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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 GILBERT BLOCH,
ARNOLD B. FINESTONE
and
GERALD BLOCH

Appeal No. 96-3315
Application 08/209,405[1]

ON BRIEF

Before MEISTER, FRANKFORT and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

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[1] Application for patent filed March 14, 1994. According to appellants, the application is a continuation-in-part of Application 07/975,080, filed November 12, 1992, abandoned.

DECISION ON APPEAL

This is a decision on appeal from the refusal of the examiner to allow claims 1, 2, 3 and 10 through 14 as amended subsequent to the final rejection. Claims 1, 2, 3 and 10 through 14 are all of the claims remaining in the application. Claims 4 through 9 have been canceled.

Appellants' invention relates to a pressure-sensitive sealing tape having sufficient strength, stiffness and body to enable the tape, when in roll form, to be dispensed from a conventional pull and tear tape dispenser. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim may be found in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hurst	3,632,386	Jan. 4, 1972
Lutzmann et al. (Lutzmann)	4,096,013	June 20, 1978
Williams	4,557,971	Dec. 10, 1985

Claims 1, 2, 3 and 10 through 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hurst in view of Williams and Lutzmann.

Rather than reiterate the examiner's full statement of the above-noted rejection and the conflicting viewpoints advanced

by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 15, mailed June 11, 1996) for the examiner's complete reasoning in support of the rejection, and to appellants' brief (Paper No. 14, filed February 22, 1996) and reply brief (Paper No. 16, filed June 17, 1996) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner.

As a consequence of our review, we have reached the determination which follows.

Like appellants, even if we were to agree that it would have been obvious to one of ordinary skill in the art to modify Hurst's roll-form release sheet/tape in the manner urged by the examiner in view of Williams and Lutzmann (answer, page 4), we are of the view that such modifications would <u>not</u> produce a pressure-sensitive sealing tape as set forth in the claims before us on appeal. Independent claim 1 defines the sealing tape therein as "consisting essentially of:" A) a thin, biaxially oriented, synthetic-plastic film ply; B) a paper ply cold laminated to the inner surface of the plastic film ply by a water-based adhesive to form a laminate; C) a layer of pressure-sensitive adhesive "coating one side of the laminate;" and D) a release agent "coating the other side of the laminate. Thus, claim 1 requires a sealing tape having five (5) layers and excludes any other layers that would materially

affect the basic and novel characteristics of the claimed sealing tape.

Hurst, Figure 1, discloses a release sheet or tape having eleven (11) layers, with paper layer (12) and plastic film layers (13) being affixed together with primer coatings to define a laminate, which laminate then has silicon release coatings (14, 16) applied thereto, pressure-sensitive adhesive layers (18) applied over the silicon release layers and backings (20) applied over the adhesive layers. Hurst makes no mention of a biaxially oriented plastic film, of corona discharge treatment, or of cold lamination of the paper and plastic layers using water-based adhesive. Moreover, even if the plastic film layers and the primer coating layers of Hurst were to be replaced with
biaxially oriented plastic film layers that have been corona discharge treated to accept a water-based adhesive so as to allow

cold lamination, as is urged by the examiner, we fail to find that the examiner's combination would result in or render obvious the sealing tape particularly set forth in the claims before us on appeal.

In the first place, the examiner's finding (answer, page 4) that Hurst discloses a pressure sensitive adhesive tape comprising

> a paper-plastic laminate coated on one side with a pressure sensitive adhesive and coated on the other side with a release agent

is factually incorrect. Although the silicone release layer (14) pointed to by the examiner on page 5 of the answer is certainly coated on one side of the laminate in Hurst, the other side of the laminate is likewise coated with a silicone release layer (16) that is intermediate the plastic film of the laminate and the pressure-sensitive adhesive layer (18) located on that side, thereby precluding the pressure-sensitive adhesive from "coating one side of the laminate," as in appellants' claim 1. Unlike the examiner, we are of the

opinion that the language of appellants' claim 1 requires that the pressure-sensitive adhesive be applied as a coating directly on one side of the laminate, while the release agent is applied as a coating directly on the other side of the laminate. As a second point, we consider that the examiner has totally disregarded the limiting effect of the "consisting essentially of" language of appellants' claim 1.

Thus, after considering the combined teachings of the applied references, it is our determination that the examiner has <u>not</u> established a <u>prima facie</u> case of obviousness with regard to appellants' claimed sealing tape. For that reason, we will not sustain the examiner's rejection of claims 1, 2, 3 and 10 through 14 under 35 U.S.C. § 103.

The decision of the examiner rejecting claims 1, 2, 3 and 10 through 14 of the present application is reversed.

<u>REVERSED</u>

JAMES M. MEISTER)
Administrative Patent Judge)
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) BOARD OF PATENT
CHARLES E. FRANKFORT) APPEALS AND
Administrative Patent Judge) INTERFER-ENCES
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