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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FLORIAN KLINGER

Appeal No. 1997-3801
Application 08/397,960

HEARD: MAY 16, 2000

Before PAK, OWENS, and DELMENDO, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 1-6 and 5-15 as amended after final rejection. Claims 16-24, which are all of the other claims remaining in the application, stand withdrawn from consideration by the examiner as being directed toward a nonelected invention.

THE INVENTION

Appellant's claimed invention is directed toward a process for making laminated plastic cards having a thermo-mechanically sensitive substrate.[1] Appellant states that the conventional laser printing process, wherein a substrate having an image thereon is passed between heated rollers which fix or set the print so that it is permanent and stable, damages thermo-mechanically sensitive substrates (specification, page 2). Appellant states that a purpose of the claimed process is to permit thermo-mechanically sensitive substrates to be used without damage in laser printing, and that this goal is achieved by use of only partial setting of the graphic subject matter by radiant heat (specification, pages 3 and 6). Claim 1 is illustrative and reads as follows:

1. Process for the production of laminated plastic cards,

comprising a thermo-mechanically sensitive substrate having a graphic subject matter printed thereon, which comprises;

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[1] Appellant states that a thermo-mechanically sensitive substrate is one which is significantly affected as to its physical properties, appearance or other properties relevant to its function as a printed substrate when it is passed between two rollers which are heated to a minimum temperature of 120EC and pressed against one another with a minimum pressure of 150 Kg (specification, pages 4-5).

1. providing a set of digital instructions, which defines the graphic subject matter;

2. depositing, by conventional laser printer operations, printing colors on said thermo-mechanically sensitive plastic substrate to form said graphic subject matter;

3. only partially setting said graphic subject matter by radiant heat;

4. juxtaposing to said substrate, carrying said graphic subject matter, at least a coating film on the printed face thereof; and

5. bonding said substrate and said face coating film.

THE REFERENCES

Biddle	3,068,140	Dec. 11, 1962
Ohta et al. (Ohta)	3,811,828	May 21, 1974
Warther et al. (Warther)	4,978,146	Dec. 18, 1990

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1, 2, 6-11 and 15 over Warther in view of Ohta, and claims 3-5 and 12-14 over Warther in view of Ohta and Biddle.

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, we reverse these rejections.

Warther discloses a process for making a laminated plastic card which can have a thermo-mechanically sensitive substrate[2] having graphic subject matter printed thereon (col. 8, lines 37-39). Warther teaches that the printer used to form the graphic subject matter is programmable (col. 8, line 60; col. 9, line 37), which indicates that the process can include the use of a set of digital instructions which defines the graphic subject matter. Use of a laser printer for forming the graphic subject matter is disclosed (col. 8, lines 43 and 67). After the graphic subject matter has been formed on the substrate, a coating film is applied to each side of the substrate, preferably by adhesive bonding (col. 5, lines 14-35; col. 8, lines 6-20).

Warther does not disclose the use of only partial setting of the graphic subject matter by radiant heat. The examiner relies upon Ohta for a teaching of fusing and fixing a toner

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[2] The substrate can be Teslin®, which is one of the thermo-mechanically sensitive materials used by appellant (specification, page 10).

image by use of radiant heat (answer, page 5).[3] Ohta, however, does not disclose only partial fusing of the toner.[4] The examiner argues that the degree of fusing is a parameter which would have been the result of routine experimentation (answer, page 8).

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 Fritch*, 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. *See Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84. The examiner has not provided

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[3] *See, e.g.*, column 4, lines 18-23 of Ohta.

[4] Appellant indicates that “setting” as recited in their claim 1 and “fusing” as used by Ohta have the same meaning (reply brief, page 6).

such an explanation but, rather, has merely made an assertion that one of ordinary skill in the art would have determined the degree of fusing by routine experimentation. The motivation relied upon by the examiner for using only partial fusing comes solely from the description of appellant's invention in the specification. Thus, the examiner used impermissible hindsight when rejecting the claims. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we reverse the examiner's rejections.[5]

DECISION

The rejections under 35 U.S.C. § 103 of claims 1, 2, 6-11 and 15 over Warther in view of Ohta, and claims 3-5 and 12-14 over Warther in view of Ohta and Biddle, are reversed.

REVERSED

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[5] Biddle, which is applied by the examiner to dependent claims 3-5 and 12-14, is not relied upon for any teaching which would remedy the above-discussed deficiency in the disclosures of Warther and Ohta.

CHUNG K. PAK Administrative Patent Judge	)
TERRY J. OWENS Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
ROMULO H. DELMENDO Administrative Patent Judge	)

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