

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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte

MICHAEL FRANCIS WEBER and ANDREW JOHN OUDERKIRK

Appeal No. 2003-0090
Application No. 09/006,379

Heard: May 8, 2003

Before WALTZ, TIMM, and JEFFREY T. SMITH, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 21-25, 27-34, and 56. Claims 1-20 and 35-54, the only other claims pending in the application, stand withdrawn from consideration pursuant to a restriction requirement. We have jurisdiction over the appeal under 35 U.S.C. § 134.

THE CLAIMED SUBJECT MATTER

As claims 21-25, 27-34, and 56 are grouped together (Brief at 5), we focus on the only independent claim, claim 21. Claim 21 reads as follows:

21. An article in the form of a free-standing film comprising:

- (a) a base comprising a polymer layer having a major surface; and
- (b) an anti-reflective stack optically coupled to said major surface of said base

that reduces the reflectivity of said base at said major surface over a wavelength range of interest,

said stack comprising alternating layers of (i) high index polymer; and (ii) low index polymer.

THE EVIDENCE

As evidence of unpatentability, the Examiner relies upon the following prior art reference:

Schrenk et al. (Schrenk)

5,103,337

Apr. 7, 1992

THE REJECTION

Claims 21-25, 27-34, and 56 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Schrenk. We affirm substantially for the reasons given in the Answer. We add the following primarily for emphasis.

OPINION

Claim 21 is directed to a free-standing film. The film includes a base and an anti-reflective stack. The stack is optically coupled to the major surface of the base. The stack reduces the reflectivity of the base at the major surface at a particular wavelength range. The stack comprises alternating layers of high index and low index polymers. Claim 21 requires the base to have a polymer layer. The specification indicates that the base may include a plurality of alternating layers of different indices of refraction (specification at 4, ll. 6-9).

Schrenk describes an optical interference film made of multiple layers of polymers with different indices of refraction. The film is substantially transparent to wavelengths of light in the visible spectrum (Schrenk at col. 2, ll. 32-37). Schrenk also characterizes the film as suppressing two or more successive higher order reflections in the visible range of the spectrum (Schrenk at col. 3, ll. 44-49). In other words, the film is anti-reflective. The layers have differing refractive indices in repeating units of ABCB, which, according to the Examiner (Answer at 5) and undisputed by Appellants, meet the requirements of the alternating “high index” and “low index” polymer layers. The Examiner finds that an outer layer of the Schrenk film is a base layer in accordance with claim 21 (Answer at 3).

Appellants make two related arguments. First, they argue that Schrenk does not teach “the base whose reflectivity is reduced by optical coupling of an anti-reflective stack to a major surface of the base.” Second, they argue that Schrenk does not teach “an anti-reflective stack

which is capable or [sic: of] reducing reflectivity of another object (e.g. a base) that is external to the stack.” (Brief at 6).

We agree that Schrenk does not expressly state that reflectivity is reduced in the manner claimed. However, the mere recitation of a newly discovered property, inherently possessed by a prior art product, does not cause a claim drawn to that product to distinguish over the prior art. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Therefore, where the prior art is silent with respect to the property, but the examiner has reason to believe that the property may, in fact, be an inherent characteristic of the prior art product, the examiner possesses the authority to require an applicant to prove that the subject matter shown to be in the prior art does not, in fact, possess the property. *Id.*

Here, the Examiner has reason to believe that the property is inherent based on the similarity of the construction of the film to that claimed and disclosed in the specification. We particularly note that the specification indicates that the base layer may include a plurality of alternating layers of polymers with different indices of refraction (specification at 4, ll. 6-9). Thus, the entire film may be multiple stacks of polymers of alternating indices of refraction. That is what Schrenk teaches. Given that there is a reasonable basis to believe that the anti-reflection property is inherently present in the film of Schrenk, it is reasonable to shift the burden to Appellants to prove that, in fact, the prior art film does not necessarily or inherently possess the characteristics of the claimed product. *Best*, 562 F.2d at 1254, 195 USPQ at 433. Whether the rejection is based on “inherency” under 35 U.S.C. § 102, or on “*prima facie* obviousness”

under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the inability of the examiner to manufacture products or to obtain and compare prior art products. *Id.*; *see also In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

As Appellants provide no showing that the claimed film is, in fact, necessarily different than the film of Schrenk, we conclude that the Examiner has established a *prima facie* case of unpatentability which has not been sufficiently rebutted by Appellants.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 21-25, 27-34, and 56 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 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

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