

The opinion in support of the decision being entered today was not written for publication is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN E. MAHN, SR.
and JOHN E. MANN, JR.

Appeal No. 1997-3266
Application 08/374,960

ON BRIEF

Before WILLIAM F. SMITH, PAK and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 10 and 12, and refusal to allow claims 13 and 14 as amended after final rejection. Claim 11, which is the only other claim remaining in the application, stands withdrawn from consideration by the examiner as being directed toward a nonelected invention.

THE INVENTION

Appellants' claimed invention is directed toward a method for applying indicia to a cloth substrate. Claim 10 is illustrative:

10. The method of applying indicia to a cloth substrate comprising placing a heat activated transfer onto said cloth substrate, said heat activated transfer comprising a heat activated adhesive layer and a clear upper thermoset layer, wherein said heat activated adhesive layer is placed in contact with said cloth layer, placing a transfer sheet onto said heat activated transfer, said transfer sheet comprising a carrier and a sublimation dye forming indicia with said sublimation dye in contact with said thermoset layer of said heat activated transfer;

applying heat and pressure against said transfer sheet and said heat activated transfer and said cloth to cause said adhesive to melt and bond to said cloth and to cause said sublimation dye to sublime and transfer to said thermoset layer.

THE REFERENCES

Mahn, Sr. et al. (Mahn) 1986	4,610,904	Sep. 9,
Borresen 1987	4,692,198	Sep. 8,
Yamane 1994	5,350,474	Sep. 27,

(effective filing date Apr. 8,
1991)

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as

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follows: claim 10 over Borresen in view of Yamane, and claims 12-14 over Borresen in view of Yamane and Mahn.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

Borresen discloses a method for printing a pattern onto a surface receptive to sublimation dye (col. 1, lines 6-7). A laminate is formed having, in order, an auxiliary carrier, an adhesive, a carrier foil, and sublimation dye (col. 2, lines 48-65). Characters then are formed by cutting or punching material out of the sublimation dye and carrier foil layers, thereby exposing the adhesive at the cut away portions (col. 3, line 23 - col. 4, line 6). The laminate is fixed to a surface by hot pressing (col. 4, lines 9-11).

In the examiner's view, Borresen's laminate having the formed characters meets the requirements of appellants' transfer sheet comprising a carrier and sublimation dye

indicia (answer, page 3). Regarding appellants' heat activated transfer, the examiner argues that column 2, lines 9-39 of Borresen disclose a thermoset layer placed onto a cloth substrate (answer, pages 3 and 6). This portion of the reference discloses, as examples of suitable substrate materials, textiles, thermoplastic materials, thermosetting materials, and lacquered aluminum sheets, and teaches that "[e]ven the objects to be decorated may be made of the above-mentioned plastics materials or may be provided with coatings of such materials, e.g., by lacquering" (col. 2, lines 24-26). This quoted portion, the examiner argues, is a teaching that the substrate can be a textile coated with a thermosetting material (answer, page 3). The examiner, however, does not explain why the reference reasonably would have led one of ordinary skill in the art to this particular combination.

Even if Borresen is considered to have suggested, as a substrate, a textile coated with a thermoset material, the reference does not disclose a heat activatable adhesive between the thermoset material and the textile. For a suggestion of this claim requirement the examiner relies upon Yamane (answer, page 4). Yamane discloses forming a laminate

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having, in order, a substrate, a release layer, a hot melt adhesive layer, and ink characters, and discloses hot pressing this laminate onto a textile material and then removing the release layer and substrate to produce a textile having ink characters covered by hot melt adhesive (col. 7, lines 18-61).

The examiner has not established that Borresen's teaching of forming a coating, such as a lacquer, would have fairly suggested, to one of ordinary skill in the art, using a hot melt adhesive to fasten a thermoset layer to a textile surface. Moreover, even if such a suggestion were provided, the relied-upon portion of Yamane does not disclose fastening such layers. Instead, it discloses forming a layer of hot melt adhesive on a surface. Thus, even if the references were combined as proposed by the examiner, the claimed invention would not be produced.

The examiner argues (answer, page 7):

Yamane was cited for its limited teaching of heat-transferring a plastic layer onto a cloth substrate. Those skilled in this art would have recognized that the thermosettable layer taught by Borresen could be applied to the textile layer by a conventional heat transfer process, as taught by Yamane. While Yamane describes transferring an indicia-bearing plastic layer, as Appellants note, Borresen teaches a separate step of transferring a sublimation dye into

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the thermoset layer, as is now claimed.

This argument is deficient in that it does not explain why the prior art itself would have led one of ordinary skill in the art to combine the teachings of the references as proposed by the examiner. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). Particularly, the examiner has not explained the basis in the prior art for the above-quoted "[t]hose skilled in the art would have recognized" argument. The record indicates that rather than coming from the prior art, the teaching relied upon by the examiner for using a hot melt adhesive to attach a thermoset layer to a cloth layer comes from appellants' disclosure of their invention in the specification. The record, therefore, indicates that examiner's rejection is based upon impermissible hindsight. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Consequently, we reverse the rejection of claim 10.

The Mahn reference is not relied upon by the examiner for

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