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BOARD OF PATENT APPEALS
AND INTERFERENCES

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

94-0986

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH L. BARTHELMAN

Appeal No. 94-0986
Application 07/812,076¹

ON BRIEF

Before CALVERT, ABRAMS, and McQUADE, *Administrative Patent Judges*.

McQUADE, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 15 through 39, all of the claims pending in the application.

The appellant's invention relates to a three-dimensional decal, and to a method of producing same "utilizing a plastic

¹ Application for patent filed December 19, 1991.

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cover (i.e., a vinyl cover) sheet which, by cutting with a deeply etched heated die, results in an attractive edge control (i.e., an arcuate or curvatus [sic] edge), and produces a desirable three-dimensional effect upon removal of background material" (specification, page 3). Claims 15 and 38 are illustrative and read as follows:

15. A method for producing a three dimensional laminated decal composite having a predetermined configuration including a decal member being adhered to a decal support member with an acrylic based sensitive adhesive that prevents "bubbling up" of the decal member on the decal support member after the production of the three dimensional laminated decal composite, comprising the steps of:

(a) providing a decal support including a top and comprising a closed-cell polyvinyl chloride foam having a density ranging from about 20lbs/cubic [sic] feet to about 30 lbs/cubic feet and having a decal support melting temperature;

(b) providing a decal with a decal melt temperature that is greater than the decal support melting temperature and comprising a major proportion of a vinyl compound, and having an acrylic based pressure sensitive adhesive on a bottom thereof;

(c) securing the top of the decal support to the bottom of the decal having the acrylic based pressure sensitive adhesive by contacting the bottom of the decal having the acrylic based pressure sensitive adhesive with the top of the decal support to produce a decal/decal support combination and subsequently passing the decal/decal support combination through a laminator to produce a laminated decal composite;

(d) providing a thermal die having a die base and at least one cutting ridge secured to the die base and having a height greater than about 0.07 inches;

(e) die-cutting the laminated decal composite of step (c) with the cutting ridge of step (d) and at a cutting temperature ranging from about 260°F to about 360°F and a cutting pressure less than about 650 psi and a cutting dwell time ranging from about 0.1 sec. to about 0.8 sec. to produce a three dimensional

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laminated decal composite having a predetermined configuration and with the acrylic based sensitive adhesive of step (b) preventing "bubbling up" of the decal of step (b) on the decal support of step (a).

38. A three dimensional laminated composite produced in accordance with the method of Claim 15.

The references relied upon by the examiner as evidence of obviousness are:²

Massari (Massari '362)	3,490,362	Jan. 20, 1970
Kougel	3,573,126	Mar. 30, 1971
Massari (Massari '953)	3,673,953	July 4, 1972
Kuroda (Kuroda '358)	3,758,358	Sep. 11, 1973
Focht	4,121,960	Oct. 24, 1978
Kuroda (Kuroda '685)	4,160,685	July 10, 1979

The appealed claims stand rejected under 35 USC 103 as follows:

a) claims 15, 16, 18, 20, 22, 24, 32, 34 and 36 as being unpatentable over Kuroda '685 in view of Focht;

b) claims 17, 19, 21, 23, 30,³ 31, 33, 35 and 37 as being unpatentable over Kuroda '685 in view of Focht, and further in view of Massari (either Massari '362 or Massari '953);

² The examiner has not made it clear in the final rejection (Paper No. 5) or answer (Paper No. 8) which of the two Massari patents of record is being relied upon to support the standing rejections of claims 17, 19, 21, 23, 25 through 31, 33, 35 and 37. In this regard, the "listing of the prior art of record relied upon in the rejection of claims under appeal" on page 2 in the answer is inaccurate. In order to expedite matters, we have considered both Massari patents in reviewing the rejections in question, a circumstance which does not prejudice the appellant given our decision in this appeal.

³ The record shows that claim 30 was handwritten into the statement of this rejection in the final rejection (Paper No. 5) over the examiner's signature dated "8/93," which is well past the December 18, 1992 mailing date of the final rejection. This alteration of the record is highly improper.

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c) claims 25 through 29 as being unpatentable over Kuroda '685 in view of Focht and Massari, and further in view of Kougel; and

d) claims 38 and 39 as being unpatentable over Kuroda '358 and Kuroda '685.

We shall not sustain any of these rejections.

Kuroda '685 discloses a method of making an applique article from an upper cover layer, an intermediate layer of resiliently compressible and latently adhesive foam and a base layer which may or may not have an adhesive backing and accompanying release sheet on its lower surface. The foregoing layers are acted on by a heated die which cuts a desired configuration into at least the cover and intermediate foam layers and bonds selected portions of the cover layer to the base layer via the intermediate latently adhesive foam layer to form "a resilient padded three-dimensional applique article" (column 2, lines 10 and 11).

Focht discloses a method of making an embossed film/foam laminate having desirable sound-absorbing properties. The film and foam layers are fed from respective supply rolls through heated pressure rolls to emboss and bond the layers to one another.

Of the remaining applied references, Massari (either Massari '362 or Massari '953) discloses a method of embossing and cutting printing stencils, Kougel discloses a method of manufacturing

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electrical circuits, and Kuroda '358 discloses a method of making an applique article which is similar to the method disclosed by Kuroda '685.

With regard to the basic combination of Kuroda '685 and Focht, the examiner contends that "[i]t would have been obvious to one of ordinary skill in the art to employ different sized/structured devices for the patented process of the reference to Kuroda ('685) to effect different resulted shapes of the resulting product" (answer, page 3). While it is not entirely clear what this means, it is apparent that Kuroda '685 does not teach and would not have suggested many of the limitations set forth in independent claim 15. Examples of such limitations include providing a decal support of closed-cell polyvinyl chloride foam having the density specified in step (a), providing a decal having an acrylic based pressure sensitive adhesive on a bottom thereof as recited in step (b), providing a thermal die having at least one cutting ridge of a height greater than about 0.07 inches as recited in step (d), and die-cutting under the particular operational parameters specified in step (e). Neither Focht nor any of the other references applied in support of the rejections of method ~~claims~~ 15 through 37 overcomes these deficiencies in Kuroda '685.

To begin with, the disparate nature of these references and the examiner's strained explanation as to why it would have been

obvious to combine them in the manner proposed (see pages 3 through 8 in the answer) indicates that the proposed combination is based on an impermissible hindsight reconstruction of the method set forth in claims 15 through 37.

Moreover, even if the references were combined in the manner proposed, their collective teachings would not provide the factual basis necessary to support a conclusion of obviousness. In this regard, the examiner has failed to advance any evidence to support his bald conclusions that many of the operational parameters recited in the method claims do not patentably distinguish the claimed method over the prior art.

In addition, the examiner appears to have improperly dismissed many of the limitations in claims 15 through 37 relating to the thermal die and the composite materials on the basis that they are not germane to the patentability of the claimed method steps. Such an approach, however, is inconsistent with § 103 which requires that the claimed subject matter as a whole be taken into account in evaluating obviousness.

As for the proposed combination of Kuroda '358 and Kuroda '685 to reject dependent product-by-process claims 38 and 39, the examiner simply contends that "[t]he cited references teaches [sic] a similar three dimensional decal" (answer, page 6) and that the patentability of product-by-process claims is based on the product itself (answer, pages 8 and 9). In short, the

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