

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD A. BRAULT, DOUGLAS A. CAHILL,
RICHARD S. HIMMELWRIGHT and DENE H. TAYLOR

Appeal No. 97-0222
Application 08/115,561¹

ON BRIEF

Before KIMLIN, WEIFFENBACH and ELLIS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-37, 42, 43 and 44, all the claims remaining in the present application. Claim 1 is illustrative:

1. A process for preparing a protected ink image comprising
 - A) imagewise depositing one or more ink images on an ink receptor, the ink receptor comprising

¹ Application for patent filed September 3, 1993.

Appeal No. 97-0222
Application 08/115,561

- 1) a temporary carrier layer;
- 2) an image transparent, protective layer; and
- 3) an image transparent, adhesive, ink receptive layer permanently adhered to the protective layer;

wherein, the one or more ink images are deposited on the image transparent, adhesive, ink receptive layer to form an ink imaged layer of an imaged receptor;

B) applying to the ink imaged layer of the imaged receptor, a substrate; wherein, the adhesive of the image transparent, adhesive, ink receptive layer is activated whereby the substrate is adhered to the ink imaged layer of the imaged receptor to form an imaged laminate; and

C) removing the temporary carrier layer from the image transparent, protective layer of the imaged laminate.

The examiner relies upon the following references as evidence of obviousness:

Hunt	4,171,398	Oct. 16, 1979
Parker et al. (Parker)	4,927,709	May 22, 1990
Yamane et al. (Yamane)	5,217,793	June 8, 1993

Appellants' claimed invention is directed to a process for preparing a protected image produced by an ink jet wherein the ink comprises a carrier liquid which is either water, a

Appeal No. 97-0222
Application 08/115,561

polyhydric alcohol or a combination thereof. The process entails depositing an image from an ink jet on an adhesive, ink receptive layer that is permanently adhered to a transparent, protective layer which, in turn, is positioned on a temporary carrier layer. The ink imaged layer is then applied to a substrate which bonds to the adhesive layer. The temporary carrier layer is then removed leaving a protected ink image on the substrate.

Appealed claims 1-29, 32-35 and 42-44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hunt in view of the admitted prior art. Claims 30 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hunt in view of Parker, and claims 36 and 37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hunt in view of Yamane. In addition, the appealed claims stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-32 of copending application, U.S. Serial No. 08/115,564 in view of Hunt.²

² The Examiner's Answer misstates the double patenting rejection at page 6 of the Answer as applicable to only claims 1-37. However, since the examiner's Advisory Action of January 18, 1996 states that all the appealed claims stand rejected, and appellants have not contested the double patenting rejection but have offered to file a terminal disclaimer, we will, for purposes of this appeal, consider all the appealed claims to stand rejected under obviousness-type double patenting.

Appeal No. 97-0222
Application 08/115,561

We consider first the examiner's rejection of the appealed claims under the judicially created doctrine of obviousness-type double patenting over claims 1-32 of copending application, U.S. Serial No. 08/115,564, in view of Hunt. Appellants submit at page 14 of the principal Brief that they will not address the merits of this rejection at this time, but will file a terminal disclaimer if one becomes necessary. Consequently, perforce, we will sustain the examiner's rejection.

We now turn to the rejection of the appealed claims under 35 U.S.C. § 103 over Hunt in view of the admitted prior art (claims 1-29, 32-35 and 42-44), in view of Parker (claims 30 and 31), and in view of Yamane (claims 36 and 37). To the extent the prior art applied by the examiner establishes a prima facie case of obviousness for the claimed subject matter, appellants have proffered a declaration by Everett W. Bennett, a Ph.D. in Organic Chemistry, as evidence of nonobviousness, i.e., unexpected results. Therefore, we must, as a matter of law, begin anew and weigh the evidence of obviousness against the evidence of nonobviousness. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). However, when we look to the Examiner's Answer for the examiner's treatment of the declaration evidence, we find that the examiner committed reversible error.

Appeal No. 97-0222
Application 08/115,561

According to the examiner, "[a]n opinion as to a legal conclusion (such as unexpected results) is not entitled to any weight. In re Chilowski, 306 F.2d 908, 134 USPQ 515 (CCPA 1962)" (page 8 of Answer, emphasis added). The examiner's reliance on Chilowski is not well founded. The court in Chilowski ruled that the issue of sufficiency of disclosure under § 112, first paragraph, is a legal one that is outside the field of expertise of appellant's experts. Therefore, the court ruled that the experts' opinions regarding the sufficiency of disclosure were of no probative value. In the present case, the fatal flaw in the examiner's rationale is that the issue of unexpected results is not a legal issue that is outside the field of expertise of the declarant, Dr. Bennett. It is fundamental that the purpose of a Rule 132 Declaration is to provide an avenue for the applicant to offer a fact-based opinion that is relevant to unexpected results emanating from the claimed invention. If the declarant simply gives an opinion that the results are unexpected without providing a factual basis for the opinion, then the examiner's second criticism of the Declaration would have merit, viz., "no logical basis for anyone's conclusion as to unexpected results has been offered" (page 8 of Answer). The examiner's criticism notwithstanding, the Declaration, at pages 3 and 4, provides factual support for the declarant's opinion why it is unexpected

Appeal No. 97-0222
Application 08/115,561

in view of the Hunt disclosure to successfully realize the claimed invention of employing an aqueous ink, printed with an ink jet, onto an adhesive surface. Inasmuch as the examiner has not presented countervailing evidence in the form of prior art or scientific reasoning relevant to why one of ordinary skill in the art would have expected an aqueous ink image produced by an ink jet to be effectively printed on an adhesive surface, we must conclude that the evidence of nonobviousness proffered by appellants outweighs the evidence of obviousness presented by the examiner. Consequently, the examiner's § 103 rejections of the appealed claims are reversed.

In conclusion, based on the foregoing, the examiner's double patenting rejection of the appealed claims is affirmed. The examiner's rejections under 35 U.S.C. § 103 are reversed. The examiner's decision rejecting the appealed claims is affirmed.

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

AFFIRMED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	
CAMERON WEIFFENBACH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND

Appeal No. 97-0222
Application 08/115,561

Ratner & Prestia
P.O. Box 7228
Wilmington, DE 19803