

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte A. DALE LAKES

Appeal No. 1997-3874
Application 08/446,295

ON BRIEF

Before GARRIS, WARREN and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 22-24 and 28-33. Claims 25-27, which are all of the other claims remaining in the application, stand withdrawn from consideration by the examiner as being directed toward a nonelected invention.

THE INVENTION

The appellant's claimed invention is directed toward a

method for making a web or sheet product wherein surfaces of the web or sheet are bonded to each other by thermally fusing toner which has been applied to a bond-enabling material on the web or sheet.¹ Claim 22 is illustrative:

22. A method of making a web or sheet product comprising the steps of:

providing a web or sheet having two major surfaces,
coating a portion of one major surface thereof with a bond-enabling material for adhering toner particles on the surface of said sheet,

printing toner particles on said coated areas of said sheet,

folding said sheet along at least one major axis and sealing said folded sheet by the application of heat and pressure to said folded sheet to fuse said toner particles.

THE REFERENCES

Schoder 1919	1,297,406	Mar. 18,
Taillie 1974	3,794,550	Feb. 26,
Suzuki et al. (Suzuki) 1981	4,268,579	May 19,
Rausing 1989	4,828,636	May 9,
Imperial et al. (Imperial) 1991	5,017,416	May 21,

THE REJECTIONS

¹The bond-enabling material is a polymer (specification, page 8, line 19 - page 9, line 36).

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The claims stand rejected under 35 U.S.C. § 103 as follows: claims 22-24 and 28-32 over Rausing in view of Taillie and either Schoder or Suzuki, and claim 33 over Rausing in view of Taillie and Imperial.²

OPINION

We reverse the aforementioned rejections.

*Rejection over Rausing in view of Taillie and
either Schoder or Suzuki*

We need to address only claim 22, which is the sole independent claim.

Rausing discloses a method for producing documents such as passports, membership books and identification documents from a web by applying a thin coating of adhesive to one side of the web, printing text onto the other side of a web, folding the web to form a book page such that coatings of adhesive face one another, and joining the coatings of adhesive by simultaneously activating the adhesive and compressing the folded web (col. 1, line 62 - col. 2, line 9;

²Although claim 33 depends from claim 22, the examiner does not reject claim 22 over Rausing in view of Taillie and Imperial.

col. 5, lines 2-5).

Taillie discloses binding sheets by forming a high density of fused toner on an area where the sheets are to be bound, and refusing this toner to bind the sheets together (col. 1, lines 11-17 and 24-27; col. 2, lines 52-54; col. 3, line 67 - col. 4, line 15; col. 5, lines 1-19; col. 6, lines 44-70). Taillie teaches that the sheets are bound by the toner "without requiring any separate or additional binding materials" (col. 1, lines 15-16) and that "a secure inter-sheet binding may be achieved utilizing only the conventional and commercially available printing indicia [i.e., toner] itself as the sole sheet binding agent, rather than adhesives or other separate bindings" (col. 2, lines 23-27).

Schoder discloses an adhesive surface which adheres to sheets which are covered with printer's ink and which will not cause the sheets to curl or buckle (page 1, lines 13-17). The adhesive surface includes powdered adhesive applied to a layer of anhydrous sizing while the sizing is still tacky (page 1, lines 78-107).

Suzuki discloses a primer comprised of a diene polymer and magnesium oxide, "for preventing peeling of a thermoplastic resin coating, formed by the fluidized-bed dip-coating of thermoplastic resin powder, from a metal substrate" (col. 1, lines 30-33; col. 3, lines 49-50).

The examiner argues that it would have been obvious to one of ordinary skill in the art to substitute Taillie's toner for Rausing's adhesive as a mere substitution of one known thermoplastic adhesive for another, and to use the undercoat materials of Schoder or Suzuki to hold the thermoplastic adhesive particles in place (answer, pages 5-7).

In order for a *prima facie* case of obviousness of appellants' claimed invention to be established, the prior art must be such that it would have provided one of ordinary skill in the art with both a suggestion to carry out the appellant's claimed invention and a reasonable expectation of success in doing so. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.* The mere possibility

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that the prior art could be modified such that appellant's process is carried out is not a sufficient basis for a *prima facie* case of obviousness. See *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995).

The examiner has not explained why the applied references themselves would have motivated one of ordinary skill in the art to substitute Taillie's toner for Rausing's adhesive. The examiner has merely provided a conclusional statement that one of ordinary skill in the art would have substituted one known thermoplastic adhesive for another, without addressing whether such a person would have considered a toner to be desirable and suitable in Rausing's method. Also, the examiner has not explained why one of ordinary skill in the art would have considered the undercoat materials of Schoder or Suzuki to be desirable for holding the particles to the surface in Taillie's method and would have been effective for doing so. The record indicates that the motivation relied upon by the examiner for combining the teachings of the references comes solely from the description of the appellant's invention in

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his specification. Thus, the examiner used impermissible hindsight when rejecting the claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we reverse the rejection over Rausing in view of Taillie and either Schoder or Suzuki.

Rejection over Rausing in view of Taillie and Imperial

Imperial discloses an ion deposition printing method wherein toner particles are attracted to a pattern of ions on a drum and then are cold fused to a substrate using a cold roll rather than using thermal fusion as in xerography (col. 1, lines 7-16; col. 2, lines 36-43). The toner particles in Imperial's method are held on the substrate by a polymeric latex having a suitable solubility with the binder of the toner (col. 1, line 59 - col. 2, line 2).

The examiner argues that it would have been obvious to one of ordinary skill in the art to use Imperial's polymeric latex to hold Taillie's adhesive particles in place (answer, page 6).

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As pointed out above with respect to the rejection over Rausing in view of Taillie and either Schoder or Suzuki, the examiner has not adequately explained why the applied prior art would have led one of ordinary skill in the art to use Taillie's toner in Rausing's method. Moreover, the examiner does not explain why the applied references would have motivated one of ordinary skill in the art to use Imperial's polymeric latex, which functions to hold toner onto a substrate after the toner has been applied to the substrate by a cold roll, to hold onto a substrate Taillie's toner particles which are thermally fused. Again, the examiner has used impermissible hindsight in rejecting the claims. Consequently, we reverse the rejection over Rausing in view of Taillie and Imperial.

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DECISION

The rejections under 35 U.S.C. § 103 of claims 22-24 and 28-32 over Rausing in view of Taillie and either Schoder or Suzuki, and of claim 33 over Rausing in view of Taillie and Imperial, are reversed.

REVERSED

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BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES F. WARREN)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
TERRY J. OWENS))
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