

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TIMOTHY J. RUSS, KHAL M. KHATIB  
and JAY O. BAKER

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Appeal No. 96-3332  
Application 08/321,025<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge, COHEN  
and McQUADE Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 10 and 22 through 25. These claims constitute all of the claims remaining in the application.

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<sup>1</sup> Application for patent filed October 6, 1994.

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Appellants' invention pertains to a web of linerless labels. As articulated in the specification (page 4), it is "the primary object of the present invention to provide optimized perforation lines in label webs, particularly linerless label webs." A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the APPENDIX to the main brief (Paper No. 7).

As evidence of obviousness, the examiner has applied the documents listed below:

Mitchell et al. 1994 (Mitchell) 1992)	5,354,588	Oct. 11,  (filed Jul. 13,
Cohausz 1980 (Germany)	2,909,276	Sep. 18,

The following rejections are before us for review.

Claims 1 through 4, 7 through 9, 24, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mitchell.

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Claims 5, 6, 10, 22, and 23 stand rejected under 35  
U.S.C.  
§ 103 as being unpatentable over Mitchell, as applied above,  
further in view of Cohausz.<sup>2</sup>

The full text of the examiner's rejections and response  
to the argument presented by appellants appears in the main  
and supplemental answers (Paper Nos. 9, 11, and 13), while the  
complete statement of appellants' argument can be found in the  
main and reply briefs (Paper Nos. 7 and 12).

#### OPINION

In reaching our conclusion on the obviousness issues  
raised in this appeal, this panel of the board has carefully  
considered appellants' specification and claims, the applied  
teachings,<sup>3</sup> and the respective viewpoints of appellants and

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<sup>2</sup> This was a new ground of rejection set forth in the main answer (Paper No. 9),  
as corrected by the supplemental answer dated Sep. 28, 1995 (Paper No. 11), applying the  
newly cited Cohausz reference.

<sup>3</sup> In our evaluation of the applied teachings, we have considered all of the  
disclosure of each teaching for what it would have fairly taught one of ordinary skill  
in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966).

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the examiner. As a consequence of our review, we make the determination which follows.

The respective rejections of appellants' claims under 35 U.S.C. § 103 cannot be sustained.<sup>4</sup>

As earlier noted, the invention on appeal is based upon the primary object of providing optimized perforation lines in linerless label webs.

As readily discernible from the content of the rejection

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Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

<sup>4</sup> We lack a full understanding of the notation used by appellants in claim 1, i.e., a cut to tie ratio of ".018 x .008 to .012 x .008". The meaning of "x" is not apparent, particularly in conjunction with ".008". Further, it is unclear to us whether .018 x .008 to .012 x .008 is intended to set forth a ratio or whether this expression denotes a range of values for the ratio. This matter will be raised in our remand to the examiner, infra. Nevertheless, we understand claim 1 to the extent that we can address the deficiency of the examiner's rejection under 35 U.S.C. § 103.

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of claims 1 through 4, 7 through 9, 24, and 25 on page 3 in the main answer (Paper No. 9), the examiner's determination of obviousness is based upon a conclusion unsupported by factual evidence. The Mitchell document (U.S. Patent No. 5,354,588), cited by appellants in the specification (page 7), simply addresses very fine perforations or die cuts (column 3, lines 42 through 48), indicated by cut lines 37 in Fig. 3, without any perceived mention of a cut to tie ratio, as now claimed. A rejection under 35 U.S.C. § 103 must rest on a factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). The examiner's rejection lacks such a basis and, therefore, must be reversed.

The rejection of dependent claims 5, 6, 10, 22, and 23 under 35 U.S.C. § 103 is likewise reversed since, notwithstanding the teaching of incisions 8 at the edge of a tape, the Cohausz document does not overcome the deficiency of the Mitchell reference highlighted above.

REMAND TO THE EXAMINER

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We remand this application to the examiner to consider the matters specified below.

As discussed earlier in this opinion, the definite meaning of the notation of claim 1 (cut to tie ratio of ".018 x .008 to .012 x .008") should be established in the record.

The evidence in the application file, for example, U.S. Patent Nos. 5,240,755, 5,537,905, 5,114,771, 4,745,835 cited by appellants, should be assessed to ascertain whether these documents provide a factual basis for a conclusion of obviousness relative to the claimed invention, keeping in mind the general principle that the discovery of an optimum value of a recognized result effective variable is ordinarily within the skill of the art, and hence obvious, absent a showing of unexpected results. See In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990) and In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1990).

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In summary, this panel of the board has:

reversed the rejection of claims 1 through 4, 7 through 9, 24, and 25 under 35 U.S.C. § 103 as being unpatentable over Mitchell; and

reversed the rejection of claims 5, 6, 10, 22, and 23 under 35 U.S.C. § 103 as being unpatentable over Mitchell and Cohausz.

Additionally, we have remanded the application for consideration of specified matters.

The decision of the examiner is reversed.

REVERSED AND REMANDED

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HARRISON E. McCANDLISH  
Senior Administrative Patent Judge

IRWIN CHARLES COHEN  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

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