

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL M. CUMMINGS

Appeal No. 1997-3243
Application 08/290,093

ON BRIEF

Before JOHN D. SMITH, OWENS, and KRATZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 10, 13-18 and 20. Claims 1-9 and 11, which are all of the other claims remaining in the application, stand withdrawn from consideration by the examiner as being directed toward a

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nonelected invention.

THE INVENTION

Appellant's claimed invention is directed toward a product for forming mailers, which includes a paper web which has a pressure sensitive adhesive applied to at least one of its faces in a pattern for forming mailers. The web is wound into a roll to form multiple plies under a specified tension such that the magnitude of the tension and the weight of the roll are insufficient for the adhesive on one roll ply to adhere to an adjacent roll ply. Claim 10 is illustrative and reads as follows:

10. A roll pressure seal product for forming mailers comprising:

a roll formed of a paper web wound to form multiple plies;

a pressure-sensitive adhesive applied to portions of at least one face of said paper web and arranged in a predetermined pattern for forming multi-ply mailers, said roll being wound under a predetermined web tension between about 1.5 to 3.0 lbs/lineal inch and having a weight sufficient to avoid adhesion of the pressure-sensitive adhesive between adjacent roll plies at said face portions.

THE REFERENCES

Parrotta	4,376,151	Mar. 8,
1983		

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Sakai
1990

4,918,128

Apr. 17,

THE REJECTION

Claims 10, 13-18 and 20 stand rejected under 35 U.S.C.
§ 103 over Parrotta in view of Sakai.

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the aforementioned rejection is not well founded. Accordingly, we reverse this rejection.

During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); *In re Herz*, 537 F.2d 549, 551, 190 USPQ 461, 463 (CCPA 1976); *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976). In so interpreting appellant's claim 10, which is the sole independent claim, we

consider the claim to require that the pressure sensitive adhesive is applied to the paper prior to the paper being wound into a roll.

Parrotta discloses an adhesive product which includes a substrate, an intermediate layer of a normally tacky pressure sensitive adhesive, and a top layer of microspheres (col. 2, lines 25-34). The microspheres cover the adhesive layer such that the surface has substantially no tack when the microsphere layer remains intact, but is tacky when sufficient pressure is applied to the product to cause the microspheres to be displaced into the adhesive layer, thereby exposing the adhesive layer (col. 2, lines 34-37; col. 4, lines 3-16).

The examiner argues that Parrotta discloses at column 1, lines 7-11, column 2, lines 17-21, column 5, lines 4-33, and figure 2, a product like appellant's claimed product except for the predetermined web tension and the specific genus of adhesives (answer, page 3). We do not find in the portions of the reference relied upon by the examiner any indication that the adhesive is applied to the substrate prior to the substrate being wound into a roll as required by appellant's

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independent claim. Appellant argues (brief, page 6) that the declaration of Jenkins (filed March 31, 1995, paper no. 15) indicates that Parrotta applies his adhesive after the roll is unwound. The examiner does not present any evidence that one of ordinary skill in the art would have interpreted this reference in a manner contrary to Jenkins' interpretation.

The examiner argues that even if Parrotta applies his adhesive after the roll is unwound, it is within the level of ordinary skill in the art to apply adhesive to a web prior to the web being wound into a roll (answer, pages 3-5). The relevant inquiry, however, when determining whether it would have been *prima facie* obvious to one of ordinary skill in the art to modify the prior art so as to arrive at a claimed invention, is not whether such a modification would have been within the level of skill of one of ordinary skill in the art but, rather, is whether the teachings from the prior art itself would have fairly suggested the modification to such a person. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ

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143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. See *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84. The examiner has not provided such an explanation. The examiner argues that adhesive tapes, wall paper and label stock are commonly provided as an adhesive-coated web in the form of a roll (answer, page 5), but does not explain why an awareness of such products would have fairly suggested, to one of ordinary skill in the art, modifying Parrotta as proposed by the examiner.

For the above reasons, we find that the examiner has not set forth a factual basis which is sufficient for supporting a conclusion of *prima facie* obviousness of the invention recited in any of appellant's claims.¹ Consequently, we reverse the

¹The examiner does not rely upon Sakai for any teaching which would remedy the above-discussed deficiency in Parrotta.

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examiner's rejection. Because no *prima facie* case of obviousness has been established, we need not address appellant's evidence of commercial success. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

DECISION

The rejection of claims 10, 13-18 and 20 under 35 U.S.C. § 103 over Parrotta in view of Sakai is reversed.

REVERSED

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JOHN D. SMITH)	
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