

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AMAD TAYEBI

Appeal No. 2005-1415
Application No. 09/253,174

ON BRIEF

Before KIMLIN, TIMM, and PAWLIKOWSKI, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 13, 15, and 19 which are all the claims pending in the application. Appellant filed an amendment along with the Reply Brief of April 8, 2004. This amendment has not been entered (Office Communication, June 7, 2004). Therefore, we decide the appeal based on the claims as presented in Appendix A of the Brief filed June 5, 2003 (Brief). We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to subject matter in the field of adhesive-coated stickers and, in particular, to stickers that can be temporarily adhered to a surface using non-destructive adhesive. The stickers of the claims have weakened tear lines at particular locations. Claims 13 and 19 are illustrative:

13. A temporary posting adhesive-coated sticker capable of being temporarily attached to an application surface, comprising:

a sheet of opaque flexible material, said sheet having a perimeter defined by two parallel side edges, a top edge and a bottom edge, said sheet having at least one first area and at least one second area; said first area extending to said top edge of said perimeter and extending from one of said parallel side edges to the other of said parallel side edges and being completely and continuously coated with a pressure sensitive adhesive coating; said second area being located immediately adjacent to said first area and being substantially free from said adhesive coating and providing a memo writing space; said adhesive coating being of a temporary adhesion nature such that when said sticker is attached to and subsequently peeled off said application surface, said pressure sensitive adhesive coating remains on said first area of said sticker and said application surface suffers no damage; and,

at least one weakened tear line, selected from the group consisting of pre-slit cut lines, perforated lines and microperforated lines, wherein said weakened tear line being of such a shape and location that it substantially separates said at least one first area from said at least one second area and wherein said weakened tear line providing a low tear strength that directs an initial tear, started at one of the parallel side edges of said perimeter, to propagate along its path by offering lower resistance to tear against an applied tear force.

19. A temporary posting adhesive-coated sticker capable of being temporarily attached to an application surface, comprising:

a sheet of opaque flexible material, said sheet having a perimeter defined by two parallel side edges, a top edge and a bottom edge, said sheet having at least one first area and at least one second area; said first area extending to said top edge of said sheet perimeter and extending from one of said parallel side edges to the other of said parallel side edges and being at least partially coated with an adhesive coating; said second area being located immediately adjacent to said first area and being substantially free from said adhesive coating and providing a memo writing space; said adhesive coating being of a temporary adhesion nature such that when said sticker is

attached to and subsequently peeled off said application surface, said adhesive coating remains on said first area of said sticker and said application surface suffers no damage; and,

at least one weakened tear line, selected from the group consisting of pre-slit cut lines, perforated lines and microperforated lines, wherein said weakened tear line extends from said top edge to said bottom edge and wherein said weakened tear line providing a low tear strength that directs an initial tear, started at either end of said weakened tear line, to propagate along the path of said weakened tear line by offering lower resistance to tear against an applied tear force.

Claims 13, 15, and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,299,833 issued to Madole, Jr. on April 5, 1994 (Madole).

Appellant states that each of the claims stands on its own (Brief, pp. 4-5). We consider the claims separately to the extent that they are argued separately.

With respect to claims 13 and 15, we affirm. Because the level of fact finding is insufficient to allow review of the rejection of claim 19, we do not reach a decision with respect to that claim, but remand the application to the Examiner to allow for further development of record. Our reasons follow.

OPINION

With respect to claims 13 and 15, the Examiner has provided evidence that Madole describes a temporary posting adhesive-covered sticker having each and every feature required by these claims. Appellant argues that the structure described by Madole has no first area that extends to the top edge of the sheet that is completely and continuously coated with a non-destructive adhesive as recited in claims 13 and 15. We cannot agree. Madole describes an easel pad or flip chart wherein individual sheets are removed from the pad or chart and applied

to a supporting surface. Figure 2 of Madole depicts an embodiment with a strip of adhesive that completely and continuously coats an area between the lines of perforation 26a and 28a. As pointed out by the Examiner, once the adhesive-backed sheet of the Figure 2 embodiment of Madole is torn away from the pad or chart at perforations 26a, the adhesive extends to the top edge as claimed. This is because the torn away sheet does not include the uncoated strips 24 located above the perforation line 26a, instead, the line of perforation 26a becomes the top edge. Appellant, therefore, has not convinced us of a reversible error on the part of the Examiner in this regard.

Claim 19 is not susceptible to the above analysis because this claim requires the presence of a top-to-bottom tear line. Claim 19 is directed to a temporary posting adhesive-coated sticker comprising a sheet having two parallel side edges, a top edge and a bottom edge. The sheet has a first area extending to the top edge and also extending from one side edge to the other side edge. The first area is at least partially coated with adhesive. The sheet also has a second area located immediately adjacent to the first area and that second area is substantially free of adhesive. There is a weakened tear line extending from the top edge to the bottom edge of the sheet.

The rejection does not directly pinpoint which structure described in Madole meets the requirements of claim 19. Judging from the discussion of Figure 1 in the rejection and the response to argument, it appears that the Examiner is relying upon the web structure shown in Figure 1 or some intermediate structure formed during the process of separating the sheets S

from web W that is described in column 2, line 60 to column 3, line 3, but we cannot determine which of the structures is the basis for the rejection. Without knowing what structure the Examiner is relying upon to meet the limitations of the claim, we cannot determine whether the Examiner erred in making the rejection. We note that the Board is required by the Federal Circuit to analyze the claims on a limitation-by-limitation basis, with specific fact findings for each contested limitation and satisfactory explanations for such findings. *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1033 (Fed. Cir. 1997). Such an analysis cannot be completed here where the Examiner has not identified which structure of Madole is relied upon and how that structure meets all the limitations of the claim.

It is the Examiner's initial burden to establish reasons of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). However, we think reversal of the Examiner's decision to reject claim 19 would be premature in the present case. The facts have been insufficiently developed with respect to key issues. In such circumstances, a remand to the primary fact finder, the Examiner, for further development of the record is appropriate. It is important that ambiguous or obscure bases for decision do not stand as barriers to a determination of patentability.

We conclude that the Examiner has established that the subject matter of claims 13 and 15 is anticipated by Madole but has failed to failed to provide sufficient fact finding to allow review of the rejection with respect to the subject matter of claim 19.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 13 and 15 under 35 U.S.C. § 102(b) is affirmed. Because we are unable to review of the rejection of claim 19, we do not reach a decision with regard to the rejection of that claim, but instead remand the application to the Examiner for action not inconsistent with the above discussion.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 41.50(e) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) provides that

[w]henver a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

Regarding any affirmed rejection, 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner do not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

AFFIRMED-IN-PART
and
REMANDED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CATHERINE TIMM)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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