

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEA BARDEEN

Appeal No. 1996-1291
Application No. 08/182,409¹

HEARD: November 4, 1999

Before JOHN D. SMITH, PAK and SPIEGEL, **Administrative Patent Judges**.

PAK, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 3, 4, 6-13, 15, 17, 20, 21 and 32. Claims 16 and 22 through 31 stand withdrawn from consideration by the examiner as drawn to a non-elected invention.

¹ Application for patent filed January 14, 1994.

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The subject matter on appeal is directed to a surface decorating technique that is especially suitable for children. See specification, page 3, line 25 to page 4, line 6. Claims 1, 17 and 32 are illustrative and read as follows:

1. A method of decorating a surface of an item that has an area adapted to display a design, comprising the steps of:

(a) spreading a quantity of a viscous surface preparatory composition onto the area so as to cover the area with a viscous preparatory layer wherein said surface preparatory composition has an initial first state that allows it to be spread onto the surface of the item as the viscous preparatory layer and wherein said surface preparatory composition is curable to a final state that forms a stable layer adhered to the surface;

(b) providing a pattern sheet with the pattern formed thereon in a medium that will transfer onto said surface preparatory composition when in the initial state;

(c) contacting said preparatory layer with said pattern sheet and the pattern sheet thereon for a sufficient time to allow said medium to transfer onto said preparatory layer where a transferred pattern transfers onto said preparatory layer;

(d) removing said pattern sheet from contact with said viscous preparatory layer after the transferred pattern has been transferred thereon yet before said preparatory layer has cured into the final state; and

(e) curing said preparatory layer into the final state thereby fixing the transferred pattern.

17. A method of decorating a surface of an item of produce that has an area sufficient size to display a design, comprising the steps of:

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(a) providing a pattern sheet with the pattern pre-printed thereon in a water soluble medium;

(b) covering the area with a water-based surface preparatory composition that has an initial first state that allows it to be spread onto the surface of the item as a viscous preparatory layer yet which cures into a final state to form a stably layer adhered to the surface, said selected medium being selected as one that will transfer onto said surface preparatory composition when int he [sic, in the] initial state;

(c) contacting said preparatory layer with said pattern sheet for a sufficient time to allow said medium to transfer onto said preparatory layer whereby a transferred pattern transfers onto said preparatory layer and thereafter removing said pattern sheet within a time insufficient to allow said pattern sheet to become affixed to said item of produce; and

(d) allowing said preparatory layer to cure into said final state thereby fixing the transferred pattern on said stable layer.

32. A method of decorating a surface of an item that has an area adapted to display a design, comprising the steps of:

(a) covering the area with a surface preparatory composition that has an initial first state that is sufficiently viscous to allow it to spread onto the surface of the item as a preparatory layer, said surface preparatory composition being selected from a group consisting of: water-based non-animal glues, water-based animal glues, water-based pastes and egg white;

(b) providing a pattern sheet with the pattern formed thereon in a medium that will transfer onto said surface preparatory composition when in the initial state; and

(c) contacting said preparatory layer with said pattern sheet and the pattern thereon for a sufficient time to allow

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said medium to transfer onto said preparatory layer where a transferred pattern transfers onto said preparatory layer.

As evidence of obviousness, the examiner relies on the following prior art:

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| Golchert 1977 | 4,024,287 | May 17, |
| Kitabatake 1979 | 4,169,169 | Sep. 25, |
| Takiyama et al. (Takiyama) 1984 | 4,490,410 | Dec. 25, |

Claims 1, 3, 4, 6 through 8, 11 through 13, 17, 20, 21 and 32 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Kitabatake and Takiyama.

Claims 9, 10, 15 and 21 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Kitabatake, Takiyama and Golchert.

We have carefully reviewed the specification, claims and applied prior art, including all of the arguments advanced by both the examiner and appellant in support of their respective positions. This review leads us to conclude that the examiner's § 103 rejections are not well founded.

Accordingly, we will not sustain any of the foregoing § 103 rejections for essentially those reasons set forth in the

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Brief. We add the following primarily for emphasis and completeness.

The claimed subject matter is directed to a decorating technique especially usable by children in the decoration of pumpkins for Halloween. See, e.g., specification, page 4, lines 1-6. The decorating technique comprises spreading a viscous composition on a surface area of an item, such as a pumpkin, transferring a medium containing a design on a pattern sheet to the viscous composition "in the initial state," removing the pattern sheet from contact with the viscous composition before the composition is cured, and curing the viscous composition to fix the transferred design. See claims 1 and 17. The viscous composition is selected from the group consisting of water-based non-animal glues, water-based animal glues, water-based pastes and egg white. See claim 32.

The examiner takes the position that "[i]t would have been obvious at the time the invention was made to have utilized Takiyama et al.'s resin transferring layer in Kitabatake's transfer process" (see Answer, page 5) and "to have utilized Golchert's method or producing printing transfer

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patterns for Kitabatake's 'pre-printed' transfer pattern" (see Answer, page 6). To establish obviousness within the meaning of 35 U.S.C.

§ 103, the teachings of the prior art taken as a whole must provide motivation or suggestion to arrive at the claimed subject matter. *See Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 550-51 (Fed. Cir. 1985). However, for the reasons well articulated by appellant at pages 5 through 10 of the Brief, we can think of no reason, absent appellant's own disclosure, why one of ordinary skill in this art would have been motivated to combine the diverse teachings of Kitabatake, Takiyama and Golchert as the examiner has proposed. Although we find that the transfer method of the type described in Kitabatake is useful for "almost all objects including human skin, clothes, building materials and the like," see column 1, lines 65 to column 2, line 3, the types of chemicals used in Kitabatake's transfer method are materially different from those chemicals described in Takiyama, compare Kitabatake,

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columns 2 through 4, with Takiyama, columns 2 through 4. Nowhere does either Kitabatake and/or Takiyama indicate that the chemicals of the type described in Takiyama are useful for the transfer method described in Kitabatake. See Takiyama and Kitabatake in their entirety. Nor does Golchert remedy this deficiency. See Golchert in its entirety. To employ the chemicals described in Takiyama in the transfer method of Kitabatake is to destroy the invention on which Kitabatake is based, for the use of such chemicals materially compromises the objectives of Kitabatake. **See *Ex parte Hartmann***, 186 USPQ 366, 367 (Bd. App. 1974). Accordingly, we cannot sustain any of the examiner's § 103 rejections.

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

REVERSED

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| JOHN D. SMITH |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHUNG K. PAK |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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