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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SHOU UCHIDA,
RYOHEI SAWAZAKI, KEIJI HAYASHI,
KOUHEI TAKEDA

Appeal 2015-004794
Application 12/956,063
Technology Center 1700

Before CHUNG K. PAK, GEORGE C. BEST, and DEBRA L. DENNETT,
Administrative Patent Judges.

BEST, *Administrative Patent Judge.*

DECISION ON APPEAL

The Examiner finally rejected claims 1–3 and 5–9 of Application 12/956,063 under 35 U.S.C. § 103(a) as obvious. Final Act. (June 18, 2014). Appellants¹ seek reversal of this rejection pursuant to 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6.

For the reasons set forth below, we REVERSE.

¹ Nitto Denko Corporation is identified as the real party in interest. Appeal Br. 3.

BACKGROUND

The '063 Application relates to surface protective sheets. Spec. 1. Surface protective sheets are used to protect things such as a metal sheet or a glass plate during handling. *Id.* Generally, the surface protective sheet adheres to the surface it is protecting by a natural rubber-based pressure-sensitive adhesive. *Id.* Such adhesives, however, often leave an adhesive residue when a surface protective sheet is peeled off of the surface. *Id.* at 2.

It is been suggested that a styrene-based pressure-sensitive adhesive could be used to avoid leaving a residue upon removal of the surface protective sheet. *Id.* These compounds, however, apparently do not provide sufficient adhesive force to secure the surface protective sheet to the surface to be protected. *Id.*

The '063 Application's Specification describes a surface protective sheet which is said to have a high anchoring force for adhering the surface protective sheet to the protected surface and to leave no residue behind when the surface protective sheet is peeled off of the surface. *Id.* at 3.

Claim 1 is the only independent claim in the '063 Application and is reproduced below from the Claims Appendix of Appellants' Appeal Brief:

1. A surface protective sheet, comprising:
 - a supporting base material;
 - a surface layer (I) as one outermost layer of the supporting base material; and
 - a pressure-sensitive adhesive layer on the surface layer (I),wherein:
 - the supporting base material has three or more layers, and
 - includes a mechanical property control layer as an intermediate layer of the three or more layers;

the pressure-sensitive adhesive layer contains a thermoplastic elastomer; and

the surface layer (I) contains a linear, low-density polyethylene at a content of more than 50 wt%.

Appeal Br. 22 (Claims App.).

REJECTION

On appeal, the Examiner maintains the following rejection:

1. Claims 1–3 and 5–9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kanada.² Final Act. 2–3.

DISCUSSION

In rejecting claim 1, the Examiner found that Kanada describes a surface protective sheet comprising a base material layer. Final Act. 3. The Examiner further found that one surface of Kanada's base material layer is adjacent to a back treatment layer and that the other surface of Kanada's base material layer is adjacent to a pressure-sensitive adhesive layer. *Id.* The Examiner also found that

Kanada teaches that the base [material] layer is *preferably* made of a polyolefin-based resin (paragraph [0033]). Kanada teaches that the base [material] layer may be used in the form of a single layer, two-layer, or multilayer (three or more layers) structure (paragraph [0036]). . . . Kanada also teaches that *the polyolefin-based resins[] which make up the base material layer may include a multitude of polymers, including a linear low-density polyethylene (LLDPE), and when the base material layer is a two-layer or multilayer structure, each pair of*

² WO 2008/102670, published August 28, 2008. We join the Examiner in citing US 2010/0143633 A1, published June 10, 2010, as the English-language equivalent.

adjacent layers may be made of any materials Therefore, it would have been obvious to a person having ordinary skill in the art at the time of invention to select LLDPE for use in the outermost layer, adjacent to the adhesive layer, of the base layer since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice [MPEP § 2144.07].

Id. at 3–4 (emphasis added).

Appellants argue that the Examiner has not established a prima facie case of obviousness because Kanada does not describe or suggest a surface protective sheet in which the layer adjacent to the pressure-sensitive adhesive layer is at least 50% by weight LLDPE. Appeal Br. 8–9. In the alternative, Appellants argue that they have presented evidence of unexpected results sufficient to overcome a prima facie case of obviousness.

Id. at 9–11.

We agree with Appellants that the Examiner has not established a prima facie case of obviousness. In particular, we agree that the Examiner has not provided an adequate explanation for the finding that Kanada suggests the use of a layer comprising at least 50% by weight LLDPE adjacent to the pressure-sensitive adhesive layer. Although the Examiner correctly notes that Kanada states that the base material layer is preferably made of a polyolefin-based resin, Appeal Br. 3, Kanada’s description is broader than that. In particular, Kanada states that the base material layer “may be made of any material containing a thermoplastic resin capable of being formed into a sheet or a film or made of such a thermoplastic resin.” Kanada ¶ 33. In discussing the preferred polyolefin-based resins, Kanada provides examples including polyethylene-based resins, propylene-based resins, and ethylene/propylene copolymers. *Id.* ¶ 34. In Kanada’s working

examples, the layer adjacent to the pressure sensitive adhesive layer is low-density polyethylene. *See, e.g., id.* ¶ 81.

Kanada, therefore, identifies millions of potential compositions that might be used to create the portion of the base material layer that is adjacent to the pressure-sensitive adhesive layer. The Examiner concludes that this exceedingly broad disclosure combined with routine optimization renders the subject matter of claim 1 obvious in the absence of a more detailed reason for a person of ordinary skill in the art to have selected LLDPE from Kanada's list of materials that might form the base material layer, we cannot agree with the Examiner's conclusion. *See In re Baird*, 16 F.3d 380, 383 (Fed. Cir. 1994) ("A disclosure of millions of compounds does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds.").

In view of the foregoing, we reverse the Examiner's rejection of claim 1 as unpatentable over Kanada. Claims 2, 3, and 5–9 depend from claim 1; we, therefore, also reverse the rejections of these claims.

Because we agree with Appellants that the Examiner has not established a prima facie case of obviousness, we express no opinion regarding whether Appellants have presented evidence of unexpected results sufficient to overcome a prima facie case. *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987).

CONCLUSION

For the reasons set forth above, we reverse the rejections of claims 1–3 and 5–9 of the '063 Application as unpatentable over Kanada.

REVERSED