

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOSEPH E. LIPOVAC

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Appeal No. 1998-2985  
Application No. 08/725,212

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ON BRIEF

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Before PAK, OWENS, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 14, 16, 17, 23 and 24, and the decision of the examiner refusing to allow claims 18 and 25 as amended subsequent to the final rejection. Claims 19 through 22 stand withdrawn from consideration pursuant to a requirement for restriction. See the Office action dated August 22, 1997, paper no. 7.<sup>1</sup>

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<sup>1</sup>Although the Brief, page 2, states that "[c]laims 15 and 19-22 are withdrawn from consideration," the amendment received November 10, 1997 canceled claim 15.

### THE INVENTION

The invention is directed to a cured rubber tire having designated physical characteristics. The characteristics include spaced apart scuff resistant ribs, thin gauge non-staining compatible rubber adhered to the sidewall, rubberized ink and a removable film. Additional features of the claimed subject matter are set forth in the following illustrative claim.

### THE CLAIM

Claim 23 is illustrative of appellant's invention and is reproduced below:

23. A cured tire having an integral adhered applique both cured in same cure step to form spaced apart scuff resistant ribs under the applique on the sidewall of the tire, said applique including a thin gauge non-staining compatible rubber backing adhered to said sidewall, a highly stable rubberized ink design adhered to said backing and covered with a removable film before and at the time of removal of the tire from the mold.

### THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references:

Poschel	2,188,866	Jan. 30, 1940
Kraft	2,761,489	Sep. 4, 1956
Hayakawa et al. (Hayakawa)	4,252,589	Feb. 24, 1981
Gartland et al. (Gartland)	4,967,818	Nov. 06, 1990
Bryant et al. (Bryant)	5,047,110	Sep. 10, 1991
Bohm et al. (Bohm)	5,296,077	Mar. 22, 1994

### THE REJECTION

Claims 14, 16 through 18 and 23 through 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hayakawa in view of Kraft, Bohm, Bryant, the admitted prior art, Poschel and optionally further in view of Gartland.

### OPINION

We have carefully considered all of the arguments advanced by the appellant and the examiner, and agree with the appellant that the rejection of claims 14, 16 through 18 and 23 through 25) is not well founded. Accordingly, we reverse this rejection.

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability," whether on the grounds of anticipation or obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On the record before us, the examiner relies upon a combination of at least six references to reject the claimed subject matter and establish a *prima facie* case of obviousness.

#### The Rejection under 35 U.S.C. § 103

The rejection before us is predicated upon the combination of Hayakawa and Kraft. It is the examiner's position that while Hayakawa does not disclose the tire sidewall having scuff resistant ribs, "it would have been obvious in the art to provide the tire sidewall of Hayakawa et al[.] with spaced apart scuff resistant ribs because Kraft, directed

to a method of making a cured tire having a dirt resistant white sidewall, suggests providing the tire sidewall with a series of concentric ribs and grooves and bonding a thin sheet of pigmented rubber onto the sidewall by heat molding them together (col. 2[, ] line[s] 36-40; figures 1-4) to provide a very pleasing appearance." See Answer, page 7. We disagree.

Hayakawa discloses a very specific process for formation of a mark indication on a tire sidewall. The process requires particular and specific conditions for the disclosed process. In a description of the prior art, Hayakawa discusses the prior art methods that were adopted for placing a thin rubber sheet on a tire sidewall. See column 1, lines 27-34. The following means are usually adopted:

- (1) After vulcanizing the tire, a vulcanized color patch is heated and stuck under pressure on such a tire side wall.
- (2) After vulcanizing the tire, an unvulcanized rubber patch is stuck on such a tire side wall and then vulcanization is again effected to stick the rubber patch on the tire side wall, and
- (3) Prior to vulcanizing the tire, a previously vulcanized rubber patch has been stuck on the portion of a mold corresponding to the side wall and the tire is vulcanized by this mold.

In the case of the above described process (1), when the vulcanized color patch is heated and stuck on the vulcanized tire side wall, the physical properties of the cord and rubber at the heated portion are apt to be varied and this process is not preferable. Furthermore even if the color patch is stuck on the vulcanized tire, the position to be stuck with the color patch is large in the distortion deformation, so that the color patch is apt to be separated.

The above described process (2) intends to solve the defects of the process

(1), that is to prevent the variation of the physical properties of the cord and rubber due to the local heating but two times of vulcanizations must be carried out and there is [a] problem in the production cost.

The above described process (3) comprises having stuck the vulcanized color patch to the mold corresponding to the side wall and sticking said color patch to the tire side wall portion when vulcanizing the green case, but when the green case is generally vulcanized, a releasing agent is coated on the outer surface of the green case in many cases in order to decrease formation of inferior products during vulcanization as far as possible, so that the color patch is hindered by the releasing agents during vulcanization and there is a problem in the adhesion to the tire. In addition, the color patch stuck to the mold corresponding to the side wall portion is liable to slip off upon contact with the green case and furthermore it is not practically easy to stick the color patch on the mold and even if this process is adopted, the color patch is stuck only on one side of the tire.

See column 1, line 34 to column 2, line 7. It is evident from the above disclosure that substantial considerations enter into the product of a cured tire having an applique on the sidewall. Furthermore, Hayakawa specifically discloses that the state of the patch is critical to the inventive process.

Hayakawa states that:

when the conventional unvulcanized or vulcanized color patch is used and applied to the present invention, the following problems are caused and such uses are practically difficult.

(1) In the case of use of the unvulcanized patch.

The color patch is enlarged upon shaping and the printed mark becomes thin or causes unevenness, or the print itself sticks to the mold to cause stains and the appearance of the formed color patch becomes bad and there is [a] problem in the maintenance in view of vulcanization.

(2) In the case of [the] use of the vulcanized color patch.

When shaping, the color patch does not conform to the deformation of the tire and the color patch slips off or separates and the good product can not be obtained. [Column 2, lines 50-61.]

Hayakawa solves the conflicting problems through the utilization of a specific process wherein the color patch is previously partially vulcanized to a vulcanization degree of 50 - 80% in order to readily fit the mold. See column 3, lines 4-5 and claim 1. The partially vulcanized patch is thereafter adhered to the side wall of the green case, i.e., an unvulcanized rubber. See column 3, lines 36-41. Furthermore, the state of vulcanization is critical. The patch must have the requisite degree of prevulcanization prior to attachment to the sidewall. See column 3, line 46 to column 4, line 3.

In contrast and contrary to the specific teachings of Hayakawa, Kraft discloses a process for preparing a tire with a side wall having a plurality of scuff ribs and grooves over the surface of a tire. See column 1, lines 20-29. The tire is manufactured by curing a sheet of pigmented rubber against the ribs and grooves and then buffing the rubber off of the ribs to leave it in the grooves. See column 1, lines 35-37. However, contrary to the specific teachings of Hayakawa, the pigmented rubber sheet is unvulcanized. See column 2, lines 69-70 wherein Kraft discloses that, "[t]he sheet is cured against the tire sidewall portion 5 and the tire is then removed from the matrix." As to the status of the tire itself, Kraft requires that the tire, "is cured or vulcanized to at least the resilient, elastic state." See column 2, lines 53-54 and claim 1.

Based upon the above findings and analysis, we conclude that the two processes are mutually exclusive and cannot be combined in the manner suggested by the examiner.

It is well settled that the examiner must show reasons that the skilled artisan with no knowledge of the claimed invention would select the elements from the cited prior art references for combination in the manner claimed. We determine that there is no reason, suggestion, or motivation to combine the references in the manner proposed by the examiner. Accordingly, the examiner has not established a prima facie case of obviousness and the examiner's rejection under 35 U.S.C. § 103 is not sustained. In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998).

DECISION

The rejection of claims 14, 16 through 18 and 23 through 25 under 35 U.S.C. § 103(a) as being unpatentable over Hayakawa in view of Kraft, Bohm, Bryant, the admitted prior art, Poschel and optionally further in view of Gartland is reversed.

The decision of the examiner is reversed.

REVERSED

CHUNG K. PAK	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
TERRY J. OWENS	)	APPEALS
Administrative Patent Judge	)	AND
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PAUL LIEBERMAN	)	
Administrative Patent Judge	)	
)	)	

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