

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ULF N. OLSEN

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Appeal No. 96-3225  
Application 08/229,322<sup>1</sup>

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ON BRIEF

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Before CALVERT, ABRAMS and CRAWFORD, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 16 through 29, which at that time

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<sup>1</sup> Application for patent filed April 18, 1994. According to appellant, this application is a division of Application 08/058,155 filed May 5, 1993, now U.S. Patent No. 5,344,705 issued September 6, 1994.

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constituted all of the claims remaining of record in the application, claims 1 through 15 having been canceled. Subsequent to the final rejection, an amendment was entered which made changes to claim 16 and added new claim 30. The examiner maintained the rejection, however, and therefore claims 16 through 30 are before us on appeal.

The appellant's invention is directed to a method of making a transfer sheet material that incorporates a retroreflective graphic image. The subject matter before us on appeal is illustrated by reference to claim 16, which appears in an appendix to the Appeal Brief.

**THE REFERENCES**

The references relied upon by the examiner to support the final rejection are:

Palmquist et al. (Palmquist) 6, 1951	2,543,800	Mar.
Bingham 1973	3,758,192	Sep. 11,
Belisle et al. (Belisle) 26, 1988	4,721,649	Jan.
PCT International Application 14, 1992 (Danish reference)	WO 92/07990	May

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### THE REJECTIONS

Claims 16 through 30 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 38 of copending application Serial No. 08/241,508 in view of the Danish reference, Palmquist, Bingham and Belisle.

Claims 16 through 18, 21 through 23, 25 and 27 through 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Danish reference in view of Palmquist.

Claims 19, 20 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Danish reference in view of Palmquist and Bingham.

Claim 24 stands rejected under 35 U.S.C. § 103 as being unpatentable over the Danish reference in view of Palmquist and Belisle.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Appeal Brief.

### OPINION

*The Double Patenting Rejection*

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All of the claims stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting, based upon claims 1 and 38 of copending application Serial No. 08/241,508 in view of the Danish reference, Palmquist, Bingham and Belisle. However, the records of the Patent and Trademark Office indicate that this copending application became abandoned effective January 16, 1996. Such being the case, this rejection is rendered moot and cannot be sustained.

*The Rejections Under 35 U.S.C. § 103*

The appellant's invention is directed to a method of making a transfer sheet material to be used for transferring retroreflective graphic images from the sheet material to a substrate, such as is commonly done with imprinting graphic images upon T-shirts and the like. In accordance with the requirements of claim 16, transparent microspheres are embedded in a layer of material on a base sheet and then a first "imagewise pattern" is printed upon the microspheres of a first graphic segment of the sheet with a transparent colorant, which is followed by the printing of a second "imagewise pattern" on a second graphic segment of the sheet

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with a reflective composition. When transferred to a substrate, this results in a color pattern that is visible in normal conditions, such as daylight, and a reflective color pattern visible when light is trained on the substrate, such as by the headlights of a vehicle.

At this juncture, it should be noted that based on our understanding of the appellant's invention from the specification, we interpret the phrase "imagewise pattern" to mean a graphic representation or design which does not completely cover the base sheet. Thus, we do not agree with the examiner's position that an "imagewise pattern" can be a coating over the entire sheet.

This claim stands rejected as being unpatentable over the Danish reference taken in view of Palmquist. The Danish reference discloses a transfer sheet material for the same use as that of the appellant's invention. As we understand the method disclosed in the Danish reference, the entire sheet of partially embedded microspheres is coated with a reflective composition. If a pattern is desired in the reflective composition when transferred to the substrate, it is produced by applying an imagewise pattern of a release agent over the

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coating of reflective material, prior to the application of color. Thereafter, an imagewise pattern of color is applied over the reflective composition. See pages 12 and 13.

This gives rise to two differences from the method recited in claim 16. First, the claim requires that the color be applied first and the reflective material thereafter; however, in the Danish reference the opposite is the case. Second, the claim also requires that the reflective material be applied in a "second graphic segment . . . in a second imagewise pattern," whereas in the Danish method the reflective material is applied in a coating over the entire sheet.

Palmquist discloses a reflector for use as a road sign or the like. It comprises a base layer upon which have been deposited, seriatim, a reflective layer, a transparent color layer, and a binder layer in which a plurality of spheres are embedded. There is no teaching of making either the reflective or the color layer in an "imagewise pattern." However, as the examiner has pointed out, the Palmquist system manifests itself in color being visible in the daylight and reflected color being visible under illumination by vehicle

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lights or the like, in the same manner as the appellant's invention.

It is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention (*Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985)) and that the requisite motivation stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure (see, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988)). In the present case, it is the examiner's opinion that the required suggestion is found in the fact that Palmquist "recognizes that the product of its method facilitates retroreflection of colored light rays" (Answer, page 6). However, the examiner has not articulated a reason why the artisan would have been motivated to change the Danish method so that a product having different operating characteristics would result. And, even

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if we accede to the examiner's conclusion that the required suggestion lies in knowing what would result from the Palmquist method, the combination of teachings still fails to render obvious the step of depositing the reflective material in a "second imagewise pattern," for such does not exist in the methods of either reference.

It therefore is our conclusion that the combined teachings of the Danish reference and Palmquist fail to establish a *prima facie* case of obviousness with regard to the subject matter of claim 16, and we will not sustain the Section 103 rejection thereof. Nor, it follows, will we sustain the rejection of claims 17, 18, 21 through 23, 25 and 27 through 30, which depend from claim 16.

Claims 19, 20 and 26 stand rejected on the basis of the Danish reference and Palmquist, taken further in view of Bingham, which was cited for its teaching of reflective flakes having characteristics which fall within the scope of the limitations added by these claims to independent claim 16. However, Bingham fails to alleviate the deficiencies in the basic combination of references, and therefore we also will not sustain this rejection.

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The same rationale applies to the rejection of claim 24, in which Belisle was added as evidence of the obviousness of utilizing polyurethane as a transparent resin, and therefore we will not sustain this rejection, either.

**SUMMARY**

None of the rejections are sustained.

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The decision of the examiner is reversed.

**REVERSED**

	IAN A. CALVERT	)	
	Administrative Patent Judge)	)	
	)	)	
	)	)	
	NEAL E. ABRAMS	)	BOARD OF
PATENT	Administrative Patent Judge)	)	APPEALS AND
	)	)	INTERFERENCES
	)	)	
	MURRIEL E. CRAWFORD	)	
	Administrative Patent Judge)	)	

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