

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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEREK W. HANSON

Appeal No. 2003-1516
Application 09/569,700

ON BRIEF

Before WARREN, LIEBERMAN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief and reply brief, and based on our review, find that we cannot sustain the grounds of rejections advanced on appeal: claims 1 through 5, 8, 11 through 14 and 19 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Tsai et al. (Tsai); and claims 6, 7, 9, 10 and 20 stand rejected under 35 U.S.C. § 103(a) as being obvious over Tsai.^{1,2} We refer to the examiner's answer and to appellant's brief and reply brief for a complete exposition of the opposing views of the parties.

¹ Claims 1 through 14, 19 and 20 are all of the claims in the application. *See* the appendix to the brief.

² Answer, pages 3-5. The examiner withdrew the grounds of rejection under 35 U.S.C. § 112, first and second paragraphs, of record in the final rejection (answer, page 5).

In order to apply the cited prior art to the appealed claims, we must first interpret the terms thereof in light of the written description in the specification as interpreted by one of ordinary skill in this art. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). We find that the plain language of appealed independent claim 1 requires an article of manufacture of label technology comprising at least (1) a medium surface and (2) an adhesive compound applied to one side of the medium surface. The “medium surface” of the “article of manufacture of label technology” can be, *inter alia*, paper, such as a label, as well as other materials which can provide a cover for the application surface of the digital medium (specification, e.g., page 7). The “adhesive compound” must permit removal of the “entirety of the label technology,” that is, the whole of the article of manufacture of label technology including the adhesive compound, directly from the “application surface of a digital medium,” that is, the surface of the digital medium to which the article of manufacture of label technology has been applied. The adhesive compound also cannot compromise the surface of the digital medium and permits the article of manufacture to sufficiently adhere to the application surface of the digital medium to avoid unintended separation thereof. The “digital medium” can be a digital medium disc, such as set forth in appealed claims 11 and 12.

The claimed article of manufacture of label technology as encompassed by appealed claim 1 comprises at least the two specified components as well as additional components through the transitional term “comprising,” such as electronic marker elements and a medium disc attached on an application surface through the adhesive compound. *See Exxon Chemical Patents Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) (“The claimed composition is defined as comprising - meaning containing at least - five specific ingredients.”); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”).

We find that the plain language of appealed independent claim 19 requires a digital medium disc comprising at least a removable label coupled directly to a surface of the digital disc

through some coupling means, such as an adhesive compound which can be a part of the removable label as in appealed claim 20, sufficiently to avoid unintended separation of the removable label from the surface of the digital disc without compromising the surface of the disc, that is, interfering with the function of the disc as a digital medium. However, there is no requirement in appealed claim 19 that the entirety of the label including the coupling means must be removable, as there is for the article of manufacture of label technology in appealed claim 1.

Each of appealed claims 1 and 19 contains the limitation that the adhesive or coupling means is such that “unintended separation” of the article of manufacture of label technology in claim 1 or the removable label in claim 19 from the surface of the digital medium is avoided. We fail to find in the written description in the specification any guidance in determining when the adhesive or other coupling medium along with other components would result in an embodiment that can produce an “unintended separation,” which is termed an “inadvertent” detachment in the specification (e.g., page 7), for the entire range of applications disclosed (*id.*, e.g., pages 8-9). Without such guidance, it is not apparent whether an article of manufacture of label technology or a disc with a removable label which produces only “intended” separations in some applications but only “unintended” separations in other applications is encompassed by the appealed claims, and there is no limitation in claims 1 and 19 that otherwise restricts the components of claimed embodiments in this respect.

Accordingly, issues under 35 U.S.C. § 112, second paragraph, are raised with respect to appealed claims 1 and 19 and claims dependent thereon, all of which encompass this claim language, because even upon considering the interpretation of this language in light of the written description in the specification, the same is, at best, indefinite with respect to the embodiments encompassed. However, in order to resolve prior art issues in this appeal, thus avoiding piecemeal prosecution, we determine that a reasonable, *conditional* interpretation of the claim language is that an embodiment would be encompassed where an “unintended separation” would be readily apparent in the applications in which the embodiment is used in the art, which interpretation can be made in light of the claim language and the written description of the

specification without unsupported, speculative assumptions.³ *Cf. In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962); *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993).

Turning now to consideration of the examiner's application of Tsai to appealed claims 1 and 19, it is well settled that the examiner has the burden of making out a *prima facie* case of anticipation under § 102(b) in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in the reference, either expressly or under the principles of inherency. *See generally, In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). It is further well settled that in order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988).

The dispositive issue in this appeal is whether Tsai describes an embodiment that

³ We decline to exercise our authority under 37 CFR § 1.196(b) (2003) and enter on the record a new ground of rejection of the appealed claims with respect to the issues we have raised above under § 112, second paragraph, leaving it to the examiner to address this issue upon any further consideration of the appealed claims subsequent to this appeal. In addition to the issues with respect to "unintended separation," we further observe that appealed claim 5 refers to "said label" of appealed claim 1 on which claim 5 depends, but claim 1 does not specify a "label" *per se*. Thus, the question arises of whether appealed claim 5 as presently stated is properly dependent on appealed claim 1, which consideration would also affect appealed claims 6 through 9 that are directly or ultimately dependent on claim 5, and the examiner should considered this matter as well.

anticipates appealed claims 1 and 19 within the meaning of § 102(b). We have considered the disclosure of Tsai as relied on by the examiner in the statement of the ground of rejection (answer, page 3) as well as the additional disclosure of the reference cited in response to appellant's arguments (*id.*, pages 5-8) and agree with appellant that the examiner has failed to make out a *prima facie* case of anticipation. As appellant points out, each of the embodiments of Tsai involve the attachment of an article of manufacture of label technology directly to an application surface of a digital medium disc with an adhesive compound that couples at least a part if not all of the article of manufacture to the application surface without any disclosure that the entirety of the article of manufacture of label technology or at least the whole of the label except the coupling adhesive is removable from the application surface. See, e.g., **Figs. 2A** and **2B**, adhesive layer **24**, col. 3, lines 1-13 and 32-38, col. 4, lines 29-38, col. 7, lines 45-48; **Fig. 4A**, adhesive layer **24**, col. 3, line 65, to col. 4, line 8, col. 4, lines 29-38; **Fig. 4B**, adhesive layer **24**, col. 4, lines 9-20 and 29-38, col. 7, lines 56-61. Indeed, adhesive layer **24** is referred to as a high tack adhesive (e.g., col. 7, lines 45-48), and there is no disclosure that the articles of manufacture of label technology shown in these embodiments is intended to result in the release of the entirety thereof as required by appealed claim 1 or at least the whole of the label other than the coupling adhesive as required by appealed claim 19.

With respect to the releasable support sheet relied on by the examiner in the statement of the rejection, we point out that, as appellant argues, the support sheet **12** of the embodiment of **Fig. 4B** is disclosed to be releasable by the use of an adhesive which is less aggressive than the adhesive of adhesive layer **24** with the result that the marker elements **16** and **18** along with adhesive layer **24**, both components being part of the article of manufacture of label technology and the marker elements **16** and **18** being part of the label, remain attached to the application surface of the disc upon removal of only the support sheet (col. 4, lines 9-20). Indeed, support sheet **12** of the embodiment of **Fig. 4B** is not *per se* adhered directly or coupled directly to the application surface as required by appealed claims 1 and 19. The additional disclosure of Tsai relied on by the examiner in response to appellant's arguments involves carrier strip **116** of **Fig. 9** (col. 6, line 42, to col. 7, line 23), transfer sheet **130** of **Fig. 10** (col. 7, lines 24-61), and an embodiment not shown (col. 7, line 66, to col. 8, line 16), the ultimate use of which involves the

application of adhesive layer **24** to apply or couple the thus formed article of manufacture of label technology to the application surface of the disc through adhesive layer **24**.

Thus, the examiner's reliance on low-tack adhesive **118** with respect to these embodiments does not result in an embodiment that is a description of the claimed invention under § 102(b) with respect to either of appealed claims 1 and 19. *See generally, In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972) (“[F]or the instant rejection under 35 U.S.C. 102(e) to have been proper, the . . . reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the *similarity* of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.”).

In view of the requirement in Tsai that the adhesive for attaching the releasable support sheet **12** must be less aggressive than the adhesive of adhesive layer **24** which retains marker elements **16** and **18** on the application surface of the disk, the disclosure of the low-tack adhesive would not, on this record, have provided one of ordinary with the suggestion that the entirety of the article of manufacture of label technology is removable from the application surface of the disk, and thus does not provide a factual foundation for *prima facie* obviousness under § 103(a) with respect to either or appealed claims 1 and 19. *See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (“When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted.] This suggestion or motivation need not be expressly stated. [Citation omitted.]”).

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