

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HERBERT PEIFFER  
and URSULA MURSCHALL

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Appeal No. 1997-2837  
Application No. 08/377,365

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ON BRIEF

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Before WARREN, WALTZ and KRATZ, Administrative Patent Judges.  
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1 and 3-18, as amended after final rejection. No other claims are pending in this application.

BACKGROUND

invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A biaxially oriented, multilayer polypropylene film comprising at least one base layer B, at least one interlayer Z and at least one top layer D, wherein the film contains an effective amount of at least one migrating additive, the total amount of migrating additive or additives being not more than 0.15% by weight, based on the total weight of the film; wherein, if the migrating additive is silicone oil, the silicone oil has a viscosity in the range from 5,000 to 1,000,00 mm<sup>2</sup>/s; and wherein, prior to the migrating of any said migrating additive, said base and top layer or layers is or are essentially free of migrating lubricant additives and migrating antistatic additives.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bothe	5,151,317	Sep. 29, 1992
Murschall et al. (Murschall)	5,246,769	Sep. 21, 1993
Peiffer et al. (Peiffer)	5,292,563	Mar. 08, 1994
Schuhmann et al. (Schuhmann)	5,326,625	Jul. 05, 1994

Claims 1, 3-7, 9-11 and 13-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bothe in view of Peiffer. Claims 8 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bothe in view of Peiffer further taken with Schuhmann or Murschall.

and the examiner. In so doing, we find ourselves in substantially complete agreement with the examiner's factual findings as well as the examiner's conclusion that the applied references establish the obviousness, within the meaning of 35 U.S.C. § 103, of the claimed subject matter for reasons as set forth in the answer. Moreover, we agree with the examiner's rebuttal of appellants' arguments as set forth in the answer. Accordingly, we will sustain the examiner's § 103 rejections and we add the following for emphasis only.

Rejection of Claims 1, 3-7, 9-11 and 13-18

Appellants have identified eight separate groups of claims, seven of which pertain to the examiner's first mentioned § 103 rejection (brief, pages 6-8). However, appellants have not separately argued the patentability of each separate group of claims, let alone each separate claim with any reasonable degree of specificity with respect to the rejections that remain before us. See 37 CFR § 1.192(c)(7) and (c)(8)(iv)(1995). In this

3-7, 9-11 and 13-18 to stand or fall together, on this record. We select claim 1 as the representative claim in deciding this appeal. In any event, we note that a sufficient explanation of the rejections of the appealed claims is found in the examiner's answer to refute appellants' position as set forth in the brief relative to those separately grouped claims.

Bothe discloses a readily printable or coatable biaxially oriented, multi-layer polyolefinic film including five layers comprising a base layer of polypropylene, two intermediate layers and two outer sealing layers. Bothe teaches that the two intermediate layers include polymers having substantially the same chemical composition as the base layer except for the melt flow index (column 3, lines 1-6). As explained by the examiner (answer, page 5), Bothe forms the multi-layer film by a method substantially corresponding to appellants' method (see, e.g. appealed claim 17).

Bothe teaches that additives such as slip agents, antistatic agents, etc, may be included in the base intermediate and sealing

relative to the layer (column 4, lines 23-26). Moreover, Bothe discloses that antistatic agents such as the saturated aliphatic tertiary amines described at column 4, lines 5-13 of the patent may be employed in amounts of about .05 to 3%, by weight, relative to the weight of the respective layer.

Appellants' film may include corresponding additives as indicated at page 20, line 18, through page 21, line 9, of the specification. As generally acknowledged by appellants (brief, page 4), those types of additives including aliphatic amides and tertiary amines are well known to migrate within the multi-layer film to the surface thereof. In this regard, appealed claim 1 requires that the base and top layer(s) of appellants' film are "essentially free of migrating lubricant additives and migrating antistatic additives" albeit at least one such additive is required to be present in the film in an effective amount.

We construe the "essentially free..." clause of appellants' claims as not requiring that the inner or outer layer of the final multi-layer film to which it applies be free of such

section of the supplement amendment accompanying the brief and the portions of appellants' specification referred to therein. That amendment was approved for entry by the examiner (answer, page 4)<sup>1</sup>.

Consequently, in addition to the obviousness rationale furnished by the examiner in the answer, we find that Bothe reasonably suggests a product film that substantially corresponds to the film of appellants' claim 1 based on the overlapping amounts of migratory antistatic and slip additives to be used as taught by Bothe. While appellants may not directly add such additives to the base and outer (top) layer(s) prior to finishing the manufacture of their product, it is clear, on this record, that the finished multi-layer product film may include such additives in those base and outer layers by way of migration.

In this regard, we note that claims 1, 15 and 18 and the claims which depend therefrom are drawn to a product that is described, at least partially, in terms of the process by which it is made. The patentability of such claims is determined based

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227 USPQ 964, 966 (Fed. Cir. 1985) ("If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process."). Whether a rejection is under 35 U.S.C. § 102 or § 103, where, as here, appellants' product and that of the prior art appear to be identical or substantially identical, the burden shifts to appellants to provide evidence that the prior art product does not necessarily or inherently possess the relied upon characteristics of appellants' claimed product. See In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977); In re Fessmann, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. See Best, supra; In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). Appellants have not met this burden.

Nor have appellants furnished any separate convincing

to one of ordinary skill in the art based on the combined teachings of Bothe and Peiffer.

Appellants' arguments with regard to the prior art use of migratory additives in the core and top layer are not persuasive for the reasons set forth by the examiner in the answer and for the additional reason that the herein claimed invention does not exclude such additives in the core and top (outer) layers of the final product as explained above. We note that appellants have not advanced a particularized argument based on a detailed showing establishing unexpected results co-extensive with the scope of the claimed subject matter.

#### Rejection of Claims 8 and 12

With respect to the examiner's § 103 rejection of claims 8 and 12, appellants do not contend that the additionally applied Murschall and Schuhmann references in combination with Bothe and Peiffer would not have rendered the additional limitations of those claims obvious to one of ordinary skill in the art. See

CONCLUSION

The decision of the examiner to reject claims 1, 3-7, 9-11 and 13-18 under 35 U.S.C. § 103 as being unpatentable over Bothe in view of Peiffer and to reject claims 8 and 12 under 35 U.S.C. § 103 as being unpatentable over Bothe in view of Peiffer further taken with Schuhmann or Murschall 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

CHARLES F. WARREN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
THOMAS A. WALTZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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PETER F. KRATZ	)	
Administrative Patent Judge	)	

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Appeal No. 1997-2837  
Application No. 08/377,365

Page 11

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