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MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			VAZQUEZ, ELAINE M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID GOUBARD

Appeal 2019-004096
Application 14/384,862
Technology Center 1700

Before ROMULO H. DELMENDO, JAMES C. HOUSEL, and
BRIAN D. RANGE, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant¹ appeals under 35 U.S.C. § 134(a) from the Primary Examiner's final decision to reject claims 11–13 and 20–24.² We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies “BOSTIK SA, a wholly owned subsidiary of ARKEMA France,” as the real party in interest (Appeal Brief filed December 13, 2018 (“Appeal Br.”) at 1).

² *See* Appeal Br. 2–9; Reply Brief filed April 22, 2019 (“Reply Br.”) at 1–2; Final Office Action entered June 1, 2018 (“Final Act.”) at 2–9; Examiner's Answer entered February 21, 2019 (“Ans.”) at 3–9.

I. BACKGROUND

The subject matter on appeal relates to a breathable self-adhesive article comprising at least one breathable substrate coated with a breathable adhesive layer (Specification filed September 12, 2014 (“Spec.”) at 1, ll. 6–8). Representative claim 11, the sole independent claim on appeal, is reproduced from the Claims Appendix to the Appeal Brief, as follows:

11. A self-adhesive article comprising:
a substrate having a Moisture-Vapour Transmission Rate superior or equal to $1000 \text{ g/m}^2/24\text{h}$, wherein at least one face of said substrate is coated with an *adhesive layer obtained by curing an adhesive composition comprising at least one silyl-containing polymer, at least one compatible tackifying resin and at least one catalyst,*
said adhesive layer having a Moisture-Vapour Transmission Rate superior or equal to $300 \text{ g/m}^2/24\text{h}$ for a coating weight below 50 g/m^2 and a Moisture-Vapour Transmission Rate superior or equal to $100 \text{ g/m}^2/24\text{h}$ for a coating weight superior or equal to 50 g/m^2 .

(Appeal Br. 10 (emphasis added)).

II. REJECTIONS ON APPEAL

The claims stand rejected under pre-AIA 35 U.S.C. § 103(a), as follows:

- A. Claims 11–13, 20, 21, and 24 as unpatentable over Simpson et al.³ (“Simpson”) in view of Poivet et al.⁴ (“Poivet” or “Poivet ’699”); and

³ US 2010/0286582 A1, published November 11, 2010.

⁴ WO 2009/106699 A2, published September 3, 2009. The Examiner relies on the corresponding United States published application (Poivet et al., US 2011/0052912 A1, published March 3, 2011 (“Poivet ’912”)) as an English language translation. Therefore, we also cite to Poivet ’912.

B. Claims 11–13 and 20–23 as unpatentable over Simpson in view of Griswold.⁵
(Ans. 3–9; Final Act. 2–9).

III. DISCUSSION

Rejection A. The Examiner finds that Simpson describes a self-adhesive article comprising a substrate having a moisture-vapor transmission rate of at least about 500 g/m²/day and an adhesive layer on one face of the substrate (Ans. 3; Final Act. 2–3). The Examiner acknowledges that Simpson does not disclose “an adhesive layer obtained by curing an adhesive composition comprising at least one silyl-containing polymer, at least one compatible tackifying resin and at least one catalyst” having the specified moisture-vapor transmission rate characteristics, as recited in claim 11 (Ans. 3; Final Act. 3). The Examiner finds, however, that the Appellant “admits that the adhesive composition (of the instant invention) is of the type described in [Poivet ’699]” (Ans. 3; Final Act. 3). Based on these findings, the Examiner concludes that “[i]t would have been obvious to one of ordinary skill in the art . . . to have used the adhesive of Poivet as the adhesive in Simpson in order for the adhesive bandage to retain its required cohesion over a wide temperature range” (Ans. 4; Final Act. 4). Regarding the adhesive layer’s moisture-vapor transmission rate characteristics recited in claim 11, the Examiner states that “it is implicit” that Poivet’s adhesive layer has the same characteristics recited in the claim in view of the “admission” in the Appellant’s Specification (Ans. 4; Final Act. 4).

⁵ US 2008/0058492 A1, published March 6, 2008.

The Appellant contends, *inter alia*, that the Examiner's rejection is based on an impermissible use of the Appellant's own Specification to support a conclusion that a person having ordinary skill in the art would have combined Simpson with Poivet to arrive at claim 11's subject matter (Appeal Br. 2–6). For the reasons given below, we agree with the Appellant that the Examiner's rejection is not well-founded.

Simpson describes a breathable bandage having superhydrophobic particles (e.g., porous diatomaceous earth particles) attached to a surface thereof to prevent water from penetrating from the exterior to the interior of the bandage, while allowing vapor to escape through the bandage (Simpson ¶¶ 5, 19, 24). According to Simpson, the superhydrophobic particles are attached to the substrate by forming a mixture of the particles and an adhesive and then applying the mixture to a surface of the bandage substrate (*id.* ¶ 12). Simpson discloses various adhesive binders such as polypropylene, polystyrene, polyacrylate, cyanoacrylates, and amorphous fluoropolymer (*id.* ¶ 27), but Simpson does not teach an adhesive layer cured from an adhesive composition comprising at least one silyl-containing polymer, at least one tackifier, and at least one catalyst curing agent, wherein the adhesive layer has the specified moisture-vapor transmission rate characteristics, as recited in claim 11.

Poivet does teach the same adhesive composition disclosed as suitable for making the claimed self-adhesive article (Poivet '912 Abstract; Spec. 7, l. 21–8, l. 14). According to Poivet, the adhesive composition is suitable for making self-adhesive labels and/or tapes (*id.* ¶ 1). Poivet teaches that the adhesive provides improved adhesive strength and tack properties and retains a required cohesion over a wide temperature range (*id.* ¶ 14).

But, as the Appellant argues (Appeal Br. 2–4), Poivet provides no indication or suggestion that its disclosed adhesive composition would meet the requirements described in Simpson, which is a breathable bandage that prevents liquid water from penetrating, while allowing water vapor to escape. Absent the impermissible use of the Appellant’s own Specification, the Examiner’s findings, analysis, and conclusion lack some rational underpinning or evidentiary basis that would explain *why* a person having ordinary skill in the art would have been motivated or prompted to select Poivet’s adhesive composition from a virtually infinite genus of adhesive compositions to make Simpson’s self-adhesive article. *In re Jones*, 958 F.2d 347, 150–51 (Fed. Cir. 1992).

Accordingly, we do not sustain the Examiner’s rejection as maintained against independent claim 11 and all other dependent claims subject to this rejection.

Rejection B. The Examiner relies on Griswold, which discloses an adhesive that appears to fall within the scope of claim 11, in a manner that is cumulative to reliance on Poivet (Ans. 5–6; Final Act. 4–6 (citing Griswold Abstract, ¶ 48)). Griswold teaches that, in certain embodiments, other adhesives may be suitable for “adhesion against skin and modification of drug delivery rates” (Griswold ¶ 47). The Examiner, however, makes no attempt to show that such adhesives would meet Simpson’s requirements. Thus, for reasons similar to those in our discussion of Rejection A above, we hold that the Examiner’s rejection over Simpson and Griswold is also flawed as it is based on an impermissible use of the Appellant’s own Specification.

IV. CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	References/Basis	Affirmed	Reversed
11-13, 20, 21, 24	103(a)	Simpson, Poivet '699 (Poivet '912)		11-13, 20, 21, 24
11-13, 20-23	103(a)	Simpson, Griswold		11-13, 20-23
Overall Outcome				11-13, 20-24

REVERSED