

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

AUG 23 1996

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

PAT.&T.M. OFFICE  
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AND INTERFERENCES

Ex parte JOACHIM SUESS and EDWIN TAFELMEIER

Appeal No. 94-3152  
Application 07/912,555<sup>1</sup>

HEARD: AUGUST 8, 1996

Before CALVERT, MEISTER and ABRAMS, Administrative Patent Judges.  
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3 to 5, 7, 9 and 11 to 16, all the claims in the application.

Independent claims 1 and 9 read as follows:

1. An embossing foil comprising a backing film, a decorative lacquer layer releasably disposed on the backing film, and an adhesive layer on the decorative lacquer layer at the side thereof remote from the backing film, said backing film provided with a three-dimensional pattern being covered regionwise with a

<sup>1</sup> Application for patent filed July 13, 1992.



reference. We will therefore begin by comparing the language of claim 1 to the Kraetschmer disclosure.<sup>2</sup>

Kraetschmer discloses an embossing foil having a backing film 12, a decorative lacquer layer 26 releasably disposed on the backing film, and an adhesive layer 28 on the opposite side of the lacquer layer. The backing film is also provided with a three-dimensional pattern at surface 22. It is not however clear where in the reference the three-dimensional pattern is "covered regionwise with a lacquer layer" as called for by claim 1. If layer 26 is considered to be this covering layer, then it is not evident where in Kraetschmer there is a decorative lacquer layer. The examiner seems to indicate that layer 34 of Kraetschmer (Fig. 2) is a decorative lacquer layer, but this layer is only disclosed as being a color layer (col. 4, lines 44-46), and not as being made of lacquer.

Moreover, even assuming that layer 26 of Kraetschmer constitutes the second-recited lacquer layer, we find no disclosure that it covers the three-dimensional pattern on the backing film "regionwise." This limitation is not addressed in

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<sup>2</sup> We consider claim 1 indefinite in that the term "said surface" in the last line has no antecedent basis (see the rejection under 37 C.F.R. § 1.196(b), *infra*). However, in the interest of avoiding piecemeal appellate review, we construe "said surface" as referring to the surface of the backing film which is "covered regionwise with a lacquer layer."

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the examiner's answer; but on page 2 of the final rejection the examiner stated:

In terms of regionwise patterning this feature is not patentably distinct because the article gives a 3-D effect regardless whether it is regionwise patterned or non-regionwise patterned. As long as the result effect[sic] is the same; how it has been patterned is just a matter of design choice.

This does not meet the test of anticipation, for if there is any difference between the reference and the claimed subject matter, the claim is not anticipated.<sup>3</sup> There being no disclosure in Kraetschmer of the claimed regionwise covering lacquer layer, the rejection under 35 U.S.C. § 102 cannot stand.

Claim 9

As for claim 9, Kraetschmer discloses a backing film 12, a decorative lacquer layer thereon including a transparent covering layer 26, and an adhesive layer 28, but nowhere in this reference do we find any disclosure that the three-dimensional patterning is on a surface of the transparent covering layer "remote from the backing film" and "facing away from said backing film," as claimed. To the contrary, in the Kraetschmer foil the three-dimensional patterning is on the surface 22 of the layer 26 which is adjacent to and faces the backing film, rather than being

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<sup>3</sup> The question of whether a claimed limitation is "a matter of design choice" relates to the issue of patentability under § 103, not § 102. See In re Chu, 66 F.3d 292, 299, 36 USPQ2d 1089, 1094-5 (Fed. Cir. 1995).

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remote from it. The Kraetschmer reference therefore does not anticipate claim 9.

Dependent Claims

Inasmuch as the prior art does not anticipate parent claims 1 and 9, dependent claims 3 to 5, 7 and 11 to 16 are likewise not anticipated.

Rejections Under 37 C.F.R. § 1.196(b)

Pursuant to 37 C.F.R. § 1.196(b), we enter the following rejections:

(1) Claims 1, 3 to 5 and 7 are rejected under 35 U.S.C. § 112, second paragraph. The metes and bounds of the subject matter recited in claim 1 are unclear in that the term "said surface" in the penultimate line of the claim has no antecedent basis. Ex parte Reese, 128 USPQ 430 (Bd.App. 1959).

(2) Claim 7 recites:

7. The embossing foil as set forth in Claim 1 wherein said decorative layer is replaced by a reflective layer.

This claim is rejected under the fourth paragraph of 35 U.S.C. § 112 as being an improper dependent claim, in that it does not further limit parent claim 1. See also 37 C.F.R. § 1.75(c). Claim 7 does not "specify a further limitation of the subject matter claimed," and cannot be "construed to incorporate by reference all the limitations of [claim 1]," as provided by the statute, because rather than incorporating the limitation of

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claim 1 that the embossing foil includes a decorative lacquer layer, it replaces that limitation with a limitation that the embossing foil includes a reflective layer. Thus, instead of incorporating all the limitations of its parent claim, claim 7 incorporates all but one of those limitations, and adds a new limitation. This does not meet the statutory requirement for a dependent claim.

(3) Claim 14 recites:

14. The embossing foil as set forth in Claim 9 and further including a bonding layer between the decorative lacquer layer and the backing film.

Claim 14 is rejected for failure to comply with the enablement requirement of the first paragraph of 35 U.S.C. § 112. The recited bonding layer was described in the application as filed, since it was recited in original claim 14. Bocciarelli v. Huffman, 232 F.2d 647, 651, 109 USPQ 385, 388 (CCPA 1956). Nevertheless, recognizing that parent claim 9 is drawn to the embodiment disclosed in appellants' Figures 5 and 6, we find no disclosure in the specification of a bonding layer between the decorative lacquer layer 23, 24 and the backing film 21, and it is not evident how one of ordinary skill in the art would be able to carry out the invention if such a bonding layer were present. If there were a bonding layer between the decorative lacquer layer and backing film, one would not be able to put the invention into use by separating the backing film from the

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decorative layer after the decorative layer was adhered to a substrate. (In fact, appellants provide a separating or release layer 22 between backing film 21 and lacquer layer 23 "to ensure satisfactory separation of the backing film and the layer of lacquer" (p. 10, lines 27-29)).

Conclusion

The examiner's decision to reject claims 1, 3 to 5, 7, 9 and 11 to 16 under 35 U.S.C. § 102(b) is reversed. Claims 1, 3 to 5, 7 and 14 are rejected pursuant to 37 C.F.R. § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 C.F.R. § 1.197). Should the appellants elect to have further prosecution before the examiner in response to the new rejection under 37 C.F.R. § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

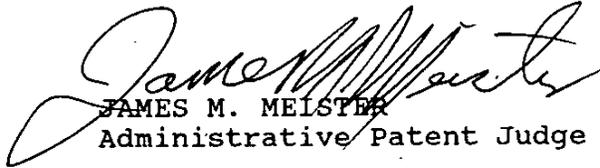
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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED; 37 C.F.R. § 1.196(b)



IAN A. CALVERT  
Administrative Patent Judge



JAMES M. MELSTER  
Administrative Patent Judge



NEAL E. ABRAMS  
Administrative Patent Judge

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