

COMMISSIONER'S DECISION SUMMARY

C.D. 1226Application No. 553,748 (OO)

Claims rejected as being obvious in view of a cited reference.

The application discloses a removable and repositionable adhesive product comprising a sheet backing having a non-repetitive discontinuous pattern of pressure sensitive adhesive islands on at least a portion of one face which product is made by spraying onto a sheet backing material a solution or dispersion of a normally tacky and pressure-sensitive adhesive in a liquid carrier and thereafter evaporating the liquid carrier leaving a non-repetitive discontinuous pattern of spaced islands of adhesive. Claims 6 to 9 of the application were rejected as being obvious in view of United States patent number 2,721,810 to Schram. An amended set of claims was submitted and the Board recommended that these claims be allowed, a recommendation which was accepted by the Commissioner of Patents.

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 553,748 having been rejected under Subsection 45(2) of the Patent Rules, the Applicant asked that the Final Action of the Examiner be reviewed. The rejection has been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board and the decision of the Commissioner are as follows:

Agent for the Applicant

Smart & Biggar
P.O. Box 2999, Station D
Ottawa, Ontario
K1P 5Y6

This decision deals with a request that the Commissioner of Patents review the Examiner's Final Action on patent application number 553,748 which was filed on December 8, 1987. The Applicant is Minnesota Mining And Manufacturing Company, assignee of inventor Arthur L. Fry and the invention is entitled "REPOSITIONABLE PRESSURE-SENSITIVE ADHESIVE SHEET MATERIAL". The Examiner in charge issued a Final Action on November 9, 1994 refusing claims 6 to 9 because the subject matter thereof was considered to lack inventive ingenuity in view of a cited reference and the Applicant replied on May 9, 1995 requesting that the refusal be reviewed by the Commissioner of Patents and that an oral hearing be held if appropriate.

The invention is directed in one aspect to a method of making a removable and repositionable adhesive sheet product comprising spraying onto a sheet backing material a solution or dispersion of a normally tacky and pressure-sensitive adhesive in a liquid carrier and thereafter evaporating the liquid carrier, leaving a non-repetitive discontinuous pattern of spaced islands of adhesive. According to a further aspect of the invention there is provided a removable and repositionable adhesive product comprising a sheet backing having a non-repetitive discontinuous pattern of pressure sensitive adhesive islands on at least a portion of one face. Independent claim 6 of the application which is representative of the rejected claims is as follows:

6. A removable and repositionable adhesive product comprising a sheet backing having a non-repetitive discontinuous pattern of pressure-sensitive adhesive islands on at least a portion of one face.

In his Final Action the Examiner refused claims 6 to 9 in view of United States patent number 2,721,810 to Schram stating, in part, that:

The reference of Schram relates to gummed paper labels which can be affixed to bottles in retail trade outlets. The label disclosed by Schram has one surface coated with a moisture sensitive adhesive, with a coating of a pressure sensitive adhesive applied to limited areas of the same surface. Such a label construction, teaches Schram, enables the label to be temporarily affixed to a typewriter platen so that information can be typed onto the label. Thereafter the label may be "easily removed from the platen since only a limited portion of the rear surface was affixed to the platen by the pressure sensitive adhesive" (column 2 lines 58-61). Schram further teaches, "The primary consideration in producing this label is that the pressure sensitive coating - regardless of geometric contour - covers only a relatively minor portion of the area of the label."

Clearly the only difference between the product defined by claim 1 of the present application and the label taught by Schram is the specific restriction "non-repetitive" used to define the pattern of pressure-sensitive adhesive islands on the face of the product. However this single difference fails to provide the necessary inventive ingenuity required to merit a Canadian Patent. Schram specifically teaches that the primary consideration is that only a limited area of the surface be covered with the pressure-sensitive adhesive and while only repetitive patterns are illustrated by Schram, those skilled in the art would not require an inventive leap to use a non-repetitive pattern of pressure sensitive adhesive.

Consequently claims 6 to 9 are rejected because the subject matter thereof lacks inventive ingenuity in view of Schram, as the difference thereover is held to be obvious to one of ordinary skill in the art to which the alleged invention pertains.

The question before the Board is therefore whether or not the invention claimed in claims 6 to 9 is obvious in view of the cited prior art.

In its response to the Final Action dated May 9, 1995 the Applicant has argued that Schram discloses a very specialized use of pressure sensitive adhesive together with a moisture sensitive adhesive and that it is not Applicant's intention or desire that the claims of the application cover such products. Accordingly the Applicant has submitted an amended claim 6 limiting the claim and therefore dependent claims 7 to 9 to a product comprising a sheet backing free of any moisture sensitive adhesive. The Board has considered these new claims and considers that they claim products which are sufficiently different from the products disclosed in Schram as to be patentable thereover.

In making this finding the Board has taken into account the judicial test for obviousness set forth in the Federal Court of Appeal decision in Beloit Canada Ltd. et al. v. Valmet Oy 8 C.P.R. (3d) 289, at page 294, namely:

The test for obviousness is not to ask what competent inventors did or would have done to solve the problem. Inventors are by definition inventive. The classical touchstone for obviousness is the technician skilled in the art but having no scintilla of inventiveness or imagination; a paragon of deduction and dexterity, wholly devoid of intuition; a triumph of the left hemisphere over the right. The question to be asked is whether this mythical creature (the man in the Clapham omnibus of patent law) would, in the light of the state of the art and of common general knowledge as at the claimed date of invention, have come directly and without difficulty to the solution taught by the patent. It is a very difficult test to satisfy.

The Board therefore recommends that rejected claims 6 to 9 be replaced by new claims 6 to 9 and that the application be returned to the Examiner for further prosecution consistent with the recommendation.



M. Howarth
Member



M. Wilson
Member

I concur with the recommendation of the Board that rejected claims 6 to 9 be replaced by new claims 6 to 9 and return the application to the Examiner for further prosecution consistent with the Board's recommendation.



P.J. Davies
Acting Commissioner of Patents

Dated at Hull, Quebec,
this 23rd day of March, 1998