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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 1997-4439
Application No. 08/452,125

ON BRIEF

Before WINTERS, JOHN D. SMITH and OWENS, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 8-14 and 18-20.

Claim 8 is representative and is reproduced below:

8. A method for fabricating a transfer sheet (10) for transferring a temperature responsive decal having personally applied crayon coloring (22) onto a section of fabric clothing (20), said method comprising the steps of:

providing a paper sheet (12) treated with a release agent layer disposed thereof;

applying a transparent layer (16) of fluidic thermo-plastic transfer material directly onto the release agent on the paper sheet (12) for establishing a discrete area of transfer material on the paper sheet (12) suitable for coloring by a consumer, the transfer layer (16) being adapted to bond to the release agent in ambient conditions and release therefrom in response to a predetermined elevated temperature;

solidifying the transfer layer (16);

and characterized by partially embedding a plurality of plastic adhesive-abrasive particles (18) on the transparent transfer layer (16) for providing a rough surface sufficiently rough for abrading crayon (22) rubbed thereover and for melting in response to heat to form an adhesive for enhancing the bond between the transfer material (16) and the fabric (20) to securely trap the abraded crayon therebetween.

The references of record relied upon by the examiner are :

Hare	4,980,224	Dec. 25, 1990
Reed et al. (Reed)	4,294,641	Oct. 13, 1981

Appealed claims 8-10, 14, 18, and 20 stand rejected under 35 U.S.C. § 102 as anticipated by Reed. Appealed claim 19 stands rejected under 35 U.S.C. § 103 as obvious over Reed. Appealed claims 11-13 stand rejected under 35 U.S.C. § 103 as unpatentable over Reed in view of Hare.

We cannot sustain these rejections.

The subject matter on appeal is directed to a method for fabricating a transfer sheet for transferring a thermally responsive decal onto a section of fabric, such as a t-shirt. Significantly, the decal is modified so that it may be personally colored by an applied crayon. Specifically, in the claimed method, a transparent transfer layer of thermoplastic material is applied and solidified on a release layer disposed on a paper sheet. Thereafter, a plurality of plastic adhesive-abrasive particles are embedded in the transfer layer for providing a rough surface such that a crayon rubbed over the surface is abraded to form a crayon coated surface on the transfer sheet. When the decal is transferred onto a fabric, the adhesive-abrasive particles melt in response to heat which renders the particles adhesive so that an enhanced bond is formed between the decal and the fabric to securely trap the abraded crayon therebetween. As described in his specification at page 8, lines 27-29, the adhesive-abrasive particles form “[a]n extremely strong mechanical adhesive bond when melted into the fibers of a section of fabric” which “[g]reatly improves the wear characteristics of the transfer sheet...”.

The examiner's finding that appealed claims 8-10, 14, 18, and 20 are anticipated by Reed is necessarily predicated on his factual determination that certain particulate particles described in the Reed patent are inherently "adhesive-abrasive" particles as claimed by appellants. See page 2 of Paper No. 8 and page 3 of paper No. 11 wherein the examiner's statements imply that Reed's plasticizer particles which are composed of low molecular weight polymers such as linear polyesters, polyamides and polyethylene are necessarily "adhesive-abrasive" particles as claimed apparently in part because appellants' "adhesive-abrasive" particles may also be composed of polyester or nylon (polyamide) particles as described in the specification at page 8, line 22. On the other hand, appellant argues that the Reed particles are neither adhesives nor abrasives as required by the language of their claims. See the brief at page 5, lines 19 and 20 and the Sammis declaration at page 2. For the reasons below, we find that the examiner has failed to meet his burden of establishing as a factual matter that the Reed particles are inherently "adhesive-abrasive" particles as claimed by appellant.

Reed discloses a heat transfer sheet (used for the application of designs to textiles) which comprises a flexible carrier sheet or web bearing a transfer layer of a polymer composition which is rendered non-blocking at normal temperatures by a particulate solid dispersed therein. Reed's solid particles are so selected that at the melting temperature of the transfer layer they are either removed by sublimation or converted to a form "which does not interfere with the transfer of the design to the textile." See the Reed abstract. Reed does disclose that particulate polyesters, polyamides, and polyethylene may be used as non-blocking particles in the transfer sheet, but further specifies that such polymers are low molecular weight polymers which, when melted, form a phase separate from the polymeric transfer layer. See Reed at column 5, lines 7-11. Although appellant describes the use of polyester and nylon as sources of his "adhesive-abrasive" particles as a preferred embodiment of his invention, appellant identifies these particulate materials as ground polyester and nylon which are "commonly used in the textile industry to adhere sections of fabric together". See the specification at page 8, lines 22-24. Moreover, appellant

defines his “abrasive-adhesive” particles as forming “an extremely strong mechanical adhesive bond when melted into the fibers of a section of fabric” (specification at page 8, lines 27-29), not a separate phase which “does not interfere” with the transfer of a design to a fabric as in Reed. Accordingly, there is no express indication in the Reed disclosure that the described low molecular polymer plasticizer particles possess any adhesive properties.

Here, we further observe that because of a paucity of detailed and specific disclosures regarding the low molecular weight polymeric particles of Reed, a comparative factual analysis between the claimed “adhesive-abrasive” particle components and the Reed particles, such as made in In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) cannot be undertaken. Inherency is a question of fact and cannot be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). While it may be possible that the low molecular weight polymeric particles of Reed possess some degree of adhesiveness when melted, that “possibility” is not sufficient to establish a prima facie case that such particles are

“adhesive-abrasive” particles within the meaning of the claim language in question. Accordingly, even if we agreed with the examiner that Reed’s disclosure at column 7, lines 16-20 that his solid particles form a fine matt surface which functions to improve the printability, drawing and typing properties of the transfer layer establishes that Reed’s particles inherently possess a sufficiently rough surface for abrading crayon as called for in the appealed claims, we still cannot agree with the examiner that Reed anticipates the rejected claims. Accordingly, we cannot sustain the rejection of appealed claims 8-10, 14, 18, and 20. Since the examiner’s obviousness rejections of appealed claims 19 and 11-13 are deficient for the same reason, these rejections cannot be sustained.

The decision of the examiner is reversed.

REVERSED

SHERMAN D. WINTERS)

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

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Application No. 08/452,125

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Appeal No. 1997-4439
Application No. 08/452,125

APJ JOHN D. SMITH

APJ OWENS

APJ WINTERS

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):
Prepared: October 30, 2000

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT