

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLF LASSON and PETER OHMAN

Appeal No. 1995-5015
Application 08/036,272¹

HEARD: November 2, 1999

Before OWENS, WALTZ and KRATZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1-4 and 7-17, which are all of the claims remaining in

¹ Application for patent filed March 24, 1993.

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the application.

THE INVENTION

Appellants claim a method for producing a packaging material by applying a film of plastic material to a first surface of a metal foil to form a laminate and securing, by use of a binder material, a second surface of the metal foil of the laminate to a core layer having a hole therein. Claim 9 is illustrative and reads as follows:

9. A method of producing packaging material, comprising the steps of:

applying a first film of plastic material on a first surface of a metal foil to form a first laminate; and

securing a second surface of the metal foil web of the first laminate adjacent a first surface of a core layer with a second film of binder material, the core layer being formed with an opening in the form of a hole.

THE REFERENCES

Holmström et al. (Holmström)	4,256,791	Mar. 17, 1981
Löfgren et al. (Löfgren)	5,122,410	Jun. 16, 1992

THE REJECTIONS

Claims 1-4 and 7-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Holmström in view of Löfgren.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejection is not well founded. Accordingly, we reverse this rejection.

Holmström discloses a method for producing a packaging material wherein a laminate is formed by fastening a metal foil web to a paper or cardboard web by use of a thermoplastic adhesive, the laminate is passed between pressure/cooling rollers, a layer of plastic is extruded onto the metal foil web, and the resulting laminate is passed between another set of pressure/cooler rollers (col. 4, lines 20-32 and 54-56; figure 1). Holmström does not apply a plastic film to a first surface of a metal foil web to form a laminate, and attach a second surface of the metal foil web of the laminate to a core layer by use of a binder material as required by appellants' claims.

Löfgren discloses a method for forming a laminate which

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has good gas and aroma barrier properties and is useful in the manufacture of packaging containers (col. 2, lines 1-13). The laminate is formed by joining two partial laminates, each of which consists of a carrier layer and a barrier layer, by use of a conventional bonding agent (col. 3, lines 45-63; figure 3). The carrier layers are made of a thermoplastic material and the disclosed barrier layer materials are silicon dioxide and silicon nitride (col. 3, lines 1-3 and 24-26).

The examiner argues that Löfgren is relied upon for a teaching that the level of skill in the art was sufficiently high that one skilled in the art would have known how to laminate Holmström's materials in the order recited in appellants' claims, and would have been motivated to do so (answer, page 5).

In order for a *prima facie* case of obviousness of appellants' claimed invention to be established, the prior art must be such that it would have provided one of ordinary skill in the art with both a suggestion to carry out appellants' claimed process and a reasonable expectation of success in doing so. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5

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USPQ2d 1529, 1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.* The mere possibility that the prior art could be modified such that appellants' process is carried out is not a

sufficient basis for a *prima facie* case of obviousness. See *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995).

The examiner has not explained where the motivation referred to by the examiner for modifying Holmström's method is found in the applied references. This motivation appears to come solely from the description of appellants' invention in their specification. Thus, the record indicates that the examiner used impermissible hindsight when rejecting the claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert.*

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denied, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we reverse the examiner's rejection.

DECISION

The rejection of claims 1-4 and 7-17 under 35 U.S.C. § 103 over Holmström in view of Löfgren is reversed.

REVERSED

TERRY J. OWENS

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Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	
Administrative Patent Judge)	APPEALS AND
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