

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN MAHN

Appeal No. 96-3781
Application No. 08/259,891¹

ON BRIEF

Before KIMLIN, ELLIS and LIEBERMAN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed June 15, 1994. According to appellant, this application is a division of Application No. 08/027,954, filed March 8, 1993, now U.S. Patent No. 5,380,391, issued January 10, 1995.

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This is an appeal from the final rejection of claims 1-5 and 10, all the claims remaining in the present application.

Claims 1 and 10 are illustrative:

1. An indicia bearing transfer for use on an elastomeric substrate comprising:

an elastomeric layer compatible with an elastomeric substrate;

a solvent ink layer providing indicia on said elastomeric layer, said solvent ink layer having a color contrasting with said elastomeric layer; and

a clear thermoset layer covering said solvent ink layer.

10. A composite material comprising a cured elastomeric base layer;

a cured elastomeric sheet bonded to said cured elastomeric base layer;

a clear thermoset layer coating at least a portion of said elastomeric sheet;

indicia comprising sublimation dye heat transferred into said thermoset layer;

The examiner relies upon the following references as evidence of obviousness:

Knudsen	4,098,935	Jul. 4, 1978
Gartland et al. (Gartland)	5,160,383	Nov. 3, 1992

Appellant's claimed invention is directed to a transfer, or laminated sheet, comprising an elastomeric layer, indicia of solvent ink on the elastomeric layer and a clear thermoset

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layer covering the solvent ink. The transfer finds utility as being bonded to an elastomeric substrate, such as a tire, to provide identifying markings thereon.

Appealed claims 1-5 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gartland in view of Knudsen. In addition, claims 1-5 stand rejected under 35 U.S.C. § 112, second paragraph.

We consider first the examiner's rejection of claims 1-5 under § 112, second paragraph. According to the examiner, the claimed expression "a solvent ink" is indefinite because "it is not clear whether there is solvent still present on the article" (page 3 of Answer).

It is well settled that in evaluating the definiteness of claim language, the language must be read in light of the specification as it would be by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In the present case, we agree with appellant that when the claim language "a solvent ink" is read in light of the specification, one of ordinary skill in the art would readily understand that the language is defining a

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type of ink known in the art that is provided on the elastomeric layer. We further agree with appellant that it is immaterial whether some solvent remains on the elastomeric layer, although it is highly likely that part of the solvent will migrate into the layer. Accordingly, we will not sustain the examiner's § 112, second paragraph rejection.

We will also not sustain the examiner's rejection of claims 1-5 under 35 U.S.C. § 103 over the collective teachings of Gartland and Knudsen. The flaw in the examiner's rejection is that even when the references are combined the claimed indicia bearing transfer does not result. Gartland, the primary reference, does not disclose indicia of a solvent ink layer on an elastomeric layer. Rather, Gartland teaches the incorporation of a colorant, such as a dye or a pigment, in the elastomeric layer. From Gartland's disclosure at column 5, lines 34 et seq., as well as EXAMPLES 1 and 2, it can be seen that the colorant material is blended into the elastomeric composition. Also, Gartland does not disclose the claimed clear thermoset layer which covers the solvent ink layer. While the examiner relies upon Knudsen for this teaching, appellant accurately points out that Knudsen teaches

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printing indicia of ink on top of the protective layer.

Consequently, the combined teachings of Gartland and Knudsen do not result in the claimed indicia bearing transfer.

We will sustain the examiner's rejection of claim 10. Knudsen discloses the claimed composite material comprising a cured elastomeric base layer, an elastomeric sheet bonded to the cured elastomeric base layer, a thermoset coating on the elastomeric sheet and indicia comprising ink on the thermoset layer. Although Knudsen does not disclose that the indicia is in the form of a sublimation dye, it is notoriously well known in the art to employ sublimation dyes to impart indicia on a thermoset layer. Accordingly, we find that it would have been obvious for one of ordinary skill in the art to substitute a sublimation dye for the printing ink of Knudsen on the protective layer. Also, while Knudsen is silent regarding the clarity of the thermosetting protective layer, it would appear that the protective layer exemplified at column 5, lines 27-32, of the reference is within the scope of suitable thermoset layers disclosed at page 6 of appellant's specification, first paragraph, and Knudsen does not disclose adding a colorant to the protective layer. Moreover, we find that it would have

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been obvious to one of ordinary skill in the art to select the degree of clarity for the protective layer that suits the desired field of application.

In conclusion, based on the foregoing, the examiner's § 103 rejection of claim 10 is affirmed. The examiner's § 103 and § 112 rejections of claims 1-5 are reversed.

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

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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JOAN ELLIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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