

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES R. DE FIFE,
ROBERT J. WILLIAMS,
JOHN C. KOKAY and
DAVID M. GUSTAFSON

Appeal No. 1997-1485
Application 08/279,046

ON BRIEF

Before WILLIAM F. SMITH, WALTZ and SPIEGEL, **Administrative
Patent Judges.**

WALTZ, **Administrative Patent Judge.**

DECISION ON APPEAL

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This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 10 through 35, which are all of the claims remaining in this application.

According to appellants, the invention is directed to a composite multi-layer laminate material suitable for use as the face of pressure-sensitive sheet labels, decals and tapes (Brief, page 3). Claim 10 is illustrative of the subject matter on appeal and is reproduced below:

10. A composite comprising

(A) a first sheet of paper;

(B) a first coating of polyethylene or polypropylene film having a printable upper surface and a lower surface bonded to the upper surface of the first sheet of paper;

(C) a second coating of polyethylene or polypropylene film having its upper surface bonded to the lower surface of the first sheet of paper;

(D) a third coating comprising a pressure-sensitive adhesive on the lower surface of the second coating of polyethylene or polypropylene film;

(E) a release-coated liner comprising at least one layer of sheet material wherein the release coated surface of the liner is in contact with the third coating of pressure-sensitive adhesive.

In addition to appellants' "admissions" of the prior art,

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the examiner has relied upon the following references as
evidence

of obviousness:

Patterson et al. (Patterson) 1989	4,859,511	Aug. 22,
Tsubaki et al. (Tsubaki) 1994	5,326,624	Jul. 5,
	(U.S. filing date of Jul. 9,	1992)

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Claims 10 through 35 stand rejected under 35 U.S.C. § 103 as unpatentable over Tsubaki in view of Patterson and "applicant's [sic] admissions." (Answer, page 3). We **reverse** this rejection for reasons which follow.

OPINION

The claims on appeal recite a composite where a paper substrate has an upper and lower surface coated with a polyolefin (e.g., polyethylene or polypropylene), with the lower surface polyolefin having a coating of (A) a resin where the coefficient of friction is greater than the coefficient of friction of the polyolefin (independent claim 23, see Figure 3); or (B) a pressure-sensitive adhesive and a release-coated liner (see independent claim 10 and Figure 2); or (C) a pressure-sensitive adhesive and a release-coated liner laminate (see independent claim 29).

The examiner finds that Tsubaki discloses a composite laminate comprising a paper substrate with a layer of polyethylene on each surface of the substrate (Answer, page 4). The examiner applies Patterson for the disclosure of release sheets comprising paper coated with a polyolefin and

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the need for a release coating on the release sheet (**Id.**).

The examiner cites

appellants' specification, pages 21-23, for the disclosure that a variety of release coatings are commercially available and "hence well known." (Answer, page 6). From these findings, the examiner makes the following conclusions:

It would have been obvious to one of ordinary skill in the art to have combined the teachings of the references in an effort to develop a laminate with an adhesive backing. The use of an adhesive backing would allow one to secure the laminate onto a substrate and further the use of a release sheet over an adhesive surface is well known as shown in Patterson '511 (col. 1, lines 8-25; col. 3, lines 38-43). (Answer, page 7).

Appellants argue that Tsubaki does not disclose an adhesive layer or a release layer as required by the claims and that neither reference applied against the claims discloses the pressure-sensitive adhesive (element (D) of claim 10, see the Brief, pages 6 and 8).

We agree with appellants that the examiner has not established that Tsubaki or Patterson discloses or suggests element (D) of claim 10, i.e., a third coating on the lower surface of the second coating of polyolefin comprising a

pressure-sensitive adhesive.¹ The examiner provides no factual basis but merely concludes that it would have been obvious to one of ordinary skill in the art "to develop a laminate with an adhesive backing." (Answer, page 7). However, the examiner has failed to provide any evidence or convincing reason as to why one of ordinary skill in the art would have modified the photographic supports of Tsubaki with an adhesive backing. "Where the legal conclusion [of obviousness] is not supported by facts it cannot stand." **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Furthermore, it must be noted that, without any adhesive facing disclosed or taught by Tsubaki, there would be no reason or motivation to use a release sheet as disclosed by Patterson or as admitted in appellants' specification.

The examiner does not direct his comments to any particular claim in the Answer. However, it appears that some of the examiner's comments are directed to claim 23 on appeal

¹ Tsubaki does disclose treatment of the surface of the base paper on the side opposite the photographic layer with a copolymer of ethylene and acrylic acid to promote adhesion between the base paper and the back resin layer (column 2, lines 45-49; column 7, lines 1-8; and Example 4 and Table 4 in column 13).

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when the examiner states that the surface of the back resin layer of Tsubaki can be coated and this coating is "similar" to appellants' resin coating in contact with the lower surface of the second polyolefin coating (Answer, page 5, citing Tsubaki, column 9, lines 50-55). Tsubaki teaches that the back resin layer of the photographic support may be coated with "various back coat layers" for preventing electrification (column 7, lines 46-49). The specific back coating layers of Example 1 are a back coating solution of silica and styrene latex with a small amount of sodium polystyrenesulfonate (column 9, lines 50-59). However, the examiner has failed to establish, by evidence or convincing reason, that this coating would meet the limitation recited in claim 23 on appeal, which is "said resin coating having a coefficient of friction which is greater than the coefficient of friction of the second coating of polyolefin film." The examiner's mere conclusion on page 8 of the Answer that it would have been obvious "to select a resin coating having a coefficient of friction which is greater than [sic, than] the coefficient of friction of the second coating of the polyolefin film in order to provide good release properties" is without any factual basis. The

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examiner has not established why good release properties would have been desired for the photographic supports disclosed by Tsubaki.

For the foregoing reasons, we determine that the examiner has failed to establish a **prima facie** case of obviousness in view of the reference evidence of record and appellants' "admissions." Accordingly, the rejection of claims 10-35 under 35 U.S.C. § 103 over Tsubaki in view of Patterson and appellants' "admissions" is reversed.

The decision of the examiner is reversed.

REVERSED

William F. Smith)
Administrative Patent Judge)
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PATENT	Thomas A. Waltz) BOARD OF
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