

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE L. SAMMIS

Appeal No. 1997-1423
Application No. 08/421,025

HEARD: February 24, 2000

Before WINTERS, JOHN D. SMITH, and OWENS, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 8-22.

Claim 8 is representative and is reproduced below:

8. A method for fabricating a personally colored decal for transfer from a transfer sheet (10) onto a section of fabric clothing (20), said method comprising the steps of:

providing a paper sheet (12) treated with a release agent layer disposed thereover;

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applying a transparent layer (16) of fluidic thermo-plastic transfer material directly onto the release agent on the paper sheet (12) for establishing a discrete area of transfer material on the paper sheet (12) devoid of inks or other opaque agents and suitable for coloring by a consumer, the transfer layer (16) being adapted to bond to the release agent in ambient conditions and release therefrom in response to a predetermined elevated temperature;

solidifying the transfer layer (16);

disposing a plurality of non-water soluble adhesive-abrasive particles (18) on the transparent layer (16) for providing a rough surface for abrading crayon (22) rubbed thereover;

applying heat to the adhesive-abrasive particles (18) above the melting temperature of the adhesive-abrasive particles (18); and

characterized by melting the non-water soluble adhesive-abrasive particles (18) to form an adhesive (18).

The references of record relied upon by the examiner are :

Reed et al. (Reed)	4,294,641	Oct.	13,
1981			
Hare	4,980,224	Dec.	
25, 1990			

The appealed claims stand rejected under 35 U.S.C. § 103 as unpatentable over Hare in view of Reed.

We cannot sustain this rejection.

The subject matter on appeal is directed to a method of fabricating a decal for transfer onto a section of fabric, such as a t-shirt, that may be personally colored.

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Specifically, in the claimed method, a transparent transfer layer of thermoplastic material is applied and solidified on a release layer disposed on a paper sheet. Thereafter, a plurality of non-water soluble adhesive-abrasive particles are disposed in the transfer layer for providing a rough surface such that a crayon rubbed over the surface is abraded to form a crayon coated surface on the transfer sheet. When the decal is transferred onto a fabric, the adhesive-abrasive particles are heated above their melting point to render the particles adhesive so that a bond is formed with the fabric. As described in his specification at page 8, lines 27-29, the adhesive-abrasive particles form "[a]n extremely strong mechanical adhesive bond when melted into the fibers of a section of fabric" which "[g]reatly improves the wear characteristics of the transfer sheet...".

The examiner's conclusion that the herein claimed process would have been obvious to a person of ordinary skill in the art is necessarily predicated on his factual determination that certain particulate particles described in the Reed patent are inherently water-insoluble "adhesive-abrasive" particles as claimed by appellants. Thus, in his answer at

page 7, the examiner contends that the polyester particles employed in Reed's transfer process "[w]ill inherently exhibit the same physical properties ('adhesive-abrasive') of the polyester particles used in the present invention (emphasis added)". To support this argument, the examiner observes that appellants' "adhesive-abrasive" particles may be polyester particles as described in the specification at page 8, line 22. On the other hand, appellant argues that the Reed particles are neither adhesives nor abrasives as required by the language of their claims. See the brief at page 5 and the Sammis declaration at page 2. For the reasons below, we agree with appellant that the examiner has failed to meet his burden of establishing as a factual matter that the Reed particles are inherently "adhesive-abrasive" particles as claimed by appellant.

Reed discloses a heat transfer sheet (used for the application of designs to textiles) which comprises a flexible carrier sheet or web bearing a transfer layer of a polymer composition which is rendered non-blocking at normal temperatures by a particulate solid dispersed therein. Reed's solid particles are so selected that at the melting

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temperature of the transfer layer they are either removed by sublimation or converted to a form "which does not interfere with the transfer of the design to the textile." See the Reed abstract. Reed does disclose that particulate polyesters may be used as non-blocking particles in the transfer sheet, but further specifies that such polyesters are low molecular weight linear polyesters which, when melted, form a phase separate from the polymeric transfer layer. See Reed at column 5, lines 7-11. Although appellant describes the use of a polyester as the source of his "adhesive-abrasive" particles as a preferred embodiment of his invention, appellant identifies the particulate polyester for the claimed invention as ground polyester which is "commonly used in the textile industry to adhere sections of fabric together". See the specification at page 8, lines 22-24. Moreover, appellant defines his "abrasive-adhesive" particles as forming "an extremely strong mechanical adhesive bond when melted into the fibers of a section of fabric" (specification at page 8, lines 27-29), not a separate phase which "does not interfere" with the transfer of Reed's design to the fabric. Accordingly,

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there is no express indication in Reed that these prior art polyester particles possess any adhesive properties.

Here, we further observe that because there is a paucity of detailed and specific disclosures regarding the low molecular weight linear polyester particles of Reed, a comparative factual analysis between the claimed "adhesive-abrasive" particle components and the Reed particles, such as made in In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), cannot be undertaken. Inherency is a question of fact and cannot be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). While it may be possible that the low molecular weight linear polyester particles of Reed possess some degree of adhesiveness when melted, that "possibility" is not sufficient to establish a prima facie case that such particles are "adhesive-abrasive" particles within the meaning of the claim language in question. Accordingly, even if we agreed with the examiner that a person of ordinary skill in this art would have been motivated by Reed's disclosure¹ (that

¹ See Reed at column 7, lines 16-21.

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APJ JOHN D. SMITH

APJ OWENS

APJ WINTERS

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: December 20, 2000

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT