

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES N. GORDON and GANGHUI TENG

Appeal No. 1997-4284
Application No. 08/471,760

ON BRIEF

Before KIMLIN, GARRIS, and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 12-20, which are all of the claims remaining in the application.

THE INVENTION

Appellants claim a method for transferring onto an imaged transparency a reflective protective overcoat having a reflective opaque area such that the image surface is protected and made viewable as a reflected image. Claim 12 is illustrative:

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12. A method for transferring a reflective protective overcoat onto an imaged transparency, the method comprising the steps of:

providing an imaged transparency, the imaged transparency comprising an image surface supported on a transparent substrate;

providing a laminar transfer sheet, the laminar transfer sheet comprising a transferable reflective protective overcoat releasably carried on a carrier web, the transferable reflective protective overcoat having a reflective opaque area corresponding at least with the extents of the image surface, the reflective protective overcoat comprising at least a durable layer, the reflective protective overcoat capable of being made bondable to the image surface upon activation of the laminar transfer sheet;

bringing the laminar transfer sheet and the image surface of the imaged transparency into substantial interfacial association such that the opaque area blanketwise covers the extents of the image surface and the durable layer is interposed between the carrier web and the image surface of the imaged transparency;

activating the laminar transfer sheet to effectuate substantially interfacial bonding of the reflective protective overcoat to the image surface of the imaged transparency; and

removing the carrier web from the laminar transfer sheet such that the reflective protective overcoat is released from the carrier web and remains substantially interfacially bonded to the image surface of the imaged transparency, whereby the image surface is protected and made viewable as a reflected image.

THE REFERENCES

Takeuchi et al. (Takeuchi) 4,856,857 Aug. 15,
1989

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejection is not well founded. Accordingly, we reverse this rejection.

Bloom discloses a method for making a reflective imaged transparency which differs from appellants' method in that there is no reflective opaque area laminated onto the imaged transparency along with the durable layer (col. 18, lines 41-44). Bloom makes his article reflective by use of an opaque substrate (col. 9, lines 32-35). Thus, Bloom's image is viewed through the durable layer, the reflection coming from the substrate, whereas appellants' image is viewed through the substrate, the reflection coming from the reflective opaque area of the transferable reflective protective overcoat.

The examiner argues that Bloom teaches that opaquing fluids can be successfully applied to the durable layer to provide a reflective background (answer, page 4). The portion of Bloom relied upon by the examiner in support of this argument (col. 21, lines 57-67) pertains to an opaquing fluid test of the durable layer, wherein it is determined whether

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the durable layer will accept an opaquing fluid with no beading, the fluid will dry to a smooth continuous coating, and the dried fluid will adhere to the durable layer after exposure to ultra-violet radiation. The film formed from the opaquing fluid is not part of the article produced by Bloom's method.

The examiner argues that Bloom's opaquing test, together with Bloom's teaching that the substrate can be reflective, is an adequate suggestion to convert the imaged transparency to a reflective print having a reflective layer (answer, page 5). The examiner, however, does not explain why the reference would have led one of ordinary skill in the art to this modification. The examiner apparently has relied upon appellants' disclosure of their invention for this guidance, and in doing so has used impermissible hindsight. 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).

The examiner relies upon Takeuchi for motivation to place an opaque reflective layer between Bloom's adhesive layer (which is adjacent to the image) and the durable layer (answer, page 5). Takeuchi discloses a hologram having, between an adhesive layer (32) and a durable layer (34), a holographic effect enhancing layer (4) (figure 15). The holographic effect enhancing layer can be a thin reflective metal film having a thickness not exceeding 200D which allows great transmittance of light such that the holographic effect is obtained and images below the film are not shielded (col. 7, lines 1-32). The examiner argues that one of ordinary skill in the art, given Bloom's opaquing fluid test discussed above, and given that Takeuchi's substrate can be either opaque or transparent (col. 19, lines 36-37), would have been motivated to adjust the thickness of Takeuchi's holographic effect enhancing layer as needed to obtain the desired reflectance and to place this layer between Bloom's adhesive layer and protective layer to produce a protected imaged transparency viewable in reflectance (answer, pages 5-6).

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must

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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 explained why the prior art itself would have led one of ordinary skill in the art to appellants' claimed invention. Instead, the examiner has used appellants' disclosure of their invention as a guide to piece together isolated teachings from the references, such as Bloom's opaquing fluid test and Takeuchi's holographic effect enhancing layer, and to modify these teachings such that appellants' claimed invention is produced. In doing so, the examiner has relied upon impermissible hindsight. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d at 1553, 220 USPQ

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at 312-13; *Rothermel*, 276 F.2d at 396, 125 USPQ 331.

Accordingly, we reverse the examiner's rejection.

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DECISION

The rejection of claims 12-20 under 35 U.S.C. § 103 over
Bloom in view of Takeuchi is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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TERRY J. OWENS)	
Administrative Patent Judge)	

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Brian L. Michaelis, Esq.
Brown, Rudnick, Freed & Gesmer, P.C.
One Financial Center, 18th Floor
Boston, MA 02111