

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

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. SUNDAR RAJAN and VINCENT J. MAKO

Appeal No. 1997-3650
Application No. 08/206,658

ON BRIEF

Before PAK, WARREN, and OWENS, *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 31 through 44, 46 and 47, which are all the claims pending in the above-identified application.

APPEALED SUBJECT MATTER

Claim 31 is representative of the subject matter on appeal and reads as follows:

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31. A method of making a printed retroreflective signing material, comprising the steps of:

A. providing a transparent film having a polymeric sign surface;

B. providing an electrophotographic printing apparatus having a reusable imaging surface;

C. providing an image defining means comprising (i) a computer in which is stored a raster file, and (ii) a means for translating an image from the raster file to the reusable imaging surface;

D. defining an image to be printed by entering it into the raster file;

E. translating the image from the raster file into a latent image on the reusable surface;

F. providing dry toner powder comprising a colorant, a binding agent for adhering the dry toner powder to the polymeric sign surface, and a charge carrier;

G. applying the dry toner powder to portions of the reusable imaging surface in the pattern of the latent image;

H. transferring the dry toner powder from the reusable imaging surface to the sign surface;

I. fusing the applied dry toner powder to form a fixed printed image;

J. providing a retroreflective sheeting material; and

K. laminating the transparent film to the retroreflective sheeting.

At page 6 of the specification, the claimed "retroreflective signing material" is defined as follows:

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. . . Such retroreflecting sheeting is known in the sign art. Enclosed lens retroreflective sheetings and the use of glass beads to provide for reflexed light reflectors are described in . . . , the disclosures of which are incorporated by reference herein.

Generally, enclosed lens retroreflective sheetings include, in order, an adhesive layer for application to a support such as a license plate blank, a specular reflective surface, a light transmitting spacing layer, and a monolayer of glass beads within a light transmitting resin layer. Often, a protective outer layer or top layer is also present.

PRIOR ART REFERENCES

The prior art references relied upon by the examiner are:

Akman	3,854,942	Dec. 17, 1974
Kato et al. (Kato)	4,320,186	Mar. 16, 1982
Ciccarelli et al. (Ciccarelli)	4,621,039	Nov. 4, 1986
Kubit	4,637,974	Jan. 20, 1987
Bailey et al. (Bailey)	4,664,966	May 12, 1987
Rajan et al. (Rajan)	5,378,575	Jan. 3, 1995
		(Filed May 15, 1990)

Operator's Guide, *3M Brand Multifunctional Printer Model 1800*, pages unnumbered (unknown publication date) (hereinafter referred to as "Operator's Guide")¹.

3M Brochure, *Introducing the LBQ Laser Printing System from 3M*, pages unnumbered (unknown publication date) (hereinafter referred to as "Brochure")².

¹ The appellants acknowledge that this literature is available as "prior art." See the Communication dated July 23, 2001 (Paper No. 25).

² The appellants also acquiesce that this literature is also available as "prior art." See the Brief in its entirety.

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REJECTIONS

Claims 31 through 44, 46 and 47 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 through 7 of Rajan. Claims 31 through 44, 46 and 47 stand rejected under the judicially created doctrine of nonobviousness-type (based on *Schneller*) double patenting as unpatentable over claims 1 through 7 of Rajan. Claims 31 through 44, 46 and 47 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Kubit in view of Akman or Kato; and Ciccarelli, Brochure, Operator's Guide and Bailey.

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the examiner and the appellants in support of their respective positions. As a consequence of this review, we make the determinations which follow.

OBVIOUSNESS-TYPE DOUBLE PATENTING

We summarily affirm the examiner's rejection of claims 31 through 44, 46 and 47 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims

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1 through 7 of Rajan since the appellants have not challenged the propriety of this rejection.

OBVIOUSNESS UNDER 35 U.S.C. § 103

The examiner's rejection of claims 31 through 44, 46 and 47 under 35 U.S.C. § 103, however, is on different footing. This rejection is premised upon that:

It would have been obvious to one of ordinary skill in this art at the time of the invention to substitute the toner of Ciccarelli et al. in the process of Kubit; use printing apparatuses as taught by 3M in the process of Kubit; and to laminate the film of Kubit on a retroreflective base within a weather resistant package. [See answer, page 7.]

The examiner, however, has not identified any suggestion or motivation in the applied prior art references that would have led one of ordinary skill in the art to laminate the transparency of the type³ described in Kubit on the retroreflective base described in Bailey. *In re Rouffet*, 149 F.3d 1350, 1356, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599-00 (Fed. Cir. 1988). As discussed in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985), it is the prior art itself, and

³The examiner points to no evidence that the transparency of the type described in Kubit can be used as a weather resistant cover or a sign for a retroreflective material.

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not the appellants' achievement, that must establish the obviousness of the combination. Obviousness cannot be established by hindsight. *In re Gorman*, 933 F.2d 982, 986-87, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

As our reviewing court⁴ stated,

. . . "virtually all [inventions] are combinations of old elements." . . . Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patent would ever issue

To prevent . . . hindsight . . . to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.

However, the examiner has not carried his burden of showing some suggestion or motivation to combine the prior art references to arrive at the claimed subject matter. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1530-31 (Fed. Cir. 1993) (the examiner has the initial burden of showing a *prima facie* case of obviousness regarding the claimed subject matter).

In view of the foregoing, we are constrained to reverse the examiner's decision rejecting claims 31 through 44, 46 and 47 under 35 U.S.C. § 103.

⁴ *Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1457-58

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REMAND

Relying on *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968), the examiner has rejected claims 31 through 44, 46 and 47 under the judicially created doctrine of "nonobviousness-type" double patenting as unpatentable over claims 1 through 7 of Rajan. According to the *Manual of Patent Examining Procedure* (MPEP) § 804 (8th Ed., Rev. 1, Aug. 2001):

Non-statutory double patenting rejection based on *Schneller* **will be rare**. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.

However, the record does not indicate whether the examiner has consulted with his supervisory patent examiner and obtained approval from the Technology Center Director consistent with the requirements of *Manual of Patent Examining Procedure* (MPEP) § 804 (8th Ed., Rev. 1, Aug. 2001). Accordingly, we remand this application to the examiner's jurisdiction to:

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1) Consult with his supervisory patent examiner to determine the propriety of the nonobviousness-type double patenting rejection in question, and

2) If proper, obtain approval of the Technology Center Director prior to forwarding this application to the Board of Patent Appeals and Interferences.

CONCLUSION

In summary:

1) The examiner's obviousness-type double patenting rejection of claims 31 through 44, 46 and 47 is affirmed;

2) The examiner's Section 103 rejection of claims 31 through 44, 46 and 47 is reversed; and

3) The application is remanded to the examiner to follow the proper procedure set forth in the *Manual of Patent Examining Procedure* regarding the examiner's nonobviousness-type double patenting rejection of claims 31 through 44, 46 and 47.

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Accordingly, the decision of the examiner is affirmed.

TIME FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
CHARLES F. WARREN)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
TERRY J. OWENS)	
Administrative Patent Judge)	

CKP:hh

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