

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAM SMITH,
JIANSHE CHEN and
ANNE DUGAS

Appeal 2008-1290
Application 09/969,893
Technology Center 1700

Decided: April 10, 2008

Before EDWARD C. KIMLIN, CHUNG K. PAK, and CATHERINE Q. TIMM, *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 13 through 25, all of the claims pending in the above-identified application. We have jurisdiction pursuant to 35 U.S.C. § 6.

We AFFIRM.

STATEMENT OF THE CASE

The subject matter on appeal is directed to an article having a label with the label being attached to the article via an adhesive (Spec. 3). Further details of the appealed subject matter are recited in representative claim 13 reproduced below:

13. An article comprising a label, wherein the label is attached to the article by an adhesive that comprises a starch component, a gelatin component and water, said adhesive being substantially clear when dry.

The Examiner has relied upon the following references as evidence of unpatentability of the claimed subject matter:

Hyden	1, 985,898	Jan. 1, 1935
Williams	3,205,091	Sep. 7, 1965
Ploetz	3,657,043	Apr. 18, 1972
Shimokawa	4,350,788	Sep. 21, 1982
Gleason	EP 0 319 692 B1	Dec. 8, 1993

The Examiner has rejected the claims on appeal as follows:

- 1) Claims 13 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Hyden;
- 2) Claims 16, 18, and 19 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hyden and Williams;
- 3) Claims 14, 15, 22, and 23 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hyden, Williams, and Gleason;
- 4) Claims 20 and 21 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hyden, Williams, and Shimokawa; and

5) Claims 17, 24, and 25 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hyden, Williams, and Ploetz.

Accordingly, the Appellants appeal from the Examiner's decision rejecting the claims on appeal under 35 U.S.C. §§ 102(b) and 103(a).

RELEVANT FACTUAL FINDINGS, PRINCIPLES OF LAW, ISSUES AND ANALYSES

I. *ANTICIPATION*

Under 35 U.S.C. § 102(b), anticipation is established only when a single prior art reference describes, either expressly or under the principle of inherency, each and every element of a claimed invention. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). The law of anticipation, however, does not require that the prior art reference teach Appellant's purpose or utility described in the Specification, but only that the claims on appeal "read on" something disclosed in the reference. *See Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983).

As correctly found by the Examiner (Ans. 3), Hyden teaches applying a label to an article using "adherent coatings or films of a composition which is responsive to water-sensitive adhesives" (p. 1, col. 1, ll. 1-5 and col. 2, ll. 3-20 and 36-44). We find that Hyden teaches using this adherent (sizing) coating composition to promote adhesion between the article and a label gummed with a water-sensitive adhesive (p.1, col. 2, ll. 20-26 and p.2, col. 1, ll. 3-12).

The Appellants only contend that Hyden does not teach its adhesion promoting (sizing) coating composition as including the claimed ingredients and having the claimed transparency upon drying (Br. 4).

The dispositive question is, therefore, whether Hyden describes the claimed ingredients and transparency for its adhesion promoting sizing composition within the meaning of 35 U.S.C. § 102(b). On this record, we answer this question in the affirmative.

As acknowledged by the Appellants (Br. 5), Hyden teaches this adhesion promoting sizing coating composition as including “one or more resins, preferably synthetic resins, one or more water-sensitive agglutinants, and *optionally* one or more softeners...dissolved or suspended in a liquid...” (emphasis added) (*see also* p.2, col. 1, ll. 41-50). We find Hyden exemplifies two such adhesion promoting sizing coating compositions containing, *inter alia*, gelatin, water, and glyptal resin (p. 2, col. 2, Example I, and p. 3, col. 1, Example IV). We find that Hyden teaches that:

Though each of the specific examples above described discloses only one water-sensitive agglutinant, it is within the purview of this invention to use a plurality thereof. *See* p. 3, col. 2, ll. 5-8.

We find that Hyden describes a limited number of the water-sensitive agglutinants employed, namely gelatin, starch, aquaresin, sugars, casein, and dextrin (p.2, col. 1, ll. 56-60). We find that Hyden teaches the locations of these adhesion promoting compositions applied to an article are not noticeable to the layman (p. 2, col. 1, l. 13). According to page 2, column 1, lines 14-26 of Hyden:

It, however, can be detected by one skilled in the art because, due to the nature of the composition employed, the coating will be very slight color, opacity ... not sufficient, however, to impair the appearance or servability of the wrapper ... When the moistureproof wrapper is transparent, the film or coating applied may also be transparent with the result that this desirable characteristic is not impaired to any great extent

In other words, Hyden teaches that its exemplified adhesion promoting compositions containing agglutinants (glues) are substantially clear or should be made clear upon drying (not detectable to the layman). Hence, we find that one of ordinary skill in the art would have readily envisaged an adhesive having the claimed ingredients, i.e., gelatin, starch, and water, and the claimed transparency within the meaning of 35 U.S.C. § 102(b). *In re Schaumann*, 572 F.2d 312, 315 (CCPA 1978). Accordingly, we concur with the Examiner that Hyden renders claim 13 anticipated within the meaning of 35 U.S.C. § 102(b).

II. OBVIOUSNESS

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). “[A]nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co., v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-

41 (2007); *see also DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006) (“The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.”); *In re Bozek*, 416 F.2d 1385, 1390 (CCPA 1969) (“Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness ‘from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.’”); *In re Hoeschele*, 406 F.2d 1403, 1406-407 (CCPA 1969) (“[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom”).

CLAIMS 16, 18, AND 19

The Appellants do not dispute the Examiner’s finding that Williams teaches or would have suggested employing a starch-based adhesive to attach a plastic label to an article. *Compare* Ans. 4, with Br. 8-9. Nor do the Appellants dispute the Examiner’s determination that it would have been obvious to employ the starch-based adhesion promoting compositions taught by Hyden to attach a label, including a plastic label, to an article. *Compare* Ans. 4, with Br. 8-9.

As to claim 16, there is no dispute that Hyden and Williams would have suggested attaching a plastic label to an article. Rather, the Appellants contend that neither Hyden nor Williams teaches or would have suggested

employing an adhesive composition containing water, a gelatin component, and a starch component. We are not persuaded by this contention since Hyden teaches such composition as indicated *supra*. Accordingly, based on the above factual findings, we concur with the Examiner that it would have been obvious to employ the starch-based adhesion promoting compositions containing water, gelatin, and starch taught by Hyden to attach a label, such as a plastic label, to an article within the meaning of 35 U.S.C. § 103(a).

As to claims 18 and 19, the Appellants only contend that Hyden and Williams do not teach or suggest a starch component comprising at least two different types of starches (Br. 8). However, the Appellants do not dispute the Examiner's finding that Williams teaches that starches are equivalent for the adhesive purposes and therefore, would have suggested employing at least two starches in adhesive compositions. *Compare* Ans. 4, with Br. 8-9. Accordingly, we concur with the Examiner that it would have been obvious to one of ordinary skill in the art to employ at least two different starches as the starch component of the starch-based adhesion promoting compositions taught by Hyden within the meaning of 35 U.S.C. § 103(a). *See, e.g., In re Castner*, 518 F.2d 1234, 1238-39 (CCPA 1975)(one of ordinary skill in the art would have been led to combine known additives for their art recognized functions); *In re Lintner*, 458 F.2d 1013, 1015-16 (CCPA 1972); *see also In re Kerkhoven*, 626 F.2d 846, 850 (CCPA 1980)(it is *prima facie* obvious to combine two different materials useful for the same purpose to form a third material which is to be used for the very same purpose).

CLAIMS 14, 15, 22, AND 23

The Appellants do not dispute the Examiner's finding that it is well known in the art to attach a label to a glass container via a starch-based adhesive as evidenced by Gleason. *Compare* Ans. 5, with Br. 9-10. Nor do the Appellants dispute the Examiner's determination that it would have been obvious to employ the starch-based adhesion promoting compositions of the type taught by Hyden to attach a label to a glass container. *Compare* Ans. 5, with Br. 9-10. Rather, the Appellants only contend that Hyden, Williams and/or Gleason do not teach an adhesive composition containing water, a gelatin component, and a starch component (Br. 9). Again, we are not persuaded by this contention since Hyden teaches such composition as indicated *supra*. Accordingly, we concur with the Examiner that it would have been obvious to employ the starch-based adhesion promoting compositions taught by Hyden to attach a label to a glass container within the meaning of 35 U.S.C. § 103(a).

CLAIMS 20 AND 21

The Appellants do not dispute the Examiner's determination that one of ordinary skill in the art would have been led to employ the crosslinking agent, liquifier, humectant, urea, dicyandiamide and zinc carbonate taught by Shimokawa in the starch-based adhesion promoting compositions of the type taught by Hyden with the reasonable expectation of successfully increasing water resistance as taught by Shimokawa. *Compare* Ans. 5-6, with Br. 10. Rather, the Appellants only contend that Hyden, Williams and/or Shimokawa do not teach an adhesive composition containing water, a gelatin component,

and a starch component (Br. 10). Again, we are not persuaded by this contention since Hyden teaches such composition as indicated *supra*. Accordingly, we concur with the Examiner that it would have been obvious to one of ordinary skill in the art to employ the crosslinking agent, liquifier, humectant, urea, dicyandiamide and zinc carbonate taught by Shimokawa in the starch- based adhesion promoting compositions taught by Hyden within the meaning of 35 U.S.C. § 103.

CLAIM 24

The Appellants do not dispute the Examiner's determination that one of ordinary skill in the art would have been led to attach a label, such as the transparent label taught by Ploetz, to an article using Hyden's adhesion promoting composition as suggested by Hyden, Williams, and Shimokawa. *Compare* Ans. 6-7, with Br. 11. Rather, the Appellants only contend that Hyden, Williams, Shimokawa and/or Ploetz do not teach an adhesive composition containing water, a gelatin component, and a starch component (Br. 11). Again, we are not persuaded by this contention since Hyden teaches such composition as indicated *supra*. Accordingly, we concur with the Examiner that it would have been obvious to one of ordinary skill in the art to attach a label, such as the transparent label taught by Ploetz, to an article via Hyden's adhesion promoting composition as suggested by Hyden, Williams and Shimokaw within the meaning of 35 U.S.C. § 103 (a).

CLAIMS 17 AND 25

The Appellants do not dispute the Examiner's determination that one of ordinary skill in the art would have been led to attach a label, such as the transparent label taught by Ploetz, to an article as suggested by Hyden, Williams and Gleason. *Compare* Ans. 7, with Br. 12. Rather, the Appellants only contend that Hyden, Williams, Gleason and/or Ploetz do not teach an adhesive composition containing water, a gelatin component, and a starch component (Br. 12). Again, we are not persuaded by this contention since Hyden teaches such composition as indicated *supra*. Accordingly, we concur with the Examiner that it would have been obvious to one of ordinary skill in the art to attach a label, such as the transparent label taught by Ploetz, to an article via Hyden's adhesion promoting composition as suggested by Hyden, Williams and Gleason within the meaning of 35 U.S.C. § 103(a).

ORDER

The decision of the Examiner is affirmed.

TIME PERIOD

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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