

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDRE RUDOLF LOUIS COLAS, GARY LORD,
MARIE THERESE VALENCIA and XAVIER THOMAS

Appeal No. 2002-2211
Application No. 09/304,393

ON BRIEF

Before STAAB, JEFFREY T. SMITH and MOORE, *Administrative Patent Judges*.
JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal the decision of the Primary Examiner finally rejecting claims 1 to 6 and 8.¹ We have jurisdiction under 35 U.S.C. § 134.²

¹ According to the Appellants, claim 10 is allowed and claims 7 and 9 are objected to as being dependent on a rejected claim. (Brief, p. 2).

² In rendering this decision, we have considered Appellants' arguments presented in the Brief filed January 17, 2002.

BACKGROUND

Appellants' invention relates to a method for adhering a first substrate to a second substrate with an adhesive device comprising a carrier sheet having at least two surfaces. On both sides of the carrier sheet is a continuous layer of a silicone gel having a density in the range of about 100 to 4500 g/m². According to Appellants, the gel has sufficient tack to adhere substrates including medical prosthesis on patients, electrical components and construction elements. (Brief, p.

2). Claim 1, which is representative of the claimed invention, appears below:

1. In a method for adhering a first substrate to a second substrate with an adhesive device, the improvement comprising the use of an adhesive device comprising:

a carrier sheet, said carrier sheet having at least two surfaces;

on one surface of the carrier sheet is a first, continuous layer of a silicone gel having a density in the range of about 100 to 4500 g/m²; said gel having sufficient tack to adhere to the first substrate; and

on a second surface of the carrier sheet is a second continuous layer of a silicone gel having a density in the range of about 100 to 4500 g/m², said gel having sufficient tack to adhere to the second substrate.

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Examiner's rejection over Fabo. However, we reverse the rejection over Brassington.

OPINION

In a case such as this, we must analyze the claimed language to determine the scope and meaning of each contested limitation. *See Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). The preamble elements in a Jepson-type claim allows Appellants to use the preamble to recite “elements or steps of the claimed invention which are conventional or known.” *Kegel Co. v. AMF Bowling, Inc.*, 127 F.3d 1420, 1426, 44 USPQ2d 1123, 1127 (Fed. Cir. 1997) (quoting 37 C.F.R. § 1.75(e) (1996)). The fact that the Appellants have chosen the Jepson form of the claim evidences the intention “to use the preamble to define, in part, the structural elements of his claimed invention.” *Kegel*, 127 F.3d at 1426, 44 USPQ2d at 1127. Thus, the preamble is a limitation in a Jepson-type claim. *See Epcon Gas Systems Inc. v. Bauer Compressors Inc.*, 279 F.3d 1022, 1029, 61 USPQ2d 1470, 1475 (Fed. Cir. 2002); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985).

Fabo describes a device that adheres a first substrate to a second substrate. Specifically, Fabo describes a flexible carrier sheet (1) embodied within two

continuous silicone-gel layers (2, 3) on both sides of the carrier sheet. (Pages 3 and 4; Fig. 1). Fabo does not disclose the density of the silicone gel. However, Fabo discloses the silicone gel is the type described in GB-A 2,192,142. (Page 5). This is the same reference cited by Appellants, specification page 7, as describing suitable silicone gels. Moreover, we note Appellants have not argued that the density of the silicone-gel layer of Fabo are different from the claimed invention. (See Brief in its entirety). Consequently, we agree with the Examiner that the invention of claim 1 is unpatentable over the Fabo reference.

Appellants argue that the Examiner has not established the claimed invention is *prima facie* obvious because Fabo does not render obvious “a method of using a silicone gel composition to adhere a first substrate to a second substrate. In fact, the reference teaches away from the present invention when it suggests the inclusion of the top layer (4)” (Brief, pp. 4-5).

We do not agree. As pointed out by the Examiner, Answer page 4, Figure 1 describes a device wherein two substrates (4, 5) are adhered to one another through the use of a carrier layer having continuous silicone gel layers applied on both sides of the carrier sheet. The claimed invention is not limited to specific substrate types.

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Consequently, the process of forming the device describe by Figure 1 would meet the limitations of claim 1. The prior art must be considered together with the knowledge of one of ordinary skill in the pertinent art. A reference need not explain every detail since it is speaking to those skilled in the art. *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994).

Based on our consideration of the totality of the record before us, having evaluated the *prima facie* case of obviousness in view of Appellants' arguments, we conclude that the subject matter of claims 1 to 6 and 8 would have been obvious to a person of ordinary skill in the art from the teachings of Fabo. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

We cannot affirm the rejection over Brassington. Brassington does not describe a substrate that has a tacky silicone gel on both sides of the carrier sheet. In fact, Brassington discloses the wound dressing has tacky silicone gel only on one surface. The Examiner does not address why it would have been obvious to apply a tacky silicone gel on both sides of a wound dressing. (Page 3, line 54 *et sequential*). 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

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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 such an explanation.

CONCLUSION

The rejection of claims 1 to 6 and 8 under 35 U.S.C. § 103(a) as unpatentable over Fabo is affirmed. The rejection of claims 1 to 6 and 8 under 35 U.S.C. § 103(a) as unpatentable over Brassington is reversed.

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Time for taking action

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

AFFIRMED

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

JAMES T. MOORE
Administrative Patent Judge

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