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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** TIMOTHY J. RUSS  
and FRANCIS R. SMITH

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Appeal No. 95-0876  
Application 08/006,517<sup>1</sup>

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ON BRIEF

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Before PATE, STAAB, and McQUADE, **Administrative Patent Judges**.

PATE, **Administrative Patent Judge**.

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<sup>1</sup> Application for patent filed January 21, 1993.

### ***DECISION ON APPEAL***

This is an appeal from the final rejection of claims 1 through 9, 13 through 15, and 17 through 24. These are all the claims remaining in the application.

The invention relates to a double sided adhesive tape wherein at least one of the adhesive sides is a repositional adhesive. Also claimed are a method of making the tape and a method of using the tape. The following claims are representative of the claimed subject matter.

1. A method of making a double sided tape comprising the steps of:
  - (a) applying a first adhesive coat to an elongated tape substrate first face;
  - (b) applying a second adhesive coat to the substrate second face;
  - (c) at least one of steps (a) and (b) being practiced to apply a repositional adhesive;
  - (d) applying a release liner to the first adhesive to provide a tape, the release liner being the only release liner associated with the tape; and then
  - (e) rolling the substrate into a roll with the second adhesive engaging the release liner.
  
9. A double faced tape comprising:
  - an elongated tape substrate having first and second faces, and in roll form;
  - first and second adhesives operatively associated with said first and second faces, at least one of said adhesives comprising a repositional adhesive;

a release liner applied to one of said first and second adhesives, and only one of said adhesives, said release liner being the only release liner associated with the tape; and

a tie coat provided between each of said substrate faces and said adhesives

17. A method of using a double sided tape having first and second faces with adhesive on both faces, including repositional adhesive on the first face, comprising the steps of:

(a) applying the second adhesive to a first object so that the first adhesive extends outwardly from the first object; and

(b) causing a second object to releasably come into contact with the first adhesive, and ultimately removing the second object from contact therewith.

The reference relied upon by the examiner in his rejection under 35 U.S.C. § 103 is as follows:

Esmay	4,599,265	Jul. 8, 1986
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Additionally, the following references not previously of record are cited by the Board as evidence of anticipation and obviousness in a rejection entered by the Board under 37 CFR § 1.196(b):

Kellgren	2,206,899	Jul. 9, 1940
Smith	4,215,432	Aug. 5, 1980

The examiner has rejected claims 1 to 10, 13 to 15, and 17 to 24 under 35 U.S.C. § 103 as unpatentable over Esmay. According to the examiner, Esmay teaches a method of making a double-coated adhesive tape comprising applying a first adhesive to an elongated tape substrate first face and applying a second adhesive coating to the second substrate face and rolling the substrate into a roll. The examiner further states that Esmay teaches that one or both adhesive coatings may be releasable. The examiner recognizes that Esmay does not require the provision of a single release liner for his double sided adhesive tape when it is placed in a spiral roll. However, the examiner is of the view that the provision of a release liner to a double sided adhesive tape is old and well known in the adhesive tape art. Therefore, it is the examiner's determination that it would have been obvious to one skilled in the art to place a releasable liner on the adhesive tape of Esmay prior to rolling up the tape. The examiner's motivation for this combination is that one of ordinary skill in the art would expect the release liner to function in its art recognized capacity.

With respect to claims 2, 15, and 23, the examiner recognizes that Esmay does not disclose a spaced separation-facilitating means. However, the examiner is of the opinion that it well known in the art to provide such a means and it would have been obvious to include such a means in the Esmay tape as modified by the examiner.

As to claims 4, 8, 10, and 11, the examiner states that Esmay teaches priming his carrier to ensure better adhesion. Therefore the examiner is of the view that it would have been obvious to prime the substrate of Esmay with a tie coat to provide better adhesion.

As to claims 19, 20, and 24, Esmay contemplates a wide variety of instances where his tape would be useful. The examiner mentions adhering to paper or painted metal. The examiner states that it would have been obvious to one of ordinary skill in the art that the tape was adherable to shelving, and the disclosure of Esmay would have thus rendered such a process obvious to one of ordinary skill in the art. Rather than reiterate the argument of the appellants, reference is made to the Appeal Brief and the Reply Brief for the full details of these arguments.

### ***OPINION***

We have carefully reviewed the rejections on appeal in light of the arguments of the appellants and the examiner. As result of this review, we have reached the determination that the examiner has established a ***prima facie*** case of obviousness with respect to claims 17, 18, 19, and 24. Accordingly, the rejection of these claims will be sustained. We have further determined that the examiner has not established a ***prima facie*** case of obviousness with respect to claims 1 through 9, 13 through 15, and 20 through 23. The

rejection of these claims will not be sustained. Additionally, we will enter a rejection of claims under 37 CFR § 1.196(b).

It is our finding that the Esmay disclosure is directed to a removable pressure-sensitive adhesive tape which has an alkyl acrylate polymer which is sufficiently low-tack so that it is readily peelable from applied substrates after prolonged dwell time. The adhesive coating provides effective adhesion to a substrate of paper, metal, glass, plastic or painted surfaces. Column 2, lines 23-25. The double-coated tape may be readily and cleanly removed both from the object being mounted and from the substrate to which the object is mounted. Column 2, lines 34-37. Thus we concur in the examiner's finding that the adhesive disclosed in Esmay is of the repositionable type. While the tape in Esmay provides sufficient adhesive properties, it is noted that since the adhesives are cured by photopolymerization, the adhesive will not self adhere when the tape is rolled up in a spiral fashion. According to Esmay, this provides a distinctive advantage in that the double-coated tape of the invention can be wound directly upon itself for storage and shipment without any need for a disposable liner. Column 2, lines 42-44. Inasmuch as Esmay purposely dispenses with the removable liner, as it is unnecessary given his adhesive composition, we are in agreement with the appellants that it would not have been obvious to apply a removable liner to the tape of Esmay when rolled for dispensing and shipment. While we are in agreement with the examiner that obviousness is not determined solely on

the teaching of the applied reference, in this case the applied reference teaches away from the modification that the examiner posits for one of ordinary skill in the art. In other words, it would not have been obvious to provide a liner with the tape of Esmay because the liner is by Esmay's own disclosure unnecessary.

We further find that Esmay additionally discloses in Examples 10 and 11, a double-coated tape made with one side as a repositionable adhesive while the other side is made as an "ordinary aggressively pressure-sensitive adhesive layer." In this instance the tape provides one layer that is cleanly peelable from an ordinary substrate while the first layer, being aggressively adhesive is not peelable. Esmay discloses that this tape was applied to an aircraft floor panel which was covered by a polyvinylidene fluoride film. Tests showed that this tape held the vinyl sheet securely in place against the sort of stresses experienced by aircraft carpeting in use and that the vinyl sheet with the double-coated tape could be repeatedly removed for a such purposes as changing the cabin between passenger and freight configurations. Esmay at column 6, lines 34-39. Therefore, it is our finding that Esmay discloses a method of using a double-sided tape having first and second faces with adhesive on both faces including a repositionable adhesive that is the low-tack second adhesive layer in Example 10 on the first face thereof. In Example 10, the second adhesive is applied to the vinyl sheet to which it is more or less permanently affixed. The second object is the aluminum aircraft floor which is contacted by the first

adhesive. Thus it can be seen that the disclosure of Esmay clearly anticipates claims 17 and 18 of the application on appeal.

As our fact-finding has shown, there is no difference between the disclosure of Esmay and the method as claimed in claims 17 and 18. Therefore the obviousness rejection of these claims is affirmed, since the evidence establishes lack of all novelty in the claimed invention which necessarily evidences obviousness. After all, anticipation is the epitome of obviousness. See *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

With respect to claims 19 and 24, we note that Esmay clearly discloses that his double-sided pressure sensitive tape is suitable for a reliable adhesion with respect to ordinary paper, metal, glass, plastic, and painted substrates. Esmay, column 2, lines 23-25. Inasmuch as Esmay discloses mounting ordinary paper on painted or unpainted plastic, metal, or glass, we are in agreement with the examiner that it would have been obvious to one of ordinary skill in the art to use the tape of Esmay to mount paper, posters, bulletins, and temporary labels to shelves or furniture edges. Metal, glass, and plastic are common components found in modern office furniture.

Turning now to the rejection of the other claims on appeal, claims 1 through 9, 13 through 15, and 21 through 23, we note that all these claims, whether method or apparatus claims, require a releasable liner covering one of the adhesives. With respect to Esmay it

is our finding that Esmay discloses a tape with the particular advantage that a liner is unnecessary. According to Esmay, it is a virtue of his double-coated tape that the tape can be wound directly upon itself for storage and shipment without any need for a disposable liner. Esmay, column 2, lines 41-44. While we agree with the examiner that the provision of a release liner on a double-sided adhesive tape is old and well known in the adhesive tape art, we are not in agreement that provision of such a liner on the tape of Esmay would have been obvious to one of ordinary skill in the art. The provision of a release liner in the invention of Esmay is contrary to the specific, express disclosure of that patent. It is a singular advantage of Esmay that no release liner is necessary. Therefore one of ordinary skill in the art would not find therein any suggestion for the modification of the Esmay invention. For this reason the examiner has established no *prima facie* case of obviousness with respect to claims 1 through 9, 13 through 15, and 21 through 23. The rejection of these claims is reversed.

***Rejection Pursuant to 37 CFR § 1.196(b)***

It is our finding that Kellgren discloses a method of making a double-sided repositionable tape. According to Kellgren, the adhesive tape provided by his invention is a convenient and efficient way of “temporarily securing sheet material to various surfaces, as for example labels, notices, posters, shelf and drawer lining paper, etc.” Kellgren,

column 1, lines 24-27. Kellgren further discloses that when it is desirable to remove the sheet material, it is only necessary to pull it free. Kellgren also discloses that either the attached sheet or the double-sided tape will be pulled free and then if the double-sided tape still adheres to the substrate, it can be removed easily. See column 1, lines 29-33. Thus, there can be little doubt that the Kellgren patent discloses a double-sided repositional tape.

With respect to the method of making, Figure 2 of Kellgren shows applying a first and second adhesive coat to elongated tape substrate on the first and second faces thereof by way of a bath of pressure sensitive adhesive and a volatile solvent in coating tank 6. After the solvent is removed in a drying oven 20, a temporary liner is added to the double-sided tape. In Figure 3, a dilute bath of the pressure sensitive adhesive is added to the tape substrate in tank 15 before the tape is coated with its main adhesive.

Therefore, the dilute pressure sensitive adhesive comprises a tie layer to join the principal adhesive layers to the substrate as shown in Figure 3. Finally with regard to Figure 4, Figure 4 shows a removable liner being applied to the tape and the tape being slit before the tape is wound into a spiral to be shipped to the user. Claims 1, 3, 4, 8, 9, 13, 17, 20, 21, 22, and 24 are rejected under 35 U.S.C. § 102(b) as clearly anticipated by Kellgren. As noted above, Kellgren discloses all the limitations of the method of making the tape, the method of using the tape, and the tape, *per se*.

Claims 2, 15, and 23 are rejected under 35 U.S.C. § 103 as unpatentable over Kellgren and Smith. We take official notice of the ubiquitous nature of separation facilitating manifestations found on rolled sheet material throughout our daily life. As examples of these separation facilitating manifestations, we count paper towels, toilet paper, plastic grocery produce bags, pop-up diaper wipes, and postage stamps in rolls or sheets. All these examples point to a knowledge in the art that spaced separation-facilitating manifestations may be included in rolled-up tapes or sheets for the universally recognized advantage of convenient dispensing. Additionally, Smith shows such perforations for separating individual products, in this case aprons, from a dispensing roll of the products. Given this knowledge in the art we are of the opinion that it would have been obvious to include such separation facilitating manifestations in the double-sided adhesive tape of Kellgren for the suggested benefit of facilitating dispensing of the tape. The teaching of the patent to Kellgren combined with the knowledge in the prior art would have rendered claims 2, 15, and 23 obvious to one of ordinary skill in the art.

### ***Summary***

The rejection of claims 17 through 19 and 24 has been affirmed. The rejection of claims 1 through 9, 13 through 15, and 20 through 23 under 35 U.S.C. § 103 as

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unpatentable over Esmay is reversed. A new rejection under 35 U.S.C. § 102 has been entered by the Board against claims 1, 3, 4, 8, 9, 13, 17, and 20 through 22, and 24.

A new rejection under 35 U.S.C. § 103 of claims 2, 15, and 23 has been entered by the Board.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof. 37 CFR § 1.197.

With respect to the new rejection under 37 CFR § 1.196(b), should appellants elect] the **alternate** option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellants elect this alternate option, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be

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returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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 - 37 CFR § 1.196(b)***

	)	
William F. Pate, III	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Lawrence J. Staab	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
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