

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY I. LERNER and STEVEN B. WINTER

Appeal 2008-4030
Application 11/328,284
Technology Center 1700

Decided: November 24, 2008

Before CHUNG K, PAK, ROMULO H. DELMENDO, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

Statement of the Case

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of all pending claims 6-9 and 32-48 (Appeal Brief filed September 27, 2007,

hereinafter “App. Br.”; Final Office Action entered February 27, 2007).¹

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Appellants’ invention is directed to a method of making a “display device for the illustration of color.” (Spec. 2:16-19). According to Appellants:

The method of the invention includes printing a mount base with a release composition to provide a printed release composition layer, drying . . . the release composition layer, printing a pressure sensitive indirect adhesive on the release composition layer to provide a pressure sensitive indirect adhesive layer, [and] mounting a display swatch to the printed pressure sensitive indirect adhesive layer. (*Id.* 4:34-5:5).

Claims 6, 7, 9, and 42 read as follows:

6. A method of making a color display device, the method comprising:
 - printing at least one area of a mount base with a release composition to provide at least one area having a printed release composition layer;
 - drying the release composition layer;
 - printing a pressure sensitive indirect adhesive on the at least one of the at least one dried release composition layer to provide at least one pressure sensitive indirect adhesive layer on the dried release composition layer;
 - painting a display swatch web by knife coating or roller coating the paint onto the surface of the web to provide a paint coated web;
 - cutting the paint coated web into cut paint coated color display swatches; and

¹ The Examiner states that the Amendment filed August 27, 2007, has been entered and that the correct claims on appeal are listed in Claims Appendix A of Section VIII (A) of the Appeal Brief. (Ans. 2:11-16; App. Br. 33-37).

mounting the cut paint coated color display swatches to the at least one printed pressure sensitive indirect adhesive layer.

7. A method as recited in claim 6 wherein the printing of the release composition layer is done by a printing process selected from the group consisting of lithographic printing, Gravure printing, flexographic printing and silk screen printing.

9. A method as recited in claim 7 wherein the method further comprises printing the mount base with graphics when the release composition is printed on the mount base.

42. A method of making a color display device, the method comprising:

printing a plurality of areas of a mount base with a release composition to provide a plurality of areas having a printed release composition layer;

drying the release composition layers;

printing a pressure sensitive indirect adhesive on the plurality of dried release composition layers to provide a plurality of pressure sensitive indirect adhesive layers on the release composition layers;

painting a display swatch web by knife coating or roller coating the paint onto the surface of the web to provide a paint coated web;

cutting the paint coated web into cut paint coated display swatches; and

mounting the cut paint coated color display swatches to the at least one printed pressure sensitive indirect adhesive layer.

(App. Br. 28-31, Claims Appendix)

The prior art references relied upon by the Examiner to reject the claims on appeal are:

Labar	4,258,092	Mar. 24, 1981
Germann	4,441,423	Apr. 10, 1984
Lerner	4,457,718	Jul. 3, 1984

Kraft	5,580,640	Dec. 3, 1996
Rudkin	GB 1,386,888	Mar. 12, 1975

The following rejections are before us for review:²

Claims 6-8, 32-35, 37-40, and 42-48 under 35 U.S.C. § 103(a) as unpatentable in view of the combined teachings of Rudkin, Kraft, Labar, and Lerner; and

claims 9, 36, and 41 under 35 U.S.C. § 103(a) as unpatentable in view of the combined teachings of Rudkin, Kraft, Labar, Lerner, and Germann.

Appellants submit specific arguments with respect to claims 6 and 42 but not with respect to claims 7, 8, 32-35, 37-40, and 43-48. Therefore, for the first ground of rejection, we confine our discussion to claims 6 and 42.

37 C.F.R. § 41.37(c) (1) (vii). With respect to the second ground of rejection, Appellants argue claims 9, 36, and 41 together. Accordingly, we select claim 9 as representative and confine our discussion to this claim.

(Id.)

The Examiner found that Rudkin discloses a method as here claimed except “it is silent as to drying the release coating, applying the adhesive to the release coating, and painting a display swatch web by knife coating or roller coating the paint onto the surface the web to provide s paint coated web, and cutting the paint coated web into cut paint coated display swatches.” (Ans. 4:3-7). But the Examiner found that Kraft discloses applying an indirect adhesive on a release coated substrate. (*Id.* 4:7-13). The Examiner also found Labar discloses drying a release coating on a substrate before applying an adhesive to the release coating. (*Id.* 4:20-5:4).

² The Examiner states that the rejection of claims 47 and 48 under 35 U.S.C. § 112, ¶ 2 is withdrawn. (Ans. 15:20-16:2).

In addition, the Examiner found Lerner discloses a method of forming a display swatch web by coating a base using a knife over roll coating method, cutting the web into swatches, and mounting the swatches to a mount card by adhesive. (*Id.* 5:13-21). The Examiner concluded it would have been obvious to one of ordinary skill in the art to combine the teachings of the prior art to obtain the invention recited in appealed claims 6 and 42. (*Id.* 4:14-17; 5:5-10; 6:1-7).

Appellants, on the other hand, contend: “None of the cited references alone or in combination suggest a method of making a color display device by printing a release composition on a mount base and then printing a pressure sensitive indirect adhesive layer on the release composition layer.” (App. Br. 19:18-20:1). In addition, Appellants assert: “One of ordinary skill in the art would have not have [sic] any motivation to combine a reference directed to business forms (Kraft) with a reference directed to color cards (Rudkin).” (*Id.* 21:11-12). Furthermore, Appellants contend that “even if Rudkin and Kraft were combinable (which they are not), there is no ‘apparent reason to combine the known elements in a fashion claimed by the patent at issue,’ as per *KSR*.” (Reply Br. 6:25-27).

Regarding dependent claims 9, 36, and 41, the Examiner found that Rudkin, as modified by the combination of references lacks a teaching with respect to printing graphics when the release composition is printed. (Ans. 12:5-6). However, the Examiner stated that “simultaneous printing of coatings or colors is well known and conventional as shown for example by Germann.” (*Id.* 12:6-18).

Appellants, however, asserts:

The addition of Germann in rejecting claims 9, 36, and 41 fails to cure the deficiencies in the rejections of claims 6, 32, and 37 based upon Rudkin, Kraft, Labar, and Lerner. Accordingly, claims 6, 32, and 37 avoid the prior art and define patentable subject matter. But claims 9, 36, and 41 also define an additional feature that is not suggested by Germann or the other applied references. (App. Br. 25:20-24).

Issues

Thus, the issues before us are:

1. Have Appellants shown reversible error in the Examiner's determination that it would have been obvious to one of ordinary skill in the art to modify Rudkin by using Kraft's step of printing indirect adhesive onto a release composition on a release sheet as recited in appealed claims 6 and 42?
2. Have Appellants shown reversible error in the Examiner's determination that one of ordinary skill in the art would have found it obvious to print graphics when the release composition is printed on the mount base in view of the combined teachings of the prior art as recited in appealed claim 9?

the latex or other adhesive are mounted on the sample-bearing areas in conventional manner. (2:24-37).

4. Rudkin discloses that the samples of different colors are adhered to areas on a backing sheet that are coated with a release agent so that the samples can be removed, temporarily adhered to another substrate, and then returned to the sheet. (1:44-67).
5. Fig. 2 of Kraft is reproduced below:

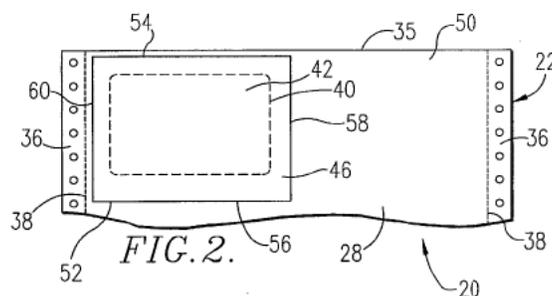


Fig. 2 depicts a label 42 defined by lines of weakness 40 from a top ply sheet 28 and backed by a release sheet 46. (4:12-21).

6. Kraft discloses: “The release sheet 46 remains attached to the top ply sheet 28 while the label 42, which had been an integrated part of the top ply sheet 28, may be peeled away and attached elsewhere by virtue of the pressure-sensitive adhesive layer . . . carried therewith.” (5:19-23).
7. Kraft teaches: “An adhesive layer . . . is applied to either the release sheet 46 or the rear face of the top ply sheet, but in any event is positioned intermediate the rear face [of top sheet 28] and the release sheet 46.” (4:30-33).
8. Kraft discloses: “The adhesive layer . . . extends within a boundary . . . beyond the lines of weakness 40 to hold the release sheet 46 to the remainder . . . [of the top ply sheet 28] but also is preferably co-

- extensive with or slightly interior to the edge of the release sheet to avoid undesired spill-over.” (4:33-38).
9. Kraft teaches that “the label 42 [is] to be peeled from the surrounding remainder . . . of the top ply sheet 28 together with the portion of the adhesive layer within the lines of weakness 40 and leaving the release layer . . . on the release sheet 46.” (4:61-65). Thus, Kraft uses an “indirect adhesive,” as defined in Appellants’ Specification, when the adhesive is applied to the release coating on the release sheet.
 10. The Examiner found that Kraft discloses the interchangeability of methods applying an adhesive (i) to the backside of a top sheet comprising a removable label and (ii) to a release coating on a release liner. (Ans. 14:5-9).

Principles of Law

“[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless it’s actual application is beyond his or her skill.” *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740 (2007).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR* at 1739.

“[A]ny need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR*, 127 S.Ct at 1742.

“When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” *Id.*

“The test for obviousness is not whether . . . the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Analysis

Rejection of Claims 6-8, 32-35, 37-40, and 42-48 in View of Rudkin, Kraft, Labar, and Lerner

Claims 6-8

Appellants argue that there is no “motivation to combine a reference directed to business forms (Kraft) with a reference directed to color cards (Rudkin).” (App. Br. 21:11-12). Specifically, Appellants assert:

[T]he Examiner contends that applying the adhesive to either the back of the label or to the release coating of the back sheet are all equivalents. This is not the case. Printing the release composition to the mount base and printing the pressure sensitive indirect adhesive layer to the release composition is required in order to achieve the controlled application of the adhesive and release composition necessary to achieve the advantages of the claimed invention. (App. Br. 21:5-10; footnote omitted).

Appellants’ arguments are unpersuasive. Rudkin discloses a method of making a display for colors including a base printed with a silicone wax

release coating and samples coated with an adhesive on one side for releasably mounting the samples on the release coatings of the base. (FF 3 and 4). While Kraft is directed to business forms, its teachings concerning the interchangeable nature of various techniques of applying adhesives to affix a material to a base would be applicable or reasonably pertinent in Rudkin's method. Specifically, Kraft teaches that an adhesive can be applied to the back of a label substrate by (1) directly applying it to the reverse side of the label or (2) by application of the backside of the label to an adhesive that was coated on a release coating on a release liner wherein the adhesive is transferred to the back of the label substrate. (FF 6, 7, and 9). Thus, the Examiner found that Kraft teaches different interchangeable methods of applying adhesive to the back of a label. (FF 10). In view of the plain teachings of the prior art, one of ordinary skill in the art would have reasonably expected that either method of applying an adhesive described by Kraft would have been suitable for application of the adhesive to the color card of Rudkin. Here, the use of familiar elements used in a known manner would be obvious to achieve predictable results. *KSR*, 127 S.Ct. at 1739. The skilled artisan, concerned with removable swatches from a mount base, would have found it obvious to use the method of applying indirect adhesives to provide a predictable technique applicable to removably mounting elements to a base. *KSR*, 127 S.Ct. at 1740. Appellants do not direct us to any evidence that the technique of applying indirect adhesives would have been beyond the skill level of one of ordinary skill in the art. (App. Br. 11-26; Reply Br. 2-7).

Appellants contend that "Kraft is not concerned with the precise placement of the adhesive relative to the release coating" (*Id.* 20:21-22) and

that “Kraft’s business forms do not demand the precision of the claimed invention.” (*Id.* 21:16). But contrary to Appellants’ contention, Kraft teaches that the precise location of the adhesive is important to avoid spill-over to undesirable areas. (FF 8). Appellants’ arguments focusing on the lack of teachings from individual references is misplaced. Obviousness is determined by what the combined teachings of the references would have suggested. *In re Keller*, 642 F.2d at 425. Here, the Examiner found that the combined teachings of Rudkin, Kraft, Labar, and Lerner disclose every limitation of claim 6. (Ans. 3:23-4:3; 4:7-13; 4:20-5:4; 5:13-21; FF 3-9). Significantly, Appellants do not contest the Examiner findings that the combined teachings disclose every limitation of the claimed subject matter. (App. Br. 11:9 -25:7).

Claims 32-35 and 37-40

Appellants rely on the same arguments for patentability as submitted with claim 6. (App. Br. 22:11-24:5). For reasons as discussed above, these arguments are not persuasive to show the Examiner erred in determining the claimed method would have been obvious in view of Rudkin, Kraft, Labar, and Lerner.

Claims 42-48

Appellants contend: “[N]one of the cited references alone or in combination suggest printing a plurality of areas of a mount base with a release composition and printing a pressure sensitive indirect adhesive on the plurality of dried release composition layers to provide a display card

having a plurality of chips.” (App. Br. 24:13-16). In addition, Appellants contend:

The Examiner has not provided any reason why anyone should print both a release coating and an adhesive coating onto a mount base with the later application of a precut swatch onto the printed coatings to gain the advantages of the invention. This is especially the case with the printing of a plurality of areas of the mount base as described by independent claim 42. (Reply Br. 7:10-12).

We cannot agree with Appellants’ contentions. The Examiner found that Rudkin discloses a method of making a display for multiple color samples including printing release composition in a plurality of areas for releasably mounting the samples on a base. (FF 3 and 4). As discussed above, Kraft teaches applying an indirect adhesive onto the release composition. (FF 7 and 9). The combination of applying an indirect adhesive onto a release composition that is applied to a release sheet, whether the release composition comprises a single area or a plurality of areas for bearing one color sample or a plurality of color samples, simply uses a known technique in a predictable manner. One of ordinary skill in the art would have found the combination obvious, as familiar elements are used in a known manner to achieve predictable results. *KSR*, 127 S.Ct at 1739.

Furthermore, contrary to Appellants’ contentions, the Examiner discusses reasons why it would have been obvious to combine the teachings of Rudkin, Kraft, Labar, and Lerner. (Ans. 4:14-17; 5:5-10; 6:1-7). Appellants do not provide any persuasive arguments or evidence to show error in the Examiner’s reasoning that one of ordinary skill in the art would have been motivated to combine the prior art teachings. (App. Br. 11-26; Reply Br. 2-7).

For these reasons we find Appellants have not shown the Examiner erred in determining the subject matter of claims 6-8, 32-35, 37-40, and 42-48 obvious in view of the prior art.

Rejection of Claims 9, 36, and 41 in View of Rudkin, Kraft, Labar, Lerner, and Germann

Appellants argue:

The addition of Germann in rejecting claims 9, 36, and 41 fails to cure the deficiencies in the rejections of claims 6, 32, and 37 based on Rudkin, Kraft, Labar, and Lerner. Accordingly, claims 6, 32, and 37 avoid the prior art and define patentable subject matter. (App. Br. 25:20-22).

Appellants' argument is insufficient to show that the Examiner erred in determining that combining the teachings of the prior art establishes the claimed subject matter is obvious. As instructed by *KSR*, "[A]ny need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR*, 127 S.Ct at 1742. Here, Rudkin discloses printing release coatings on a base substrate along with (i) descriptive, technical and advertising matter and (ii) with colored representations of room schemes beneath which are spaces coated with the release coatings. (FF 3). Thus, one of ordinary skill in the art would have understood, from common sense, the need for graphics and release coating on the same base page to identify colors descriptively and to compare colors with room schemes. It would have been obvious to the skilled artisan, from common sense, to print the graphics when printing the release coating on the same base page as this would have been one of only a finite numbers of ways to

print both elements. *KSR*, 127 S.Ct at 1742. Appellants do not direct us to any persuasive argument or evidence that employing such a technique would have been beyond the skill of one of ordinary skill in the art.

For these reason, we find that Appellants have not shown the Examiner erred in determining claims 9, 36, and 41 obvious in view of the prior art.

Conclusion

Appellants have not shown reversible error in the Examiner's determination that it would have been obvious to one of ordinary skill in the art to substitute Rudkin's step of applying adhesive to the back of a color sample with Kraft's step of printing indirect adhesive onto a release composition on a release sheet in Rudkin's method of making a color display device.

Appellants also have not shown reversible error in the Examiner's determination that one of ordinary skill in the art would have found obvious to print graphics when the release composition is printed on the mount base in view of the combined teachings of the prior art.

Order

The decision of the Examiner rejecting claims 6-9 and 32-48 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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rvb

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