

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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PETER HIMMELSBACH  
and PETER JAUCHEN

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Appeal No. 2001-0242  
Application No. 09/183,114

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HEARD: May 8, 2002

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Before PAK, KRATZ, and POTEATE, 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 refusal to allow claims 2 through 16 which are all of the claims pending in the above-identified application.

CLAIMED SUBJECT MATTER

Claims 16 and 3 are representative of the subject matter on appeal and read as follows:

16. An adhesive tape comprising a backing material coated on at least one surface thereof with a pressure sensitive adhesive composition, said pressure sensitive adhesive composition being coated on said at least one surface in a plurality of discrete and

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discontinuous areas of pressure sensitive adhesive composition, such that the pressure sensitive adhesive composition only partially coats said surface, and wherein the adhesive tape under a tensile load of 10 N/cm has an extension of greater than 10% and, when bonded to a substrate, can be removed from the substrate by pulling on the adhesive tape in the direction of the plane of the bond formed by the bonding of said adhesive tape to said substrate.

3. Backing material according to Claim 4 , wherein the self-adhesive composition is a hotmelt adhesive composition having a dynamic-complex glass transition temperature with a frequency of 0.1 rad/s of less than 5°C.

PRIOR ART

The prior art references relied upon by the examiner are:

Korpman	4,024,312	May 17, 1977
Takemoto et al. (Takemoto) (Published European Patent Application)	0 353 972 A1	Feb. 7, 1990
Kreckel et al. (Kreckel) (Published International Application under PCT)	WO 92/11333	Jul. 9, 1992

REJECTION

The appealed claims stand rejected as follows:

- 1) Claims 16, 2, 4 and 12 through 15 under 35 U.S.C. § 103 as unpatentable over the disclosure of Kreckel;
- 2) Claim 5 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Kreckel and Korpman; and
- 3) Claims 3 and 6 through 11 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Kreckel and Takemoto.

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully considered the claims, specification and applied prior art, including all of the arguments and evidence advanced by the examiner and appellants in support of their respective positions. As a consequence of this consideration, we have made the determinations which follow.

We reverse rejections (1) and (2) for the reasons set forth at pages 3 through 6 of the Brief. The examiner acknowledges that neither Kreckel nor Korpman teaches or would have suggested the placement of a pressure sensitive adhesive composition on a plurality of discrete and discontinuous areas of at least one surface of a backing material. Although Takemoto teaches such a limitation, it is not relied upon in the examiner's statements of rejection for rejections (1) and (2).

We also reverse rejection (3) for reasons stated *infra* in our new ground of rejection entered against claims 2 through 15 pursuant to 37 CFR § 1.196(b). In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection on prior art cannot be based on speculations and assumptions (*see In*

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*re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962);  
*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)),  
we are constrained to reverse the examiner's rejection (3). We  
hasten to add that this is a procedural reversal rather than one  
based upon the merits of the Section 103 rejection.

Pursuant to 37 CFR § 1.196(b), we enter the following new  
grounds of rejection:

Claims 2 through 15 are rejected under 35 U.S.C. § 112, second  
paragraph, as being indefinite for failing to particularly point  
out and distinctly claim the subject matter which the appellants  
regard as the invention. The purpose of the second paragraph of  
§ 112 is to provide those who would endeavor, in future  
enterprises, to approach the area circumscribed by the claims of a  
patent, with adequate notice demanded by due process of law, so  
that they may more readily and accurately determine the boundaries  
of protection involved and evaluate the possibility of infringement  
and dominance. *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204,  
208 (CCPA 1970). In order to satisfy the purpose of the second  
paragraph of § 112, the claims in question must accurately define  
the invention in the technical sense. See *In re Knowlton*, 481 F.2d  
1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). It is important to  
note that no claims may be read apart from and independent of the

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supporting disclosure on which they are based. *See In re Cohn*, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971).

Applying these principles to the present case, we are of the opinion that the recitations of "backing material according to claim 16" in claims 2 through 15 and "tackifiers such as oils, waxes, resins and mixtures thereof, preferably mixtures of resins and oils" in claim 5 introduce uncertainty into the claims which would preclude one skilled in the art from determining the metes and bounds of the claimed subject matter. In this regard, we observe that claim 16 is directed to an adhesive tape having a backing material as one of its components. In contrast to the actual subject matter recited in claim 16, claims 2 through 15, state in their preamble the "[b]acking material according to claim 16". Thus, it is not clear from the specification and the claims in question whether the appellants intend to limit the claims to the adhesive tape according to claim 16 consistent with the fourth paragraph of § 112 or just any backing material (without, e.g., adhesives) which is part of the adhesive tape of claim 16.<sup>1</sup>

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<sup>1</sup> The fourth paragraph of 35 U.S.C. § 112 requires dependent claims to further limit their parent claim. Thus, if the appellants' intent is to recite a backing material rather than an adhesive tape, such a recitation may violate the fourth paragraph of 35 U.S.C. § 112.

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*Compare Ex parte Kristensen*, 10 USPQ2d 1701 (Bd. Pat. App. & Int. 1989); *Ex parte Forsyth*, 151 USPQ 55, 56 (Bd. App. 1966).

Moreover, it is not clear what tackifiers are intended to encompass by "tackifiers such as oils, waxes, resins and mixtures thereof, preferably mixtures of resins and oils". Specifically, it cannot be ascertained from the specification and claim 5 whether the appellants intend to limit claim 5 to any tackifiers, the exemplified tackifiers or the preferred tackifiers. See *Ex parte Hall*, 83 USPQ 38, 39 (Bd. App. 1949).

In view of the foregoing, we determine that claims 2 through 15 not only fail to accurately define the invention in the technical sense, but also lack consistency, thus rendering them indefinite.

Claim 16 is rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of either Kreckel or Korpman and Takemoto.

Appellants do not dispute that both Kreckel and Korpman disclose the claimed adhesive tape except for the following claim feature:

said pressure sensitive adhesive composition being coated on said at least one surface in a plurality of discrete and discontinuous areas...

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The adhesive tape described in Kreckel and Korpman can be used for medical application such as bandages. See Kreckel, page 11, line 3 and Korpman, column 1, lines 41-42. This adhesive tape, according to column 1, lines 41-50, of Korpman, is advantageous in that it can be removed without pain from the skin due to both the high extensibility and easy stretchability of the film-adhesive laminate.

Although both Kreckel and Korpman is silent as to coating a pressure sensitive adhesive composition on at least one surface of a backing material in a plurality of discrete and discontinuous areas as indicated *supra*, Takemoto teaches at column 7, lines 10-21, various advantages in using a plurality of discrete and discontinuous pressure sensitive adhesive coatings on at least one surface of a backing material of a medical bandage. The backing material taught by Takemoto embraces those described in Kreckel and Korpman. See column 2, lines 19-20 and column 5, line 54 to column 6, line 4.

Given the above teachings, we determine that one of ordinary skill in the art would have been led to employ the plurality of discrete and discontinuous pressure sensitive adhesive coatings taught by Takemoto on the surfaces of the backing materials of the type described in Kreckel or Korpman, motivated by a reasonable

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expectation of successfully obtaining the advantages listed in Kreckel, Korpman and Takemoto. Accordingly, we conclude that the combined disclosures of either Kreckel or Korpman and Takemoto would have rendered the claimed subject matter obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

#### OTHER ISSUES

Upon clarification of the subject matter recited in claims 2 through 15, the examiner is to determine whether their patentability is affected by the combined teachings of either Kreckel or Korpman and Takemoto.

#### CONCLUSION

In summary, we

- 1) reverse the examiner's decision rejecting claims 2, 4 and 12 through 16 under 35 U.S.C. § 103 as unpatentable over the disclosure of Kreckel;
- 2) reverse the examiner's decision rejecting claim 5 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Kreckel and Korpman;
- 3) reverse the examiner's decision rejecting claims 3 and 6 through 11 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Kreckel and Takemoto;

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- 4) reject claims 2 through 15 under 35 U.S.C. § 112, second paragraph, as being indefinite pursuant to 37 CFR § 1.196(b);
- 5) reject claim 16 under 35 U.S.C. § 103 as unpatentable over the combined disclosure of either Kreckel or Korpman and Takemoto pursuant to 37 CFR § 1.196(b); and
- 6) order the examiner to determine whether the patentability of the subject matter of claims 2 through 15 is affected by the combined disclosures of either Kreckel or Korpman and Takemoto upon clarification of the scope of claims 2 through 15.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

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(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED/§ 196(B)

CHUNG K. PAK	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
PETER F. KRATZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
LINDA R. POTEATE	)	
Administrative Patent Judge	)	

CKP/lp

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# **Letty**

JUDGE PAK

APPEAL NO. 2001-0242

APPLICATION NO. 09/183,114

APJ PAK

APJ KRATZ

APJ POTEATE

DECISION: **REVERSE/196 (b)**

**PREPARED:** Jun 20, 2003

**OB/HD**

**PALM**

**ACTS 2**

**DISK (FOIA)**

**REPORT**

**BOOK**