

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DONALD R. DRESSLER

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Appeal No. 1999-2511  
Application 08/847,414

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ON BRIEF

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Before OWENS, WALTZ, and DELMENDO, Administrative Patent Judges.  
WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal from the examiner's final rejection of claims 25-28, 30, 31, 39 and 40 (see the Brief, page 2). Claims 1-24 and 33-38, the only other claims pending in this application, stand withdrawn from further consideration by the examiner as drawn to a nonelected invention (see the Final Office

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action dated June 24, 1998, Paper No. 25; Answer, page 2).<sup>1</sup> We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to the field of heat-applied fabric transfers where the transfer comprises a laminate, containing a carrier, a thermoplastic material, and a carrier adhesive which exhibits decreasing peel strength with increasing temperature (Brief, page 2). A copy of illustrative independent claim 25 is attached as an Appendix to this decision.

The examiner has relied upon the following references as evidence of obviousness:

Asnes	3,922,435	Nov. 25, 1975
Parker et al. (Parker)	4,902,364	Feb. 20, 1990
Liebe, Jr. (Liebe)	5,112,423	May 12, 1992

The claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Asnes in view of Parker and Liebe (Answer, page 4). We reverse the examiner's rejection essentially for the reasons stated in appellant's Brief, Reply Brief, and the reasons set forth below.

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<sup>1</sup>Appellants mistakenly list claims 1-20 and 33-38 as withdrawn on page 2 of the Brief.

**OPINION**

The examiner finds that Asnes discloses a heat-releasable adhesive layer which may comprise an acrylic-based resin "as recited in claims 25, 39" (Answer, page 4). The examiner also finds that Parker discloses a heat-releasable layer which may be an acrylic-based resin (Answer, page 5).<sup>2</sup>

Appellants argue that none of the references disclose an acrylic resin adhesive modified by adding less than 1% isocyanate as required by the claims on appeal (Brief, pages 12-13). The examiner has made no obviousness conclusion regarding the composition of the adhesive (Answer, page 6) but, in reply to appellant's argument, construes the claimed "less than 1% isocyanate resin" as encompassing zero%, thus reading on the acrylic resin adhesive disclosed by the applied references (Answer, page 11). We disagree with the examiner's claim construction for the following reasons. Claim 25 on appeal positively recites that isocyanate resin is present ("the adhesive comprising a *mixture* of an acrylic resin and an isocyanate resin," italics added). If this claim was construed

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<sup>2</sup> The examiner does not make any finding from Liebe regarding heat-releasable adhesive layers (see the Answer in its entirety).

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as including zero% of the isocyanate resin, there would not be a mixture of the recited resins. Accordingly, "less than" can not include zero% in this case. See *In re Kirsch*, 498 F.2d 1389, 1393-94, 182 USPQ 286, 290 (CCPA 1974). Furthermore, when the claim is read in light of the specification, positive amounts of isocyanate resin must be present in order to produce the claimed peel strengths. See the specification, pages 24-26, and *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Therefore we cannot sustain the examiner's rejection.

Additionally, the examiner has not provided any convincing evidence or reasons to show the motivation or teaching to combine the references as proposed in the rejection. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The examiner has not presented any convincing evidence or reasoning to support the conclusion that it would have been obvious to select an adhesive which has increased peel strength at below heat-transfer temperatures but low peel strengths at higher temperatures (Answer, page 6). As found by the examiner, Parker only teaches a peel strength at heat transfer temperatures with no teaching or suggestion as to peel strength at room temperatures (Answer, page 5). Furthermore, Parker is directed to peel strengths necessary for easy removal of the heat-

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releasable layer for a metallized laminate and the examiner has not provided any showing as to why this peel strength would be applicable to the laminate of Asnes.

Even if the references were combinable as proposed by the examiner, the claimed subject matter would not be shown or suggested. The examiner has not pointed to any finding from Asnes that this reference contains a "substantially contiguous layer of a thermoplastic containing material" as required by claim 25 on appeal. The examiner characterizes a layer disclosed by Asnes as a "transferable image layer" (Answer, page 4) but Asnes discloses this layer as a "design print" and does not specify any thermoplastic containing layer (see col. 14, ll. 4-11). The examiner gives no explanation as to why one of ordinary skill in this art would have replaced this design print layer of Asnes with a thermoplastic containing layer. Furthermore, as discussed above, none of the references disclose or suggest the claimed adhesive, peel strengths, or the temperature and peel strength relationship recited in claim 25 on appeal.

For the foregoing reasons and those stated in the Brief and Reply Brief, we determine that the examiner has failed to establish a *prima facie* case of obviousness in view of the reference evidence. Accordingly, we reverse the examiner's

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rejection of claims 25-28, 30, 31, 39 and 40 under 35 U.S.C.  
§ 103(a) over Asnes in view of Parker and Liebe.

The decision of the examiner is reversed.

**REVERSED**

TERRY J. OWENS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
ROMULO H. DELMENDO	)	
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APPENDIX

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25. A flexible laminate for use in applying graphics to a substrate, comprising:

a carrier comprising:

a transparent plastic film having opposite first and second surfaces the plastic film having a melting temperature of greater than 400°F;

an adhesive having a peel strength which decreases with increasing temperature, the adhesive being on the second surface of the plastic film;

the adhesive having a peel strength between 4.0 to 20.0 ounces per square inch of width at room temperature and less than 3 ounces per square inch of width at temperatures of greater than 200°F; and

the adhesive comprising a mixture of an acrylic resin and an isocyanate resin wherein the adhesive has less than 1% isocyanate resin on total acrylic solids in the adhesive so that the carrier can be quickly removed following application of the graphic to the substrate;

a substantially contiguous layer of a thermoplastic containing material, the thermoplastic material being on the adhesive; and

a substantially contiguous layer of a means for adhering a graphic, the graphic adherent means being on the layer of thermoplastic containing material to provide a flexible laminate from which graphics may be cut.