The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CHARLES J. BARNETTE and PHILIP M. ZAVRACKY

Appeal No. 2002-0189
Application No. 08/526,914

ON BRIEF

Before GARRIS, PAWLIKOWSKI and POTEATE, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1, 2, 4, 5 and 7 which are all of the claims remaining in the application.

The subject matter on appeal relates to a laminate. With reference to Figs. 4-7 of the appellants' drawing, the laminate comprises a laminated backing sheet 20 comprising a backing sheet 10 having a decorative side and a clear cover sheet 46 having an adhesive coating 44 on a first side thereof for adhesively laminating the cover sheet to the decorative side of the backing sheet, and said cover sheet having a release coating 48 on the second opposite side thereof. The laminate further comprises a face sheet 12 releasably adhered to the release coating 48 and wherein the decorative side of the backing sheet 10, clear cover sheet 46, adhesive coating 44, release coating 48 and face sheet 12 are fully overlapping and congruent with each other. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

> 1. A laminate for use in a computerized automated sign making machine, comprising:
>
> a laminated backing sheet comprising a backing sheet having a decorative side and a clear cover sheet having an adhesive coating on a first side thereof adhesively laminating said clear cover sheet to said decorative side of said backing sheet, said clear cover sheet having a release coating on a second opposite side thereof; and

> a face sheet releasably adhered to said release coating on said laminated backing sheet, said decorative side of said backing sheet, clear cover sheet, adhesive coating, release coating, and face sheet being fully overlapping and congruent with each other such that portions of said face sheet are removable when cut from said laminated backing sheet by the computerized automated signmaking machine, exposing corresponding portions of said decorative side of said backing sheet.

The reference relied upon by the examiner in the § 102 and § 103 rejections before us is set forth below:

Arnold	4,517,044	May 14, 1985

All of the appealed claims stand rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention. According to the examiner "the phrase 'fully overlapping and congruent with each other' [in claim 1] is deemed to be vague and confusing" (answer, page 5).

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Arnold.

Finally, all of the appealed claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Arnold.

OPINION

For the reasons which follow, none of these rejections can be sustained.

As correctly indicated by the appellants in their brief, the ordinary and accepted dictionary definition of the term "congruent" reveals that there is no merit in the examiner's position that the claim 1 phrase "fully overlapping and congruent with each other" is "vague and confusing" (answer, page 5). It follows that we cannot sustain the examiner's § 112, second paragraph, rejection of all appealed claims.

Concerning the § 102 rejection of claim 1 as being anticipated by Arnold, the examiner has provided the file record of this application with one and only one specific explanation of his position that Arnold anticipates claim 1. This one and only explanation appears on page 6 of the answer and reads as follows:

> As shown in said figure -2 [of Arnold], the backing sheet with a decorative side is shown by elements 22 and 24 together, the cover sheet is tagged as clear cover polyester film 28 which is adhesively laminated to the backing sheet, and a release lines 32 is adhered to the cover film. The structure of figure -2 shows a fully overlapping and congruent laminate. (emphasis original)

The above quoted explanation clearly fails to establish a prima facie case of anticipation. This is in part because a

number of the examiner's findings of fact are unquestionably erroneous. For example, contrary to the examiner's findings, the "cover sheet" 28 of Arnold is not adhesively laminated to the "backing sheets" 22, 24. Similarly, the sheets or layers of Arnold's Fig. 2 laminate are not "fully overlapping and congruent with each other" in accordance with appealed claim 1. In addition to the foregoing, we observe that the examiner has attempted to read the entire Fig. 2 structure of Arnold on the appealed claim 1 laminated backing sheet and accordingly that the examiner's anticipation position is further deficient in that it completely fails to account for the face sheet requirements of the independent claim on appeal.

For the above stated reasons, we also cannot sustain the examiner's § 102 rejection of appealed claim 1 as being anticipated by Arnold.

Finally, the § 103 rejection of all of the appealed claims as being unpatentable over Arnold likewise cannot be sustained. This is because the examiner's obviousness conclusion fails to even address much less supply the above discussed deficiencies of Arnold with respect to the appealed claim 1 laminate.

In summary, it is well settled that the examiner bears the initial burden, on review of prior art or on any other ground, of presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). As explained above, the examiner has failed to carry his initial burden of establishing a prima facie case of unpatentability with respect to each of the rejections advanced on this appeal. It follows that none of these rejections can be sustained.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS Administrative Patent Judge	)	
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LINDA R. POTEATE Administrative Patent Judge	)	

vsh

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