

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOAN M. STROBEL and THOMAS P. HANSCHEN

Appeal 2008-3857
Application 10/445,531
Technology Center 1700

Decided: August 21, 2008

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
PETER F. KRATZ, *Administrative Patent Judges*.

KRATZ, *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, 3-13, and 15-25. We have jurisdiction pursuant to 35 U.S.C. § 6.

Appellants' claimed invention is directed to an adhesive tape including a polypropylene-containing backing and an adhesive layer on the backing. All of the appealed claims require that the tape includes, *inter alia*, a biaxially oriented polypropylene backing. The claims characterize the tape backing as having the capability of exhibiting a serrated edge contour like the serrated plastic blade contour even "when said backing is repeatedly severed on a serrated plastic cutting blade at least five times" (claim 1 and claim 13). Appellants argue for the patentability of all of the appealed claims as a group based on the above-identified characteristic of the claimed tape backing, as that characteristic is commonly specified in each of independent claims 1 and 13. As such, we select claim 1 as the representative claim upon which we shall primarily focus in deciding this appeal as to all of the commonly rejected and argued appealed claims.

Representative claim 1 is reproduced below:

1. An adhesive tape, comprising: a backing and a layer of adhesive on said backing, wherein said backing comprises polypropylene, wherein said backing has been biaxially oriented in the MD and TD of said backing, and wherein said backing is hand-tearable in the TD, and wherein when said backing is repeatedly severed on a serrated plastic cutting blade at least five times, said backing exhibits a serrated edge that closely corresponds to the contour of the blade each of the five times.

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

Robinson	3,241,662	Mar. 22, 1966
Wong	4,451,533	May 29, 1994

Claims 1, 3-13, and 15-25 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Wong or Robinson.

We affirm.

Rejection under 35 U.S.C. § 102(b)

Appellants have not disputed the Examiner's determination that each of the above-identified applied references discloses biaxially-oriented polypropylene adhesive tapes, that is, tapes that possess a polypropylene-containing backing and an adhesive layer as correspondingly called for in representative claim 1¹. In this regard, Appellants do not challenge the Examiner's factual determination that Wong describes "a tape comprising a layer of adhesive coated on a biaxially oriented polypropylene film backing which can be easily and precisely manually cut on the type of dispensing blades used on the commercially available tabletop dispensers described above" (Wong, col. 2, ll. 18-24; Ans. 3). Nor do Appellants contest the Examiner's determination that Wong's tape can be "cut precisely along the teeth to produce a serrated cut edge on the tape" (col. 8, ll. 59-64; Ans. 3).

Likewise, Appellants do not specifically challenge the Examiner's factual findings as to the explicit disclosure of Robinson respecting an adhesive coated tape with a biaxial stretched polypropylene backing, which tape backing furnishes "tear strength characteristics of biaxially oriented

¹ See related Appeal No. 2002-2212. The application for patent involved in this appeal (Application No. 10/445,531), is a continuation of Application No. 09/331,044, the application for patent involved in prior Appeal No. 2002-2212. In a Decision mailed on March 27, 2003, a panel of the Board (BPAI) affirmed the Examiner's decision to reject the appealed claims in that prior Appeal.

polypropylene [that] give easy dispensing characteristics with the conventionally used devices employing a serrated edge cutter bar” (Robinson, col. 2, ll. 2-5; Ans. 4, 5, and 7). See the Appeal Brief and the Reply Brief in their entirety.

Rather, in arguing against the anticipation prong of the Examiner’s rejection of the subject matter embraced by representative claim 1, as well as all of the other claims on appeal, Appellants focus on a tape dispensability characteristic; that is, the claimed functional limitation of the tape backing requiring a capability to exhibit a serrated edge closely resembling a contour of a serrated plastic cutting blade after having been severed by such a blade repeatedly (App. Br. 3). Appellants contend that neither Wong nor Robinson anticipates representative claim 1 because they fail to “expressly disclose use of a plastic cutting blade for that repeatable dispensability result” *Id.*²

Have Appellants demonstrated reversible error in the Examiner’s anticipation rejection based on the asserted lack of an explicit disclosure in either of the applied references of the use of a plastic cutting blade for establishing a repeatedly dispensability result for the tape of either Wong or Robinson that matches the functional limitation of the claimed product?

² Appellants do not rely on the Pearson Affidavit in arguing against the anticipation prong of the Examiner’s rejection of the appealed claims. Arguments not made in the Briefs are considered to be waived. *See* 37 C.F.R. § 41.37(c)(vii) (2007). Moreover, even if such an argument were presented it would not have been persuasive of reversible error in the anticipation rejection for substantially the same reasons as noted in our discussion of the Pearson Affidavit with respect to the obviousness rejection, as set forth herein.

We answer this question in the negative and we affirm the Examiner's anticipation rejection over each of Wong and Robinson.

It is well settled that a prior art reference can disclose every limitation of the claimed invention, either explicitly or inherently, in supporting an anticipation rejection. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Appellants' arguments, which are predicated on an asserted requirement for an explicit disclosure of the claimed functional plastic blade serration characteristic in the applied reference, employ the wrong legal test and, as such, are utterly unpersuasive of reversible error in the anticipation prong of the Examiner's rejection.³ To hold otherwise, would render the novelty requirement of the Patent Statutes nugatory in instances, such as this, where a patent is sought for an otherwise old and previously described product by an applicant who employs newly tested for but intrinsic product characteristics for describing the old product.

Here, the novelty argument begins and ends with an assertion of a lack of an explicit description of the newly tested for product characteristic in the old product. On this record, we affirm the Examiner's anticipation rejection of all of the rejected claims.

Rejection under 35 U.S.C. § 103(a)

As discussed above and as further set forth by the Examiner in Sections 9 and 10 of the Answer, Wong shows that tapes made according to the method disclosed therein are capable of being cut with a serrated blade

³ Also, see the additional factual findings and determinations as set forth by the Examiner in the Answer and as further discussed below with respect to the obviousness prong of the Examiner's rejection, which findings and determinations further bolster the Examiner's anticipation conclusion.

such that the cut edge on the tape is serrated without distortion adjacent the cut edge (Ans. 3-7; Wong, Fig. 5 and col. 8, ll. 59-64).

Wong also teaches that the polypropylene backing layer of the tape should have a preferred thickness of .0025 to .0041 centimeters “for the feel, flexibility, strength and dispensing characteristics” (col. 3, ll. 15-19). That preferred backing thickness of Wong is a thickness well-within Appellants’ disclosed backing thickness of “about 0.002-0.006 cm” (Spec. 13, ll. 23 and 24). Additionally, a comparison of Wong and Appellants’ disclosure reveals substantial commonalities in their respective descriptions of how the backing material is made from substantially similar propylene resins. Compare, e.g., column 2, line 59 through column 3, line 60 and the examples of Wong with column 10, line 4 through column 13, line 32 of Appellants’ Specification.

Likewise, Robinson describes tapes that substantially correspond to the tape of representative claim 1 as set forth by the Examiner in the Answer but for the manner in which the functional tearing and severing characteristics are explicitly described in those references, as set forth above and in the Answer.

The Examiner has found that the correspondence of the tapes of Wong and Robinson to the tape of representative claim 1 are sufficient that those prior art tapes would reasonably be expected to possess the hand tearing and cutting or severing properties as set forth in Appellants’ representative claim 1.⁴ For the reasons advanced by the Examiner in the Answer and for the

⁴ We note that representative claim 1 does not require any particular ease of hand-tearing or that the severing is capable of being conducted at any particular speed or with any particular serrated plastic cutting blade. Nor is the measure of relative correspondence between the contour of the cutting blade and serrated edge of the backing particularly limited by the relative

reasons set forth above, the evidence adduced by the Examiner is more than adequate to make out a prima facie case of obviousness of the representative claim 1 subject matter.

In a case such as this where the critical limitations for establishing novelty in the claimed subject matter are recited as a functional characteristic that reasonably appears to be a characteristic of the prior art material insofar as broadly called for in the representative appealed claim, it is incumbent upon Appellants to prove that the prior art material does not in fact possess the characteristics relied on. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. *See Best*, 562 F.2d at 1255. In such cases, it is of no moment whether the rejection is based upon 35 U.S.C. § 102 or § 103, since the burden on Applicants is the same. *Id.* Here, Appellants have not satisfied this burden by the Affidavit of Scott D. Pearson.

Mr. Pearson identifies himself as a laboratory manager at 3M Stationary Products Division and a named inventor of a published U.S.

term “closely.” Indeed, the specified functions of representative claim 1 are inclusive of backings that may be difficult to hand-tear or difficult to cut with most plastic serrated blades. All that is required by the claimed functional language is that the backing is capable of: (1) being torn by exerting any hand tearing force, including a heavy hand tearing force and (2) being severed repeatedly by at least one serrated plastic blade, including a very sharp plastic blade, in a fashion so as to ultimately allow for the formation of a relatively similar serrated edge on the cut backing in at least five instances.

Patent Application and a U.S. Patent said to relate to the same subject matter. Mr. Pearson states, *inter alia*, that:

3. I have reviewed the currently-pending claims of the above-identified application and the Wong et al. and Robinson et al. references cited in the Office Action, dated October 4, 2005, in the above-identified application. I believe that substituting a plastic blade for the metal blade of these references would not necessarily produce the same dispensability result.

4. Dispensability of biaxially oriented polypropylene films refers to the ability to repeatedly produce a serrated edge of a film that closely follows the contour of the blade on which it is cut. The force differences between dispensing of a film on a metal versus plastic blade likely arise from the different contact areas of typical steel and polystyrene (PS) plastic blades. PS plastic blades typically have a larger contact area, for example due to their initial sharpness being less than steel blades and their rapid and greater wear with use in comparison to steel blades, leading to larger, areas of plastic deformation occurring before rupture of the film, which is why the cut film on a PS plastic blade no longer closely follows the desired cut edge. Therefore, plastic and metal blades are not necessarily interchangeable in dispensers for adhesive tapes to produce the same repeated dispensability result of a cleanly serrated edge that closely follows the contour of the blade.

For the reasons stated by the Examiner, the Pearson Affidavit is not persuasive as a rebuttal to the prima facie case of obviousness furnished by the Examiner and based on the teachings of either Wong or Robinson (Ans. 7-9). At the outset, the Examiner's obviousness position is not predicated on substituting a plastic blade for a metal blade in either of Wong or Robinson but rather on the position that the tapes of Wong or Robinson substantially correspond to the tape required by representative claim 1, and would have been expected to possess the functional characteristic of being capable of

being severed by a plastic blade in a manner so as to repeatedly yield a serrated edge closely corresponding to the blade contour, as required.

The problems with PS blade deformation with use (wear) noted by Mr. Pearson in item No. 4 of the Affidavit has not been shown to be particularly relevant to the claimed subject matter in that the recited tape characteristic is not predicated on a particular type of plastic blade being employed for measuring the tape property relating to the serrated edge obtained on severing the tape. Moreover, Mr. Pearson has not presented any indication that any tests were actually performed with respect to the tapes disclosed and/or suggested by Wong or Robinson, much less that the tapes of Wong or Robinson could not yield a serrated edge that closely follows the contour of a commercially available or otherwise known prior art plastic blade used for serration thereof and to the extent required by the claim 1 and claim 11 serrated edge formation limitation at issue.

While Wong employed a metal serrated blade for tape cutting and Robinson a conventional serrated edge cutter bar, each of these references need not expressly teach all of the properties of the tapes described therein for their tapes to constitute an anticipating disclosure (ultimate of obviousness), let alone a disclosure from which the subject matter of claim 1 would have otherwise been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

We observe that Appellants do not rely on their Specification test data in arguing against the Examiner's rejection. In this regard, we note that Appellants acknowledge that "[t]he tests and test results described above are intended solely to be illustrative, rather than predictive, and variations in the testing procedure can be expected to yield different results" (Spec., p. 25).

On this record, it is not clear how the Pearson Affidavit, which essentially furnishes a conclusive opinion as to the substitution of a PS plastic blade for a metal blade in dispensing tapes, like those of Wong or Robinson, provides persuasive support for Appellants' rebuttal position in this appeal, much less establishes that the tape backings of Wong or Robinson would not possess the claimed severability characteristics.

Accordingly, we affirm the Examiner's obviousness rejection of all of the appealed claims over each of Wong and Robinson.

Consequently, we find no error in the Examiner's legal conclusions of anticipation and obviousness. We shall, therefore, sustain all of the examiner's rejections.

CONCLUSION

The decision of the examiner to reject claims 1, 3-13, and 15-25 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Wong or Robinson 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)(1)(iv).

AFFIRMED

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