



UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ROGER A. HANSEN

Appeal 2007-3424
Application 10/368,772
Technology Center 1700

Decided: May 13, 2008

Before BRADLEY R. GARRIS, ERIC GRIMES, and ALLEN R.
MACDONALD, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a decal organization tool, which the Examiner has rejected as anticipated by or obvious in view of the prior art. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

“Many products produced by industry are sufficiently complex, and sometimes even potentially dangerous to a customer, that numerous safety

messages, warning signs, instructions and other notices must be affixed to the product before sale” (Spec. 1). The Specification refers to all such signage, along with informative and decorative signs, as “decals or decal messages” (*id.*).

The Specification discloses “a decal organization tool and process by which all existing decals associated with and required for a particular product or product model are consolidated onto a single large decal sheet” (*id.* at 11). The Specification also discloses “the use of an adhesive which leaves a permanent residue on the product and allows the manufacturer to identify every decal placed on the product even after the decals have been removed” (*id.*).

Claims 2-4, 7, 9-22, and 30-39 are pending and on appeal (Br. 4).

Claims 33 and 36 are representative and read as follows:

33. A decal organizational tool for use with a hazardous product which requires a plurality of instructional decals for the education and welfare of a user of the product, the decal organizational tool comprising:
an informational layer having an obverse face and a reverse face and comprising:

a plurality of instructional decals with messages different from one another and descriptively relating to instructional information for the education and welfare of a user of the product, the messages being printed on one of the obverse and reverse faces of the information layer whereby all of the different instructional decal messages will be available to a decal installer as a group of the plurality of decals and can be brought to the product as a group; and

a removal cut surrounding and associated with each different instructional decal that defines an edge of each decal and that permits removal of each associated decal from the information layer; and

an adhesive applied to the reverse face of the information layer; and
a liner sheet releasably retained to the information layer by the adhesive such that the plurality of decals are releasably peelable from the

liner sheet, whereby the liner sheet, when stripped bare of the plurality of instructional decals, becomes an indicator for the decal installer that all the decal messages describing the product on the liner sheet have been applied to the product, thereby assuring that the instructional decal messages will be applied to the product for the education and welfare of the user of the product.

36. The decal organization tool of Claim 33 wherein the adhesive contains an additive responsive to ultraviolet light, such that when at least one of the plurality of decals with a portion of the adhesive is adhered to the product and the at least one decal is thereafter removed from the product, a residue of the additive remains substantially permanently on the product to define a visible footprint on the product and matched to the at least one decal when the ultraviolet light is incident on the product, thereby confirming that a decal message was applied to the product.

The Examiner has rejected claims 2-4, 7, 30, 33, and 34 under 35 U.S.C. § 102(b) as anticipated by Kruchko.¹ The Examiner has rejected claims 2-4, 7, 9-22, and 30-39 under 35 U.S.C. § 103(a) as obvious in view of Kruchko and Mocilnikar.² Appellant has argued each of the claims rejected for anticipation separately and has argued the claims rejected for obviousness in twelve groups (Br. 31). The claims argued as a group will stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii).

ANTICIPATION

The Anticipation Issue

Claims 2-4, 7, 30, 33, and 34 stand rejected under 35 U.S.C. § 102(b) as anticipated by Kruchko. The Examiner's position is that Kruchko discloses a product meeting all the structural limitations of the rejected

¹ Kruchko, U.S. Patent 5,389,476, issued Feb. 14, 1995.

² Mocilnikar et al., U.S. Patent 5,346,259, issued Sept. 13, 1994.

claims and the “intended use phrases such as ‘for use’, ‘for the education’, ‘will be available’, etc. have not been given any patentable weight because said phrase[s] are not deemed to be of positive limitation” (Ans. 4).

Appellant responds that the rejected claims contain limitations relating to what is printed on the decals on the claimed tool, and those limitations should be given patentable weight in the anticipation analysis (App. Br. 21-23, 27-29).

In view of these conflicting positions, the anticipation issue presented is: Do the printed matter limitations recited in the rejected claims distinguish the claimed decal organization tool from the decal product disclosed by Kruchko?

Findings of Fact Relating to Anticipation

1. Kruchko discloses a method of making life-sized decals in which a photographic image is digitized and the background of the desired image is digitally removed or masked (Kruchko, col. 3, l. 39 to col. 4, l. 9).

2. The digitized image is divided into image sections separated by registration lines (Kruchko, abstract and col. 4, ll. 32-52).

3. “The image sections are printed onto sheets of a clear medium removably laminated to a backing sheet to form a decal. . . . The clear medium is preferably laminated to the backing sheet by an adhesive which remains on the clear medium after it is removed from the backing sheet.” (Kruchko, col. 5, ll. 13-20.)

4. “The printed decal sheets are then die-cut to permit the image sections to be easily removed from the backing sheet. . . . [T]he die-cut rule

can be constructed to leave a border 42 of the clear medium around the image sections. . . . When the image sections are reassembled on a wall, the border 42 will be the same color as the wall.” (Kruchko, col. 5, ll. 24-41.)

Discussion of the Anticipation Issue

Based on our findings and those of the Examiner, Kruchko anticipates claims 2-4, 7, 30, and 33. Claim 33 is the broadest of these claims. Claim 33 is directed to a “decal organization tool” comprising two layers (an information layer and a liner sheet) held together by an adhesive. Kruchko’s product comprises a clear medium laminated to a backing sheet by an adhesive (FF 3). Claim 33 also requires that the information layer has a plurality of decals printed on it, and that each decal is surrounded by a removal cut. The clear medium of Kruchko’s product has a plurality of decals (image sections) printed on it (FF 3), and the decals are surrounded by a removal cut (FF 4).

Thus, Kruchko’s product meets all of the structural limitations of claim 33. The remainder of claim 33’s description is directed either to the intended use of the claimed product or to nonfunctional printed material that is entitled to no weight in determining patentability.

Specifically, the preamble of claim 33 states that the claimed product is “for use with a hazardous product which requires a plurality of instructional decals for the education and welfare of a user of the product.” This preamble language does not limit the structure of the claimed product (although it might help define the printed content of the decals, an issue we will get to shortly). “[W]here a patentee defines a structurally complete

invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation.” *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997).

The same is true of the claim language stating that

the liner sheet, when stripped bare of the plurality of instructional decals, becomes an indicator for the decal installer that all the decal messages describing the product on the liner sheet have been applied to the product, thereby assuring that the instructional decal messages will be applied to the product for the education and welfare of the user of the product.

Although this language appears in the body of the claim, it also does nothing more than recite an intended use for the claimed product (or what is left of it after the decals are removed) and therefore is not a structural limitation.

Claim 33 also states that the decals are printed on the information layer “whereby all of the different instructional decal messages will be available to a decal installer as a group of the plurality of decals and can be brought to the product as a group.” This claim language merely states the result of a structural limitation; specifically, having a plurality of decals printed on a single sheet. “A ‘whereby’ clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim.” *Texas Instruments, Inc. v. U.S. International Trade Comm.*, 988 F.2d 1165, 1172 (Fed. Cir. 1993).

Finally, claim 33 states that the claimed product includes “a plurality of instructional decals with messages different from one another and descriptively relating to instructional information for the education and welfare of a user of the product” to which the decals are intended to be attached. The weight to be given to this claim limitation is the central issue

in this appeal. The Examiner gives this limitation no patentable weight (Ans. 4); Appellant cites *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983), as supporting his position that the printed content of the decals distinguishes the claimed product from the prior art (App. Br. 28-29).

Appellant argues that claim 33 meets the *Gulack* test because the instructional information is related to the decals in at least two ways. First, the decals support the instructional information. See [*Gulack*]. (Federal Circuit held that digits have a functional relationship with the band on which they are printed in part because the band supports the digits). Second, the decals are sized and shaped to be applied to particular locations on the product to which the instructional information relates. Accordingly, the instructional information would not achieve its purposes of promoting the education and welfare of a user of the product without the decals, and the decals would not provide the desired result without the instructional information. Thus, the instructional information does have a functional relationship with the substrate, that is, the decals themselves.

(App. Br. 29.)

We agree with Appellant that *Gulack* provides the appropriate test for determining whether limitations defining descriptive material should be given patentable weight, but disagree with Appellant on how the instant claims fare under that test. The invention claimed in *Gulack* comprised “three key elements: (1) a band . . .; (2) a plurality of individual digits imprinted on the band or ring at regularly spaced intervals; and (3) an algorithm by which the appropriate digits are developed.” *Id.* at 1382. The band was printed with the digits generated by the algorithm and could be used “to perform magic tricks or to display various aspects of number

theory.” *Id.* at 1383. The claims had been rejected as obvious based on prior art that taught a band with different material printed on it. *Id.* at 1384.

The court stated that limitations reciting printed matter cannot be ignored but “[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight.” *Id.* at 1385 (footnote omitted). The “critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *Id.* at 1386.

In *Gulack*, the court held that the substrate and printed matter had such a relationship because the looped structure of the substrate and the particular digits printed on it interrelated to give the claimed article a property it would not have had if either the structure or the digits were changed. Therefore, the content of the printed matter was held to produce a nonobvious difference between the claimed product and the prior art.

We disagree with Appellant’s position that the printed matter and substrate of claim 33 share a “novel and unobvious functional relationship” like that of the product in *Gulack*. The printed matter and the substrate of the article defined by claim 33 have the same relationship as any other decal (or set of decals) has with its substrate: the decal is printed on one layer of the substrate, and the other layer of the substrate provides a backing from which the decal can be peeled when a user wants to apply it to something. There is nothing “novel and unobvious” about that relationship.

In our view, the facts of this case are more similar to those of *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004). The claims at issue in *Ngai* were directed to a kit that differed from the prior art only in the content of printed instructions that were included with it. *Id.* at 1337. The court held that the claimed kit did not meet the *Gulack* test: “In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result. Here, the printed matter in no way depends on the kit, and the kit does not depend on the printed matter. All that the printed matter does is teach a new use for an existing product.” *Id.* at 1339.

The same analysis holds here. The instant Specification states that decals are peeled off their liner sheet when a user wants to apply them (Spec. 5-6, 20). Whether the decals are on individual sheets or on one big sheet does not change the relationship between the printed matter and the substrate. Just as in *Ngai*, all the printed matter defined by claim 33 does is teach a new use for a known product – a substrate comprising multiple decals. *Cf. Ex parte Nehls*, 2008 WL 258370 (BPAI 2008, precedential) (particular nucleic acid sequences in a computer database are nonfunctional descriptive material because they are not functionally related to the computer system that compares a target sequence to sequences in a database).

Claim 34 depends from claim 33 and “further includ[es] a support device for holding the information layer and the liner sheet in an upright orientation for the convenience of the decal installer.”

Appellant argues that “[i]t is clear from inspection that Kruchko does not teach or disclose the claimed support device” (Br. 30).

The Examiner responds that a “surface on which the decal tool is laid on will provide as a supporting device” (Ans. 4). That may well be true, since the intended use language of claim 34 is not a claim limitation, and all the claim actually requires is a device *capable of* supporting the article of claim 33 in an upright orientation.

The issue with respect to anticipation, however, is whether Kruchko discloses such a device. The Examiner has pointed to no specific passage in Kruchko that describes the disclosed decal product combined with a device that is capable of holding it in an upright orientation. We are therefore compelled to reverse the rejection of claim 34 for anticipation.

Claim 30 is similar to claim 33 but adds two limitations:

- “a border associated with each of the plurality of instructional decals that at least partially surrounds one of the plurality of instructional decals, each border of adjacent decal being spaced from one another by an intervening gap,” and
- “a product match margin located in at least one of the intervening gaps and contacting the border of one of the decals, the product match margin matching the predetermined color of the product such that when the decal is affixed to the product and is viewed at a distance from the product by a human viewer, the product match margin will color match the predetermined color of the product and no portion of the decal outside the associated border visually color contrasts substantially with product, thereby effectively visually concealing any irregular margin between the border and the removal cut.”

The Specification states that the border associated with the decals can take a variety of forms: among other things, it can be a “simple line border” or a “filled interior border . . . in which the border is literally defined by the

darkened or colored background of the decal message” (Spec. 20). Claim 7 depends on claim 30 and specifies that the border is a “line border.”

The Specification describes the “product match margin” as a margin surrounding the decal message(s) that is either colored to match the product to which the decal is intended to be applied, or is “transparent so that . . . the color of the product will be visible through such transparent margin” (Spec. 13). Claims 2-4 depend on claim 30 and specify that the product match margin is colored.

We agree with the Examiner that Kruchko’s product has both a border and a product match margin, as required by claim 30. Kruchko teaches that the decals are die-cut “to leave a border 42 of the clear medium around the image sections” (FF 4). The instant Specification expressly teaches that product match margins can be transparent.

Appellant argues that Kruchko’s product lacks a “product match margin” because the registration marks disclosed by Kruchko for use in reassembling the life-size decal “must be visually distinguishable from the product in order to be useful in ensuring proper registration” (*id.* at 22). This argument is unpersuasive, because Kruchko teaches that, because of the transparent border, “[w]hen the image sections are reassembled on a wall, the border 42 will be the same color as the wall” (Kruchko, col. 5, ll. 24-41); i.e., Kruchko’s border 42 is a product match margin.

Kruchko’s product also has a border associated with each decal. As shown in Kruchko’s figures, the border is a simple line border (see, e.g., Kruchko, Fig. 4A). The figures are line drawings rather than photographs, but in any event, even if the images on the decals were photographs, the

edge of each image would form what the instant Specification refers to as a “filled interior border”; i.e., a border that is “literally defined by the darkened or colored background of the decal.”

Appellant argues that Kruchko “does not disclose Applicant’s claimed continuous border surrounding the ‘information.’ The arm or leg which has been properly treated by the Examiner as being the ‘information’ . . . cannot also be read as being Applicant’s claimed ‘border,’ which is described in Applicant’s claim as spaced from the ‘information.’” (App. Br. 21-22.)

This argument is unpersuasive. Claim 30 requires the borders of *adjacent* decals to be spaced from each other, but does not require the border of a given decal be spaced from any other part of the decal. Claim 30 therefore encompasses the “filled interior border” described in the Specification.

Finally, Appellant argues that the printed matter limitations of claim 30 distinguish it from the prior art for the same reason as claim 33’s printed matter limitations. For the reasons discussed above, we disagree.

Claims 2-4 differ from the product expressly disclosed by Kruchko, in that the claims require a colored border rather than Kruchko’s transparent border. Claim 7 may also differ from Kruchko’s express disclosure, in that a line border (as required by claim 7) would not necessarily result from following the digital photographic process described by Kruchko.

In each case, however, the difference between what is claimed and what is taught in the prior art is no more than a difference in the content of printed matter. When that is the case, the *Gulack* test applies: the claimed

product is unpatentable over the prior art unless the substrate and the printed matter have a “new and unobvious functional relationship.”

We do not find such a relationship here. A colored decal margin has the same functional relationship to its substrate as a transparent margin, and the same is true of a line border and a filled interior border. Making part of a product one printed matter color rather than another, or surrounding part of a product with a particular type of printed matter border, without more, does not render the product patentable over prior art that is otherwise identical.

OBVIOUSNESS

The Obviousness Issue

Claims 2-4, 7, 9-22, and 30-39 stand rejected under 35 U.S.C. § 103(a) as obvious in view of Kruchko and Mocilnikar. The Examiner reasons that Mocilnikar discloses an adhesive that contains an additive responsive to ultraviolet light, and it would have been obvious to use Mocilnikar’s adhesive in Kruchko’s decal product (Ans. 5).

Appellant responds that Mocilnikar’s adhesive can be combined with Kruchko’s decal product only with the benefit of hindsight based on the instant disclosure, and therefore the references do not support a prima facie case of obviousness (Br. 34-35).

In view of these conflicting positions, the obviousness issue presented is: Would it have been obvious to a person of ordinary skill in the art to use the ultraviolet-detectable adhesive disclosed by Mocilnikar as the adhesive in the decal product disclosed by Kruchko?

Findings of Fact Relating to Obviousness

5. Mocilnikar discloses a tamper-proof label (Mocilnikar, col. 1, ll. 5-7).

6. Mocilnikar's label includes, among other things, "an aggressive adhesive layer on the back of the label in order to permanently adhere to goods" (Mocilnikar, col. 3, ll. 16-18).

7. Mocilnikar describes the adhesive layer more specifically as "a white pigmented pressure sensitive, ultra cross-linked acrylic adhesive layer 44. . . . The acrylic adhesive layer 44 has high shear characteristics, temperature resistance up to approximately 220° C, and leaves a residue producing a footprint which appears bluish-white when illuminated with a 365 nanometer (nm) blacklight source." (Mocilnikar, col. 5, ll. 48-59.)

8. The instant Specification characterizes Mocilnikar's technique as "utilizing ultraviolet light and an appropriate light-sensitive additive" (Specification 10).

9. Mocilnikar discloses that appropriate acrylic adhesives were commercially available (Mocilnikar, col. 5, l. 65 to col. 6, l. 2).

Discussion of the Obviousness Issue

Based on our findings and those of the Examiner, we conclude that a person of ordinary skill in the art would have considered it obvious to use Mocilnikar's acrylic adhesive in Kruchko's decal product. Mocilnikar discloses that acrylic adhesives were known and commercially available at the time the instant application was filed (FF 7, 9). Mocilnikar also discloses that the acrylic adhesives are aggressive adhesives that will

permanently adhere a label to a substrate (FF 6). In view of these disclosures, a person of ordinary skill in the art would have considered it obvious to combine the known, commercially available adhesive disclosed by Mocilnikar with the decal product disclosed by Kruchko in order to allow for permanent mounting of the full-size decal created by Kruchko's product.

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007). “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious,” the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

Here, the combination of Mocilnikar's adhesive with Kruchko's decal product is no more than the predictable use of prior art elements – an adhesive and a sheet of decals – according to their established functions. The evidence of record also shows that the Mocilnikar's adhesive contains an additive responsive to ultraviolet light, as recited in claim 36 and other claims on appeal. Those claims are therefore prima facie unpatentable under § 103 based on the cited references.

Appellant argues the claims in several groups (Br. 31). The first group argued is claims 30, 33, and 38. We will consider claim 33 to be representative of this group; claim 38 will stand or fall with claim 33. 37 C.F.R. § 41.37(c)(1)(vii). Although Appellant grouped claim 30 with claims 33 and 38, he also presented separate arguments for claim 30, which we also address below.

Appellant argues that Kruchko does not teach or suggest certain limitations of claim 33 (Br. 35-37) and “Mocilnikar fails to disclose or suggest the missing elements” (*id.* at 38). As discussed above with regard to the rejection under 35 U.S.C. § 102(b), however, we find that Kruchko anticipates claim 33. Anticipation is the epitome of obviousness. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983).

Although Appellant grouped claims 30 and 33 together, he also argued that claim 30 contains additional limitations (Br. 39). Appellant argues that the printed matter limitations of claim 30 are not taught by Kruchko. This argument is addressed above with respect to the rejection for anticipation.

Appellant also argues that claim 30 would not have been obvious because Mocilnikar does not teach a product match margin and that the products of Kruchko and Mocilnikar are so different that a person of ordinary skill in the art would not have been led to combine them (Br. 39-40). These arguments are not persuasive because, as discussed above, the teaching of a product match margin is provided by Kruchko and we conclude that the combination of Mocilnikar’s adhesive and Kruchko’s decal product would have been a predictable use of prior art elements, and therefore obvious.

We therefore affirm the rejection of claims 30 and 33 as unpatentable under 35 U.S.C. § 103 in view of Kruchko and Mocilnikar. Claim 38 falls with claims 30 and 33.

Appellant argues claims 2, 3, and 4 separately but the argument is similar for each claim: Appellant argues, essentially, that the references do

not teach a product match margin that is colored (Br. 40-43). With respect to claim 7, Appellant argues that the references do not teach or suggest a line border around decals (*id.* at 43-44).

Each of these arguments is unpersuasive for the reason discussed above with respect to the anticipation rejection: For printed matter to be entitled to patentable weight under *In re Gulack* it must have a “new and unobvious functional relationship” with its substrate. A colored product match margin and a line border do not meet the *Gulack* test because they have the same functional relationship to their substrate as a transparent margin and a filled interior border, and therefore are not entitled to patentable weight. These printed matter limitations therefore do not patentably distinguish the claimed product from the product that is made *prima facie* obvious by the prior art.

With respect to claim 9, which requires that the decal have a colored background, Appellant argues that the references do not teach a colored background or concealing an irregular margin around one (with a product match margin) (*id.* at 44-45).

These arguments are unpersuasive. Kruchko discloses that its decals are derived from photographs, so they would have backgrounds of several different colors. Necessarily, at least part of the background (i.e., the photograph enlarged to form the decal) would be a different color from any surface the decal would be mounted on. Appellant’s argument with respect to the product match margin has been addressed already.

Appellant argues claims 10, 16, 36, and 39 as a group (Br. 31). Claim 36 is representative of these claims, and is directed to the product of claim

33 with an adhesive that contains an additive responsive to ultraviolet light. Appellant argues that the cited references do not suggest including an ultraviolet-responsive additive in an adhesive in order to address the potential product liability issue caused by missing decals (*id.* at 46-48)

This argument is not persuasive. It is true that neither Kruchko nor Mocilnikar discusses product liability litigation or missing decals on hazardous products. But the prior art does not have to suggest combining references for the same reason that a patent applicant combined them in order to support a *prima facie* case of obviousness. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741-42 (2007) (“In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. . . . [A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.”). *See also In re Dillon*, 919 F.2d 688, 692-93 (Fed. Cir. 1990) (“[T]he statement that a *prima facie* obviousness rejection is not supported if no reference shows or suggests the newly-discovered properties and results of a claimed structure is not the law.”).

The fact that Mocilnikar’s acrylic adhesive leaves a residue that is visible under ultraviolet light, and that this property can be advantageous for decals on hazardous products, is not the only reason that those of skill in the art would combine it with Kruchko’s decal product. As discussed above, Mocilnikar also discloses that the adhesive was commercially available and permits permanent mounting of a label (or decal) on a substrate. Those of ordinary skill in the art would have considered it obvious to use the adhesive

for its properties as an adhesive, whether or not it was responsive to ultraviolet light.

Appellant also argues that

[a]nother important purpose of Applicant's invention as recited particularly in Claim 36, and which is associated with the claimed printed matter limitations, is providing an assembly and transport mechanism that assures that all the essential decal messages required by a specific hazardous product arrive as a group so they will be available as a group to the installer at the site to be affixed to the hazardous product.

(Br. 48-49.)

As we understand it, Appellant's argument is that the claimed product is distinguished from the prior art because of the printed matter contents of the decals that are printed on it. This argument is unpersuasive for the reasons discussed above.

Appellant argues claims 11, 12, 17, and 37 as a group (Br. 31) but also presents separate argument with respect to claim 12, which is addressed below. Claim 37 is representative of these claims, and is directed to the product of claim 36 where "each removal cut has continuous regular edges except for a predetermined irregularity zone unique to each of the plurality of decals." Appellant argues that the irregularity zone, combined with the ultraviolet-responsive adhesive, allows a manufacturer to prove that a specific label had been attached to a product (Br. 51-52). Appellant argues that the cited references do not teach that recited structure because the "term 'regular edge' describes substantially regular geometric configurations, such as square, rectangles," etc., whereas Kruchko has "virtually random" edges and Mocihnikar lacks an irregularity zone (*id.* at 52).

The instant Specification does not define the terms “continuous regular edge” or “irregularity zone,” although the Specification refers to Figure 7 as exemplary. Figure 7 shows two decals that are rectangular with rounded corners, and that have two or three square protrusions on the bottom edge. The Specification states that the “combination of protrusions and the spacing between the protrusions allow the creation of a specific footprint unique to each decal message” (Spec. 30). The Specification also states that the irregularity zone can take a variety of forms (*id.* at 30-31).

In our opinion, the decals disclosed by Kruchko meet the limitations of claim 37. The edge of each of the decals is continuous, in that a removal cut completely surrounds each decal (Kruchko, col. 5, ll. 30-42). Each of the decals includes protruding areas that contain registration marks 34 and that help to create a specific footprint unique to each decal (*id.* at col. 5, ll. 48-52; Fig. 4A). To the extent that the term “regular edge” limits the scope of the claim, Kruchko’s exemplary embodiments include decals that have edges that are straight lines (e.g., at the points where the different decals are intended to be overlapped), and a straight edge would reasonably appear to be a “regular edge” (*id.* at Fig. 4A). The language of claim 37, when given its broadest reasonable interpretation consistent with the Specification, encompasses the product made *prima facie* obvious by the prior art.

Appellant argues “Claim 12 contains a further limitation and does not stand or fall with” claims 11, 17, and 37 (Br. 53). Claim 12 specifies that the irregularity zone is “in the product match margin such that each irregularity zone blends with the predetermined color of the product and is

substantially visually concealed when the decal is adhered to the product.”

Appellant argues that

neither Kruchko nor Mociłnikar disclose Applicant’s irregularity zone positioned on the margin of the decal message and wherein the irregularity zone is provided with the color of the product so as to make the structural features of the irregularity zone virtually unnoticeable on both liner sheet and on the product by having them blend closely with the predetermined color.

(Br. 53.) Appellant presents a similar argument with respect to claims 21 and 22, which also require that the irregularity zone “blends with the product predetermined color and is visually concealed when the plurality of decals is adhered to the product” (see Br. 55-56).

This argument is not persuasive. The protruding areas containing the registration marks 34 shown in Kruchko’s exemplary embodiments meet the limitations of an irregularity zone and are located completely in the transparent margins of the decals. They would therefore blend with the color of the wall and make the irregularity zone “substantially visually concealed” when Kruchko’s decal was mounted on a wall or other surface. The protrusions therefore meet the limitations of claims 12, 21, and 22.

Appellant argues claims 13-15 and 18-20 as a group (Br. 31). Claim 18 is representative of this group and is directed to a decal product including, among other things, decals that have a regular edge except for an irregularity zone, “wherein each irregularity zone includes at least one protrusion extending outward from the edge of the associated decal.”

Appellant argues that “[t]hese structural features define a coding structure which, in combination with the footprint producing residue, allows each

decal message footprint to be distinguished from the footprints of other decal messages” (Br. 54).

We disagree with Appellant’s interpretation of the claim language. Claim 18 does not require a system of protrusions that “define a coding structure.” It requires only that the irregularity zone include a protrusion. The decals in Kruchko’s exemplary embodiments all have protrusions; specifically, the protrusions that contain the registration marks 34 (Kruchko, Fig. 4A). These protrusions meet the limitation of claim 18.

Appellant argues claims 31 and 34 as a group (Br. 31). Claim 34, which is representative of this group, is directed to the decal product of claim 33, further including a support device for holding it upright. Appellant argues that the “examiner has not identified any structure in these [cited] references which serves as such a support device” (Br. 57-58).

The recitation in claim 34 of the intended use of the support device is not a claim limitation. Claim 34 requires only that the support device be *capable of* supporting the product of claim 33 in an upright orientation. Kruchko teaches that conventional methods for making life-sized reproductions include enlarging a photograph on a poster board or a rigid substrate (Kruchko, col. 1, ll. 12-26). Based on the known methods of mounting life-size reproductions on poster board or a rigid substrate and Kruchko’s disclosure of assembling a set of decals to reproduce a life-sized image, it would have been obvious to combine Kruchko’s decal product with a poster board or rigid substrate large enough to reassemble the life-sized image on it, in order to mount it in places other than a building’s wall and to allow it to be moved around. A poster board or rigid substrate would be

capable of supporting Kruchko's decal product in an upright orientation and therefore meets the limitation of claim 34.

Appellant argues claims 32 and 35 as a group (Br. 31). Claim 35, which is representative of this group, is directed to the decal product of claim 33, comprising at least six decals. Appellant argues that "Kruchko does not disclose six different unrelated instructional decal messages. Mocilnikar has more than six decal messages but such messages are all identical" and the references cannot be properly combined (Br. 58).

This argument is not persuasive. For the reasons discussed above, the content of the printed matter of the claimed product is not entitled to patentable weight, and therefore does not distinguish the claimed product from the prior art. Kruchko teaches that its disclosed decal product is made by dividing a full-size image into sections that can be printed by a printing press on a single sheet (Kruchko, col. 4, ll. 19-46), then reassembled into a full-size image. It would have been obvious to those of ordinary skill in the art, based on Kruchko's disclosure, to divide a full-size image into any number of sections, including six, in order to fit the full-size image onto a single sheet for a printing press.

SUMMARY

We reverse the anticipation rejection with respect to claim 34 but affirm it with respect to claims 2-4, 7, 30, and 33. We affirm the rejection under 35 U.S.C. § 103. Because our reasoning differs substantially from that of the Examiner, however, we designate both affirmances as new grounds of rejection under 37 C.F.R. § 41.50(b).

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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

AFFIRMED

Ssc:

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