

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* GARY E. MAAKS, JOHN R. MECCIA, and JOSEPH J. WRONA
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11 Appeal 2007-4064
12 Application 10/462,183
13 Technology Center 3700
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16 Decided: January 9, 2008
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20 *Before:* TERRY J. OWENS, ANTON W. FETTING and
21 STEVEN D.A. McCARTHY, *Administrative Patent Judges.*

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23 McCARTHY, *Administrative Patent Judge.*
24

25 DECISION ON APPEAL

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27 STATEMENT OF THE CASE

28 The Appellants appeal under 35 U.S.C. § 134 (2002) from the final
29 rejection of claims 1-10, 18 and 19. We have jurisdiction under 35 U.S.C.
30 § 6(b) (2002).

1 The Appellants' invention is the product formed by applying a
2 foamed, water-based adhesive to an article of manufacture. The adhesive
3 must be "reactivable;" that is, the adhesive, once applied to a substrate and
4 dried or otherwise solidified, must be susceptible of returning to a state in
5 which the adhesive is capable of bonding to another substrate. The
6 Appellants point out that "[a]ny water-based adhesive that can be foamed
7 can be used in the practice of the invention as long as the dried adhesive is
8 thermoplastic." (Specification 2, l. 16-17). In their brief, the Appellants
9 contend that the word "preapplied" is a term of art meaning that an adhesive
10 is applied "onto a substrate for later activation or 'reactivation.'" (Br. 4).

11 Independent claim 1 is representative of the claims on appeal and
12 reads as follows:

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14 1. An article of manufacture having preapplied
15 to at least a portion thereof a reactivable
16 adhesive, wherein the reactivable adhesive was
17 applied to the article in the form of a foamed
18 water-based adhesive.
19

20 Claims 1-10, 18 and 19 are rejected under 35 U.S.C. § 102(e) as being
21 anticipated by Lydzinski (U.S. Patent Application Publication 2004/
22 0063802).

23 We affirm.

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ISSUE

26 The issue in this appeal is whether the Appellants have shown that the
27 Examiner erred in rejecting claims 1-10, 18 and 19 under 35 U.S.C.

1 § 103(a). In addressing this issue, we consider whether Lydzinski discloses
2 a reactivatable adhesive applied to at least a portion of an article of
3 manufacture in the form of a water-based foam.

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FINDING OF FACT

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The record supports the following finding of fact by a preponderance
7 of the evidence.

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Lydzinski discloses “a method for bonding materials together which
9 comprises applying. . . [a] foamed adhesive composition . . . to a first
10 substrate, bringing a second substrate in contact with the adhesive
11 composition applied to the first substrate, and subjecting the applied
12 composition to conditions which will allow the composition to form a set
13 bond.” (Lydzinski 1, ¶ 0010). These substrates may include plastic or paper
14 stock materials. (*Id.*) Preferred adhesive compositions include aqueous
15 emulsions of vinyl acetate/ethylene/dioctylmaleate terpolymers foamed until
16 the amount of air dispersed in the emulsions is between about 10 vol% and
17 about 50 vol%. (Lydzinski 2, ¶ 0016 and 3, ¶ 0032). Lydzinski discloses
18 that “[t]he adhesive may be used to manufacture packaging materials in both
19 laminating and heat sealing applications.” (Lydzinski 3, ¶ 0033).

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PRINCIPLES OF LAW

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The subject matter of a claim is anticipated if “a single prior art
23 reference discloses each and every limitation of the claimed invention. . . .
24 Moreover, a prior art reference may anticipate without disclosing a feature
25 of the claimed invention if that missing characteristic is necessarily present,
26 or inherent, in the single anticipating reference.” *Schering Corp. v. Geneva*

1 *Pharmaceuticals, Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (citations
2 omitted). An examiner may reject a product claim for anticipation on the
3 basis of an unrebutted “prima facie” case. That is:

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5 where the Patent [and Trademark] Office has
6 reason to believe that a functional limitation
7 asserted to be critical for establishing novelty in
8 the claimed subject matter may, in fact, be an
9 inherent characteristic of the prior art, it possesses
10 the authority to require the applicant to prove that
11 the subject matter shown to be in the prior art does
12 not possess the characteristic relied on.
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14 *In re Best*, 562 F.2d 1252, 1254-55 (C.C.P.A. 1977) (quoting *In re*
15 *Swinehart*, 439 F.2d 210, 213 (C.C.P.A. 1971)).

17 ANALYSIS

18 Claims 1-10, 18 and 19 stand rejected as anticipated by Lydzinski.
19 The Appellants did not provide separate arguments addressing the novelty of
20 particular claims. Therefore, the Board will decide the patentability of
21 claims 1-10, 18 and 19 as a group, claim 1 being deemed representative of
22 the group. 37 C.F.R. § 41.37(c)(vii) (2007); *In re Dillon*, 919 F.2d 688, 692
23 (Fed. Cir. 1990) (*en banc*).

24 Claim 1 recites a product. Therefore, the sole issue in this appeal is
25 whether Lydzinski discloses the product recited in claim 1. Although claim
26 1 defines the product in terms of a method for making the product, “[i]t has
27 long been established that one cannot avoid anticipation by an earlier
28 product disclosure by claiming the same product more narrowly, that is, by

1 claiming the product as produced by a particular process.” *SmithKline*
2 *Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317 (Fed. Cir. 2006).

3 The Examiner has established a prima facie case that Lydzinski
4 anticipates the product of claim 1. Lydzinski discloses a method which
5 inherently produces a product including an article of manufacture, namely, a
6 plastic or paper stock material, and a residue of a foamed, water-based
7 adhesive composition applied to at least a portion of the article. (FF). Given
8 its broadest reasonable interpretation consistent with the disclosure of the
9 present specification, *see In re American Acad. of Science Tech Ctr.*, 367
10 F.3d 1359, 1364 (Fed. Cir. 2004), the limitation requiring that that the
11 adhesive be “reactivable” is functional in that the limitation defines the
12 adhesive composition in terms of the capability of a dried residue of the
13 composition to be “reactivated.” The record as a whole would have
14 provided the Examiner with reason to believe that Lydzinski describes
15 applying an adhesive composition including a mixture of aqueous copolymer
16 emulsions which would dry to form a “reactivable” residue, as discussed in
17 more detail below. Since the Examiner has reason to believe that Lydzinski
18 inherently discloses a product within the scope of claim 1, Lydzinski prima
19 facie anticipates claim 1.

20 The Appellants contend that “Lydzinski does not disclose the pre-
21 application of a foamed adhesive to a substrate surface or the later
22 reactivation of the preapplied adhesive so as to anticipate the claimed
23 invention.” (Br. 4). This argument appears to be based on their contention
24 that the word “preapplied” is a term of art meaning that an adhesive is
25 applied “onto a substrate for later activation or ‘reactivation.’” (Br. 4).
26 During prosecution, however, “claims . . . are to be given their broadest

1 reasonable interpretation consistent with the specification, and . . . claim
2 language should be read in light of the specification as it would be
3 interpreted by one of ordinary skill in the art.” *In re American Acad. Of*
4 *Science Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re*
5 *Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)). Here, the word “preapplied” as
6 used in claim 1 must be interpreted as broadly equivalent in meaning to the
7 word “applied.” The Appellants have not identified evidence sufficient to
8 prove that those of ordinary skill in the art would understand “preapplied” to
9 require later activation or reactivation of the dried adhesive on the article of
10 manufacture.

11 Even if those of ordinary skill in the art might have understood the
12 common meaning of the word “preapplied” to imply *later* activation of the
13 dried adhesive, the meaning of the word as used in claim 1 could not be so
14 limited. “The discovery of a new property or use of a previously known
15 composition, even when that property and use are unobvious from the prior
16 art, can not impart patentability to claims to the known composition.” *In re*
17 *Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). The meaning of the word
18 “preapplied” advanced by the Appellants differs from the common meaning
19 of the word “applied” only with respect to a use to which the product later
20 might be put, namely, reactivation of the dried adhesive. Narrowing the
21 meaning of the term “preapplied” in the manner advocated by the Appellants
22 would allow the Appellants to distinguish their product from Lydzinski’s on
23 the basis of an intended use of the product rather than on the basis of the
24 nature and properties of the product itself. Lydzinski anticipates the product
25 of claim 1 despite the failure of the reference to disclose later reactivation of
26 the adhesive.

1 The Appellants contend that “[t]he examiner’s interpretation of the
2 foamed adhesive of Lydzinski as being inherently capable of reactivation is
3 without merit. Lydzinski does not disclose drying of an applied adhesive in
4 a state in which it would be capable of reactivation.” (Br. 5). Lydzinski
5 teaches that “[t]he adhesive may be used to manufacture packaging materials
6 in both laminating and heat sealing applications.” (Lydzinski 3, ¶ 0036).
7 The only adhesive compositions disclosed in Lydzinski are foamed aqueous
8 solutions or emulsions (*e.g.*, Lydzinski 1, ¶ 0013) susceptible of use to bond
9 plastic or paper stock materials without the addition of heat. Any heat
10 sealing application of such adhesive compositions necessarily would involve
11 the addition of heat to reactivate the adhesives after drying. Therefore,
12 Lydzinski inherently discloses the application of a *reactivable* adhesive to
13 an article of manufacture.

14 The Appellants concede that “[a]ny water-based adhesive that can be
15 foamed can be used in the practice of the invention as long as the dried
16 adhesive is thermoplastic.” (Specification 2, l. 16-17). Since Lydzinski
17 discloses applying to plastic or paper stock material an aqueous emulsion
18 similar to a preferred emulsion disclosed in the present specification, the
19 Examiner had reason to believe that Lydzinski’s emulsion inherently would
20 dry to a residue having softening properties similar to those of the residue of
21 the preferred adhesive material disclosed in the present specification. This is
22 particularly true since Lydzinski does not appear to disclose the performance
23 of a curing step while the adhesive is setting.

24 Lydzinski discloses applying to plastic or paper stock material an
25 aqueous emulsion similar to a preferred emulsion disclosed in the present
26 specification. While describing the adhesives which might be applied to the

1 article of manufacture, the present specification states that “[p]referred
2 adhesives are foamable adhesives comprising from about 80 to about 100%
3 by weight of a polymer emulsion comprising a vinyl acetate homopolymer
4 or *ethylene-vinyl acetate* copolymer” (Specification 5, ll. 21-23 [emphasis
5 added]). Lydzinski discloses the application of single copolymer emulsions
6 to substrates (Lydzinski 1, ¶ 0013) and describes a preferred adhesive for
7 application to a plastic or paper stock substrate as a resin emulsion
8 comprising a *vinyl acetate/ethylene/dioctylmaleate* terpolymer (Lydzinski 2,
9 ¶ 0016). Both the present specification and Lydzinski suggest foaming the
10 emulsion until the amount of air dispersed in the adhesive is between about
11 10 vol% and about 50 vol%. (Specification 9, ll. 3-5; FF).

12 The Examiner established a prima facie case that Lydzinski’s
13 adhesive is inherently “reactivable.” This prima facie case shifted the
14 burden of proof to the Appellants to show that the product claimed in claim
15 1 differs from the product of Lydzinski’s process. *In re Thorpe*, 777 F.2d
16 695, 697 (Fed. Cir. 1985). The Examiner provided the Appellants with
17 notice of the contention that an adhesive composition disclosed in paragraph
18 0016 of Lydzinski is inherently reactivable. The Appellants submitted no
19 evidence rebutting this contention. In particular, the Appellants submitted
20 no evidence sufficient to show that the adhesive compositions disclosed in
21 paragraph 0016 of Lydzinski need not dry to form thermoplastic residues or
22 that bringing the article of manufacture to which such an adhesive has been
23 applied into contact with another such material before drying would affect
24 the softening characteristics of the residue.

1 On the record before us, the Examiner properly rejected claim 1 as
2 anticipated by Lydzinski. Claims 2-10, 18 and 19 were grouped with claim
3 1 for purposes of this appeal and fall with that claim.

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CONCLUSION OF LAW

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On the record before us, the Appellants have not shown that the
Examiner erred in rejecting the appealed claims as anticipated by Lydzinski.

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DECISION

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The Examiner's rejection of claims 1-10, 18 and 19 is affirmed.

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

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§ 1.136(a)(1)(iv) (2007).

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AFFIRMED

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