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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/136,641	08/08/2011	James H. May	G-3717	7289

7590 03/02/2020
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EXAMINER

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ART UNIT	PAPER NUMBER
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1745

MAIL DATE	DELIVERY MODE
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03/02/2020

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES H. MAY and THOMAS ZYGMONT

Appeal 2018-008004
Application 13/136,641
Technology Center 1700

Before CATHERINE Q. TIMM, JAMES C. HOUSEL, and DONNA M. PRAISS, *Administrative Patent Judges*.

HOUSEL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 2–4 and 6–13. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.²

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Remo, Inc. Appeal Brief (“Appeal Br.”) filed February 12, 2018, 1.

² Our Decision additionally refers to the Specification (“Spec.”) filed August 8, 2011, the Examiner's Non-Final Office Action (“Non-Final Act.”) dated

CLAIMED SUBJECT MATTER

The claims are directed to a method of drumhead imaging. Spec. 1, Title. Specifically, Appellant discloses that the invention is directed to a method of forming a dye sublimation image of a simulated animal skin or other graphic image in a vibrating membrane employed in a musical instrument. *Id.* at 1:5–7.

Claim 13, reproduced below from the Claims Appendix to the Appeal Brief, is illustrative of the claimed subject matter:

13. A method for forming a dye sublimation image comprising the steps of:
 - providing an image;
 - providing a substrate;
 - transferring said image onto said substrate;
 - providing a sheet of gas permeable membrane with vibrational character comprised of bi-axially oriented non-woven polyester fibers for use in the fabrication of a musical drumhead, said sheet of gas permeable membrane having a plurality of surface pores and a musical drum sound producing capability;
 - joining said image enhanced substrate with said sheet of gas permeable membrane:
 - applying a combination of heat and pressure to said Joined said image enhanced substrate and said sheet of gas permeable membrane to cause said individual surface pores to expand to enable said dye to gasify and permeate said surface pores to transfer said image; and,
 - cooling said membrane to enable said surface pores to seal over and encase said image to integrate said image with said membrane in delamination and weather resistant relation.

July 12, 2017, the Examiner’s Answer (“Ans.”) dated May 24, 2018, and the Reply Brief (“Reply Br.”) filed July 24, 2018.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Robbins et al. ("Robbins") ³	US 3,444,732	May 20, 1969
Hare et al. ("Hare")	US 6,083,656	July 4, 2000
Odamura et al. ("Odamura")	US 2003/0007058 A1	Jan. 9, 2003
Torikoshi et al. ("Torikoshi")	US 2006/0216497 A1	Sept. 28, 2006
<i>Laminator Specifications</i> , LPD3206 product description, http://fujipla-japan.com/goods/list.html , downloaded 9/1/2015, Fujipla, Inc., 2006. ("Fujipla")		

REJECTIONS

The Examiner maintains, and Appellant requests our review of, the following grounds of rejection under 35 U.S.C. § 103(a):

1. Claims 2–4, 6–8, 10, 11, and 13 as unpatentable over Torikoshi in view of Hare; and
2. Claims 9 and 12 as unpatentable over Torikoshi in view of Hare, and further in view of Fujipla, Odamura, and Robbins.

OPINION

After review of the Examiner's and Appellant's opposing positions and the appeal record before us, we determine that Appellant's arguments are sufficient to identify reversible error in the Examiner's obviousness

³ The Examiner refers to this reference as McKinley, which appears to refer to the last name of the second named inventor on this patent. We adopt the common convention of referring to patents using the last name of the first named inventor.

rejections. *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011). Accordingly, we reverse the stated rejections for the reasons set forth in the Appeal and Reply Briefs.

The Examiner finds that Torikoshi teaches a method for forming a dye sublimation image substantially as recited in claim 13, except for transfer printing an image onto a substrate. Non-Final Act. 3–4. For this feature, the Examiner finds that Hare teaches imaging a transfer material, followed by transfer the print to a substrate and concludes that it would have been obvious to do so in Torikoshi. *Id.* at 4.

Appellant argues that neither Torikoshi nor Hare is in the same field of endeavor as that of claim 13. Appeal Br. 3. In particular, Appellant contends that Torikoshi teaches a method of manufacturing an image transfer sheet in the field of electrophotography using an electrostatic latent image developed using a color toner powder. *Id.* at 3–4. Appellant also contends that Hare teaches a method of applying an image to a fabric using two heating steps including hand ironing an image coating from a transfer sheet to the fabric, and re-ironing the transferred image with a tack-free overlay sheet. *Id.* at 4. In contrast, Appellant asserts that the claimed invention is directed to a method for preservation of musical drumheads impregnated with graphic images. *Id.*

Appellant further argues that neither Torikoshi nor Hare is reasonably pertinent to the problem faced by inventors. Appeal Br. 4–5. In this regard, Appellant contends that neither reference has any connection to the field of musical drumheads, nor does either reference suggest to those skilled in the field of the invention that the technology taught therein would have any application to the problem solved by the claimed method. *Id.* at 5. Appellant

asserts that neither reference addresses or attempts to solve the problem confronting the inventors, i.e., delamination of graphical images from the musical drumheads. *Id.* According to Appellant, Torikoshi teaches use of various materials, including PET resin film, for embossing image or prints employing electrophotographic technology, and Hare teaches applying an image to fabrics or other materials. *Id.* at 6.

Appellant's arguments are persuasive of reversible error. A reference is analogous art if it is either in the same field of the endeavor, regardless of the problem addressed, or is reasonably pertinent to the particular problem with which the inventor was concerned. *In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006); *see also, In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656, 658–59 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979). The same field of endeavor test “for analogous art requires the PTO to determine the appropriate field of endeavor by reference to explanations of the invention's subject matter in the patent application, including the embodiments, function, and structure of the claimed invention.” *Bigio*, 381 F.3d at 1325. Moreover, “[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.” *Clay*, 966 F.2d at 659.

Here, the Examiner makes no finding that the prior art is directed to the same field of endeavor as the claimed invention. Instead, the Examiner responds to Appellant's arguments that neither Torikoshi nor Hare are analogous prior art by finding that these arguments are directed to the

intended use of the membrane, i.e., a musical drumhead, which “is a claim limitation which may not distinguish over [the] prior art,” merely requiring the ability to be used as a drumhead. Ans. 2. The Examiner finds that most membranes have “vibrational character,” and Torikoshi teaches use of a bi-axially stretched PET membrane, but errs in holding that the product made by a claimed method is not a positive limitation of the method claim. We note that the Examiner refers to Appellant’s disclosure, in particular to Appellant’s admission that graphic applications including dye sublimation processes are not new in the art. However, the rejection does not rely on such admission.

Further, the Examiner finds that Appellant has not shown that Torikoshi’s PET membrane could not be used in the fabrication of a drumhead. However, the Examiner, not Appellant, bears the initial burden to establish that the claimed invention would have been *prima facie* obvious. *Oetiker*, 977 F.2d at 1445 (“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability”). Here, with regard to a method for producing a graphic image on a musical drumhead, the Examiner bears the burden of establishing that it would have been obvious to have produced a musical drumhead using the recited process. As Appellant correctly notes, the law on intended use applies differently for methods for making products as compared to the products themselves.

We further note that, though the Examiner finds that Torikoshi teaches the same process as recited in claim 13, except for transfer printing an image onto a substrate, the Examiner fails to direct our attention to any disclosure of a dye sublimation process entailing the transfer of a dye image

from a substrate into the open pores of a membrane due to heat and pressure, followed by cooling of the membrane to close these pores, nor do we find any. Indeed, Torikoshi teaches away from sublimation-type processes because their resolution tends to decrease with increasing printing speed and teaches away from use of dyes due to fading. *See* Torikoshi ¶¶ 7, 13. Torikoshi, therefore, favors an electrophotographic method because resolution is maintained even with increasing printing speed and toner pigments have excellent light resistance. *Id.* ¶¶ 9, 13. Thus, Torikoshi not only is directed to a different field of endeavor, electrophotography using toner pigment, but also does not disclose a dye sublimation method for forming musical drumheads as recited in claim 13. As Appellant correctly asserts, Hare does not remedy these deficiencies in Torikoshi.

Therefore, we do not sustain the Examiner's obviousness rejection of claim 13, or of dependent claims 2–4, 6–8, 10, and 11, over the combination of Torikoshi and Hare. We note that the Examiner applies additional prior art to Fujipla, Odamura, and Robbins to address limitations of dependent claims 9 and 12. Non-Final Act. 5. These references are not relied on to, and indeed do not, remedy the deficiencies in the combination of Torikoshi and Hare. Accordingly, we likewise do not sustain the obviousness rejection of claims 9 and 12 for the same reasons given above.

CONCLUSION

Upon consideration of the record, and for the reasons given above and in the Appeal and Reply Briefs, the decision of the Examiner rejecting claims 2–4 and 6–13 under 35 U.S.C. § 103(a) as unpatentable over Torikoshi in view of Hare, alone or further in view of Fujipla, Odamura, and Robbins, is *reversed*.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Basis/Reference(s)	Affirmed	Reversed
2-4, 6-8, 10, 11, 13	103(a)	Torikoshi, Hare		2-4, 6-8, 10, 11, 13
9, 12	103(a)	Torikoshi, Hare, Fujipla, Odumura, Robbins		9, 12
Overall Outcome				2-4, 6-13

REVERSED