

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIRK NEMEGEER
and
YVES VANCRAEYNEST

Appeal No. 97-2557
Application No. 08/453,829¹

HEARD: June 10, 1998

Before McCANDLISH, Senior Administrative Patent Judge,
PATE 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 through 25, which are all of the claims pending in this application.

¹ Application for patent filed May 30, 1995. According to the appellants, the application is a continuation of Application No. 08/058,302, filed May 10, 1993, now abandoned.

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We REVERSE.

BACKGROUND

The appellants' invention relates to reinforced concrete. An understanding of the invention can be derived from a reading of exemplary claims 1 and 14, which appear in the appendix to the appellants' brief.

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

Moens	4,224,377	Sep. 23, 1980
Kobayashi et al. (Kobayashi)	4,565,840	Jan. 21, 1986
Destree et al. (Destree)	4,883,713	Nov. 28, 1989

Claims 1 to 10 and 13 to 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moens in view of Kobayashi.

Claims 11, 12, 24 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moens in view of Kobayashi and Destree.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Office action mailed July

25, 1995 (Paper No. 14), the examiner's answer (Paper No. 17, mailed April 17, 1996) and the supplemental examiner's answer (Paper No. 20, mailed August 13, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 16, filed December 26, 1995), reply brief (Paper No. 18, filed June 17, 1996) and supplemental reply brief (Paper No. 21, filed October 9, 1996) 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 any of the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 25 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 the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual 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). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d

1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The claims under appeal recite reinforced concrete (claims 1 to 13) or a method of reinforcing concrete (claims 14 to 25). All claims require that the concrete material to have a compressive strength of at least 80 Newtons per square millimeter without fibers (see claim 1, ¶ (c) and claim 14, ¶ (a)).

The applied prior art (i.e., Moens, Kobayashi and Destree) do not teach or suggest a concrete material having a compressive strength of at least 80 Newtons per square millimeter without fibers.

The appellants specification (page 7, lines 15-17) provides that conventional concretes without fibers have a compressive strength of about 30 to 50 Newtons per square millimeter.

The examiner determined (Paper No. 14, page 2) that the claimed limitation that the concrete material have a compressive strength of at least 80 Newtons per square millimeter without

fibers was an obvious engineering design choice. We do not agree.

As correctly pointed out by the appellants (brief, page 7) the examiner has not pointed to any disclosure of any concrete material having a compressive strength of at least 80 Newtons per square millimeter. Since the examiner has not established that concrete material having a compressive strength of at least 80 Newtons per square millimeter was known in the art at the time the invention was made, the examiner has not provided a factual basis to conclude that such a concrete would have been an obvious engineering design choice. Moens is silent as to the compressive strength of the concrete used in his invention. Thus, the compressive strength is a matter of engineering design choice, but only within the known range of compressive strengths for known concretes. Since the record before us only establishes that concrete having a compressive strength of up to 50 Newtons per square millimeter were known in the art, we are constrained to reverse the examiner's implicit determination that concrete having a compressive strength of at least 80 Newtons per square millimeter would have been obvious to one of ordinary skill in the art at the time the invention was made.

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For the reason provided above, the decision of the examiner to reject claims 1 through 25 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 25 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
WILLIAM F. PATE, III)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/453,829

APJ NASE

APJ PATE

SAPJ McCANDLISH

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 16 Jun 98

FINAL TYPED: