

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. 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 CHARLES GUTENTAG

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Appeal No. 2000-1314  
Application No. 09/109,279

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ON BRIEF<sup>1</sup>

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Before CALVERT, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 30, which are all of the claims pending in this application.

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<sup>1</sup> On January 24, 2001, the appellant filed a request (Paper No. 18) to withdraw the hearing scheduled for February 21, 2001. Such request was granted.

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We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to "the field [of] adhesive backed carrier tape packaging systems utilizing pressure sensitive adhesive (PSA) tapes" (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kawanishi et al. 1990 (Kawanishi)	4,966,282	Oct. 30,
Gutentag 1993	5,203,143	Apr. 20,
Schenz 1998	5,765,692	June 16,

Claims 1 to 9, 13 to 17, 19 to 21 and 28 to 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gutentag in view of Schenz.

Claims 28 to 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kawanishi in view of Schenz.

Claims 10 to 12, 18 and 22 to 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over the species shown in Figures 1-10 and 12 because of the appellant's admission that they are not patentable over those species.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 11, mailed November 19, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed October 5, 1999) and reply brief<sup>2</sup> (Paper No. 13, filed January 14, 2000) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and

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<sup>2</sup> The declaration of Charles Gutentag (Paper No. 12, filed January 14, 2000) was not entered by the examiner (see Paper No. 15, mailed February 10, 2000) and has not been considered by this panel of the Board of Patent Appeals and Interferences.

claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 30 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Obviousness is tested by "what the combined teachings of the references would have

suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. In this case, it is our view that the applied prior art contains no suggestion or incentive for a person of ordinary skill in the art at the time the invention was made to have modified the prior art device of Gutentag or Kawanishi to arrive at the claimed invention.

Claims 1 to 3 require a pair of elongated pressure sensitive adhesive tapes with each tape having a longitudinal linear side portion, a longitudinal sinusoidal shaped side portion and an adhesive surface. Claims 4 to 6 require a pair of elongated pressure sensitive adhesive tapes with each tape having a longitudinal linear side portion, a longitudinal sawtooth shaped side portion and an adhesive surface. Claims 7

to 9 require a pair of elongated pressure sensitive adhesive tapes with each tape having a longitudinal linear side portion, a longitudinal alternating fringe side portion and an adhesive surface. Claims 13 to 17 and 19 to 21 require at least one pressure sensitive adhesive tape having a longitudinal linear side portion, a longitudinal irregular side portion and an adhesive surface. Claims 28 to 30 require at least one pressure sensitive adhesive tape having two opposite sinusoidal shaped side portions and an adhesive surface. However, these limitations are not suggested by the applied prior art. Gutentag teaches a pair of elongated pressure sensitive adhesive tapes 125 with each tape having two longitudinal linear side portions and an adhesive surface 120. Kawanishi teaches a pair of adhesive layers 210 with each layer having two longitudinal linear side portions and an adhesive surface. While Schenz does teach an adhesive portion 42 whose configuration may vary over a wide range (see column 6, line 48, to column 7, line 45), it is our opinion that Schenz does not teach or suggest providing a pressure sensitive adhesive tape with a longitudinal irregular side

portion as set forth in claims 1 to 9, 13 to 17, 19 to 21 and 28 to 30.

In our view, the only suggestion for modifying either Gutentag or Kawanishi in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that the decision of the examiner to reject claims 1 to 9, 13 to 17, 19 to 21 and 28 to 30 under 35 U.S.C. § 103 is reversed.

It follows from our decision to reverse the examiner's rejection of claims 1 to 9, 13 to 17, 19 to 21 and 28 to 30 under

35 U.S.C. § 103 that the decision of the examiner to reject claims 10 to 12, 18 and 22 to 27 under 35 U.S.C. § 103 is likewise reversed since this rejection was based on the species shown in Figures 1-10 and 12 and claimed in claims 1 to 9, 13 to 17, 19 to 21 and 28 to 30 being unpatentable.

REMAND

We remand this application to the examiner for further consideration of claims 22 to 24. Specifically, the examiner should determine if claims 22 to 24 are anticipated by Gutentag and if not whether any difference(s) would have been obvious at the time the invention was made to a person of ordinary skill in the art from the teachings of Gutentag and any other prior art of record.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 30 under 35 U.S.C. § 103 is reversed. In addition, this application has been remanded to the examiner for further consideration of claims 22 to 24.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Seventh Edition, Rev. 1, Feb. 2000).

REVERSED; REMANDED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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ROZSA & CHEN  
SUITE 1601  
15910 VENTURA BOULEVARD  
ENCINO, CA 91436-2815

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