

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 TIMOTHY S. SAMMARCO,  
THOMAS Z. FU, WILLIAM L. BROWN  
and  
ALEXANDER A. KOUKOULAS

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Appeal No. 2005-1369  
Application 10/307,464

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ON BRIEF

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Before GARRIS, KRATZ, and DELMENDO, Administrative Patent Judges.  
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1, 3, 4 and 6-12.

The subject matter on appeal relates to a laminated board structure comprising a paperboard substrate and a pigmented opaque polymer film applied thereto, wherein the board structure yields a particular range of Sheffield smoothness and Parker

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print surface smoothness and wherein the pigmented opaque polymer film is applied to the substrate board by extrusion or by hot melted adhesion. This appealed subject matter is adequately represented by independent claim 1 which reads as follows:

1. A laminated board structure for enhanced graphics packaging comprising:

a paperboard substrate; and

a pigmented opaque polymer film applied directly to the substrate board,

wherein the board structure yields a Sheffield smoothness of 100-350 SU and a final Parker print surface smoothness from 1.5-4.0 microns when measured using a pressure of 10 kgf/cm<sup>2</sup> and wherein the pigmented opaque polymer film is applied to the substrate board by extrusion or by hot melt adhesion.

The reference set forth below is relied upon by the examiner in the § 102 and § 103 rejections before us:

Cavagna et al. (Cavagna)                      4,898,752                      Feb. 6, 1990

All of the appealed claims are rejected under 35 U.S.C. § 102(b) as being anticipated or alternatively under 35 U.S.C. § 103(a) as being unpatentable over Cavagna.<sup>1</sup>

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<sup>1</sup> On page 2 of the Brief, the appellants state: "Appealed claims do not stand or fall together as will be more apparent from the Arguments set forth below." Accordingly, in assessing the merits of the above-noted rejections, we will separately

(continued...)

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For a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner regarding these rejections, we refer to the Brief and Reply Brief and to the Answer respectively.

#### OPINION

For the reasons set forth in the Answer and below, we will sustain the rejections advanced on this appeal.

With regard to the § 102 rejection, it is well settled that anticipation is established when a prior art reference expressly or inherently contains each and every limitation of the claimed subject matter. See Schering Corp. v. Geneva Pharm., Inc., 339 F.3d 1373, 1379, 67 USPQ2d 1664, 1668-69 (Fed. Cir. 2003).

Thus, a finding of anticipation is not forestalled merely because, as argued by the appellants, Cavagna fails to

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<sup>1</sup>(...continued)  
consider the individual claims to the extent that they have been separately argued as well as separately grouped. See In re Dance, 160 F.3d 1339, 1340 n.2, 48 USPQ2d 1635, 1636 n.2 (Fed. Cir. 1998). Also see former regulation 37 CFR § 1.192(c)(7) (2003) as well as current regulation 37 CFR § 41.37(c)(1)(vii) (September 2004).

expressly teach such here-claimed characteristics as the smoothness values defined by appealed independent claim 1. Indeed, the examiner's unpatentability position is based upon the proposition that patentee's laminated board structure would necessarily and inherently possess such characteristics.

For example, the examiner logically argues that the claim 1 smoothness values are indistinguishable from those of Cavagna because the Sheffield units of patentee's substrate are within the here-claimed range (see lines 12-14 in column 2) and, since an even smoother surface would be created when the polymer film is placed on this substrate, the Sheffield units of Cavagna's ultimate laminated board structure by necessity also would fall within the here-claimed range.

In this latter regard, the appellants seem to believe that Cavagna does not teach that his ultimate product, namely, a polymer coated paperboard, has a smoother surface than the paperboard substrate. Such a belief is contrary to patentee's explicit disclosure on lines 51-60 of column 3 wherein Cavagna describes his invention as a coated paperboard product and states that the purpose of his invention "is to upgrade at least one

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surface of an otherwise inexpensive, unbleached, paperboard material to a more . . . smooth surface" (id. at lines 55-59).

In addition, on page 1 of the Reply Brief, the appellants state:

Assuming, arguendo, that Cavagna . . . requires a substrate smoothness within the claimed range the reference in no way teaches or suggests a specific smoothness for a coating applied to the substrate.

This statement, however, does not militate against the propriety of the examiner's rejection. As explained above, notwithstanding the absence of an express teaching, a finding of anticipation nevertheless is correct when properly based on a theory of inherency. Schering Corp., 339 F.3d at 1379, 67 USPQ2d at 1668-69.

The appellants further argue that the claim 1 requirement for a polymer film applied by extrusion or by hot melt adhesion distinguishes from Cavagna because patentee's polymer film or coating is applied via a printing method. This argument is not convincing. As properly explained by the examiner in the Answer, claim 1 is directed to a product in the form of a laminated board structure, and the patentability determination of this claim is based on the product itself rather

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than the process by which it is made (i.e., the process of applying the polymer film by extrusion or by hot melt adhesion as recited in claim 1). See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). On the record of this appeal, the claim 1 product including the polymer film thereof, though made by a different extrusion or hot melt adhesion process, is indistinguishable from the product of Cavagna.

Concerning these matters, it is the appellants' basic contention that the examiner has the burden of showing unpatentability rather than the appellants' burden to show the contrary. Under the circumstances before us, this contention is not well founded. Where, as here, the claimed and prior art products appear to be identical, the Patent and Trademark Office can require 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, "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, 562 F.2d 1252, 1255, 195 USPQ

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430, 433-34 (CCPA 1977). As indicated previously, the appellants have not carried their burden of showing that Cavagna's product does not actually possess the characteristics of the product defined by appealed independent claim 1.

Analogous reasoning applies to the separately argued dependent claims. For example, although Cavagna contains no express teaching of the internal bond strength values defined by dependent claim 4, it is reasonable to regard patentee's product as inherently possessing such internal bond strength values since this product and the appellants' claimed product are intended for similar uses (e.g., as packaging material) and therefore would require similar strength characteristics. On this record, the appellants have provided no evidence in support of a contrary view.

In light of the foregoing and for the reasons expressed in the Answer, it is our ultimate determination that the examiner has established a prima facie case of unpatentability which the appellants have failed to successfully rebut with argument or evidence of patentability. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We hereby sustain,

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therefore, the examiner's § 102 and § 103 rejections of all  
appealed claims based on the Cavagna reference.

The decision of the examiner is affirmed.

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

AFFIRMED

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
PETER F. KRATZ	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

BRG:psb

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