

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

\_\_\_\_\_  
Ex parte JOHN R. SMITH

\_\_\_\_\_  
Appeal No. 1996-0670  
Application No. 08/043,388<sup>1</sup>

\_\_\_\_\_  
HEARD: October 6, 1999

\_\_\_\_\_  
Before JOHN D. SMITH, WALTZ and SPIEGEL, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal from the examiner's final rejection of claims 1-5, 7-26, 28-41 and 53-54. Subsequent to the final rejection, appellants submitted an amendment dated Aug. 15, 1994, Paper No. 9, which cancelled some claims and amended claims 2-5, 7, 9, 14-15, 17-21, 23-26, 28, 30, 35-36 and 38-

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<sup>1</sup> Application for patent filed April 6, 1993.

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41. This amendment was entered by the examiner as noted in the Advisory Action dated Sept. 6, 1994, Paper No. 10. The claims now on appeal are claims 2-5, 7-21, 23-26, 28-41, and 53-54, which are the only claims remaining in this application.

According to appellant, the invention relates to a method of making a pressure sensitive adhesive-coated laminate comprising coating a sheet having a release surface with a pressure sensitive adhesive (PSA) to form a laminate, drying or curing the PSA, and marrying the laminate to the inner surface of a facing layer where an admixture of specified polysiloxanes are used to modify the PSA so as to reduce the initial tackiness by producing a low zero-minute peel value (Brief, page 2).

Appellant states that claims 2-5, 7-12, 14-21, 23-26, 28-33, 35-41, and 53-54 stand or fall together while claims 13 and 34 stand or fall together (Brief, page 3). Appellant provides specific, substantive reasons for the separate patentability of these two groups of claims on pages 8-9 of the Brief. Accordingly, we select claim 53 from the first grouping of claims and claim 13 from the second grouping of

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claims and decide the ground of rejection in this appeal on the basis of these claims alone. See 37 CFR § 1.192(c)(5)(1993). Claim 53 is illustrative of the subject matter on appeal and a copy of claim 53 is attached to this decision as an Appendix.

The examiner has relied upon the following reference as evidence of obviousness:

Sackoff et al. (Sackoff)                    4,151,319                    Apr. 24, 1979

This merits panel of the Board cites and discusses the following reference:

Warrick<sup>2</sup>                                            2,560,498                    July 10, 1951

Claims 2-5, 7-21, 23-26, 28-41 and 53-54 stand rejected under 35 U.S.C. § 103 as unpatentable over Sackoff (Answer,

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<sup>2</sup> This reference is cited and incorporated by reference on page 30 of appellant's specification. A copy of this reference is attached to this decision.

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page 3).<sup>3</sup> We *affirm* the examiner's rejection for reasons set forth in the Answer and those which follow.

#### OPINION

Appellant admits that the manipulative steps disclosed by Sackoff to make a laminate are the same as recited in the claims on appeal (Brief, page 4). Appellant further admits that Sackoff uses a polysiloxane material as a means of producing a low zero minute peel value,<sup>4</sup> as also recited in the claims on appeal (*Id.*). However, appellant argues that the claims on appeal recite a different means to produce a zero-minute peel value, namely, an admixture of two polysiloxanes denominated as polysiloxane (i) and (ii)(Brief,

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<sup>3</sup> The final rejection of claims 1-5, 7-26, 28-41 and 53-54 under § 103 as unpatentable over Sackoff in view of Laurent (U.S. Patent No. 4,346,189, issued Aug. 24, 1982) was not repeated in the Answer (see the Answer, page 2, paragraph (4), and the final rejection dated May 9, 1994, Paper No. 7, page 3). Although the examiner did not explicitly withdraw this rejection in the Answer, the amendment dated Aug. 15, 1994, Paper No. 9, pages 5-6, assumes this rejection will be withdrawn in view of the proposed amendment. Regardless, this rejection is not before us on appeal. See *Paperless Accounting v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 663, 231 USPQ 649, 652 (Fed. Cir. 1986).

<sup>4</sup> "Peel Value" and "zero minute peel value" are defined in appellant's specification at pages 24-25 and also in Sackoff at columns 12-13.

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page 5). Appellant submits that Sackoff discloses using any of five different classes of polysiloxanes, including the two classes (i) and (ii) recited in the claims on appeal, but does not teach an admixture of two polysiloxane materials (*Id.*). Appellant further argues that polysiloxane (i) as recited in the claims on appeal requires a much lower molecular weight than taught by Sackoff for the corresponding polysiloxane component (Brief, pages 5, 7 and 8). Appellant also cites *In re Baird*<sup>5</sup> for the holding that a generic disclosure does not render obvious a species, particularly when the reference (Sackoff) teaches away from the molecular weight of the polysiloxane (i) component (Brief, pages 8-9).

The examiner states that Sackoff discloses both polysiloxane (i) and (ii) for inclusion with PSA and "that it would have been obvious to one of ordinary skill in this art to employ a combination/mixture of such water soluble and polyalkyl polysiloxanes in conjunction with the PSA" in view of the "principle" of *In re Kerkhoven* (Answer, page 4).<sup>6</sup> The

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<sup>5</sup> 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994).

<sup>6</sup> The examiner incorrectly cites *Corometrics v. Berkeley* for the "principle" on page 4 of the Answer (also repeated on

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examiner states that the same classes of siloxane are admittedly used by Sackoff as are employed by appellant and this would apparently insure that, when using a mixture of such siloxanes, the same results would be obtained (Answer, page 5).

Sackoff discloses that "the material used to decrease the 'zero minute peel value' is a polysiloxane and must be capable of being intimately mixed and dispersed throughout the pressure sensitive adhesive." (column 2, lines 42-45).

Sackoff specifically discloses five classes of polysiloxane materials that produce the "desired advantageous properties" (column 13, line 59; the classes of materials are listed at column 13, line 60-column 14, line 38). We agree with the examiner that it would have been *prima facie* obvious to combine two known materials, each of which was taught by Sackoff to be useful to produce advantageous properties when

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page 6 of the Answer). It is apparent that the examiner stated the correct USPQ citation but meant to cite *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) for the "principle" that it would have been obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition to be used for the very same purpose. See *Kerkhoven*, 626 F.2d at 850, 205 USPQ at 1072.

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mixed with the PSA, in order to form an admixture with the PSA for the very same properties. "[T]he idea [or motivation] of combining them flows logically from their having been individually taught in the prior art." *Kerkhoven, supra*. See also *In re Castner*, 518 F.2d 1234, 1238-39, 186 USPQ 213, 217 (CCPA 1975); *In re Crockett*, 279 F.2d 274, 276, 126 USPQ 186, 188 (CCPA 1960); *In re Sussman*, 136 F.2d 715, 718, 58 USPQ 262, 264 (CCPA 1943); and *Ex parte Quadranti*, 25 USPQ2d 1071, 1072 (Bd. Pat. App. & Int. 1992).

Appellant's arguments are not well taken for the following reasons. Any holding from *Baird, supra*, is not applicable to the fact situation of this rejection. The choice or selection from the disclosure of Sackoff is rather narrow, i.e., merely selecting an admixture of two classes of polysiloxanes from the five classes of polysiloxanes disclosed by Sackoff. Furthermore, Sackoff teaches a preference for various classes of  $R_1$  values, including the classes denominated as polysiloxanes (i) and (ii) in the claims on appeal (see Sackoff, column 14, lines 39 and 62; column 15, lines 6, 26, 41, and 46). Contrary to appellant's

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interpretation of Sackoff, the reference does not "teach away" from the molecular weight range, as shown by the viscosity, recited for polysiloxane (i) in claim 53 on appeal (a viscosity range of 5 to 60,000 cps). One corresponding class of polysiloxanes taught by Sackoff touches the endpoint of the claimed range at "about" 60,000 cps viscosity (column 15, lines 41-45). Sackoff further incorporates by reference the polysiloxanes of Warrick, which discloses polysiloxanes having a viscosity range of 2,000 to 8,000 cs (see Sackoff, column 15, lines 53-56, and Examples 1-12 of Warrick). Appellants incorporate by reference this same patent (specification, page 29, line 23-page 30, line 3). Therefore the claimed viscosity range for polysiloxane (i) would have been suggested to one of ordinary skill in the art from the Sackoff disclosure, whether considering the viscosity limitation of claim 53 on appeal (5 to 60,000 cps) or claim 13 on appeal (1,000 to 3,000 cps).

Appellant submits that the specific data indicating improved results, as set forth in Figure 8 of the specification, are sufficient to overcome a *prima facie* case of obviousness (Reply Brief, pages 2-3). Once the examiner has established a *prima facie* case of obviousness and

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appellant has submitted evidence in rebuttal, we determine the patentability anew by the preponderance of evidence based on the totality of the record. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Having reviewed the data in Figure 8, as disclosed on pages 33-34 of the specification, we determine that appellant has not met the burden of showing unexpected results. *See In re Geisler*, 116 F.3d 1465, 1469-70, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972). Initially, we note that it is not enough that the results for appellant's invention and the prior art are different. Appellant must demonstrate that such results are unexpected. *Geisler*, 116 F.3d at 1469-70, 43 USPQ2d at 1365; *Klosak*, 455 F.2d at 1080, 173 USPQ at 16. Appellant has not explained the results or procedures of Example 1 on pages 33-34 of the specification which result in the production of the data set forth in Figure 8. The comparative examples should be accomplished in the same manner except for the polysiloxane used but the

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specification merely states that the comparison was done "in similar fashion" (page 34, line 17). The specification also fails to disclose the specific procedure for the comparative example where the dimethyl silicone component is not present (representing the "prior art", see Figure 8). The amount of the remaining component, a dimethylsiloxane-oxyalkylene block copolymer, is not disclosed. Therefore we cannot determine whether equal amounts of the polysiloxane materials were compared. Finally, we observe that the showing in the specification is not reasonably commensurate in scope with the degree of protection sought by the claims on appeal. *In re Kulling*, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983). While the showing is based on specific polysiloxanes, viscosities, weight ratios, pressure sensitive adhesive, and laminate film, the claims on appeal are not so limited (especially claim 53). Appellant has not shown that the results of Example 1 in the specification are commensurate in scope with the claims on appeal or would be reasonably predictive of the subject matter on appeal.

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For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a *prima facie* case of obviousness. Based on the totality of the record, with due consideration of appellant's arguments and evidence, we determine that the preponderance of evidence weighs in favor of obviousness within the meaning of 35 U.S.C. § 103. Accordingly, the

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rejection of claims 2-5, 7-21, 23-26, 28-41 and 53-54 under  
35 U.S.C. § 103 as unpatentable over Sackoff is affirmed.

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

**AFFIRMED**

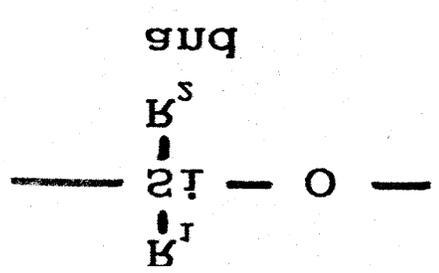
JOHN D. SMITH	)	
Administrative Patent Judge	)	
	)	
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	)	BOARD OF PATENT
THOMAS A. WALTZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
CAROL A. SPIEGEL	)	
Administrative Patent Judge	)	

jrg

APPENDIX

FOOTNOTES:

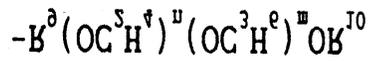
FOOTNOTES FROM MONOMERIC NITRATES (I) AND (II) AS  
FUNCTIONS AND FUNCTIONS IN THE PRESSURE SENSITIVE ADHESIVE AND  
ADHESIVE, THE POLYMERIZATION (I) REFINED SUPPLEMENTARY MATERIALS  
AND (II) IN THE FUNCTIONAL COMPOSITION WITH THE PRESSURE SENSITIVE  
PRESSURE SENSITIVE ADHESIVE OF AN ADHESIVE OF POLYMERIZATION (I)  
FROM 0.1 TO 1.0 PERCENT BASED ON THE SOLIDS CONTENT OF THE  
SENSITIVE ADHESIVE POLYMERIZATION, THE MEANS COMBINING FROM  
THE "ZERO POINT OF THE LINE" OF THE POLYMERIZATION POLYMERIZATION  
COMBINING A PRESSURE SENSITIVE ADHESIVE AND MEANS FOR DECREASING  
OTHER SURFACES: THE MODIFIED PRESSURE SENSITIVE ADHESIVE  
FUNCTIONS TO THE INNER SURFACE OF A POLYMERIZATION POLYMERIZATION  
PRESSURE SENSITIVE ADHESIVE SIDE OF THE FILM CREATED FIRST  
TO GIVE OR GIVE THE PRESSURE SENSITIVE ADHESIVE, AND MAKING THE  
FUNCTIONS, SUPPLEMENTARY THE FIRST FUNCTION TO CONDITIONS SURFACE  
WITH A MODIFIED PRESSURE SENSITIVE ADHESIVE TO GIVE A FIRST  
COMBINING COMBINING A FIRST SURFACE POLYMERIZATION A RELEASE SURFACE THEREON  
23: AN IMPROVED METHOD FOR MAKING A FUNCTION



(I)

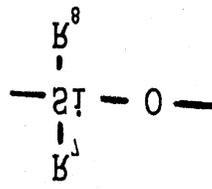


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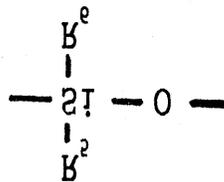
ξοικωπησ

μμερετυ B<sup>2</sup> ισ σ βογλοχλαηκλεμε διοπε μβαλυμδ εμε εφικαεφικαη



(II9)

εμσ



(I9)

wherein  $R_{10}$  is hydrogen or a monovalent hydrocarbon group having from 1 to 10 carbon atoms and contains both oxyethylene and oxypropylene units,  $R_9$  is an alkylene group having at least two carbon atoms,  $n$  and  $m$  are numbers, the sum of  $n$  and  $m$  is at least 1 and the oxyalkylene unit  $R_{10}O(OC_3H_6)_m(C_2H_4O)_n$ , has a molecular weight of at least about 80, and wherein there are at least two units having structure (Ia) and at least three units having structure (IIa) and wherein the oxyalkylene unit constitutes from about 85 to 30 weight percent of the polysiloxane polymer;  $R_6$  may be methyl, ethyl, or phenyl; and  $R_7$  and  $R_8$  may be the same or different and may be methyl or ethyl, and said polysiloxane (ii) has a viscosity in the range of from 50 to 5000 cps measured at 25° C with a #4 spindle at 30 rpm, the amount of polysiloxane (i) in said admixture being effective to separate from the adhesive and to bloom to the adhesive/air interface of said first laminate coated with said adhesive composition to provide efficient repositionability and the amount of polysiloxane (ii) in said admixture being effective to provide faster wet-out of the adhesive to a bonding substrate and, ultimately, superior adhesion thereto.

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JENINE GILLIS

ATTN: Warrick reference (2,560,498) is  
in the envelope--ready to be mailed.

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Serial No.

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Judge WALTZ

Judge SPIEGEL

Judge JOHN D.

SMITH

Received: 10/19/99

Typed: 10/19/99

DECISION: AFFIRMED

Send Reference(s): Yes No  
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 1700

Index Sheet-2901 Rejection(s):

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Acts 2: \_\_\_\_\_

Palm: \_\_\_\_\_

Mailed:

Updated Monthly Disk (FOIA): \_\_\_\_\_

Updated Monthly Report: \_\_\_\_\_