

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MELVIN S. FREEDMAN

Appeal No. 2001-2132
Application No. 08/985,443

ON BRIEF

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 rejection of the examiner refusing to allow claims 54 through 57, 59, 61 through 66, 68, 70 through 72, 79, 80 and 82 through 86, and claims 73 through 78 as amended subsequent to the final office action.

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 and has a stiffness of from about 10 to 100 Gurley. Additional limitations are provided in the following illustrative claim.

THE CLAIM

Claim 54 is illustrative of appellant's invention and is reproduced below:

54. A die-cuttable and matrix strippable multilayer film facestock having an overall thickness of from 1.5 mils 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 polyethylene having a density of from 0.89 to 0.965 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.

THE REFERENCE OF RECORD

As evidence of anticipation and obviousness the examiner relies upon the following reference:

Shigemoto

4,380,567

Apr. 19, 1983

THE REJECTIONS¹

Claims 54, 55, 59, 61, 65, 73, 76, 79, 80, 82 and 83 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Shigemoto.

Claims 54 through 57, 59, 61, 64 through 69, 70, 73 through 76, 79, 80, 82 83 and 86 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shigemoto.

OPINION

We have carefully considered all of the arguments advanced by the appellant and the examiner and agree with the examiner that the rejection on the grounds of anticipation and obviousness are well founded. Accordingly, we affirm both rejections.

As an initial matter the appellant has stated that, “the claims fall into a single group.” See Brief, page 5.² Accordingly, we select claim 54, an independent claim as representative of the claimed subject matter and limit our consideration thereto. See 37 CFR §1.192(c)(7) (2000).

¹The rejection under 35 U.S.C. § 112, first paragraph has been withdrawn. See Answer, page 2. The rejections over Takashi under 35 U.S.C. §§ 102 and 103 have been withdrawn. See Answer, page 3.

²All references to the Brief refer to the Substitute Appeal Brief (Paper No. 28).

Rejection under Section 102

It is the examiner's position that the "the claimed stiffness of 10-100 Gurley is inherent of the multilayer film." See Answer, page 6. We agree.

Shigemoto is directed to an ethylenic composite film structure of sandwich structure. See column 1, lines 5-6. We find that the film structure is composed of a layer A of high density polyethylene having a preferable density of 0.950-0.965 which is anticipatory of the claimed density. See column 2, lines 30-42. We further find that the high density polyethylene of Examples 5 and 6 is 0.952, each of which is anticipatory of the claimed density. The high density polyethylene is surrounded by a layer of B of a random copolymer of ethylene and an alpha olefin. See column 1, lines 16-24. We find that the thickness of layer B is 1-20 microns. See column 3, lines 65-67. We find that the thickness of layer A is 5-100 microns. See column 4, lines 9-11. This thickness corresponds to a range in mils of 0.27 mils to 4.72 mils. We further find that the overall thickness of the layer in Examples 5 and 6 is 40 μm which translates to 1.57 mils and is anticipatory of the overall thickness required by the claimed subject matter. Furthermore the base layer A is substantially thicker than the outer layer B as required by the claimed subject matter.

We agree with the examiner's finding that the base layer is free of filler particles inasmuch as the reference is silent with respect to the presence of fillers in the base layer. Furthermore, since patentee utilizes the composition for a transparent packaging material,

one would expect that filler is absent from the article.

As to the “stiffness of from 10-100 Gurley,” it would have been well known to the person skilled in the art that Gurley is a measure of force required to bend paper or paper substitutes. The force required to bend paper or a paper substitute is a function of the material itself. Accordingly, if one were to choose a high density polyethylene having a given length and thickness within the scope of the claimed subject matter, e.g., Examples 5 and 6, the specific parameters chosen would be determinative of the Gurley stiffness measured and accordingly a function of the material itself. Stated otherwise, as the only requirement of the claimed subject matter is directed to a polyethylene having a specific density range and thickness as taught by Examples 5 and 6, and no other parameters are required to determine Gurley stiffness, it follows that Gurley stiffness is a characteristic of the material itself. It is well settled that when appellants’ product and that of the prior art appears to be identical or substantially identical, the burden shifts to the appellant to provide evidence that the prior art product does not necessarily or inherently possess the relied-upon characteristics of appellant’s claimed product. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 597 (CCPA 1980); In re Best, 562 F.2d 1252, 1255-56, 195 USPQ 430, 433-34 (CCPA 1977). Furthermore, the discovery of a new property even when that property is unobvious from the prior art, cannot impart patentability to claims directed to a known composition. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Based upon the above findings of fact and analysis, we conclude

that the Shigemoto reference of record is satisfies the requirement of 10 to 100 Gurley of the claimed subject matter.

As to the terms, “die-cutttable and matrix strippable” inasmuch as Shigemoto teaches the requisite structure based upon the same core layer and a skin layer, it would be expected that the multilayer film of Shigemoto would share the same physical characteristics as that of the claimed subject matter. As stated above, it is well settled that the mere recitation of a newly discovered function or property inherently possessed by compositions known in the prior art, does not cause a claim drawn to these compositions to distinguish over the prior art. Rather, the burden of proof shifts to the appellant to prove that the subject matter shown to be in the prior art does not necessarily possess the characteristic, i.e., “die-cutttable and matrix-strippable” of the claimed product. In re Best, 562 F.2d 1252, 1255-56, 195 USPQ 430, 433-34 (CCPA 1977); In re Skoner 517 F.2d 947, 950-51, 186 USPQ 80, 82-83 (CCPA 1975).

Finally we affirm the rejection both on the grounds of anticipation and obviousness inasmuch as Shigemoto of record discloses particular values anticipatory of the claimed subject matter for the density of the polyethylene and the thickness of each of the core layer and matrix layer. Our determination of anticipation is based on the unique merits of each case. In the instant case, we conclude that the teachings of Shigemoto anticipate values within the range required by the claimed invention. Hence, Shigemoto anticipates the claimed subject matter.

As to the rejection under Section 103, it is well settled that the ultimate obviousness is lack of novelty. The claims cannot have been anticipated and not have been obvious. In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

DECISION

The rejection of claims 54, 55, 59, 61, 65, 73, 76, 79, 80, 82 and 83 under 35 U.S.C. § 102(b) as being anticipated by Shigemoto is affirmed.

The rejection of claims 54 through 57, 59, 61, 64 through 69, 70, 73 through 76, 79, 80, 82, 83 and 86 under 35 U.S.C. § 103(a) as being unpatentable over Shigemoto is affirmed.

The decision of the examiner is affirmed.

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

AFFIRMED

BRADLEY R. GARRIS)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

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PAUL LIEBERMAN)
Administrative Patent Judge)

WARREN, Administrative Patent Judge, Concurring:

I concur with the result reached by this panel.

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)	BOARD OF PATENT
)	APPEALS
CHARLES F. WARREN)	AND
Administrative Patent Judge)	INTERFERENCES

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