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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES E. MCGUIRE JR.¹

Appeal 2018-008159
Application 14/307,127
Technology Center 1700

Before KAREN M. HASTINGS, CHRISTOPHER C. KENNEDY, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

KENNEDY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–13 and 19–21. An oral hearing was held on November 1, 2019. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

The subject matter on appeal relates to adhesive paint films comprising an adhesive layer and a nonadhesive tab portion that facilitates easy removal of the paint film. *See, e.g.*, Spec. ¶¶ 2, 24; claim 1. Claim 1 is

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 AERO Advanced Paint Technology, Inc. App. Br. 3.

reproduced below from page 23 (Claims Appendix) of the Appeal Brief
(some formatting added):

1. A paint film comprising:

at least one adhesive layer that is outwardly exposed on the
paint film prior to application of the paint film to a surface;

at least one polymer layer; and

a non-adhering gripping portion along at least one edge of the
paint film,

wherein the gripping portion comprises an uninterrupted
extension of the polymer layer of the paint film, but without the
adhesive layer adjacent thereto, and

wherein the paint film has uniform or non-uniform color
throughout.

REJECTIONS ON APPEAL^{2,3}

The claims stand rejected under 35 U.S.C. § 103 as follows:

1. Claims 1, 2, 4, 6–13, 19, and 20 over Steininger
(US 2004/0208998 A1, published Oct. 21, 2004) and Pomerantz
(US 6,071,583, issued June 6, 2000).

2. Claims 1, 2, 4, 6–13, 19, and 20 over Steininger and Franck
(US 2002/0018889 A1, published Feb. 14, 2002).

² The Examiner characterizes the rejections as, e.g., “Reference A or B in view of reference C or D.” *See* Final Act. 2. For clarity, we have split the alternative rejections into independent rejections that do not use the word “or.”

³ After the Final Action, claim 3 was rewritten to depend from claim 5 rather than from claim 1. In the Final Action, claim 3 was grouped with claim 1, but it is now grouped with claim 5. *See* App. Br. at 8 n.1; Advisory Act. dated Dec. 27, 2017, at 2 (“Claim 3, which has been amended in the after final amendment . . . to depend [from] claim 5, will be rejected along with claims 5 and 21 . . .”).

3. Claims 1, 2, 4, 6–13, 19, and 20 over McGuire (US 2010/0059167 A1, published Mar. 11, 2010) and Pomerantz.
4. Claims 1, 2, 4, 6–13, 19, and 20 over McGuire and Franck.
5. Claims 3, 5, and 21 over Steininger, Pomerantz, and de Vroom (US 4,766,038, issued Aug. 23, 1988).
6. Claims 3, 5, and 21 over Steininger, Pomerantz, and Smith (US 2013/0316115 A1, published Nov. 28, 2013).
7. Claims 3, 5, and 21 over Steininger, Franck, and de Vroom.
8. Claims 3, 5, and 21 over Steininger, Franck, and Smith.
9. Claims 3, 5, and 21 over McGuire, Pomerantz, and de Vroom.
10. Claims 3, 5, and 21 over McGuire, Pomerantz, and Smith.
11. Claims 3, 5, and 21 over McGuire, Franck, and de Vroom.
12. Claims 3, 5, and 21 over McGuire, Franck, and Smith.

ANALYSIS

After review of the cited evidence in the appeal record and the opposing positions of the Appellant and the Examiner, we determine that the Appellant has not identified reversible error in the Examiner's rejections. Accordingly, we affirm the rejections for reasons set forth below, in the Final Action dated Aug. 10, 2017, and in the Examiner's Answer dated July 2, 2018.

Rejections 1–4

The Appellant argues Rejections 1–4 as a group, presenting separate arguments only for claims 1 and 10. Claims 2, 4, 6–9, 11–13, 19, and 20 will stand or fall with claim 1. We address claims 1 and 10 below.

Claim 1

The Examiner finds that Steininger and McGuire each independently teach paint films comprising the elements of claim 1 except that both references “fail to teach an area of the film coat not being coated with adhesive on an edge of the film coat to allow easy removal.” Final Act. 2. The Examiner finds that the paint films of both Steininger and McGuire are “taught as being required to be removed when used on aircraft and other vehicles.” *Id.*

The Examiner finds that Pomerantz and Frank each independently teach “leaving a part of a film substrate layer free of adhesive at an edge in order to allow an easy start to removal of an adhered film from the surface of an object.” *Id.* at 2–3.

The Examiner determines that it would have been obvious “to have formed an edge of the film substrate layer of the paint films of [Steininger or McGuire] without adhesive to allow easy removal of the paint films because of the teachings of Pomerantz or Franck.” *Id.* at 3.

The Appellant raises several arguments against the Examiner’s rejection, which we address below.

1. The Appellant argues that the Examiner’s rejection of claim 1 “fails to establish a prima facie case of obviousness” because the films of Steininger and McGuire “are focused on exterior surfaces . . . where the process for starting removal of the paint replacement film . . . should not be so easy as to prematurely start removal when subject to the extreme wind resistance and other challenging environmental conditions in which they are expected to be used.” App. Br. 9–10.

That argument is unpersuasive. Although Steininger and McGuire teach the use of their films on vehicles including aircraft, neither is limited to such applications or even to exterior applications. *See* Steininger ¶ 2; McGuire at Abstract. Steininger and McGuire broadly teach application of their paint films to “substrates” or “articles” and provide vehicles as examples. *See* Steininger ¶ 2; McGuire at Abstract.

Additionally, both Steininger and McGuire disclose that easy removability is an important feature of their paint films. *See* Steininger ¶ 11 (“[I]t is an object of the invention to produce films which can be removed again without residues.”); McGuire ¶ 20 (“Not only is it desirable for a material to adhere adequately to a surface, but it is also desirable to be able to remove the material easily when desired.”). Both Steininger and McGuire also expressly disclose concerns for weather stability. *See* Steininger ¶ 11; McGuire ¶ 12. To the extent that the films of Steininger and McGuire are applied to vehicles and subject to harsh wind/weather conditions, the Examiner explains that, “if this is recognized as a problem by one of ordinary skill in the art, it would be an obvious matter to fold the grip tab at the edge of the paint film so that it has minimum exposure to weathering.” Ans. 5–6. As evidence that it would have been within the ordinary level of skill in the art to account for wind and weather issues, the Examiner cites Smith, finding that Smith “teaches that [it] is known to fold an edge of a paint film over the edges of a substrate to form a smooth outer appearance.” *Id.* It appears that such folding would protect the edges of the paint film from wind/weather by moving the edges to an interior portion of the vehicle.

On this record, we are not persuaded the disclosures in Steininger and McGuire of exterior applications for their paint films indicates reversible

error in the Examiner's rejection. *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections . . .”).

2. The Appellant argues that “no motivation for the asserted modification of Steininger or McGuire exists as the secondary references, Pomerantz and Franck, are directed toward *different* applications and articles than those described by Steininger and McGuire.” App. Br. 11. The Appellant argues that Steininger and McGuire are focused on “relatively large exterior surface areas” whereas Pomerantz and Franck “relate to relatively small footprints . . . utilized indoors.” *Id.*

Those arguments are not persuasive. As set forth above, both Steininger and McGuire explicitly disclose the desirability of easy removal of their adhesive paint films. Pomerantz and Franck disclose nonadhesive portions at the edge of an adhesive to facilitate easy removal of the adhesive. *See Pomerantz at Abstract; Franck at Abstract.* The Examiner’s proposed combination is simply the use of a known element (tab portion without adhesive) according to its established function (easy removal of adhesive) in the context of the paint films of Steininger and McGuire that specifically note the desirability of such a feature. Such combinations typically do not result in nonobvious subject matter. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416–21 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”). Even assuming that Steininger and McGuire are directed to different and/or larger articles than Pomerantz and Franck, the Appellant does not persuasively establish that would have dissuaded a person of ordinary skill in the art from using the known method of

facilitating adhesive removal disclosed by Pomerantz and Franck with the adhesive films of Steininger and McGuire.

3. The Appellant argues that the proposed modification “would change the principle of operation of the prior art being modified and is counter to express requirements set forth in Steininger and McGuire.” App. Br. 12. Specifically, the Appellant argues that adding nonadhesive tabs or strips to the edge of the adhesive films of Steininger or McGuire would make the films of Steininger and McGuire less weather resistant and unsuitable for exterior applications. *See id.*

That argument is unpersuasive for reasons similar to those described above. In particular, Steininger and McGuire disclose that easy removability is an important feature of their paint films, and the Examiner’s proposed modification advances that goal of Steininger and McGuire. It would have been within the ordinary level of skill in the art to account for weather and wind in exterior applications by, for example, wrapping edges to reduce wind and weather exposure of nonadhesive tabs.

4. The Appellant argues that there is no indication that the films of Steininger or McGuire “have issues with ‘start of removal’” such that they would benefit from nonadhesive tab regions. App. Br. 12–13. That argument is not persuasive because the mere fact that Steininger and/or McGuire do not expressly identify a problem with “start of removal” does not establish or suggest that nonadhesive tabs would not assist with adhesive removal in the films of Steininger and McGuire as suggested by Pomerantz and Franck.

5. The Appellant argues that Franck discloses making a nonadhesive region by covering the adhesive with a nonadhesive layer, which allegedly

falls beyond the scope of the term “without the adhesive layer adjacent [to the non-adhering gripping portion].” App. Br. 13.

That argument is not persuasive because Franck’s disclosure of covering an adhesive region with a nonadhesive layer is one embodiment disclosed by Franck. *See* Franck ¶ 21. More broadly, Franck discloses “adhesive film strips . . . which preferably have a nonadhesive grip-tab region from which the process of detachment is initiated.” *Id.* ¶ 3. A person of ordinary skill in the art would have understood that a “nonadhesive grip-tab region” could be formed by omitting adhesive in the grip-tab region, or by covering the adhesive with a nonadhesive. The fact that Franck provides a working example that uses the latter method does not detract from Franck’s broader disclosure which reasonably suggests “nonadhesive grip-tab region[s]” created by any means, including by means of simply omitting an adhesive layer. *See KSR*, 550 U.S. at 418 (“[T]he [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); *see also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”). In view of Franck’s disclosure of a “nonadhesive grip-tab region,” a person of ordinary skill in the art would have at once envisaged creating such a region simply by omitting the adhesive layer, which was known in the art. *Cf.* Pomerantz at 4:66–5:16 & Figs. 1, 2 (describing and depicting nonadhesive region 14 formed by omitting adhesive layer).

6. The Appellant argues:

Similarly, Pomerantz also does not teach or suggest such “an uninterrupted extension,” instead describing how its “grip element comprises a localized surface deformity which causes the uncoated portion of said tab body to be slightly out of plane surface in the vicinity of said grip element.” (Pomerantz, Claims 1 and 9 and 3:66-5:16 and 6:6-31.)

App. Br. 13.

That argument is not persuasive. Pomerantz discloses a “removable double-sided adhesive tab” in which “[e]ach side of the tab is divided into a coated portion coated by an adhesive composition and an uncoated portion.” Pomerantz at Abstract. Figure 2 of Pomerantz is reproduced below.

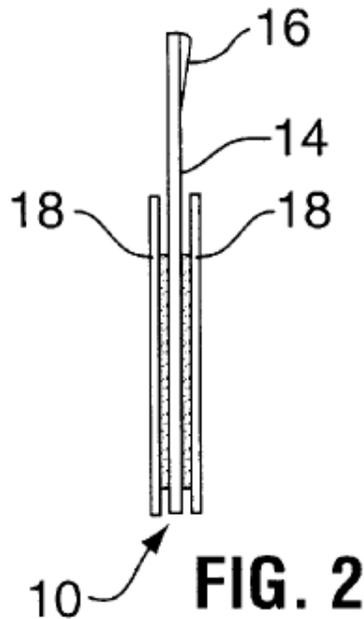


Figure 2 of Pomerantz depicts a side view of a double-sided adhesive. *Id.* at 4:38–39. Figure 2 shows a tab 10 with layer 14 that, in the lower half of Figure 2, is coated on each side by adhesive to which release liners 18 are attached. *Id.* at 4:66–5:16. Figure 2 further shows, towards the upper half of the figure, uncoated portion 14, which is depicted as an uninterrupted

extension of the lower portion of layer 14 that is coated by adhesive. *Id.* “[L]ocalized crimp or dimple 16” renders the top end of uncoated portion 14 “slightly out of plane when the tab 10 is place[d] adjacent to a rigid planar surface.” *Id.* Thus, contrary to the Appellant’s argument, the crimp or dimple 16 does not cause the entire uncoated portion 14 to be out of plane relative to the rest of the tab; Figure 2 clearly depicts a non-adhering gripping portion 14 that is an uninterrupted extension of the lower portion of layer 14 that is coated with adhesive. Thus, the record does not support the Appellant’s argument that “Pomerantz also does not teach or suggest such ‘an uninterrupted extension.’” App. Br. 13.

7. The Appellant argues that Pomerantz and Franck are nonanalogous art. App. Br. 13–14. We disagree. Even assuming Pomerantz and Franck are not from the same field of endeavor as the claimed subject matter, they are analogous art because they are “reasonably pertinent to the particular problem with which the inventor is involved.” *See In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Specifically, one problem addressed by the inventors was removability of the adhesive paint film. Pomerantz and Franck have specific relevance to the problem of removing adhesives. Accordingly, those references “logically would have commended [themselves] to an inventor’s attention in considering his problem.” *See In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992); *cf. also Wyers v. Master Lock Co.*, 616 F.3d 1231, 1237 (Fed. Cir. 2010) (“The Supreme Court’s decision in *KSR International Co. v. Teleflex, Inc.* directs us to construe the scope of analogous art broadly” (internal citation omitted)).

* * *

On this record, we are not persuaded of reversible error in the Examiner's rejection of claim 1.

Claim 10

Claim 10 depends from claim 7, which in turn depends from claim 1. Claim 7 recites “[a]n object comprising a surface on which the paint film of claim 1 is adhered to at least a portion thereof.” Claim 10 further recites, “wherein the object comprises an access panel on an aircraft fuselage.”

In the Final Action, the Examiner finds that claim 10 simply recites a “known end use[] of paint films.” Final Act. 3.

In the Appeal Brief, the Appellant argues the Examiner fails to address the requirements of the claim, and that the Examiner has not adequately established Official Notice of an asserted fact. App. Br. 15.

In the Answer, the Examiner finds that “it is extremely well known in the art that the doors of both land and air vehicles are painted, and that this is a matter of immediate common knowledge.” Ans. 7.

In the Reply Brief, the Appellant argues that “the Examiner has not met his burden of establishing a prima facie case of obviousness in relying on official notice in the rejection of claim 10.” Reply Br. 3.

The Appellant's argument is not persuasive of reversible error in the rejection. Steinger teaches the use of its paint films in “the motor vehicle industry,” and it specifically describes “automobile bodies.” Steinger ¶¶ 2, 4. McGuire likewise specifically mentions vehicles, including “aircraft and motorized vehicles like automobiles and trucks,” and McGuire teaches the importance of protecting the paint on the surfaces of such vehicles. McGuire ¶ 2. In view of those disclosures, a person of ordinary skill in the art would have immediately recognized that a door (access panel) is a

portion of both an aircraft and an automobile that is painted. Thus, Official Notice aside, Steininger’s disclosure of application of its film to substrates including motor vehicles would have reasonably suggested doors to a person of ordinary skill in the art, and McGuire’s disclosure of application of its film to “articles” including aircraft would reasonably have suggested aircraft doors (access panels) to a person of ordinary skill in the art. As noted above, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *See KSR*, 550 U.S. at 418. We are not persuaded of reversible error in the Examiner’s rejection of claim 10. *See Jung*, 637 F.3d at 1365.

Rejections 5–12

The Appellant argues Rejections 5–12 as a group, presenting separate arguments for claims 3, 5, and 21, which we address below.

Claim 5

Independent claim 5 is similar to claim 1 but requires “at least one cut-out positioned [in the paint film] and corresponding to a feature on a surface of an object.” The Examiner finds that de Vroom and Smith both teach “cutting a paint film” to fit a substrate. Final Act. 4. The Examiner determines:

It would have been obvious . . . to cut the paint film of the combination above to fit the size and perimeter of any given application and therefore form cut outs to avoid specific areas not requiring a paint film in a given final application . . . [S]uch holes would logically conform to door handles and other objects not intended to be covered by the decorative film.

Id.

The Appellant argues that de Vroom “merely teaches how a user can cut paint film therein into ‘pieces of the desired size to fit as needed,’” and

that “[t]here is clearly no teaching of a cut-out as recited in claim 5 positioned within the paint films of de Vroom, nor a suggestion of the same.” App. Br. 17.

That argument is not persuasive. De Vroom teaches paint films for use with, e.g., motor vehicles, that its “product can either be rolled up or cut in pieces for storage,” and that, “[i]f necessary, a piece whose size *corresponds to that of the area to be covered* with paint can be cut from the product.” de Vroom at 3:35–40 (emphasis added), 4:41–42, 5:47–49 (claim 7); *see also id.* at 5:9–10 (“The user can then cut pieces of the desired size to fit as needed.”). A person of ordinary skill in the art familiar with motor vehicles would have understood that de Vroom’s disclosure of “cut[ting]” film to a desired size that “corresponds to” the “area to be covered” reasonably suggests cutouts where necessary, for items such as door handles. *See KSR*, 550 U.S. at 418 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

The Appellant also argues that “Smith merely teaches that the film therein can be ‘die-cut to the shape of a painted surface of a vehicle body.’” App. Br. 17. Similar to the Appellant’s argument concerning de Vroom, that argument is unpersuasive because it fails to account for “the inferences and creative steps that a person of ordinary skill in the art would employ.” *See KSR*, 550 U.S. at 418. Like de Vroom, Smith teaches that its films may be “adhered to a painted surface of a motor vehicle body.” Smith ¶ 10. Smith teaches that its films may be die-cut to the shape of the surface of the vehicle body that the film is designed to cover, “according to the shape of a vehicle body part.” *Id.* ¶ 42. As with de Vroom, a person of ordinary skill in the art familiar with motor vehicles would have understood that, if a film were cut

to fit a vehicle body part such as a door, a cutout would be necessary for, e.g., a door handle. On this record, we are not persuaded of reversible error in the Examiner's rejection of claim 5. *See Jung*, 637 F.3d at 1365.

Claim 3

Claim 3 depends from claim 5 and further recites, "wherein the gripping portion comprises an uninterrupted extension of the polymer layer of the paint film, but without the adhesive layer adjacent thereto." As noted above in our analysis of claim 1, claim 1 includes this limitation, and the Examiner's discussion of claim 1 covers this limitation.

Although the Appellant includes a separate header for claim 3, the Appellant's arguments are the same as those discussed and rejected above concerning Franck and Pomerantz in the context of claim 1. *See App. Br. 19*. Those arguments are likewise unpersuasive in the context of claim 3. We are not persuaded of reversible error in the Examiner's rejection of claim 3. *See Jung*, 637 F.3d at 1365.

Claim 21

Claim 21 depends from claim 5 and further recites "wherein the feature [to which the cutout corresponds] is selected from windows, mechanical fasteners, and handles."

As above, the Appellant argues that de Vroom and Smith do not teach cutouts. *App. Br. 20*. As above, we are not persuaded by that argument. The disclosures of both of those references concerning cutting films to correspond to the shape of the part to be covered reasonably suggests cutouts corresponding to any automobile feature that might reasonably require a cutout, including door handles. A person of ordinary skill in the art, in view

of the disclosures of the prior art, would have immediately recognized vehicle doors as an application for paint films, and would have immediately recognized that doors have handles. We are not persuaded of reversible error in the Examiner's rejection of claim 21. *See Jung*, 637 F.3d at 1365.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1, 2, 4, 6–13, 19, 20	103	Steininger, Pomerantz	1, 2, 4, 6–13, 19, 20	
1, 2, 4, 6–13, 19, 20	103	Steininger, Franck	1, 2, 4, 6–13, 19, 20	
1, 2, 4, 6–13, 19, 20	103	McGuire, Pomerantz	1, 2, 4, 6–13, 19, 20	
1, 2, 4, 6–13, 19, 20	103	McGuire, Franck	1, 2, 4, 6–13, 19, 20	
3, 5, 21	103	Steininger, Pomerantz, de Vroom	3, 5, 21	
3, 5, 21	103	Steininger, Pomerantz, Smith	3, 5, 21	
3, 5, 21	103	Steininger, Frank, de Vroom	3, 5, 21	
3, 5, 21	103	Steininger, Frank, Smith	3, 5, 21	
3, 5, 21	103	McGuire, Pomerantz, de Vroom	3, 5, 21	
3, 5, 21	103	McGuire, Pomerantz, Smith	3, 5, 21	
3, 5, 21	103	McGuire, Frank, de Vroom	3, 5, 21	
3, 5, 21	103	McGuire, Frank, Smith	3, 5, 21	
Overall			1–13, 19–21	

Appeal 2018-008159
Application 14/307,127

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
Outcome				

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED