

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. SMITH

Appeal No. 95-0761
Application 08/050,511¹

HEARD: MARCH 5, 1998

Before JOHN D. SMITH, WARREN and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1-16, which are all of the claims remaining in the application.

¹ Application for patent filed April 20, 1993.

THE INVENTION

Appellant claims a dry transfer graphics article which has, in order, a backing film, a release coating, a continuous brittle polymeric film, and a pigmented pressure sensitive adhesive in a pattern, such that when the adhesive is bonded to a substrate and the backing film is pulled away from the substrate, the polymeric film fractures along the borders defining the pattern and only the portion of the polymeric film attached to the adhesive transfers with the adhesive to the substrate. Appellants also claim a method for making the article by applying each of the layers of the article and curing the article. Claim 1 is illustrative and reads as follows:

1. A method for preparing a pressure sensitive dry transfer graphics article for application to a bonding substrate comprising the steps of:

- a) applying, to a backing film comprising a first face and a second face, a release coating to said first face;
- b) applying to said release coating a continuous film of brittle polymeric compound;
- c) applying in imagewise fashion to said polymeric film a pigmented pressure sensitive adhesive coating to form a graphic pattern; and
- d) curing said article formed by steps (a) through (c);

whereby, upon application of said pressure sensitive dry transfer graphics article to the bonding substrate by pressure applied to the areas defined by said graphic pattern, said pigmented pressure sensitive adhesive is transferred to the bonding substrate and, after peeling said article away from said bonding substrate, said polymeric film fractures along the borders defining said graphic pattern such that the polymeric film in union with said graphic pattern is transferred with said pressure sensitive adhesive to the bonding substrate and the polymeric film not in union with said graphic pattern remains with said release coating.

THE REFERENCES

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Rosenfeld	4,028,165	June 7, 1977
Arnold et al. (Arnold)	4,308,310	Dec. 29, 1981
Incremona et al. (Incremona)	4,919,994	Apr. 24, 1990
Hochner (Canadian patent)	934,614	Oct. 2, 1973

THE REJECTIONS

Claims 1-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Arnold, Hochner or Rosenfeld, each in view of Incremona. These claims also stand rejected under 35 U.S.C. § 112, first paragraph, written description and enablement.²

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the aforementioned rejections are not well founded. Accordingly, these rejections will be reversed.

Rejection under 35 U.S.C. § 103

Arnold discloses a dry transfer decal comprised of, in order, a backing film, a urethane film, printed ink layers, an optional clear lacquer layer, and a screened or printed high tack adhesive layer (Fig. 1; col. 1, lines 54-59; col. 2, line 43 - col. 3, line 53). The urethane film

² The examiner's answer includes an objection to the specification under 35 U.S.C. § 112, first paragraph, but does not include an associated rejection. Since claims 1-16 were rejected under 35 U.S.C. § 112, first paragraph, in the final rejection (paper no. 4) and the examiner has not withdrawn the rejection, it appears that the omission of the rejection of claims 1-16 under 35 U.S.C. § 112, first paragraph, in the examiner's answer was inadvertent. Thus, we consider claims 1-16 to be rejected under 35 U.S.C. § 112, first paragraph.

bonds strongly to the backing film but can be peeled from it, and should be tough and flexible (col. 2, line 65 - col. 3, line 12). Arnold does not disclose a release coating, a continuous film of a brittle polymer applied to the release coating, and adhesive applied imagewise to the continuous brittle polymeric film.

Hochner discloses a dry transfer material which includes a backing film having thereon a polymeric coating which preferably verges on being brittle, printed indicia on the surface of the polymeric coating, and a dry elastomeric pressure sensitive adhesive over the indicia and the unprinted portion of the polymeric coating (page 2, lines 26-32; page 3, lines 28-31; page 7, lines 14-16). When the adhesive is adhered to a substrate and the backing film is pulled away, the adhesive shears along the outline of the indicia and the indicia are pulled from the polymeric coating along with the adhesive to which the indicia are attached (page 8, lines 1-5). Hochner does not disclose a release coating and adhesive applied imagewise to the brittle polymeric film such that the brittle polymeric film will fracture along the borders of the adhesive when the backing film is pulled away from a substrate to which the adhesive is attached.

Rosenfeld discloses a dry transfer article comprised of a backing film having thereon a polymeric coating which has a low modulus of elongation, indicia applied to the polymeric coating, and adhesive which may be applied in registration with the indicia (col. 2, lines 40-45). Rosenfeld teaches that release coatings were known in the art, but that they have disadvantages which are overcome by his article, wherein the ink is released from the polymeric coating by burnishing the carrier film (col. 1, lines 41-57; col. 2, lines 17-20; col. 4, lines 2-12). Rosenfeld

does not disclose use of a release coating in his article, application of the adhesive to the polymeric coating, or sufficient adhesion of the indicia to the polymeric coating that the polymeric coating will fracture when the backing film is pulled away from a substrate to which the adhesive is applied.

The examiner argues that Arnold, Hochner and Rosenfeld disclose appellant's article except for the pigmented adhesive and release layer (answer, pages 4-5). We are not persuaded by this argument because we find the above-noted differences between the teachings of these references and appellant's claimed invention.

The examiner argues that the release layer is either inherent or an obvious modification of the references, but provides no supporting evidence or reasoning.

When an examiner relies upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990). Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986).

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere

fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritsch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. *Id.* at 1266, 23 USPQ2d at 1783-84.

Because the examiner has not provided the required evidence or reasoning to support his argument that appellant's release layer is inherent in or would have been obvious to one of ordinary skill in the art in view of the applied references, the examiner's argument is not sufficient for establishing a *prima facie* case of inherency or obviousness as to the release layer.

The examiner argues that Arnold, Hochner and Rosenfeld disclose the intended mode of operation in appellant's "whereby" clause (answer, page 5). The examiner does not explain, and we do not independently find, where any of these references disclose an adhesive applied in a graphic pattern to a brittle polymeric coating such that the brittle polymeric coating will fracture along the borders of the graphic pattern when the article is peeled away from a substrate to which the adhesive is attached.

The examiner argues that Incremona discloses (col. 8, line 44) the use of pigmented adhesives in dry transfer graphics articles, and that it would have been obvious to one of ordinary skill in the art to use a pigmented adhesive in the Arnold, Hochner and Rosenfeld articles (answer, page 5). Appellant does not challenge this argument.

Regarding the method claims, the examiner argues (answer, page 6) that

at least the great majority, if not all, of the claimed nominal method steps are disclosed by each of the three relied upon combination rejections, and as such the Examiner has chosen to additionally rely upon the doctrine of *in re Durden* [sic], 763 F. 2d [sic] 1406, 222 USPQ 359, as further modified by *ex parte Kifer* [sic], 5 USPQ 2d [sic] 1904, that a process is not patentable for the sole reason that it uses as an intermediate or makes a product that is patentable, which seems clearly applicable.

This argument is not convincing because the examiner has not pointed out, and it is not apparent, where the particular method steps recited in appellant's claims are disclosed in or would have been suggested to one of ordinary skill in the art by the relied-upon references. The examiner's broad statement that "at least the great majority, if not all, of the claimed nominal method steps are disclosed by each of the three relied upon combination rejections" (answer, page 6) is not sufficient for establishing *prima facie* obviousness of the particular method claimed by appellant.

As for the examiner's reliance on a *per se* rule that a process is not patentable solely because it uses a patentable intermediate or makes a patentable product (answer, page 6), the Federal Circuit stated in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), that "reliance on *per se* rules of obviousness is legally incorrect and must cease." The

court further stated:

Mere citation of *Durden*, *Albertson*, or any other case as a basis for rejecting process claims that differ from the prior art by their use of different starting materials is improper, as it sidesteps the fact-intensive inquiry mandated by section 103. In other words, there are not “*Durden* obviousness rejections” or “*Albertson* obviousness rejections,” but rather only section 103 obviousness rejections. 71 F.3d at 1570, 37 USPQ2d at 1132.

When an examiner is determining whether a claim should be rejected under 35 U.S.C. § 103, the claimed subject matter as a whole must be considered. *See Ochiai*, 71 F.3d at 1569, 37 USPQ2d at 1131. The subject matter as a whole of process claims includes the starting materials and product made. When the starting and/or product materials of the prior art differ from those of the claimed invention, the examiner has the burden of explaining why the prior art would have motivated one of ordinary skill in the art to modify the materials of the prior art process so as to arrive at the claimed invention. *See Ochiai*, 71 F.3d at 1570, 37 USPQ2d at 1131. The examiner has not provided such an explanation.

The examiner argues that appellant’s claims, because the transition term is “comprising”, are open to additional layers (answer, page 8). This argument is not convincing because, regardless of whether appellant’s article and method can include other layers, the examiner has not explained why the references disclose or would have suggested, to one of ordinary skill in the art, the particular combination of layers recited in appellant’s claims.

For the above reasons, we conclude that the examiner has not carried his burden of establishing a *prima facie* case of obviousness of appellant’s claimed article or method.

Rejection under 35 U.S.C. § 112, first paragraph

The examiner argues that because appellant's specification does not disclose any meaningful information regarding the pigmented adhesive, and does not disclose substantive criteria concerning making selections such as pigment colors, particle size ranges, concentrations and degree of opacity, appellant's disclosure does not meet the written description and enablement requirements of 35 U.S.C. § 112, first paragraph (answer, pages 3-4).

A specification complies with the 35 U.S.C. § 112, first paragraph, written description requirement if it conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-4, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *In re Edwards*, 568 F.2d 1349, 1351-2, 196 USPQ 465, 467 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

Appellant's original specification discloses that a pigmented pressure sensitive adhesive is used in appellant's claimed article (page 6, line 15; original claim 4) and method (page 6, line 31; original claim 1). Thus, the specification indicates that appellant was in possession as of his filing date of an article and method in which a pigmented pressure sensitive adhesive is used. We therefore find that the examiner has not carried his burden of establishing a *prima facie* case of

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inadequate written description.

A specification complies with the 35 U.S.C. § 112, first paragraph, enablement requirement if it allows those of ordinary skill in the art to make and use the claimed invention without undue experimentation. *See In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *Atlas Powder Co. v. E. I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984). As stated by the court in *Wright*, 999 F.2d at 1561-62, 27 USPQ2d at 1513:

Nothing more than objective enablement is required, and therefore it is irrelevant whether this teaching is provided through broad terminology or illustrative examples. [citation omitted]

When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling.

The examiner's statements that appellant's specification does not disclose information and selection criteria for the pigmented adhesive do not constitute a reasonable explanation as to why the scope of protection provided by appellant's claims is not enabled by appellant's specification. The examiner has provided no evidence or reasoning which shows that one of ordinary skill in the art, given appellant's original disclosure, would not have been able to practice appellant's claimed invention without undue experimentation. Hence, we conclude that the examiner has not carried his burden of establishing a *prima facie* case of lack of enablement.

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DECISION

The rejections of claims 1-16 under 35 U.S.C. § 103 over Arnold, Hochner or Rosenfeld, each in view of Incremona, and under 35 U.S.C. § 112, first paragraph, written description and enablement, are reversed.

REVERSED

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
)	
TERRY J. OWENS)	
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