

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JUANITA MERCURE, DAVE MICHALEK, DENNIS OLHEISER,  
THOMAS SCARBOROUGH, TROY TAYLOR and THOMAS SIFFORD

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Appeal No. 2005-0279  
Application No. 10/036,708

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ON BRIEF

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Before WILLIAM F. SMITH, GARRIS and JEFFREY T. SMITH,  
Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-4, 6-18, 20-24 and 27-29.

The subject matter on appeal relates to an extrusion-laminated reinforced shrink wrap comprising first and second layers of thermoplastic, wherein at least one of these layers comprises a shrink film, a reinforcing grid disposed between

these layers, and a tie layer of elastomeric material disposed between the layers and holding the reinforcing grid but allowing slippage of the grid in the tie layer upon tensile loading, wherein the first and second layers, the reinforcing grid and the tie layer are extrusion laminated together to form the reinforced shrink wrap and wherein the elastomeric tie layer has a lower modulus than at least one of the thermoplastic layers. This appealed subject matter is adequately represented by appealed independent claim 1 which reads as follows:

1. An extrusion-laminated reinforced shrink wrap comprising:

a first layer of thermoplastic;

a second layer of thermoplastic;

at least one layer of said first and second layers comprising a shrink film of highly irradiated polyolefin;

a reinforcing grid disposed between the first and second layers of thermoplastic; and

a tie layer of elastomeric material disposed between the first layer and the second layer holding the reinforcing grid but allowing slippage of the reinforcing grid in the tie layer upon tensile loading,

wherein the first layer, the second layer, the reinforcing grid and the tie layer are extrusion laminated together to form the reinforced shrink wrap, and wherein the elastomeric tie layer has a lower modulus than at least one of the thermoplastic layers.



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describes a tie layer of elastomeric material whereas patentee discloses a flexible adhesive layer but considers these layers to be indistinguishable because appellants' elastomeric material and patentee's flexible adhesive may in each case be an acrylic based material (cf., the last paragraph on page 8 of the subject specification and lines 9-15 in column 4 of the applied reference).<sup>2</sup> In addition, although Wynne does not disclose that his various layers and reinforcing grid are extrusion laminated together to form the reinforced shrink wrap as recited in appealed claim 1, the examiner nevertheless reaches an unpatentability determination on the grounds that the ultimate products disclosed by Wynne and defined by claim 1 appear to be identical. In support of this determination, the examiner cites, for example, In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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<sup>2</sup>It is here appropriate to emphasize that the appellants (unlike the examiner) are well positioned to determine whether the flexible adhesive used by Wynne is encompassed by the elastomeric material tie layer of claim 1 since the real party of interest for the subject application (see page 1 of the brief) and the Wynne patent (see the title page) is the same, namely, Reef Industries, Inc. Indeed, the inventive entities listed for the subject application and the Wynne patent include a common inventor (i.e., Dennis Olheiser).

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The appellants disagree with the examiner's finding that the here claimed tie layer is indistinguishable from Wynne's adhesive layer. This disagreement is expressed on page 4 of the brief in the following manner:

An adhesive layer is altogether different from a tie layer due to the differences in the lamination process used for the two layers. Three lamination technologies are commonly used and known in the art: adhesive lamination, thermal (or heat) lamination, and extrusion lamination. Adhesive lamination uses an **adhesive layer** applied onto one of the substrates prior to combination of the thermoplastic layers. Thermal (or heat) lamination melts the **adhesive layer**, either by heated rollers or a heated oven prior to combination. Extrusion lamination, on the other hand, uses a molten polymer web that serves as a **tie layer**. The tie layer would not work (at last not very well) in an adhesion lamination process, and the adhesive layer likewise would not work in an extrusion lamination process. Therefore, disclosure of an adhesive layer cannot constitute disclosure of the claimed layer.

The appellants above quoted argument is unpersasive for two reasons. First, it is completely unsupported on the record of this appeal. Second, and more importantly, this argument is directly contradicted by the appellants' own specification disclosure. In particular, the appellants' aforequoted assertion that "[t]he [here claimed] tie layer would not work . . . in an adhesion lamination process . . ." is contrary to the disclosure at lines 20-21 on specification page 15 that, "[w]hile an

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extrusion lamination method is used to make the reinforced shrink wrap, other lamination methods, such as an adhesive lamination, may also be employed" (emphasis added). Especially because this disclosure militates for the examiner's position and against the appellants', the argument under consideration must be considered to lack perceptible merit.

The appellants also argue that the here claimed tie layer is functionally different from Wynne's adhesive layer. This argument appears on page 4 of the brief as follows:

The adhesive layer [of Wynne] does not allow slippage of the grid while simultaneously maintaining lamination. Rather, as is known in the art, the adhesive layer must delaminate in order to allow movement of the grid. This aspect of the adhesive layer is noted by Wynne: "[t]he grid should sag to prevent further tearing." Col. 2, ll. 39-40. The "sagging" effect refers to the delamination of the adhesive from the grid.

Again, this argument is not supported by the record of this appeal. In this regard, the appellants urge that "[t]he 'sagging' effect [disclosed at lines 39-40 in column 2 of Wynne] refers to the delamination of the adhesive from the grid" (id.). However, this disclosure of Wynne does not at any point use the term "delamination" to describe the desired sagging of his grid. Contrariwise, patentee explicitly teaches that his "adhesive

should be used in an effective amount to prevent delamination" (column 2, lines 35-36; emphasis added) and that his "adhesive should not be an excessive amount that retards the movement of the grid under stress such as puncture" (column 2, lines 37-39; emphasis added). In our view, these teachings undermine the appellants' position and reinforce the examiner's. It follows that this argument likewise is unpersuasive.

On pages 4 and 5 of the brief, the appellants contend that their tie layer and extrusion-lamination process result in different properties and thus a different product than the adhesive layer containing product of Wynne. As support for this contention, the appellants refer to the data in Table 1 on page 5 of the brief.<sup>3</sup> Pursuant to the appellants' interpretation of this data, "[a] shrink wrap made in accordance with the claimed invention has a 3" Load @ Yield that is almost twice that of a shrink wrap made using an adhesive layer such as disclosed in *Wynne*" (brief, pages 4-5). As fully explained by the examiner in

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<sup>3</sup>The brief inappropriately fails to identify the source of this Table 1 data. Our independent study of the application record indicates that the data has been obtained from Table 5 on page 13 of the appellants' specification and from Table 2 in column 4 of the Wynne patent.

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the answer, this table does not provide a proper comparison of the appellants' claimed and patentee's disclosed products since, for example, the thicknesses of the compared tie and adhesive layers are completely different. As a consequence, the differing yield results, upon which the appellants base their aforementioned arguments, are without probative value.

In light of the foregoing and for the reasons expressed in the answer, we fully share the examiner's determination that the reinforced shrink wrap defined by appealed claim 1 is indistinguishable from the reinforced shrink wrap of Wynne. Thus, on the record before us, the claim 1 shrink wrap including the tie layer and the characteristics thereof appear to be identical to patentee's shrink wrap including the adhesive layer and characteristics thereof. Therefore, we consider the record before us to evince a prima facie case of anticipation. This record likewise evinces a prima facie case of obviousness based on the proposition that lack of novelty is the ultimate of obviousness. See In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

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Concerning the issue of obviousness, the appellants proffer the declaration dated March 26, 2001 by Dennis J. Olheiser which is said to show that the appellants' claimed product has unexpectedly superior properties compared to the product of Wynne. As again correctly pointed out by the examiner in the answer, the proffered comparison is inappropriate. For example, because the declarant has not specifically identified the compositions and thicknesses of the compared layers, it is impossible to assess what, if any, probative value should be given to the differing yield strengths exhibited by the compared products. Stated otherwise, the declaration data is insufficient to evince that the claim 1 product differs at all, much less unexpectedly so, compared to Wynne's product. As a final point regarding the appellants' assertions of unexpected properties, we point out that a Section 103 rejection is not rebuttable by such evidence when, as here, the rejection actually is based on the ultimate of obviousness, namely, lack of novelty. Fracalossi, id.

In conclusion, it is appropriate to emphasize that, where the claimed and prior art products are identical or substantially identical, as here, the Patent and Trademark Office can require

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an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on "inherency" under 35 U.S.C. § 102, 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 Patent and Trademark Office to manufacture products or to obtain and compare prior art products. In re Best, 652 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

This burden of proof has not been carried by the appellants on the record of this appeal for the reasons fully detailed above and in the answer. We hereby sustain, therefore, the examiner's Section 102 and Section 103 rejections of all appealed claims based on the patent to Wynne.

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The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. and TM Office 21 (September 7, 2004)).

AFFIRMED

WILLIAM F. SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
BRADLEY R. GARRIS	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JEFFREY T. SMITH	)	
Administrative Patent Judge	)	

BRG:hh

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