UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK VITO DI STEFANO

Appeal 2006-2307
Application 10/370,686
Technology Center 1700

Decided: November 22, 2006

Before KIMLIN, PAK, and KRATZ, *Administrative Patent Judges*.
KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 1-23, the only claims that remain pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

Appellant's invention is directed to an aqueous pressure sensitive adhesive emulsion blend, a method of preparing such an emulsion, and products including such a blend. Claim 20 is illustrative of the claimed subject matter and is reproduced below:

> 20. An aqueous based pressure sensitive adhesive emulsion blend comprising an aqueous pressure sensitive adhesive polymer emulsion and a high Tg polymer emulsion, said high Tg polymer having a Tg of 50 ºC to 300 ºC and a number average particle size of 80 nm to 1000 nm, said aqueous pressure sensitive adhesive polymer emulsion having a number average particle size of less than 500 nm.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Otsuki	JP 05-271645[1]	Oct. 19, 1993
Rosenski	US 5,319,020	Jun, 07, 1994
Brown	US 5,641,567	Jun. 24, 1997

Claims 1-20 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over JP05-271645. Claims 1-20 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP05-271645 in view of Rosenski. Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over JP05-271645. Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Otsuki JP05-271645 in view of Brown.

OPINION

We have reviewed each of Appellant's arguments for patentability. However, we are in agreement with the Examiner that the claimed subject

[1] Our references to JP05-271645 in this Decision are to the English language translation thereof of record.

matter would have been anticipated by and/or obvious to one of ordinary skill in the art in view of the applied prior art as set forth in the Examiner's rejections. Accordingly, we sustain the Examiner's anticipation and obviousness rejections for essentially the reasons expressed in the Answer. We add the following for emphasis.

§ 102(b)/§103(a) Rejection of Claims 1-23 over JP05-271645

Appellant does not argue all of the rejected claims separately. Rather, Appellant refers to claims 11 and 20 as a group in the arguments.[2] Thus, we select claim 20 as representative of the rejected claims in deciding the appeal as to this ground of rejection.

Anticipation by a prior art reference does not require that the reference recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. *See Verdegaal Bros. Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (*see Hazani v. U.S. Int'l Trade Comm'n,* 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)). However, the law of anticipation does not require that the reference teach what the appellants teach in their specification, but only that the claims on appeal "read on" something disclosed in the reference (*see Kalman v. Kimberly-Clark Corp.*,

[2] While Appellant makes a passing reference to claims 12 and 23 in the arguments set forth in the Brief, Appellant argues for the patentability of the latter claims based on the same arguments made for all of the other rejected claims (Brief 5).

713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984)). Anticipation under this section is a factual determination. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)).

In the case before us, the Examiner has determined that JP05-271645 describes a pressure sensitive adhesive blend comprising first and second polymers corresponding to Appellant's polymer blend. The Examiner has determined that JP05-271645 describes an aqueous pressure sensitive adhesive comprising a polymer emulsion blend including a first polymer having a T_g of 50 °C or greater with a particle size of 0.2 micron (i.e. 200 nm) and a second polymer having a particle size of 0.5-1.0 micron (i.e. 500-1000nm).[3] In addition, the Examiner has pointed to the description in JP05-271645 of a comparison Example 6 wherein a polymer emulsion blend of a first polymer (Production Example 3) having a particle size of 180 nm is blended with a dispersion of a second polymer (Production Example 6) having a high T_g of 79 °C and a particle diameter of 105 nm (Answer 3-4, and JP05-271545 at 6-11). Moreover, the Examiner notes that Table 3 of JP05-271645 reports strong adhesion properties for the pressure sensitive adhesive of comparison Example 6 (Answer 4 and 6, and JP05-271645 at 6-11).

[3] Appellant does not dispute this determination of the Examiner. Nor does Appellant dispute the Examiner's determination "that the translation's 'mm' is in fact a representation of 'μ'. This can be gleaned from the original Japanese text. Also note l mm = l μ = 1 micron = 1000nm." *Answer* 3.

Given the above and for reasons more fully set forth in the Answer, we agree with the Examiner that JP05-271645 renders the subject matter of representative claim 20 prima facie anticipated. Moreover, we note that a disclosure that anticipates, prima facie, under 35 U.S.C. § 102 also renders the claim prima facie unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See *also In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

Appellant contends that the blended polymer product of JP05-271645 does not show pressure sensitive adhesiveness after production thereof; that is, when it is formed. This argument is not persuasive of any error in the Examiner's anticipation/obviousness rejection for reasons stated by the Examiner in the Answer and as further articulated herein. In this regard and as correctly noted by the Examiner, representative appealed claim 20 does not require that the pressure sensitive adhesive possess any particular quantifiable level of adhesiveness in general or a particular degree of adhesion as soon as formed. Moreover, Appellant's arguments concerning the lack of a description of the less than 500 nm averages particle diameter required for the pressure sensitive adhesive polymer emulsion component of the blend of representative claim 20 is not well taken. This is because the Examiner specifically refers to comparative Example 6 of JP05-271645 for exemplification of such a product and Appellant has not even addressed that comparative Example disclosure in arguing against the Examiner's anticipation rejection over JP05-271645. In addition, Appellant "teaching away" contention has no merit in opposition to the anticipation prong of the

Examiner's rejection in that comparative Example 6 is part of the prior art described by JP05-271645.

Whether a rejection is made under 35 U.S.C. § 102, or under § 103, it is well settled that when Appellant's product and that of the prior art appear to be identical or substantially identical the burden shifts to Appellant to provide evidence that the prior art product does not necessarily or inherently possess the relied upon characteristics (pressure sensitive properties) of Appellant's claimed product. See *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977); *In re Fessmann*, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. *See In re Best*, 562 F.2d at 1255, 195 USPQ at 434. Here, appellant haves not undertaken, much less persuasively discharged, that burden.

Concerning the Examiner's obviousness rejection, we note that in addition to the comparative Example 6 of JP05-271645, JP05-271645 further suggests a product corresponding to that of Appellant's representative claim 20. This is because JP05-271645 teaches that the aqueous pressure sensitive blend can include a high T_g polymer component having particle diameters in the range of 500 to 2,000 nm in addition to a vinyl copolymer aqueous dispersion of particles corresponding to a size as claimed. Representative claim 20 requires that the high T_g polymer component of the blend must have an average particle size less than 500

nm.[4] However, the claimed size range (less than 500nm) is so close to the prior art range, that one of ordinary skill in the art would have reasonably arrived at the use of a polymer component having a size within the claimed adjacent range upon routine experimentation to determine the precise outer limits of workable sizes of the high T_g polymer employed in JP05-271645. It is well settled that a prima facie case of obvious exists when the claimed range and the prior art range do not overlap but are close enough such that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985).

As for the argument that JP05-271645 teaches away from the use of particle size diameters less than 500 nm, we again note that JP05-271645 includes a specific comparative Example with a particle size within the claimed range. Moreover, one of ordinary skill in the art would have recognized that the relative size of the high T_g polymer could vary somewhat from the specifically disclosed size range of JP05-271645 while obtaining acceptable properties for the final blended pressure sensitive adhesive. This is so because the pressure sensitive adhesive properties depends on other factors besides the the high T_g polymer size. For example, the particular polymers employed in the blend, the particular glass temperature (T_g) of the high T_g polymer, and the amount thereof employed in the blend have an effect on the properties of the adhesive blend. *See*, e.g., Table 3 of JP05-271645.

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[4] We note that Appellant does not argue that the claimed number average size represents a patentably significant difference over the particle size measure employed by Otsuki.

To the extent that Appellant may be arguing that the claimed invention is attended by unexpected results in arguing against the obviousness rejection, we note that the limited examples furnished in Appellant's specification are considerably narrower in scope than representative claim 20. In this regard, appellant bears the burden of establishing unexpected results for the claimed subject matter. Moreover, we observe that claim 20 employs open comprising language and is not limited to the use of any particular amount of a high T_g polymer having an average particle size less than 500 nm, nor to the use of any particular high T_g polymer or aqueous pressure sensitive adhesive polymer. Also, Appellant has not compared the claimed invention to the closest prior art (Comparative Example 6) of JP05-271645. Finally Appellant has not fairly established that any of the results accompanying the claimed invention would have been unexpected to one of ordinary skill in the art.

Consequently, on this record, we affirm the Examiner's anticipation/obviousness rejection over JP05-271645.

§ 103(a) Rejection of Claims 1-23 over JP05-271645 and Rosenski.

Appellant presents substantially the same arguments against this rejection as were presented against the Examiner's obviousness rejection over JP05-271645 alone. Appellant does not argue the rejected claims separately. Thus, we select claim 20 as the representative claim. Because we find that JP05-271645 furnishes sufficient evidence to establish the obviousness of the claim 20 subject matter, we shall also affirm the Examiner's rejection of claims 1-20 and 23 over the combined teachings of JP05-271645 and Rosenski for the reasons stated above and in the Answer.

§ 103(a) Rejection of Claim 21

Appellant relies on the same arguments as presented against the Examiner's obviousness rejection of claims 1-20 and 23 and do not otherwise contest the Examiner's separately stated rejection of claim 21. In this regard, we agree with the Examiner that the particle size distribution limitation has been acknowledged to allow for a broad particle size range and does not serve to patentably distinguish the claimed pressure sensitive adhesive-containing product from the products suggested by JP05-271645 (Answer 5 and 7). It follows that we shall also sustain the Examiner's obviousness rejection of claim 21 for reasons stated above and in the answer.

§ 103(a) Rejection of Claim 22

Appellant relies on the same arguments as presented against the Examiner's obviousness rejection of claims 1-20 and 23 and we do not find those arguments persuasive for reasons stated above. Appellant also maintains that Brown employs a normally tacky (at room temperature) adhesive. Therefore, Appellant contends that it would not have been obvious to one of ordinary skill in the art to combine the pressure sensitive adhesive of JP05-271645 with the release liner of Brown in order to obtain a product corresponding to the claim 22 product. However, we disagree with that unsubstantiated attorney's argument in that Appellant has not fairly articulated why one of ordinary skill in the art would have found the use of a release paper as taught by Brown to lack combinability with the pressure sensitive adhesives of JP05-271645. In this regard, while we are mindful that Otsuki does not require a mold release liner, JP05-271645 does not

preclude the use of such a known silicone coated paper liner as taught by Brown in combination with the pressure sensitive adhesives disclosed by JP05-271645. In this regard, the use of such a release liner would allow for ease of separation where a packaged tape has been subjected to the application of pressure during storage or where one of the comparison example pressure sensitive adhesive formulations disclosed in JP05-271645 are employed. It follows that we shall also sustain the Examiner's obviousness rejection of claim 22 for reasons stated above and in the Answer.

CONCLUSION

The decision of the Examiner to reject claims 1-20 and 23 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over JP05-271645; to reject claims 1-20 and 23 under 35 U.S.C. § 103(a) as being unpatentable over JP05-271645 in view of Rosenski; to reject claim 21 under 35 U.S.C. § 103(a) as being unpatentable over JP05-271645; and to reject claim 22 under 35 U.S.C. § 103(a) as being unpatentable over JP05-271645 in view of Brown, is affirmed.

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

AFFIRMED

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