

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKATERU MURAOKA,
TAKASHI KINOSHITA,
HITOSHI AKEMI, and
SABURO OTSUKA

Appeal No. 1997-0427
Application 08/296,427

HEARING REQUESTED¹

Before WILLIAM F. SMITH, ELLIS, and ROBINSON, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

¹ This appeal was scheduled to be heard January 25, 2000. Due to inclement weather, the hearing was canceled. In reviewing this case in preparation for the hearing it became apparent to the merits panel for the reasons set forth herein that a hearing was not needed in order to decide the appeal.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 20, all the claims in the application.

Claims 1 and 19 are representative of the subject matter on appeal and read as follows:

1. A medical adhesive sheet comprising:

a support having a laminate structure comprising a non-porous sheet and a porous sheet, and

a pressure-sensitive adhesive layer comprising an acrylic polymer prepared by polymerizing an alkyl (meth)acrylate as a main component monomer, and an organic liquid component which is compatible with the acrylic polymer, formed on the porous sheet side of the support, wherein the pressure-sensitive adhesive layer is subjected to a crosslinking treatment,

wherein the porous sheet is embedded with the pressure-sensitive adhesive layer such that the pressure-sensitive adhesive layer reaches the laminate interface between the non-porous sheet and the porous sheet.

19. A method of making a medical adhesive sheet comprising:

embedding a pressure-sensitive adhesive layer in a porous sheet wherein the pressure-sensitive adhesive layer reaches a laminate interface located between a non-porous sheet and said porous sheet.

The reference relied upon by the examiner is:

Eur. Pat. App. (Akemi)

0 435 199 A2

July 3, 1991

Claims 1 through 20 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Akemi. We reverse.

Discussion

The claims on appeal are directed to a medical adhesive sheet and a method for making the sheet. The sheet comprises a support having a laminate structure which comprises a non-porous sheet and a porous sheet and a specified pressure-sensitive adhesive layer. Importantly, the claims require that the porous sheet is embedded within the pressure-sensitive adhesive layer so that the pressure-sensitive adhesive layer reaches the laminate interface between the non-porous sheet and the porous sheet.

The examiner has correctly determined that Akemi describes a medical adhesive sheet which comprises a support having a laminate structure comprising a non-porous sheet and a porous sheet and a pressure-sensitive adhesive layer which can contain the components specified in the claims on appeal. The examiner has also correctly determined that Akemi describes adhering the pressure-sensitive adhesive layer to the porous sheet side of the laminate structure.

Given these facts, one would expect that the examiner's statement of the rejection in the Examiner's Answer would focus on why it would have been obvious to one of ordinary skill in the art to embed the porous sheet of the laminate structure of Akemi within the pressure-sensitive adhesive layer of the reference so that the pressure-sensitive adhesive

layer reaches the laminate interface between the non-porous sheet and the porous sheet all as required by the claims on appeal. However, this has not happened. Rather it appears from the examiner's statement of the rejection on pages 3-6 of the Examiner's Answer that the examiner has misread Akemi. The examiner alleges at page 4 of the Examiner's Answer that Akemi describes a medical adhesive sheet according to the claimed invention wherein the pressure-sensitive adhesive layer is "embedded on the porous sheet (page 3, line 3)." This is incorrect.

What Akemi actually states at that portion is that the pressure-sensitive adhesive layer is "on the surface of the porous sheet." The word "embed" does not appear at that portion of the reference. Nor does it appear that the word "embed" is used anywhere in the reference. At best, Akemi describes the assembly of the medical adhesive sheet of that reference as involving the adherence of the pressure-sensitive adhesive layer to the porous sheet. See, e.g., Example 1 of Akemi. However, no details are given as to how the two layers are "adhered" so that it cannot be determined whether the device created in that example meets the terms of the claims on appeal.

The examiner has failed to come to grips with that aspect of the claimed subject matter which specifies how the porous sheet is embedded in the pressure-sensitive

adhesive layer. Indeed, it appears that the examiner dismissed this limitation as it appears in product claims 1-18 in her statement at page 7 of the Examiner's Answer that claims 1-18 are "not method of making claims, but product claims." While this statement is undoubtedly true, its relevance is not seen. Claims 1-18 contain as a positive structural limitation the requirement that the porous sheet be embedded with the pressure-sensitive adhesive layer in the specified manner. Medical adhesive sheets made of the same components but in which the porous sheet is not embedded with the pressure-sensitive adhesive layer as specified are not within the scope of the claims on appeal.

The examiner was under the burden to either explain why one following the teachings of Akemi would necessarily arrive at a medical adhesive sheet having all of the requirements of the claims on appeal or why one of ordinary skill in the art would have found it obvious to modify the disclosure of Akemi to arrive at such a medical adhesive sheet. The examiner has not done so on this record.

As a final point, we note that our determination that the examiner has not established a prima facie case of obviousness means that we need not consider the declaration filed under 37 CFR § 1.132.

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The decision of the examiner is reversed.

REVERSED

WILLIAM F. SMITH)
Administrative Patent Judge)
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) BOARD OF PATENT
JOAN ELLIS)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
DOUGLAS W. ROBINSON)
Administrative Patent Judge)

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