

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

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARVIN FABRIKANT AND PATRICIA FABRIKANT

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Appeal No. 1998-0785  
Application No. 08/618,794

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HEARD: February 21, 2001

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Before GARRIS, TIMM, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-9, which are all of the claims pending in this application.

The subject matter on appeal is illustrated in claim 1, which reads as follows:

1. A method of forming a permanent identification indicia on a substrate that melts when heated to a predetermined temperature, comprising:

providing a label having an adhesive on one side, wherein the label, including the adhesive, also melts when heated to the predetermined temperature;

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applying the label to the substrate with the adhesive side in contact with the substrate, wherein the adhesive is of the type that permanently adheres the label to the substrate;

heating predetermined portions of the label, which portions define an outline of the indicia, to at least the predetermined temperature to melt the predetermined label portions; and

heating portions of the substrate, which portions corresponding to the predetermined label portions, to at least the predetermined temperature and debossing the substrate portions to a predetermined depth, leaving the indicia permanently on the substrate, wherein the debossed substrate portions are exposed through the label.

The references relied upon by the examiner are as follows:

Cranfill	3,629,042	Dec. 21, 1971
Ritchey	4,365,436	Dec. 28, 1982

Claims 1-9 stand rejected under 35 U.S.C. § 103 as obvious over Cranfill in view of Ritchey.

#### OPINION

For the reasons set forth below, we reverse the above-noted rejection.

Before reaching the merits of the appellants' position and the examiner's position, we note that a proper rejection under 35 U.S.C. § 103 requires the following considerations. Under a 35 U.S.C. § 103 rejection, the examiner should set forth in the rejection:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line numbers(s) where appropriate,

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- (B) the difference or differences in the claims over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

MPEP § 706.02(j)(Rev. 1, Feb. 2000).

Also, the rejection must apply the following four factual inquiries enunciated in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), as a background for determining obviousness:

- (A) Determining the scope and contents of the prior art;
- (B) **Ascertaining the differences between the prior art and the claims at issue;** [emphasis added]
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

MPEP § 2141 (Rev. 1, Feb. 2000).

Turning now to the issues of the instant case, the examiner's position is that Cranfill discloses a method for embossing a label, made of an adhesive-backed piece of a metal foil or plastic film, into a thermoplastic resin substrate. The label is pressed into the substrate by using a die 16 which is maintained at a certain temperature in order to melt the substrate and adhere the label. (Office Action of Paper No. 7, page 2). The examiner acknowledges that Cranfill does not disclose melting away

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of the label. (Answer, page 7). The examiner relies upon Ritchey for this aspect of the invention. (Office Action of Paper No. 7, page 2). The examiner reasons that it would have been obvious to provide contrasting labels in the manner taught by Ritchey in the Cranfill debossing process to improve the aesthetic appearance of the label of Cranfill. (Office Action of Paper No. 7, page 3).

Appellants' claim 1, requires, *inter alia*, applying a label to a substrate using an adhesive, heating portions of this label to melt these heated portions of the label, heating portions of the substrate to which the label is attached, at locations corresponding to the heated portions of the label, and debossing these heated substrate portions, wherein the debossed substrate portions are exposed through the label.<sup>1</sup>

We find that the examiner's rejection does not appreciate the above-mentioned requirements of claim 1; nor does the examiner's rejection properly compare these requirements with Cranfill and Ritchey. Hence, the examiner has not properly ascertained the differences between the prior art and the claims at issue, as required by Graham v. John Deere Co., *Id.* Our reasons for this conclusion are outlined below.

The reference of Cranfill concerns an embossing method (col. 1, lines 33-36). It is disputed among appellants and the examiner as to whether "debossing" actually occurs in the reference of Cranfill. (Brief, pages 6 and 7, Reply Brief, pages 2 and 3, and the Answer, page 6).

Upon our review of Cranfill, we find that the method of Cranfill indeed creates indentations of some sort within

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<sup>1</sup> We note that appellants' other independent claim 6 also encompasses these limitations.

substrate 10 because column 1, lines 47-50 of Cranfill indicates that the heated die presses not only the flexible film (label) but also a portion of the thermoplastic resin substrate 10 underneath the film into the shape dictated by the die, as shown in Figure 3.

However, these indentations are not formed in the same manner as required by appellants' method claim 1. In this regard, we essentially agree with appellants' remarks made on pages 11 through 14 of their Brief whereby appellants essentially argue that their claims are directed to "sticking a label to a substrate that melts when heated to a predetermined temperature, and then forming indicia into the substrate by melting portions of the substrate through the label" (Brief, page 11), and that this is distinguishable from the combination of Cranfill in view of Ritchey. Our reasons are set forth below.

To emphasize, claim 1 requires a method comprising "providing a label having an adhesive . . .; applying the label to the substrate with the adhesive side in contact with the substrate . . .; heating predetermined portions of the label . . . to melt the predetermined label portions; and heating portions of the substrate, which portions corresponding to the predetermined label portions, . . . and debossing the substrate portions . . . , wherein the debossed substrate portions are exposed through the label".

In the instant case, substrate 10 of Cranfill is not exposed through the label 14 (i.e., the medallion 14 of Cranfill) at portions corresponding to melted portions of label 14. So the issue of whether debossing actually occurs in Cranfill is not really relevant, because even if it does occur, the substrate is not debossed in the manner as required by appellants' claims. Nor does the reference

of Ritchey cure these deficiencies of Cranfill for the following reasons.

The examiner asserts that it would have been obvious to incorporate the teachings found in Ritchey of exposing an underlying layer of a label<sup>2</sup> (substratum) by melting an overlying layer of the label (superstratum), into the method of Cranhill, to arrive at appellants' invention. (Office Action of Paper No. 7, page 2, Answer, page 5). The examiner takes the position that the substratum of Ritchey is a substrate. (Answer, page 7). Appellants disagree with the examiner's interpretation, and argue that the substratum could hardly be equated to the substrate of their claims. (Brief, page 8).

We also disagree with the examiner's interpretation of Ritchey. Ritchey teaches to provide indicia to a label only, not to both a label and a substrate whereby the label is attached to a substrate by an adhesive, as required by appellants' claims (Figs. 1-11 and corresponding text of Ritchey). We therefore disagree with the examiner's attempt to define Ritchey's substratum 18 as a substrate within the meaning of appellants' claims, because substratum 18 of Ritchey is in fact a layer of a label, not a substrate to which a label is attached by an adhesive, as required by appellants' claims. Ritchey does not teach to melt portions of a label, **that is attached by an adhesive to a substrate**, and to deboss corresponding portions of such a substrate (which is attached to the label by an adhesive), wherein the debossed substrate portions are exposed through the label.

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<sup>2</sup> We use the word "label" here, but note, as the examiner points out on page 7 of the Answer, Ritchey also uses the word "panel". However, Ritchey teaches that the panel may be used for a label of any desired type (col. 4, lines 39-41). Hence, we have chosen to use the word "label".

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Therefore, Ritchey lacks the aspect of appellants' claims requiring "applying the label to the substrate with the adhesive side in contact with the substrate . . . ; heating portions of the substrate, which portions corresponding to the predetermined label portions, . . . and debossing the substrate portions . . . , wherein the debossed substrate portions are exposed through the label".

Hence, Ritchey does not cure the aforementioned deficiencies of Cranfill, and accordingly, the combination of references does not arrive at appellants' claimed invention.

On pages 8 and 9 of their Brief, appellants also argue that there is no motivation to combine the teachings of Ritchey with the disclosure of Cranfill. Appellants argue that Cranfill already teaches that the aesthetic appearance can be improved by using a shiny, metallic label, and that therefore the examiner's reason for combining the references is inappropriate. Appellants further argue that one would not substitute the foil of Cranfill with the complex label of Ritchey because (1) it does not simplify the process since the label of Ritchey is complex, (2) the Ritchey label would not work in the die press process of Cranfill, and (3) Ritchey's label requires a different method of forming an indicia.

The examiner rebuts and states that the use of multiple coloring in a label is not taught by Cranfill, and that, for aesthetic appearance purposes, one skilled in the art would be motivated to incorporate such a teaching into Cranfill. The examiner also argues that one skilled in the art would be motivated to utilize the recessed indicia as taught in Ritchey in the process of Cranfill. (Answer, page 7).

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Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found (1) either in the references themselves or (2) in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Here, we cannot find any suggestions in the applied art that would have motivated one skilled in the art to alter the process of Cranfill by incorporating the label of Ritchey. Nor has the examiner based his reasoning on any suggestions found in the knowledge generally available to one of ordinary skill in the art. As appellants point out, Cranfill uses a completely different process than Ritchey. Cranfill uses a die to form a three-dimensional medallion. Ritchey uses a stylus to melt layers of a label. These disparate processes provide no desirability for the combination, and we find that the examiner's asserted motivation to combine these references is based on improper hindsight reasoning.



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APJ GARRIS

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APJ TIMM

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DECISION: **REVERSED**