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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte Neenah Paper, Inc.
(Inventor: Francis J. Kronzer)

Appeal 2011-007454
Application 12/267,133
Technology Center 1700

Before RICHARD E. SCHAFER, PETER F. KRATZ , and
BEVERLY A. FRANKLIN, *Administrative Patent Judges*.

SCHAFER, *Administrative Patent Judge*.

DECISION ON APPEAL

Neenah Paper, Inc. (Applicant) appeals from an Examiner's decisions rejecting claims 24-33 and 36-43. 35 U.S.C. §§ 6(b) and 134(a). We reverse.

The Invention

Applicant's invention relates to methods of applying images such as decorative pictures, designs or illustrations to articles of clothing such as T-shirts. The method begins with creating an image, for example text or a picture, on a suitable surface. A masking sheet having a base layer and a transferable mask layer is brought into contact with the image. The masking sheet is positioned so that a portion of the transfer layer and image are in direct contact. The masking sheet is removed depositing a layer of transfer material on the image and leaving an area on the masking sheet devoid of the transfer material. Applicant calls this area a "negative image" and the masking sheet with the negative image a "negative image mask." The transfer layer side of the negative image mask is brought into direct contact with a substrate. The transfer layer is deposited on the substrate creating masked (transfer layer) and unmasked areas. An image is created in the unmasked area and the transfer layer is removed from the substrate. The process, except for the final image formation and mask removal steps, is illustrated in Applicant's Figures 2a to 2c and 5a to 5c.

We reproduce representative Claim 24, the sole independent claim below:

> 24. A method of applying an image to a substrate, the method comprising the steps of:
>
> a) imaging a printable surface with an image to form an imaged surface having a printed area and a non-printed area;
>
> b) positioning a masking sheet comprising a base layer and an outer masking layer adjacent the imaged surface such that the outer masking layer is in contact the

imaged surface;

c) transferring a corresponding portion of the outer masking layer to the printed area of the imaged surface, leaving a negative image mask on the masking sheet;

d) transferring the negative image mask to a substrate to create a masked area and an unmasked area on the surface of the substrate;

e) imaging the unmasked area on the surface of the substrate; and

f) thereafter, removing the negative image mask from the substrate.

Rejections

In the Answer, the Examiner maintained the following rejections, all under 35 U.S.C. § 103(a):

1. Claims 24-25, 28, 36, and 38 over the combined teachings of Clark[1] and Ogawa;[2]

2. Claims 26-27 and 37 over the combined teachings of Clark, Ogawa and Scrutton;[3]

3. Claims 29-31 and 39-43 over the combined teachings of Clark, Ogawa and Oshima;[4]

4. Claim 32 over the combined teachings of Clark, Ogawa and Murray;[5] and

5. Claims 33-35 over the combined teachings of Clark, Ogawa and of Kuboyama.[6]

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[1] U.S. Patent 4,434,198.
[2] Japanese Patent Application No. 04-114157 A.
[3] U.S. Patent 5,147,489.
[4] U.S. Patent 6,984,281 B2.
[5] U.S. Published Patent Application 2004/0029030 A1.
[6] U.S. Patent 4,645,555.

Discussion

The examiner held that the subject matter of Claim 24 would have been obvious from the combined disclosures of Clark and Ogawa. Specifically, The Examiner concluded that it would have been obvious to combine the mask transfer step taught by Ogawa with the method of forming a stencil taught by Clark. Answer 5. The Examiner found that Clark teaches that the ink-impermeable mask 12 can be removed from the release layer 11 and base layer 10 of the stencil. Answer 4, citing Clark 4:1-21. The Examiner held that it would have been obvious to use the mask 12 in Ogawa's image forming process resulting in Applicant's claimed process. Answer 4-5.

Applicant argues that the Examiner has not provided an adequate reason for removing Clark's ink-impermeable layer 12 from the porous backing layer 10 so that it can be used in Ogawa's process. Brief 7, 2nd paragraph.

On this point, Applicant's argument is well taken. The Examiner relied upon Clark as teaching that the mask (ink-impervious layer 12) is removable from the porous base layer 10. Answer 4, citing Clark 4:1-21. Our review of the cited portion of Clark shows that it does not support the Examiner's finding. That portion only teaches the relative bond strengths between the mask layer 12 and the tissue layer 10, on the one hand, and the mask layer and the toner on the copy paper 14, on the other. We see no teaching or suggestion of separating the ink-impervious mask layer 12 from the porous layer 10.

We have reviewed the English language abstract and figures of the Ogawa reference, but do not see anything that would cure the above-noted

deficiency in Clark. In this regard we find it disappointing that neither Applicant nor the Examiner have provided a full English translation of this clearly important reference.

Accordingly, we reverse the Examiner's decisions rejecting Claim 24 and its dependent Claims 25-33 and 36-43.

The decisions of the Examiner are reversed.

REVERSED

kmm