

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 WILLIAM J. HUNT, WARREN D. KETOLA,
LEE A. PAVELKA, and RICHARD L. SEVERANCE

Appeal No. 2005-1787
Application No. 10/211,027

ON BRIEF

Before PAK, KRATZ, and PAWLIKOWSKI, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 12, 14 through 24 and 27 through 29, which are all of the claims pending in the above-identified application.

APPEALED SUBJECT MATTER

Claim 1 is representative of the subject matter on appeal and reads as follows:

1. A method of making a weatherable coated polymeric film, said method comprising the steps of:

coating a first outer surface of a polymeric film with a UV-light curable composition to form a polymeric film having one or more uncoated areas and one or more coated areas; and

exposing the first coated outer surface to an effective amount of UV-light and curing the UV-light curable composition, wherein the UV-light is substantially free of wavelengths of about 230 nm to about 265 nm.

EVIDENCE

The sole prior art reference relied upon by the examiner:

Cicci	4,836,102	Jun. 6, 1989
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The literature relied upon by the appellant is:

Brochure entitled "Screen Graphics Focus on UV Curing," Fusion Systems, Inc., pages 1-15, (Unknown publication date) (hereinafter referred to as "Exhibit A").

REJECTION

The appealed claims stand rejected as follows¹:

1) Claims 1, 14 and 29 under 35 U.S.C. § 102(a) as anticipated by the disclosure of Cicci; and

¹ See the Brief, page 3 and the Answer, pages 3-4.

- 2) Claims 2 through 12, 14 through 25, 27 and 28 under 35 U.S.C. § 103 as unpatentable over the disclosure of Cicci.

OPINION

We have carefully reviewed the claims, specification and prior art, including all of the evidence and arguments advanced by both the examiner and the appellants in support of their respective positions. This review has led us to conclude that the examiner's Sections 102(a) and 103 rejections are well founded. Accordingly, we affirm the examiner's rejections for essentially the reasons set forth in the Answer. We add the following primarily for emphasis and completeness.

Under Section 102(a), anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. **See *In re Spada***, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); ***RCA Corp. v. Applied Digital Data Systems, Inc.***, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

With the above precedents in mind, we turn to the examiner's rejection of claims 1, 14 and 29 under Section 102(a) as anticipated by the disclosure of Cicci. See the Answer, pages 3-4 and the Brief, page 3. The examiner finds that Cicci teaches transfer-coating a partially cured radiation-curable ink in a pattern on a printable substrate corresponding to the first step recited in claims 1, 14 and 29 and exposing the resulting ink coated printable substrate to UV-light having a wavelength in the range of 200 to 450, preferably in the

range of 400 nm to 450 nm, to further cure the ink corresponding to the second step recited in claims 1, 14 and 29. See the Answer, pages 3-4. The appellants do not challenge the examiner's finding that the transfer-coating step taught by Cicci corresponds to the first step recited in claims 1, 14 and 29. Compare the Answer, pages 3-4, with the Brief in its entirety; see also the appellants' specification, page 3, line 26, to page 4, line 5, defining "coating" as inclusive of "transfer coating". The appellants only argue that Cicci teaches additional coating steps excluded by the transitional phrase "consisting essentially of" recited in claims 1, 14 and 29 and teaches the employment of an UV-light not substantially free of wavelengths of about 230 nm to about 265 nm contrary to claims 1, 14 and 29. See the Brief, pages 3-4.

We are not persuaded by these arguments. First, as acknowledged by the appellants (Brief, page 3), the transitional phrase "consisting essentially of" is open to unclaimed steps which do not materially affect the basic and novel characteristics of the claimed invention. *Atlas Powder v. Du Pont de Nemours & Co.*, 750 F.2d 1569, 1573-74, 224 USPQ 409, 411 (Fed. Cir. 1984); *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976); *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963). Concerning this matter, it is significant that the subject specification discloses that "[t]he polymeric film may be coated with a UV-curable composition using **one or more** coating steps and coating processes. Suitable coating processes include, but are not limited to, ... thermal **transfer printing**, ... **transfer coating**, gravure coating,

... lithographic coating or **combinations thereof** (emphasis added).” See the Specification, page 3, lines 26-30. The subject specification further indicates that the claimed method is open to additional steps, such as “attaching one or more substrates to a second outer surface of the polymeric film by any conventional method of attaching including, but not limited to, adhesion, lamination, stitching, and mechanical fasteners ...” See the Specification, page 5, lines 9-20. Therefore, we determine that the specification as a whole indicates that the unclaimed coating steps described in Cicci do not materially affect the basic and novel characteristics of the claimed method. *Herz*, 537 F.2d at 551-52, 190 USPQ at 463; *Ex parte Boukidis*, 154 USPQ 444 (Bd. App. 1966). On this record, the appellants have not demonstrated that the unclaimed coating steps described in Cicci materially affect the basic and novel characteristics of the claimed method. *In re De Lajarte*, 337 F.2d 870, 874, 143 USPQ 256, 258 (CCPA 1964) (The appellants have the burden of showing that the basic and novel characteristics of a claimed invention is materially affected by unclaimed features). In fact, the appellants’ own statements in the specification are contrary to the appellants’ new position set forth in the Brief.

Second, as correctly found by the examiner (Answer, pages 3 and 6), Cicci’s teaching relating to preference for using a UV-light having a wavelength in the range of 400 nm to 450 nm corresponds to the claimed UV light substantially freed of wavelengths of about 230 nm to about 265 nm. Although Cicci at column 4, lines 29-34, exemplifies using a V-bulb emitting “80% of usable energy in the 400 to 450 nm range,” such example

does not negate the full description provided in Cicci. The fact remains that Cicci clearly teaches that a UV-light having a wavelength of 400 nm to 450 nm is preferred.

This is especially true in this situation since Cicci further teaches that “filters may be used to block those [short] wavelengths which would tend to polymerize the outer surface 43 of the ink layer.” See column 3, line 68 to column 4, line 2. According to the appellants (Specification, page 1, lines 24-26), “[s]urface cure’ refers to extensive reaction near or at the coating surface and is most affected by wavelengths of **about** 240-270 nm (emphasis ours).” Thus, we determine that Cicci’s preference for a UV-light having a wavelength of 400 nm to 450 nm to avoid surface curing indicates that its preferred UV-light is substantially freed of wavelengths of “**about** 230 nm to about 265 nm”.

The appellants take the position that the curing system employed by Cicci does not produce the claimed UV light substantially freed of wavelengths of “about 230 nm to about 265 nm”.² See the Brief, page 4. In support of this position, the appellants refer to Exhibit 1. *Id.* Thus, it appears to be the appellants’ position that Cicci does not provide an enabling disclosure as to curing an ink coating with a UV light having a wavelength substantially freed wavelengths of “about 230 nm to about 265 nm”.

² According to the appellants (Brief, page 4), “[t]he specification defines ‘substantially free’ as meaning that the photon intensity in this wevelength region is **not detectable** using an EIT Uvicure Power Puck (EIT Inc., Sterling, VA) integrating radiometer.” The appellants do not provide any evidence or explanation relating to the degree of detection applicable to an EIT Uvicure Power Puck integrating radiometer or a condition at which an IT Uvicure Power Puck integrating radiometer is used to perform the detection.

However, for the reasons well articulated by the examiner (Answer, pages 3 and 6), we are not convinced that the appellants have demonstrated that Cicci lacks an enabling disclosure as to curing an ink coating with a UV light having a wavelength substantially freed wavelengths of “about 230 nm to about 265 nm”. ***Compare In re Spence***, 261 F.2d 244, 246, 120 USPQ 82, 83 (CCPA 1958). As correctly found by the examiner (Answer, page 3), “Cicci teaches that if the radiation source produces too high a level of short wavelength UV, **filters** may be used to block those wavelengths which would tend to polymerize the outer surface 4b of the ink layer (See column 3, lines 66-69; column 4, lines 1-2).” Thus, we concur with the examiner that one of ordinary skill in the art interested in carrying out the preferred method of Cicci would have employed its curing system, together with filters, to produce a UV light in the preferred range of 400-450 nm.

Having considered all of the arguments and evidence advanced by the appellants, we concur with the examiner that Cicci fully describes the subject matter defined by claims 1, 14 and 29 within the meaning of Section 102.

We turn next to the examiner’s rejection of claims 2 through 12, 14 through 25, 27 and 28 under 35 U.S.C. § 103 as unpatentable over the disclosure of Cicci. The appellants do not question the examiner’s findings relating to the limitations recited in claims 2 through 12, 14 through 25, 27 and 28, except for the phrase “consisting essentially of” and the claimed UV-light wavelengths as indicated ***supra***. Thus, for the same factual findings and conclusions set forth above, we are not convinced that Cicci

would not have taught or suggested the claimed subject matter within the meaning of Section 103.

CONCLUSION

In view of the foregoing, we affirm the examiner's decision rejecting claims 1, 14 and 29 under 35 U.S.C. § 102(a) and claims 2 through 12, 14 through 25, 27 and 28 under 35 U.S.C. § 103. Accordingly, the decision of the examiner is affirmed.

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

AFFIRMED

CHUNG K. PAK
Administrative Patent Judge

PETER F. KRATZ
Administrative Patent Judge

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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