

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER J. ROGERS and JAMES H. PAGONES

Appeal No. 96-2625
Application 08/329,536¹

ON BRIEF

Before KIMLIN, GARRIS and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 8-12, which are all of the claims remaining in the

¹ Application for patent filed October 26, 1994. According to appellants, the application is a division of Application 08/121,360, filed September 13, 1993, now U.S. Patent No. 5,376,418, issued December 27, 1994.

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application.

THE INVENTION

Appellants' claimed invention is directed toward a method for making a label which protects the image shown by the label, and for applying the label to a substrate by use of the label's pressure sensitive adhesive layer. The method includes cutting a transparent release liner, which is releasably adhered to a transparent face stock by a transparent adhesive, such that the release layer includes a removable section and an image receiving section, and inscribing reverse image indicia on the image receiving section. The label is applied to the substrate by removing the removable section of the release layer to expose adhesive, and adhering the label to the substrate with the adhesive such that the image receiving section of the release liner having the indicia thereon abuts against the substrate. Appellants state that the image is visible through the transparent release liner, transparent adhesive and transparent face stock, and is protected by the release liner and/or the face

stock (specification, fourth page,² lines 9-12). Claim 8 is

illustrative and reads as follows:

8. A method of making an image protected, pressure sensitive label comprising the steps of:

a) providing a label form including a sheet of transparent release liner releasably adhered to a sheet of transparent face stock by a transparent adhesive;

b) cutting the release liner inwardly of the periphery of the face stock sheet to define (1) a removable section that, when removed, will expose said adhesive, and (2) an adjacent image receiving section;

c) inscribing reverse image indicia on said image receiving section of said release liner opposite of said face stock sheet;

d) removing said removable section to expose said adhesive; and

e) adhering said label to a substrate by said adhesive with said release liner section abutting said substrate.

THE REFERENCES

Heatwole	3,799,829	Mar. 26, 1974
Grass et al. (Grass)	4,188,251	Feb. 12, 1980
Voy et al. (Voy)	4,661,189	Apr. 28, 1987
VanErmen	5,103,583	Apr. 14, 1992

² Only the first page of the specification is numbered.

on the side of the adhesive layer opposite the backing layer (col. 1, lines 65-71; col. 2, lines 34-35; figures 1 and 4). Heavy perforations through all three layers separate an inner portion of the label from an outer portion (col. 2, lines 2-5; figure 1). The label is attached to a surface by removing the outer portion of the peelable layer to expose the underlying adhesive, and pressing the exposed adhesive against the surface such that the inner portion of the peelable layer abuts against the surface (col. 2, lines 5-7; figures 1 and 4). The adhesive layer and the peelable layer preferably are transparent so that indicia printed on the side of the backing layer facing the adhesive layer is visible through the peelable layer and the adhesive when the label is fastened to an automobile windshield (col. 4, lines 5-12). To transfer the label to a second surface, the inner portion of the label is removed from the first surface, the peelable layer of the inner portion is removed from the inner portion's adhesive layer, and the adhesive layer is pressed against the second surface (col. 2, lines 8-15).

VanErmen discloses a label system which includes a label (14) having a central portion (16) which preferably is

transparent, and an adhesive layer (20) on the portion of one side of the label which lies substantially outside the central portion, and release layer (12) which is removably attached to the adhesive layer on the side of the adhesive layer opposite the label and which has an opening (22) which exposes an adhesive-free central portion of the label (col. 2, lines 33-60). Information is marked on the adhesive-free central portion of the label (col. 1, lines 55-59; col. 2, lines 60-62). After the marking, the label is fixed to a surface by removing the release layer and pressing the adhesive against the surface (col. 1, lines 59-60). Because the marking is disposed between the article and the label, and thereby lies underneath the label, the marking is protected from damage (col. 1, lines 60-62; col. 3, lines 28-29).

Neither Heatwole nor VanErmen discloses printing on the peelable or release layer as required by step c of appellants' claim 8, which is the only independent claim.

The examiner argues that "[i]t would have been obvious to a person having ordinary skill in the art to have provided reverse image printing on the release liner of Heatwole, since VanErmen recognizes that reverse image printing on a surface

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of a transparent layer which eventually abuts the substrate protects the printing from damage, (col. 3, lines 28-29)" (answer, page 4).

Appellants argue that one of ordinary skill in the art would not print on Heatwole's peelable layer because if the printing were on that layer, the label could not be transferred to a second surface without the printing being lost when the peelable layer is discarded during the transfer process (reply brief, pages 4-5). Thus, appellants argue, the modification to Heatwole proposed by the examiner would destroy Heatwole for its intended purpose (reply brief, page 5).

The examiner responds that the printing on the inner portion of Heatwole's peelable layer would change the purpose of that portion of the peelable layer (supplemental answer, page 2). Consequently, the examiner argues, one of ordinary skill in the art would not transfer the label to a second surface as taught by Heatwole but, rather, would leave the label on the first surface (*see id.*).

As indicated by the above discussion, the examiner interprets VanErmen as teaching that the printing is protected because it abuts against the substrate. VanErmen, however, indicates that the printing is protected not because it abuts against the substrate but, rather, because it is underneath the label (col. 3, lines 28-29). The examiner has not explained, and it is not apparent, why VanErmen would have led one of ordinary skill in the art to protect Heatwole's printing by placing it on the peelable layer rather than by placing it, as VanErmen does (col. 1, lines 55-62), and as Heatwole can do (col. 2, lines 35-36), on the article side of the label.

Moreover, as discussed above, placing Heatwole's printing on the inner portion of the peelable layer would have the disadvantage of preventing the label from being transferable to a

second surface. The examiner has not explained, and it is not apparent, why the applied references would have led one of ordinary skill in the art to place the printing on Heatwole's peelable layer and thereby forgo the benefit of being able to

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transfer the label to a second surface.

It is clear that the motivation relied upon by the examiner for combining the teachings of the references so as to arrive at appellants' claimed invention comes solely from the description of appellants' invention in their specification. Thus, the examiner used impermissible hindsight when rejecting the claims. See *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.d. 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.d. 393, 396, 125 USPQ 328, 331 (CCPA 1960).

Accordingly, we reverse the rejection of claim 8 over Heatwole and VanErmen. The additional references applied to dependent claims 9-12 are not relied upon for teachings which could remedy the above-described deficiencies in Heatwole and VanErmen as to the rejection of independent claim 8 from which claims 9-12 depend. Consequently, we also reverse the rejections of claims 9-12.

DECISION

The rejections under 35 U.S.C. § 103 of claim 8 over

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Heatwole in view of VanErmen, claim 9 over Heatwole in view of
VanErmen and Grass, claim 10 over Heatwole in view of VanErmen
and Voy, and claims 11 and 12 over Heatwole in view of
VanErmen and Hoffmann, are reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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