as to obtain the benefits offered by a combination of materials in a protective coating. For example, U.S. Patent Nos. 4,891,274 and 5,234,514 utilize varying amounts of silicon and several other materials to create aluminum alloys that provide varying degrees of protection, as well as other benefits that aluminum alone can provide.

Reversed

Remanded

CHUNG K. PAK)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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