

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN A. ROBERTSON
and
EDWARD S. O'NEAL

Appeal No. 2003-1983
Application 09/704,077

ON BRIEF

Before WILLIAM F. SMITH, KRATZ and POTEATE, Administrative Patent Judges.

POTEATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 9-17 and 22. Claims 18-21 are also pending but have been withdrawn from consideration as directed to a non-elected invention. See Examiner's Answer, Paper No. 11, mailed April 16, 2003, page 1.

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Claim 9, the sole independent claim, is representative of the subject matter on appeal and is reproduced below:

9. A method for making workpieces for identification thereof, which comprises the steps of:

(a) providing a laser that emits a beam comprising a select band of radiation;

(b) coating said workpiece with a coat of a basecoat which is a laser-blackenable paint;

(c) at least partially curing said basecoat;

(d) contacting said at least partially-cured basecoat with said laser beam to char said basecoat to form fragile product identification indicia thereon; and

(e) overcoating said basecoat with a coat of a clear topcoat; whereby, said fragile product identification indicia are protected by said clear topcoat while permitting said product identification indicia to be seen.

The references relied upon by the examiner are:

Sachs et al. (Sachs)	4,326,001	Apr. 20, 1982
Yokoyama et al. (Yokoyama)	4,791,267	Dec. 13, 1988
Oishi et al. (Oishi)	5,449,534	Sep. 12, 1995
Corbett	5,985,377	Nov. 16, 1999
Borzym et al. (Borzym)	6,018,859	Feb. 1, 2000

GROUNDS OF REJECTION

1. Claims 9-14, 16 and 22 stand rejected under 35 U.S.C. § 103 as unpatentable over Yokoyama in view of Oishi or Sachs.

2. Claim 17 stands rejected under 35 U.S.C. § 103 as

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unpatentable over Yokoyama in view of Oishi or Sachs and further in view of Corbett.

3. Claim 15 stands rejected under 35 U.S.C. § 103 as unpatentable over Yokoyama in view of Oishi or Sachs and further in view of Borzym.

We reverse as to all three grounds of rejection.

BACKGROUND

The invention relates to a method for marking workpieces for identification with high quality barcodes and human-readable information. Revised Appeal Brief (hereinafter "Appeal Brief"), Paper No. 10, received December 30, 2002, page 7. The method relies on a dual paint coat system wherein the workpiece is first coated with a laser-blackenable paint. Claim 9. The basecoat is partially cured with a laser beam to char the basecoat and thereby form fragile product identification indicia thereon. Id. Thereafter, the basecoat is overcoated with a clear topcoat which protects the fragile product identification indicia while allowing it to be seen. Id. According to appellants, the inventive method overcomes the problem associated with prior art methods wherein the fragile, dusty markings become smudged or otherwise contaminated. Appeal Brief, page 8.

DISCUSSION

An invention is unpatentable under 35 U.S.C. § 103 if the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). The initial burden of establishing a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For the reasons set forth in greater detail below, we find that the examiner has failed to satisfy his burden of showing that the claimed invention would have been obvious to a person of ordinary skill in the art at the time of the invention.

The examiner found that Yokoyama teaches the invention as claimed in claim 9 with the exception that Yokoyama fails to teach the addition of a second coating (i.e., a topcoat) after performing laser marking. Examiner's Answer, page 6. The examiner maintains that:

it would have been obvious to one of ordinary skill in the art to deposit a second coating on Yokoyama et al's identifying indicia, for standard purpose of decorative and/or protective coating, especially as col. 1-2 indicate reliability and quality are important, and the taught heat and chemical resistance do not necessitate wear resistance or the like, which the ordinary user of, for examples bar codes, knows to be important for the lasting integrity of such labels.

Id. In this regard, the examiner notes that Oishi discloses a photo curable coating that *could be* applied to the labeled cathode ray tubes of Yokoyama. Id. We find that the examiner's conclusion of obviousness is improper for at least the following reasons.

First, we note that the examiner erred in finding that Yokoyama discloses a step wherein the basecoat is charred to form "fragile" product identification indicia thereon as required by claim 9 and the remaining claims on appeal which depend therefrom. The examiner concedes that claim 9 "requires use of a laser beam to 'char', i.e. burn, a cured or partially cured blackenable basecoat on a substrate, to form a 'fragile' indicia." Examiner's Answer, page 3. However, the examiner then incorrectly concludes that any marking produced by laser charring or burning is necessarily "fragile." Id.

As explained by appellants, when a laser is used to char or carbonize a basecoat in accordance with the method of the invention, "the markings are easy to smudge and the label, thereby, is quite fragile." Appeal Brief, page 12 (quoting Specification, page 3). In contrast, Yokoyama uses a laser to create "fine surface irregularities appearing on the surface region of the solid paint layer." Yokoyama, column 7, lines 7-8.

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The irregularities create a difference in the light reflectance exhibited by the surface of the paint layer and thereby appear black in color. Id. at lines 8-11. There is absolutely no indication in Yokoyama that the laser produces markings that are easy to smudge and, therefore, fragile as required by the claims.

We also find the examiner's determination of obviousness deficient in that the examiner fails to identify proper support for his conclusion that it would have been obvious to one of ordinary skill in the art to deposit a second coating on Yokoyama's identifying indicia. See Examiner's Answer, page 6. In support of his position, the examiner points to columns 1 and 2 of Yokoyama as indicating that reliability and quality are important to his invention. The examiner concludes that it would have been obvious to have modified Yokoyama's method to include application of a topcoat in order to achieve these desired properties. Id. However, the examiner fails to identify any teaching *in the prior art* that a topcoat would be effective in providing reliability and quality to Yokoyama's cathode ray tubes. See W. L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference

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or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”)

In sum, the examiner has not shown that Yokoyama, either alone or in combination with any of the secondary references, discloses or suggests the steps of using a laser to create a fragile marking on a basecoat followed by applying an overcoat of a clear topcoat to protect the fragile marking as required by independent claim 9 and the remaining claims which depend therefrom. Accordingly, we find that the examiner has failed to establish a prima facie case of obviousness and the rejections are reversed.

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REVERSED

WILLIAM F. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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LINDA R. POTEATE)	
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