Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HELMUTH SCHMOOCK

Appeal No. 2001-1818
Application 09/048,533

HEARD: MAY 23, 2002

Before LIEBERMAN, DELMENDO, and MOORE, Administrative Patent Judges.

MOORE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1-3, 5-15, and 32. Claims 16-18, 20-31 and 33 have been withdrawn from consideration, and claims 4 and 19 have been canceled.

CLAIMS

Claim 1 is representative of the claims on appeal, and reads as follows:

1. A foil having two substantially parallel surfaces, comprising: a substrate having a first side at one of said surfaces and a second side; a metallic film vaporized

onto and adhering to said second side of said substrate, said metallic film being devoid of defects; and a protective layer having a first side completely covering said film and a second side facing away from said film, said layer and said film together constituting a coating at the second side of said substrate that is fluidtight against at least one of liquids and gases, and said layer: (a) being vaporized onto the film immediately following vaporization of the film onto said substrate while said film is devoid of defects, (b) having an affinity for the metal of said film, (c) having a thickness between about 0.5μ and about 1/15,000 mm, (d) being an organic material which is at least one of a natural resin, a synthetic resin, a natural wax, or a synthetic wax, (e) being substantially non-smearing.

THE REJECTION

Claims 1-3, 5-15, and 32 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 inventor, at the time the application was filed, had possession of the claimed invention.

We reverse.

DISCUSSION

The present invention is directed to sheet material used for packaging which are resistant to permeation by gases and fluids. The composite as claimed includes a substrate, which is coated on one side by a metallic film vaporized onto the surface of the substrate. The metallic film is then coated by a protective layer vaporized onto the metallic film “while the metallic film 2 is still intact and devoid of defects” (Appeal Brief, page 3, line 16).

The Rejection of Claims 1-3, 5-15, and 32 under 35 U.S.C. § 112, First Paragraph

The Examiner states that:

> The original disclosure does not provide adequate support for the claimed foil comprising a metallic film that is ‘devoid of defects’ (as recited in lines 3-4 of claim 1 as appears on page 1 of the Appendix to the appellant’s brief). While the metallic film is said to be ‘devoid of scratches and/or other defects’ at one point during manufacture of the foil (p.6, l. 15-17), it is not certain that the metallic film

> of the finished product (i.e. the claimed foil) is necessarily devoid of defects/scratches/pin windows. This is particularly questionable in view of the first full paragraph on page 9 which refers to a 'smaller number of pin windows' when the protective coating is applied to the metallic film. Reference to a 'smaller number' of pin windows implies that some pin windows are present and, in view of page 6, lines 21-23, pin windows are defects. (Examiner's Answer, page 3, line 15 - page 4, line 6).

The Appellant, on the other hand, distinguishes the product at various stages of manufacture, asserting that an intermediate product (defined as the post-metallization but pre-protective layer product) is the product that is necessarily devoid of defects. (Appeal Brief, page 6, line 7 - page 7, line 1).

The Examiner points to claim 1 and states that claim 1 is drawn to a finished product (the product comprising a substrate, a metallic film, and a protective layer), and states that claim 1:

> requires the metallic film of the finished product to be "devoid of defects". The examiner maintains the position that the original disclosure does not provide adequate support for the claimed foil which comprises a substrate, a metallic film that is devoid of defects, and a protective layer covering the metallic film. (Examiner's Answer, page 5, lines 6-10).

The Appellant in reply asserts that the metallic film need not forever be free from defects, and does not preclude a film thus formed from later developing defects in subsequent processing. (Reply Brief, page 2, lines 13-21).

A rejection for lack of support in the specification is a rejection under the written description requirement of the first paragraph of §112. See Pall Corp. v. Micron Separations, Inc., 66 F.3d 1211, 1219, 36 USPQ2d 1225, 1230-1231 (Fed. Cir. 1995). The Applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for

purposes of that inquiry, whatever is now being claimed. Vas-Cath v. Mahurkar, 935 F.2d 1555, 1563-1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

We turn to claim 1 and the specific element the Examiner has focused on:

> a metallic film vaporized onto and adhering to said second side of said substrate, said metallic film being devoid of defects;

The specification, at page 6, lines 15-17, describes the application of the protective layer:

> Such [protective] layer is preferably applied to the metallic film while the latter is still devoid of scratches and/or other defects which would render the film permeable to gases.

This amply supports the three-layer structure claimed in claim 1, a substrate, a metallic film devoid of defects (e.g. scratches or pin-holes), and a protective layer. One of skill in the art would recognize that this passage means, at the time of application of the protective layer, a three-component structure is formed which is devoid of defects in the metallic film layer.

It appears to us that the Examiner has focused on a passage at page 9, lines 5-13 which discusses the processing of the metal film after the protective coating is applied. In this discussion, the Applicant states that:

> If a protective coating which has a high affinity to the metal film, is evaporated onto the metal film immediately after coating the metal film, then the large surface tension in the metal film is absorbed due to the high affinity. The metal film then becomes less susceptive to mechanical stress and tends to produce a smaller number of pin windows. The foil onto which the metal film is evaporated, can then be deflected over rollers and wound up without adversely affecting the imperviousness of the metal.

We note that this paragraph relates to later processing of the three-layer structure, i.e. deflecting, rolling, etc. Those later processing steps and the end results of them are not the subject of the present claim; rather, they merely recite what may

happen to the finished product. The claim requires certain features, and although later processing may destroy those features, thereby rendering the end use of the foil (or the foil itself) essentially noninfringing, the scope of our inquiry need not extend that far.

We conclude that the language of the specification conveys to one of skill in the art that the Applicant had possession of the invention as claimed at the filing date of this application.

REVERSED

PAUL LIEBERMAN Administrative Patent Judge	)
ROMULO H. DELMENDO Administrative Patent Judge	) BOARD OF PATENT)
JAMES T. MOORE Administrative Patent Judge	) APPEALS AND) INTERFERENCES

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