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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
14/313,645 06/24/2014 Ronald P. Hohmann, JR. MLP 7728.US 8886

321 7590 11/14/2018
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Table with 1 column: EXAMINER

A, PHI DIEU TRAN

Table with 2 columns: ART UNIT, PAPER NUMBER

3633

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

11/14/2018

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RONALD P. HOHMANN, JR.

Appeal 2017-010238
Application 14/313,645
Technology Center 3600

Before BIBHU R. MOHANTY, AMEE A. SHAH, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL¹

The Appellant² appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Throughout this Decision, we refer to the Appellant's Appeal Brief ("Br.," filed Dec. 5, 2016) and Specification ("Spec.," filed June 24, 2014 and amended Sept. 21, 2015), and to the Examiner's Answer ("Ans.," mailed Apr. 19, 2017) and Final Office Action ("Final Act.," mailed June 3, 2016).

² According to the Appellant, the real party in interest is Columbia Insurance Company. Br. 2.

STATEMENT OF THE CASE

The Appellant's invention "generally relates to anchoring systems for insulated cavity walls, and more specifically, a thermally-isolating fastener that creates a thermal break in a cavity wall." Spec. ¶ 1.

Claims 1 and 12 are the independent claims on appeal. Claim 1 (Br. 13 (Claims App.)) is exemplary of the subject matter on appeal and is reproduced below:

1. A thermally-isolating fastener for use in a cavity wall to connect a wall anchor to an inner wythe, the fastener comprising:

a fastener shaft having a screw portion including a driven end and an attachment portion opposite the driven end; and

a fastener head selectively attachable to the attachment portion of the fastener shaft, the fastener head comprising an internal portion and an external portion encasing the internal portion and configured to provide a thermal break in the cavity wall when installed, wherein the external portion fully encases the internal portion such that no part of the internal portion is exposed when the fastener head is attached to the attachment portion of the fastener shaft, the fastener shaft and internal portion of the fastener head comprising one of mill galvanized, hot galvanized, and stainless steel.

REJECTIONS

Claims 1–6 and 9–11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hashimoto (US 4,887,951, iss. Dec. 19, 1989), Cohen (US 3,440,922, iss. Apr. 29, 1969), and Mair (US 8,029,223 B2, iss. Oct. 4, 2011).

Claims 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hashimoto, Cohen, Mair, and Day et al. (US 4,948,319, iss. Aug. 14, 1990) (“Day”).

Claims 12–16 and 18–20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hohmann et al. (US 6,925,768 B2, iss. Aug. 9, 2005), Hashimoto, Cohen, and Mair.

Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hohmann, Hashimoto, Mair, and Day.

ANALYSIS

The Appellant contends that the Examiner’s rejections under 35 U.S.C. § 103(a) of independent claims 1 and 12 are in error because the Examiner has not provided adequate reasoning why one of ordinary skill in the art would modify Hashimoto’s resin screw to be formed from mill galvanized, hot galvanized, or stainless steel as taught by Mair. *See* Br. 8–9, 11. After careful review of the Appellant’s arguments as presented in the Appeal Brief, we do not agree with the Appellant’s contention.

The Examiner finds, in relevant part, that Hashimoto teaches a fastener having a metal fastener shaft with a screw portion including a driven end and an attachment portion, and a fastener head comprising an internal metal portion and an external nylon, resin portion, as recited in independent claims 1 and 12. *See* Final Act. 2–3, 7. The Examiner acknowledges that Hashimoto does not teach the shaft and internal head portion comprising mill galvanized, hot galvanized, or stainless steel, and relies on Mair to cure this deficiency. *Id.* at 3, 8. The Examiner concludes that “one having ordinary skill in the art would have found it obvious to

modify Hashimoto's modified structures to show the head and shaft made of mill galvanized, hot galvanized and stainless steel as taught by Mair in order to provide a fastener that is resistant to rust." *Id.* at 4; *see also id.* at 9.

Hashimoto discusses that a "major disadvantage" of a metal screw is that "its head can rust after attachment." Hashimoto, col. 1, ll. 29–33. Hashimoto also discusses that another disadvantage is a visual mismatch between the metal head and a color panel. *Id.* at col. 1, ll. 33–39. Thus, Hashimoto discloses a screw with a metal body having a small head portion and a head of synthetic resin material fitted onto the small head portion. *See id.* at col. 2, ll. 10–14. Mair teaches, and the Appellant does not disagree, a galvanized or stainless steel screw. Mair, col. 5, ll. 6–8.

The Appellant argues that "there is no need to further modify Hashimoto to have the head portion 7 and shank portion 4 be formed from steel to protect from corrosion because the screw in Hashimoto, and in particular the head 3 and head portion 7, is already corrosion resistant." Br. 8. But, Hashimoto discloses only a corrosion-resistant head external portion fitted onto the small metal head interior portion. Hashimoto, col. 2, ll. 10–14. Hashimoto is silent as to the corrosion resistant properties of the shaft and internal smaller portion of the head. As such, the Examiner is not proposing "add[ing] a coating to a fastener for corrosion protection if the fastener is already made out of material providing corrosion protection." Br. 8. Rather, the Examiner's combination proposes having Hashimoto's metal of the shaft and small head portion comprise galvanized or stainless steel, as taught by Mair, to extend the corrosion resistance to the shaft and interior head. The Appellant has not sufficiently shown why it would not be reasonable for one of ordinary skill in the art to do so to make the entire

screw, not only the external head, resistant to rust, as the Examiner determines. *See* Final Act. 4; Ans. 11.

The Appellant further argues that the Examiner uses impermissible hindsight because:

If the screw is corrosion resistant, no resin or other coating is needed as demonstrated by Mair. Only by improperly using Applicant's disclosure (which applies a thermal break material to a corrosion resistant screw) as a guide to pick and choose among the features of Hashimoto and Mair is a [sic] one corrosion resistant material covered with another corrosion resistant material to make the requirements of claim 1.

Br. 9. However, the Appellant does not adequately explain how providing more rust resistance to the interior head of the screw to counteract any wear and tear to the exterior cover of the head (*see* Ans. 11) is ineffective to support the conclusion of obviousness and includes "knowledge gleaned only from" the Appellant's disclosure. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); *see also* Ans. 11.

Thus, we are not persuaded of error on the part of the Examiner, and we sustain the Examiner's rejections of independent claims 1 and 12 and dependent claims 2–6, 9–11, 13–16, and 18–20 under 35 U.S.C. § 103(a).

The Appellant argues that the rejections of claims 7, 8, and 17 are in error because the cited prior art does not cure the deficiencies of the rejection of claim 1. *See* Br. 10–11. Because we find no such deficiency in the rejection of claim 1, we also sustain the rejections under 35 U.S.C. § 103(a) of claims 7, 8, and 17.

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Application 14/313,645

DECISION

The Examiner's rejections of claims 1–20 under 35 U.S.C. § 103(a) are AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED