

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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WALTER B. MUELLER

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Appeal No. 2003-0358  
Application 08/982,958

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ON BRIEF

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Before WARREN, LIEBERMAN and MOORE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief and reply brief, and based on our review, find that we cannot sustain the grounds of rejections advanced on appeal: claims 1, 2, 4, 5 and 32 through 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noel et al. (Noel) in view of Turnbull et al. (Turnbull), Hsu or Ennis; claims 6 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noel in view of Turnbull, Hsu or Ennis as applied to claims 1, 2, 4, 5 and 32 through 36 above, and further in view of Logan et al. (Logan); and claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Noel

in view of Turnbull, Hsu or Ennis as applied to claims 1, 2, 4, 5 and 32 through 36 above.<sup>1,2</sup> We refer to the examiner's answer and to appellant's brief for a complete exposition of the opposing views of the parties.

In order to establish a *prima facie* case of obviousness, the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988).

We find that, when considered in light of the written description in the specification as interpreted by one of ordinary skill in this art, *see, e.g., In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), including the meaning for certain terms in the claims established in the written description in the specification (pages 7-13), *see, e.g., Morris, supra; Zletz, supra*, the plain language of appealed independent claim 1 specifies a laminate comprising at least two films and a printed image label trapped therebetween. The first film is a substantially gas-impermeable multilayer film capable of delaminating into a gas-impermeable portion and a non-perforated gas-permeable portion, the portions in adherence at a predetermined intra-film cohesive strength. The second film is a perforated, gas-permeable film which is bonded to the non-perforated gas-permeable portion of the first film at a bond strength that is greater than the intra-film cohesive

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<sup>1</sup> Appealed claims 1, 2, 4 through 6 and 32 through 37 are all of the claims in the application. See the appendix to the brief.

<sup>2</sup> Answer, pages 3-9. We have not considered Kocher et al. discussed by the examiner on page 9 of the answer as the reference has not been cited in the statement of any ground of rejection. *See*

strength adhering the two portions of the first film, such that upon delamination of the first film of the laminate, the non-perforated gas-permeable portion will remain bonded to the perforated gas-permeable film. The claimed laminate encompassed by appealed independent claim 32 similarly comprises at least two films and a printed image label trapped therebetween, but differs from appealed claim 1 as there is no requirement for either the gas-permeable portion of the substantially gas-impermeable multilayer film or the gas-permeable film with respect to perforation, which can be the agent for achieving gas-permeability (specification, page 10, lines 21-23).<sup>3</sup> Appealed claims 1 and 32 also encompass laminates which can have additional film layers because of the transitional term “comprising.” See *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the inclusion of other steps, elements, or materials.”).

The threshold issue in this appeal is whether Noel teaches or suggests each and every element of the claimed laminate encompassed by appealed claims 1 and 32 arranged as required by these claims as we have interpreted them above. In response to appellant’s arguments in the brief, the examiner relies on Noel **FIG. 2**, in which web **26** is a multilayer film that “delaminates between a gas impermeable section and gas permeable section (*see* column 5, lines 47+),” and Noel **FIG. 3**, which has multilayer web **66**, along with the teachings of Noel that “the gas permeable film may be one or more layers (col 10, lines 3-5)” (answer, pages 6-8; *see also* pages 3-4). Appellant points out that web **26** consists of a delaminatable multilayer film which is gas-impermeable and that web **66** is a two film laminate wherein the films are separable and not delaminatable (reply brief, page 2). Appellant submits that the examiner’s listing of similarities between the claimed laminate and the film disclosed by Noel fails to identify the film on which the similarities are based, and thus the examiner has not identified the disclosure in Noel which teaches or suggests the modifications of the webs of Noel **FIGs. 2** and **3** to form the claimed

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*In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); compare *Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993).

<sup>3</sup> The trapped printed image or label will inherently remain trapped upon the delamination of the first film because the gas-permeable portion of that film remains bonded to the gas-permeable film in both appealed claims 1 and 32.

laminate of appealed claims 1 and 32, or explained the reason(s) why one of ordinary skill in the art would have made such modifications (*id.*, pages 3-4; *see also* brief, pages 13-16 and 23-25).

We note here that appellant further discusses Noel **FIG. 4** in which multilayer web **126** is a laminate consists of two films, one of which, multilayer film **130**, delaminates into two separate film portions, at least one portion made permeable by perforation, and is bonded to impermeable film **128**, citing col. 6, line 19, to col. 7, line 15 (brief, pages 15-16 and 24). We include consideration of this embodiment of Noel for completeness even though not expressly relied on by the examiner.

A reference can provide the suggestion or motivation to one of ordinary skill in the art to modify the teachings thereof, either expressly or by inference. *See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (“When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted.] This suggestion or motivation need not be expressly stated. [Citation omitted.]”). In this respect, it is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, *see In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

We agree with appellant that the examiner has not established on this record that, *prima facie*, Noel would have reasonably suggested to one of ordinary skill in this art that any of the embodiments illustrated by Noel **FIGs. 2-4** or any other embodiment can be modified by following other teachings or inferences found in this reference so as to arrive at a laminate comprising at least a multilayer gas-impermeable film which must be able to delaminate into a gas-impermeable portion and a gas-permeable portion, bond at the gas-permeable portion to a gas-permeable film such that the two films remain bonded when subjected to a force that delaminates the first film as required by each of appealed claims 1 and 32 as we have interpreted these claims above.

In order to arrive at the laminate structure required by the appealed claims based on the pertinent illustrated embodiments of Noel, one of ordinary skill in this art would have to bond a gas-permeable film to gas-permeable portion **30** of delaminatable film or web **26** of Noel **FIG. 2**; interchange the top film **68** of the multilayer film laminate **66** of Noel **FIG. 3** with a delaminatable film such as film or web **26** of Noel **FIG. 2**; and bond a gas-permeable film to the gas-permeable portion of delaminatable multilayer film **130** opposite bonded impermeable film **128** of multilayer web **126** of Noel **FIG. 4**. We note here that the examiner also takes the position that Noel describes other unspecified embodiments but does not explain how this is so. We cannot agree with the examiner that one of ordinary skill in this art would make such modifications to disclosed and undisclosed embodiments on the sheer basis that Noel teaches monolayer and multilayer films at col. 10, lines 3-5 (answer, pages 3 and 7), including multi-layer gas-*impermeable* films at col. 10, lines 6+ (*id.*, pages 7-8), for several reasons.

First, it seems to us that one of ordinary skill in this art would have reasonably inferred from the objectives and specific embodiments of Noel that the delaminatable film is sealed to the support member of product package at the permeable portion side, and the delaminatable film can be bonded to an impermeable film in order to meet the objects of the invention. *See, e.g.*, col. 3, lines 5-47; col. 4, lines 57-64; and Noel **FIGs. 2** and **4**, and supporting disclosure. Indeed, it is apparent that when the delaminatable film is bonded to an impermeable film, whether the delaminatable film is bonded to such film through an impermeable or permeable portion, the impermeable film along with the portion of the delaminatable film to which it is bonded separate from a permeable portion of the delaminatable film bonded to the support member upon delamination (e.g., col. 6, lines 29-33; see also col. 6, line 56, to col. 7, line 15). Thus, there is no express teaching to bond an additional permeable film to the delaminatable film, such that the resulting laminate is bonded to the support member through the additional permeable film.

And, second, we fail to find that one of ordinary skill in this art would have found in the disclosure at col. 9, line 67, to col. 10, line 35, any suggestion or inference to bond a permeable film to the permeable portion of a delaminatable film which would remain with the product package upon delamination because, as appellant points out (brief, page 16), a multi-layer film is not a multi-film laminate as these terms are used in the appealed claims, and we find that one of

ordinary skill in this art would attribute the same usage to the same terms in the disclosure of Noel at col. 9, line 67, to col. 10, line 35, describing layered films, including those layered films described as delaminatable.

Thus, on this record, we conclude that one of ordinary skill in this art would not have found in Noel the reasonable suggestion to modify the multi-film laminates thereof to obtain the basic laminate structure required by appealed claims 1 and 32, and therefore, even assuming *arguendo* that the multi-film laminate structures taught by Noel were modified to include a printed image or film trapped between the film layers as suggested by the secondary references, the result would not be the claimed laminates encompassed by appealed claims 1 and 32. *See Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988). Therefore, we must conclude that the only direction to appellant's claimed invention as a whole on the record before us is supplied by appellant's own specification.

The examiner's decision is reversed.

*Reversed*

CHARLES F. WARREN	)	
Administrative Patent Judge	)	
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	)	
PAUL LIEBERMAN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
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JAMES T. MOORE	)	
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