

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. PONTUTI, ROBERT W. WARNER,
RICHARD F. THEISSEN and JOHN A. NIELSEN

Appeal No. 96-0353
Application 08/099,220¹

ON BRIEF

Before ELLIS, OWENS and WALTZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 7-13, which are all of the claims remaining in the

¹ Application for patent filed July 29, 1993. According to appellants, the application is a division of Application 07/688,648, filed April 19, 1991, now U.S. Patent No. 5,260,113, issued November 9, 1993.

application.

THE INVENTION

Appellants' claimed invention is directed toward a method for joining at least two translucent sign face substrates by use of a seam tape which contains a scrim embedded in thermoplastic material, wherein the seam tape is applied to adjoining regions of the substrates by use of heat and sufficient pressure to wet out the fibers of the seam scrim, i.e., to cause the thermoplastic material to flow around and intimately wet and encapsulate the fibers (specification, page 4, lines 17-24). Claim 7 is illustrative and reads as follows:

7. A method of joining at least two translucent sign face substrates with a seam tape to form a seam having a transmissive optical density within $\pm 50\%$ of the transmissive optical density of the sign face substrate when the sign face is illuminated from behind the sign face substrate, said method comprising the steps of:

(a) providing at least two sheets of sign face material, such that each sheet comprises a composite of two layers of a thermoplastic material and a scrim layer sandwiched between the two layers of thermoplastic material;

(b) aligning said two sheets such that an edge of each sheet is in an adjoining position and defines an adjoining region without any gaps between the adjoining sheets of sign face material;

Appeal No. 96-0353
Application 08/099,220

(c) positioning a seam tape in said adjoining region such that a portion of said tape simultaneously overlays and contacts each sheet within the adjoining region and extends substantially the length of the adjoining region, said tape comprising a seam scrim substantially embedded in a seam thermoplastic material having an index of refraction similar to the scrim of the seam tape, said seam scrim capable of being substantially wetted out by said seam thermoplastic material;

(d) heating said adjoining region to a temperature which exceeds the melting temperature of said seam thermoplastic material;

(e) exerting sufficient pressure to said heated region to substantially wet out said seam scrim; and

(f) allowing said adjoining region to cool.

THE REFERENCES

Griffith 1973	3,734,795	May 22,
Stilling 1987	4,682,433	Jul. 28,

THE REJECTION

Claims 7-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griffith in view of Stilling.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejection is not well

founded. Accordingly, this rejection will be reversed.

Griffith discloses, *inter alia*, a method for joining the ends of a fabric belt made of woven polymeric plastic strands or strands coated with polymeric plastic material to form an endless machine belt, such as a drainage belt for a paper-making machine (col. 1, lines 25-31; col. 5, lines 9-11). A current-conducting wire, which may be coated with polymeric plastic material, is formed into inner and outer loops, wherein the inner loops are embedded within a strip of woven material which has warp and weft strands which contain polymeric plastic material (col. 3, lines 71-74; col. 4, lines 19-25; col. 5, lines 12-20). The strip is interposed between the ends of the belt such that the outer loops overlap with the ends of the belt (col. 5, lines 22-25). A current is impressed upon the wire to soften the polymeric plastic material while pressure is exerted against the loops so as to embed the loops in the softened polymeric plastic material, thereby forming an endless belt (col. 5, lines 26-30; Fig. 7).

Stilling discloses a vinyl fabric sign wherein the vinyl fabric comprises a woven, non-elastic, polyester fiber material coated with vinyl plastic (col. 3, lines 5-12).

Appellants argue that the examiner has identified no motivation in the references which would lead one of ordinary skill in the art to prepare optically translucent seams by use of a process wherein fine current-conducting wire is embedded in polymeric plastic material (brief, page 8).

The examiner argues that arriving at appellants' claimed method from the teachings of Griffith and Stilling merely involves substituting one plastic-coated fabric material for another (answer, pages 4-5). The seam so produced, the examiner argues (answer, page 5), would have the characteristic of appellants' seam of being minimally visible, i.e., being not optically objectionable to the naked eye at normal viewing distance (specification, page 4, lines 12-15), in spite of the presence of the conductive wire.

The examiner has not pointed out, and we do not independently find, any teaching in the evidence relied upon by the examiner which indicates that one of ordinary skill in the art would have considered a seam containing a conductive wire to be suitable for use in a sign as recited in appellants' claim 7. In order for a *prima facie* case of obviousness to be established, the teachings from the prior

Appeal No. 96-0353
Application 08/099,220

art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritsch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Because the motivation relied upon by the examiner comes solely from appellant's specification, the examiner used impermissible hindsight when rejecting the claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). We therefore do not sustain the examiner's rejection.

DECISION

The rejection of claims 7-13 under 35 U.S.C. § 103 over Griffith in view of Stilling is reversed.

REVERSED

Appeal No. 96-0353
Application 08/099,220

	JOAN ELLIS)	
	Administrative Patent Judge)	
)	
)	
)	
	TERRY J. OWENS)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	THOMAS A. WALTZ)	
	Administrative Patent Judge)	

Appeal No. 96-0353
Application 08/099,220

Carolyn V. Peters
3M Office of Intellectual Prop. Counsel
P.O. Box 33427
St. Paul, MN 55133-3427

TJO/ki