

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte  
MELVIN S. FREEDMAN

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Appeal No. 2001-0236  
Application No. 08/985,760

**ON BRIEF**

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Before GARRIS, WARREN and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 54 through 60, 62 through 69, 71 through 77, 79 through 85 and 87 through 89, which are all the claims pending in this application.

## **THE INVENTION**

The invention is directed to a multilayer film facestock. The facestock comprises a coextrudate of at least two layers comprising a base layer and at least one face layer. The base layer is free of filler particles. Additional limitations are provided in the following illustrative claim.

## **THE CLAIM**

Claim 54 is illustrative of appellant' invention and is reproduced below.

54. A multilayer film facestock having an overall thickness of from 1.5 mil to about 6.5 mils for use in pressure-sensitive adhesive label applications comprising a coextrudate of at least two layers comprising a base layer and at least one skin layer wherein the base layer is thicker than the skin layer, said coextrudate having a face side, said base layer comprising a propylene polymer or copolymer free of filler particles, and having a stiffness of from about 10 to 100 Gurley, and said skin layer being on the face side of the coextrudate and having an ink-printable surface, wherein said multilayer film facestock is suitable for die-cutting and stripping.

## **THE REJECTION**

Claims 54 through 60, 62 through 69, 71 through 77, 79 through 85 and 87 through 89 stand rejected under 35 U. S. C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

## OPINION

We have carefully considered all of the arguments advanced by the appellant and the examiner and agree with the appellant for the reasons set forth in the Brief and those herein that the rejection of record is not well founded. Accordingly, we reverse the rejection.

### **The Rejection Under § 112**

We turn to the sole issue before us, that of the examiner's rejection under the first paragraph of 35 U.S.C. § 112 as being directed to new matter. In a rejection under the first paragraph of 35 U.S.C. § 112, paragraph one, it is sufficient if the originally filed disclosure would have conveyed to one of ordinary skill in the art that the appellant had possession of the concept of what is claimed. In re Anderson, 471 F.2d 1237, 1240-41, 176 USPQ 331, 333 (CCPA 1973). There is no requirement that the language of the claimed subject matter be present in the specification in ipsissima verba.

The examiner submits that the language of the claimed subject matter, and in particular, “[t]he statement that the base layer is ‘free of filler particles’ is an unsupported negative limitation.” We disagree.

We find that Figures 1 through 2 disclose coextrudates of two or more layers having filler particles distributed throughout. In contrast, Figures 5 through 7 are directed to

another embodiment wherein similar extrudates are free of filler. In support of our finding, although, the specification is replete with a discussion of the addition of filler to other embodiments of the invention, in the portions of the specification relied upon by appellants, and directed to a discussion of Figures 5 through 7, pages 18 through 24, there is no suggestion or teaching that filler is added to the base layer.

Based upon the above findings and consideration, the rejection of the claimed subject matter by the examiner under the first paragraph of 35 U.S.C. § 112 is not sustained.

### **DECISION**

The rejection of claims 54 through 60, 62 through 69, 71 through 77, 79 through 85 and 87 through 89 under 35 U. S. C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention is reversed.

The decision of the examiner is reversed.

**REVERSED**

BRADLEY R. GARRIS  
Administrative Patent Judge

CHARLES F. WARREN  
Administrative Patent Judge

PAUL LIEBERMAN  
Administrative Patent Judge

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