

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM L. MELBYE,  
SUSAN K. NESTEGARD,  
LEIGH E. WOOD,  
MARVIN D. LINDSETH, and  
DALE A. BYCHINSKI

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Appeal No. 2002-0846  
Application No. 09/503,452

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HEARD: FEBRUARY 6, 2003

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

PAWLIKOWSKI, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 17-25. Claims 1-16 have been canceled.

Claim 17 is illustrative of the subject matter on appeal and is set forth below:

17. A method of continuously forming a smooth hook strip for a hook-and-loop type mechanical fastener consisting essentially of:

a) providing a web backing having an array of upstanding substantially uniformly spaced thermoplastic projections which web backing and projections are formed of the same thermoplastic material, the thermoplastic material having a flow temperature,

Appeal No. 2002-0846  
Application 09/503,452

each projection having a stem portion and a top portion, said projection having a given first cross-sectional dimension, and height, said web backing and projections combined having a given second height;

b) providing a gap formed by a first surface and a second surface, the gap being less than the second height, a first surface being heated to a temperature above the flow temperature of the thermoplastic material forming the projections; and

c) moving the web backing into and through the gap such that the thermoplastic material forming the top portion of the projections are deformed, such that the projections have a second cross-sectional dimension and height which height is less than the first height and which second cross-sectional dimension is larger than the first cross-sectional dimension, by the heated surface under pressure, providing hooks with upstanding stem portions and hook heads having a smooth upper surface.

The examiner relies upon the following references as evidence of unpatentability:

Doleman et al. (Doleman)	3,590,109	June 29, 1971
Hamano	3,718,725	Feb. 27, 1973

Claims 17-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hamano in view of Doleman.

Claims 17-25 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over certain claims of co-pending Application No. 08/766,544 in view of Hamano. We refer to pages 2-3 of the answer regarding the identification of the certain claims of co-pending Application No. 08/766,544.

On page 2 of the answer, the examiner indicates that co-pending Application No. 08/766,544 is currently under appeal. Appeal No. 2000-2013 is the decision in connection with this application.

Appellants submit that the appealed claims do not stand or fall together and that claims 17, 22, 23, and 24 should be considered separately. Hence, we consider each of these claims in this appeal. 37 CFR § 1.192(c)(7)(8)(2000).

For the reasons set forth below, we will reverse the rejection involving Hamano in view of Doleman. We will sustain the provisional rejection under the judicially created doctrine of obviousness-type double patenting.

### **OPINION**

#### **I. The rejection involving Hamano in view of Doleman**

Appellants indicate that the claims as drafted use the transitional language "consisting essentially of", which limits their process to the steps recited, and excludes process steps that would have a material affect on the process as claimed. Appellants state that in this respect the claims would at least exclude the supporting rods required in Figures 1-7 of Hamano.

On pages 9-10 of the answer, the examiner disagrees and states that the rods in Hamano are only used to maintain the loop in their upstanding position, and states that nowhere does Hamano suggest that the rods support the upstanding stem after a loop is cut. The examiner concludes that Hamano does not use the rods in any manner that would materially affect the reshaping of the tips of the upstanding projections provided by the cutting step.

Our comments on this issue are set forth below.

We note that the language "consisting essentially of," renders a method claim open only to inclusion of steps that do not materially affect the basic and novel characteristics of the

claimed method. See Ex parte Hoffmann, 12 USPQ2d 1062, 1063-64 (BPAI 1989).

Here, we are not convinced by the examiner's statements in support of her conclusion that the rods of Hamano would not materially affect the method recited in appellants' claims. To the contrary, we find that incorporation of the support rods 12 of Hamano into the presently claimed method would materially affect the basic and novel characteristics of the method. For example, looking at appellants' figures 3a and 3b, certainly if the rods are incorporated into the depicted method, the rods would interfere with the ability of the thermoplastic material to deform as set forth in step (c) when the web backing is moved into and through the gap. The examiner has not explained how the rods would not interfere in this regard. The examiner simply states that the rods in Hamano are used to maintain the loops in the upstanding position. Yet, the examiner does not explain why the rods would not interfere with the method in a material way when the rods are incorporated into the method as depicted in figures 3a and 3b.

Hence, we agree with appellants' statement made on page 9 of the brief that the language "consisting essentially of" excludes the supporting rods required in Hamano.

We further are mindful of the discussion made on page 10 of the brief regarding the alternative embodiment of Hamano involving the use of a chemical solvent to chemically soften the top portions of the loops. We are in agreement with appellants' conclusions drawn therein also.

We have reviewed appellants' reply brief in which Dr. Miller's declaration is discussed. However, because we have determined that the examiner has not set forth a prima facie

Appeal No. 2002-0846  
Application 09/503,452

case, we need not reach the issue of whether or not the showing of unexpected results discussed in appellants' reply brief is sufficient. In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

In view of the above, we reverse the rejection of claims 17-25 under 35 U.S.C. § 103 over Hamano in view Doleman.

II. The provisional rejection of claims 17-25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over certain claims in co-pending Application No. 08/766,544 in view of Hamano

We will sustain the rejection under the judicially created doctrine of obviousness-type double patenting because appellants state on page 14 of their brief that they will file a terminal disclaimer to overcome this rejection.

Upon return of this application to the jurisdiction of the examiner, we call upon the examiner and appellants to handle this issue accordingly.

III. Conclusion

The rejection of claims 17-25 under 35 U.S.C. § 103 as being unpatentable over Hamano in view of Doleman is **reversed**.

The provisional rejection under the judicially created doctrine of obviousness-type double patenting rejection is **sustained**.

Appeal No. 2002-0846  
Application 09/503,452

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED**

Bradley R. Garris	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Paul Lieberman	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Beverly A. Pawlikowski	)	
Administrative Patent Judge	)	

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Appeal No. 2002-0846  
Application 09/503,452

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