

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH W. LANGAN

Appeal No. 1998-1342
Application 08/460,204

ON BRIEF

Before CAROFF, WILLIAM F. SMITH, and OWENS Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from an examiner's final rejection of claims 1 through 12 and 20 through 25, all the claims remaining in appellants' application.

Claims 1, 12, and 20 are representative of the subject matter on appeal and read as follows:

1. An assembly comprising:
a plurality of linerless labels each having a top surface with indicia imaged thereon and a single coating of pressure sensitive adhesive release material, and a bottom surface covered with a single pressure sensitive adhesive;
each of said labels of non-quadrate configuration; and

means for readily releasably connecting said plurality of labels to each other.

12. An assembly comprising:
a plurality of linerless labels each having a top surface with indicia imaged thereon and a coating of pressure sensitive adhesive release material, and a bottom surface covered with pressure sensitive adhesive; and
means for readily releasably connecting the plurality of labels to each other, comprising a matrix material and a plurality of paper ties connecting each label to the matrix material.

20. An assembly of linerless labels comprising:
a plurality of substantially circular in configuration linerless labels, each having a top surface with adhesive release material and a bottom surface with pressure sensitive adhesive; said labels disposed in shingled relationship in a substantially straight line, a portion of the adhesive of one label overlapping a portion of the adhesive release material of an adjacent label.

The references relied upon by the examiner are:

Bane	5,324,078	Jun. 28, 1994 (filed Dec. 28, 1992)
Lane	2,170,147	Aug. 22, 1939

Claims 1 through 12 and 20 through 25 stand rejected under 35 U.S.C. § 103(a).

As evidence of obviousness, the examiner relies upon Bane and Lane. We affirm-in-part.

DISCUSSION

We believe it appropriate to separate the pending claims into three groups for the purpose of considering the issues raised in this appeal. The first group is claims 1 through 11, the second group is claims 12 and 23 through 25, and the third group is claims 20 through 22.

Claims 1 through 11

All of these claims require, inter alia, the presence of a single coating of pressure sensitive adhesive release material and a single pressure sensitive adhesive. The

examiner agrees that the labels described in Bane are “coated with two release materials and two pressure sensitive adhesives rather than a single release material and a single adhesive as is claimed here.” (Examiner’s Answer, page 3). In order to make up this difference, the examiner concludes at page 4 of the Examiner’s Answer that “the provision of only a single adhesive and release material would have been obvious if only a single type of bonding was required.”

The examiner’s statement is no doubt true. However, the examiner has not pointed to the facts in this record which establishes that one of ordinary skill in the art had any reason, suggestion, or motivation to employ “a single type of bonding” in the labels of Bane. We remind the examiner that conclusions of obviousness must be based upon facts, not generalities. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968); In re Freed, 425 F.2d 785, 788, 165 USPQ 570, 571 (CCPA 1970).

The rejection of claims 1 through 11 is reversed.

Claims 12 and 23 through 25

These claims require that the assembly of linerless labels comprise a “matrix material and a plurality of paper ties connecting each label to the matrix material.” In reviewing the Examiner’s Answer, we find no statement from the examiner acknowledging this aspect of the claimed subject matter. We have no facts and reasoning from the examiner as to why it would have been obvious to one of ordinary skill in the art to create an assembly of linerless labels which comprise a “matrix material and a plurality of paper ties connecting each label to the matrix material” as required by these claims.

A conclusion of obviousness must be based upon the subject matter of a claim as a whole. 35 U.S.C. § 103(a). Where as here, the examiner's conclusion of obviousness is premised upon less than the subject matter as a whole of a given claim, it is legally flawed and cannot be sustained.

The examiner's rejection of claims 12 and 23 through 25 is reversed.

Claims 20 through 22

Claim 20 differs from the claims discussed above in that it does not require either a single coating of release material and adhesive nor does it require a matrix material and plurality of paper ties connecting each label to the matrix material. Rather, claim 20 reads on the assembly of linerless labels illustrated in Figure 1 of Bane with the single exception that the Bane labels are quadrate in shape while claim 20 requires that the labels be "substantially circular."

We considered a similar issue in Appeal No. 1996-1211 which involved parent application 08/173,083. In considering the patentability of method claims directed to forming an assembly of linerless labels such as those now claimed in claim 20 on the basis of Bane and Lane, we stated (slip opinion, paragraph bridging pages 5-6):

Lane describes and illustrates precut stacked or shingled labels which may be quadrate (Figs. 4 and 5) or non-quadrate (Figs. 6 and 7). Lane provides evidence of a fact of which most would readily admit: prior to the present invention, labels came in many sizes and shapes, including quadrate and non-quadrate. The disclosure of Bane places no limit on the shape of the labels which can be produced by using the teachings of that reference. We view the illustration of quadrate labels in the figures of Bane as exemplary only and not limiting in any sense. The precise shape of a label depends upon many factors, both functional and aesthetic. In view of the evidence provided by Lane, we agree with the examiner that one of ordinary skill in that art would have found it obvious to use the method of Bane to produce non-quadrate labels.

In the context of the product claim 20 before us for review in this appeal, we reach the same conclusion. We view the quadrate form of the labels illustrated in Figure 1 of Bane to be exemplary only and not limiting in any sense. We believe appellant would agree that he is not the first to invent circular labels. On the record before us, we hold that one of ordinary skill in the art would have found it prima facie obvious to form an assembly of linerless labels such as illustrated in Figure 1 of Bane wherein the labels are substantially circular in configuration.

The examiner's rejection of claims 20 through 22 is affirmed.

The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

Marc L. Caroff
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

Terry J. Owens
Administrative Patent Judge

)
)
)
)
) BOARD OF PATENT
) APPEALS AND
)
) INTERFERENCES
)
)
)

Appeal No. 1998-1342
Application 08/460,204

Nixon and Vanderhye
8th Floor
1100 North Glebe Road
Arlington, VA 22201-4714