

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANTON NIJBOER, FOKKE JAGER and HENRY W. DINGLEY

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Appeal No.98-2036  
Application 08/589,250<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, McQUADE, and CRAWFORD, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Anton Nijboer et al. appeal from the final rejection of

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<sup>1</sup> Application for patent filed April 23, 1996.

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claims 1 through 20, all of the claims pending in the application. We reverse.

The invention relates to a record pad. Claim 1 is illustrative and reads as follows:

1. A record pad comprising:

a plurality of sheet sets, each sheet set comprising a paper top sheet having a top face and a bottom face, at least one underlying record bottom sheet, and a transfer mechanism for transferring indicia imaged on said top sheet to an underlying said record sheet;

said top sheet comprising an upper margin, a lower margin substantially parallel to said upper margin, and first and second side margins substantially perpendicular to said upper and lower margins, said upper margin being at the upper portion of said top sheet during normal use of said top sheet to enter indicia on said top sheet;

a securing edge margin of each of said top and record sheets of each sheet set of said plurality of sheet sets at said first side margin for connecting said sheet sets in a record pad; and

a pattern of repositionable adhesive provided on each said top sheet bottom face adjacent to and substantially parallel to said securing edge margins, said securing edge margins being substantially free of adhesive and spaced from said pattern of repositionable adhesive.

The reference relied upon by the examiner as evidence of obviousness is:

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Drake<sup>2</sup> 4,934,740 Jun. 19,  
1990

Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Drake.<sup>3</sup>

Reference is made to the appellants' main and reply briefs (Paper Nos. 9 and 11) and to the examiner's first Office action and answer (Paper Nos. 5 and 10) for the respective positions of the appellants and the examiner with regard to the merits of this rejection.

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<sup>2</sup> Also of record in the instant application is European Patent Application 325,057 to Drake. It was not until the answer (Paper No. 10) that the examiner clearly identified which of the Drake references (the U.S. patent) was being relied upon to support the appealed rejection, even though the appellants had first raised the question in their response (Paper No. 6) to the first Office action. Be this as it may, the examiner's failure to provide a timely identification of the reference relied upon, and the appellants' incorrect assumption throughout the prosecution of the application and on appeal that it was the European reference, have not prejudiced the appellants in any substantive manner since the disclosures of the two references are virtually identical.

<sup>3</sup> In the final rejection (Paper No. 7), the examiner also rejected claim 8 under 35 U.S.C. § 112, second paragraph. Since the examiner failed to restate this rejection in the answer (Paper No. 10), we assume that it has been withdrawn (see Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957)).

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Drake discloses a record pad which is described in the following terms:

A record book or pad is manufactured with record sheets 2 and removable sheets 1 disposed in pairs. Image transfer element is provided for transferring manuscript notes 7, 7a from sheet 1 to sheet 2 in a pair. Each removable sheet 1 has a line of weakness 5 whereby a portion 1a of that sheet can be torn from a spine part 3 of the book or pad. Each portion 1a has on its underside surface a region 9 of low tack adhesive by which that portion can be attached temporarily to a receptive surface remote from the book. The low tack adhesive is preferably applied as a strip 8 with a width sufficient to extend from the spine part of each removable sheet 1, over the line of weakness 5, to provide the region 9 on the removable portion 1a [Abstract].

With further regard to the location of the low tack adhesive, Drake teaches that

it is preferred that the low tack adhesive is applied so that it extends as a strip along a marginal edge part of each removable sheet and which marginal edge part comprises the spine part and that the strips of low tack adhesive are of sufficient width to extend from the spine part, over the lines of weakness and on to the respective removable sheet portions to form the regions of low tack adhesive on those portions. By this arrangement, the low tack adhesive along the spine part of the removable sheets assists in binding these sheets to their respective immediately underlying record sheets.

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With this latter arrangement in mind, it is preferred that in each pair of sheets, the upper sheet of the pair is the removable sheet while the lower sheet of the pair is the record sheet - this provides the advantage that the low tack adhesive on the underside of the upper removable sheet of a pair adhesively, albeit temporarily, restrains the removable sheet from being displaced over the associated record sheet during the application of a marking to the removable sheet so that an accurate copy of that marking may be applied to the underlying record sheet [column 2, lines 29 through 51].

As conceded by the examiner (see page 2 in the first Office action), Drake's record pad does not meet the limitations in independent claims 1 and 14 relating to the location of the pattern of repositional adhesive. Claim 1 requires the pattern of repositional adhesive to be on the bottom face of the top sheet adjacent to and substantially parallel to the securing edge margins, with the securing edge margins being substantially free of adhesive and spaced from the pattern of repositional adhesive. Claim 14 requires the same, and additionally calls for a line of weakness in each top sheet extending substantially parallel to the securing edge margin with the pattern of repositional adhesive being on the opposite side of the line of weakness from the securing

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edge margin. As indicated above, Drake's pattern of repositionable adhesive extends over the line of weakness 5 and onto the securing edge margin of each top sheet. Nonetheless, the examiner has concluded that "[i]t would have been obvious to one skilled in the art at the time the invention was made to remove the adhesive from the opposite side of the margins (5) of Drake since it is clear that the omission of the adhesive would not hinder the remaining elements from performing the same function" (first Office action, page 2).

The examiner, however, has failed to advance any evidence in support of this conclusion. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id. In the present case, Drake extends the pattern of repositionable adhesive over the line of weakness 5 and onto the securing edge margin of each top sheet for specific reasons, record sheets and to restrain

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the top sheet from being displaced over its record sheet during the application of a marking so that an accurate copy of that marking may be applied to the record sheet. In this light, and given the lack of any supporting evidence, we are constrained to conclude that the examiner's bald determination that it would have been obvious to remove the adhesive from the securing edge margins of Drake's top sheets rests on speculation, unfounded assumptions and/or hindsight reconstruction of the claimed invention.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of claims 1 and 14, or of claims 2 through 13 and 15 through 20 which depend therefrom, as being unpatentable over Drake.

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The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JOHN P. McQUADE	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
MURRIEL E. CRAWFORD	)	)
Administrative Patent Judge	)	

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