

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER W. PHILLIPS, LAUREN R. WENDT,
MYRA TAN-JOHNSON, DAVID W. TODD
and CHARLES T. MARKANTES

Appeal No. 1998-1416
Application No. 08/062,736

HEARD: August 16, 2001

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

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 18-22, 25 and 27. Claims 23, 24, 26 and 28 have been indicated as allowable by the examiner (answer, page 4). Claims 1-17 and 29-42, which are all of the other claims pending

respective positions articulated by appellants and the examiner. We have treated the claims separately to the extent appellants have argued the limitations of each claim separately consistent with 37 CFR § 1.192 (c) (7) and (c) (8) (1997). In so doing, we find that the examiner's § 102 rejection of claims 20-22 and 27 is not sustainable. However, we concur with the examiner's conclusion with respect to claims 18, 19 and 25. Accordingly, we will sustain the § 102(b) rejection of claims 18, 19 and 25. Our reasoning follows.

Initially we note that anticipation by a prior art reference does not require that reference to recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade

what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

In the case before us, we determine that Jones discloses, either expressly or inherently, every limitation of the invention set forth in claims 18, 19 and 25. As found by the examiner (answer, page 4), Jones describes a method for forming a transparent barrier film including:

the steps of providing a flexible plastic substrate, e.g., polypropylene, evaporating an aluminum oxide barrier layer having a thickness within the presently claimed range, i.e., 0.02 μm (200 Angstroms), directly onto the flexible plastic substrate and forming a heat seal layer on the barrier layer, as presently claimed (col. 2, lines 15-22; col. 3, lines 27-29; col. 4, lines 39-40; col. 5, lines 30-39, for instance). The method of Jones provides materials that are "highly gas- and liquid-impermeable" (col. 2, lines 18-20, for instance) and, therefore, the barrier layer of Jones necessarily is formed to reduce oxygen and water permeability, as recited in the instant claims.

We further note that Jones particularly describes a preference for the use of vacuum evaporation in depositing the

19 and 34-40 of Jones. Hence, Jones anticipates the method recited in appealed claims 18 and 19. Regarding dependent claim 25, Jones (column 4, lines 41-44) describes the use of an electron beam in evaporating the coating and consequently anticipates that claim, as well.

Appellants refer to Table 5² of Jones in the brief and reply brief and essentially urge that Jones only teaches the use of aluminum oxide as part of a mixture,³ such as Alundum. However, the teachings of Jones are clearly not limited to the working examples. See In re Fracalossi, 681 F.2d 792, 794 n. 1, 215 USPQ 569, 570 n.1 (CCPA 1982); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976). As correctly determined by the examiner (answer, page 6), Jones does reasonably describe the use of aluminum trioxide as a coating material.

Appellants (brief, page 9) acknowledge that Jones teaches the deposited inorganic coating "must have a thickness greater than 0.02 microns to be effective." Concerning this matter, it is well settled that the disclosure in the prior art of any value

anticipation of the claimed range. See In re Wertheim, 541 F.2d 257, 267, 191 USPQ 90, 100 (CCPA 1976); Ex parte Lee, 31 USPQ2d 1105, 1106 (Bd. Pat. App. & Int. 1993). Moreover, a prior art range which touches or substantially overlaps a claimed range anticipates, prima facie, the claimed range. See Atlas Powder Co. v. IRECO Inc., 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945-46 (Fed. Cir. 1999). Consequently, the arguments put forth by appellants in the brief and reply brief are not persuasive to the extent that they urge that there is a difference in appellants' coating thickness over that disclosed by Jones. Appellants also contend that various unclaimed features such as a particular degree of water or oxygen permeability reduction or the moving of the substrate while coating differentiate the claimed invention over Jones. Of course, arguments directed at such unclaimed limitations are not well taken.

Since claims 18, 19 and 25 have been appropriately rejected under 35 U.S.C. § 102, any evidence alleging unexpected results is irrelevant. See In re Malagari, 499 F.2d 1297, 1302, 182 USPQ

examiner's § 102 rejection of those appealed claims over Jones for the reasons set forth above and in the answer.

Our disposition of the examiner's § 102 rejection of claims 20-22 and 27 is another matter. The examiner has the initial burden of establishing a prima facie case of anticipation by particularly pointing out where all of the claim limitations are described in a single reference. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). This the examiner has not done with respect to the latter mentioned claims. See page 4, 14 and 15 of the brief.

Other Issue

As a final point, we note that appellants describe admitted prior art at pages 1, 2 and the paragraph bridging pages 25 and 26 of the specification. Moreover, Jones describes the use of a laminating adhesive in Examples 15 and 16, albeit a silicon monoxide coating was used in those examples. The examiner is advised to determine the full extent of the admitted prior art as



the claimed subject matter obvious within the meaning of 35 U.S.C. § 103 prior to final disposition of this application.

CONCLUSION

The decision of the examiner to reject claims 18, 19 and 25 under 35 U.S.C. § 102 as being anticipated by Jones is affirmed. The decision of the examiner to reject claims 20-22 and 27 under 35 U.S.C. § 102 as being anticipated by Jones is reversed.

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

AFFIRMED-IN-PART

PAUL LIEBERMAN)	
Administrative Patent Judge)	
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PETER F. KRATZ)	APPEALS
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