

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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARTOLOMEO FORZANO
and GIANFRANCO FERRERO

Appeal No. 2006-0548
Application 10/381,877

ON BRIEF

Before WARREN, WALTZ and FRANKLIN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 11, all of the claims in the application.

Claim 1 illustrates appellants' invention of a plastic sheeting, and is representative of the claims on appeal:

1. Plastic sheeting designed for mulching and/or as a barrier for retaining treating agents, particularly soil sterilants and for preventing said treating agents from being diffused in the atmosphere, wherein the covering sheet comprises a layer of polyamide or of mixtures of pure polyamides or of mixtures of a polyamide and one or more different polymers or of mixtures of several polyamides and one or more different polymers.

The references relied on by the examiner are:

Percec et al. (Percec)	5,084,352	Jan. 28, 1992
Basset et al. (Basset)	5,846,661	Dec. 8, 1998

The examiner has rejected appealed claims 1, 8, 10 and 11 under 35 U.S.C. § 102(b) as being anticipated by Basset (Office action mailed August 17, 2004 (Office action), page 2); appealed claims 1 through 8 as being anticipated by Percec (Office action, page 3); and appealed claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Basset (Office action, page 3).^{1,2}

Appellants argue each of the rejected claims individually. Thus, we decide this appeal based on each of the appealed claims. 37 CFR § 41.37(c)(1)(vii) (September 2004).

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the answer and to the brief³ and reply brief for a complete exposition thereof.

Opinion

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported finding advanced by the examiner that as a matter of fact, *prima facie*, appealed claims 1, 8, 10 and 11 are anticipated by Basset, and claims 1 through 8 are anticipated by Percec. Therefore, in view of the *prima facie* case of anticipation made out by the examiner, we have again evaluated all of the evidence of anticipation and non-anticipation based on the record as a whole, giving due consideration to the weight of appellants' arguments in the brief and reply brief. *See generally, In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3. (Fed. Cir. 1990).

In order to review the examiner's application of prior art to appealed claims 1, 8, 10 and 11, we first interpret these claims by giving the terms thereof the broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art in light of the written description in the specification unless another meaning is intended by appellants as established in the written description of the specification, and without reading into the claims any limitation or particular embodiment disclosed in the specification. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830

¹ The examiner states that the grounds of rejection are set forth in the Office action (answer, page 3).

² The claims stated to stand rejected in the answer includes claim 12 which was not pending as of the Office action (*see* Official Action Summary).

(Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The plain language of independent claim 1 specifies a plastic sheeting comprising at least one layer of 1) polyamide; 2) mixtures of pure polyamides; 3) mixtures of a polyamide and one or more different polymers; or 4) mixtures of several polyamides and one or more different polymers, wherein the “different polymers” are *any* kind of polymer other than a polyamide. The transitional term “comprises” opens the claim to include plastic sheeting that includes other materials and layers, including additional layers of any polymers. *See generally, Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) (“The claimed composition is defined as comprising - meaning containing at least - five specific ingredients.”); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”).

The preambular language of claim 1 specifies that the plastic sheeting must at least be capable of being used for mulching plants and can have barrier properties, but otherwise adds no limitation to the claimed sheeting. *See In re Stencel*, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987), and cases cited therein (“Whether a [statement] . . . of intended purpose constitutes a limitation to the claims is, as has long been established, a matter to be determined on the facts of each case in view of the claimed invention as a whole.”). To the extent that the cited language of appealed product claim 1 is intended by appellants as a method or process of *use* limitation of the claimed sheeting, such a limitation has no place in a product claim. *Cf. In re Wiggins*, 397 F.2d 356, 359 n.4, 158 USPQ 199, 201-02 n.4 (CCPA 1968), and cases cited therein (“[A]ppellant’s discovery of the analgesic properties of ‘O₂’ and of a composition containing it could properly be claimed only as a method or process of using that compound or composition in accordance with the provisions of 35 U.S.C. 100(b) and 101.”).

Appealed dependent claims 2, 3, 5, 6 and 8 further limit multi-layer sheeting encompassed by claim 1 by specifying that one outer layer (claims 2, 5, 6 and 8) or the two outer layers (claim 3) must consist of one of the polyamide containing layers as specified in claim 1.

³ We consider the brief filed May 9, 2005.

Appealed dependent claims 4 and 6 further limit multi-layer sheeting encompassed by claim 1 by specifying an inner layer of different polymers, with claim 4 specifying polyethylene. Claim 5 further limits multi-layer sheeting encompassed by claim 1 by specifying that the multi-layer sheeting can have an intermediate compatibility layer, that is, a layer which has the properties of being compatible with an adjacent layer.

Appealed dependent claim 7 further limits multi-layer sheeting encompassed by claim 1 by specifying that the intermediate layer(s) must be “intercalated in a certain order” but fails to specify that order other than requiring only that the intermediate layer(s) are “attached and/or coextruded directly or with the interposition of compatibility layer.” Appealed dependent claim 9 further limits the single layer sheeting and multi-layer sheeting encompassed by claim 1 by specifying that the single and multi-layer sheeting “may have a thickness of the order of 10 to 100 micron” and can have polyamide containing “layers as thick as a few micron to a few tenths of micron,” which limitations appear to express a desideratum with respect to thickness.

Appealed dependent claim 10 further limits the single layer sheeting and multi-layer sheeting encompassed by claim 1 by stating examples of “other polymers” including the obviously non-limiting expression “or others,” none of which limits the “one or more different polymers” specified in claim 1 in any respect.⁴

Appealed dependent claim 11 specifies a method of soil treatment which includes the step of disposing on the soil “a sheeting” encompassed by any one of the preceding claims, that is, the sheeting is laid on the soil in any fashion and stretched to some extent, however small, wherein the sheeting or a layer thereof is impermeable to gases of treating agents in the soil.

Turning now to the grounds of rejection under § 102(b), it is well settled that the examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the

⁴ We suggest that upon further prosecution of the appealed claims subsequent to the disposition of this appeal, the examiner consider whether the language of appealed claims 7, 9 and 10 complies with 35 U.S.C. § 112, second paragraph, in view of the deficiencies that we find in these claims.

claim, is described identically in the reference, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof. *See Spada*, 911 F.2d at 708, 15 USPQ2d at 1657.

Considering first the ground of rejection based on Basset, appellants contend, with respect to appealed claim 1, that this reference “specifically teaches away from the use of” the claimed sheeting, pointing to col. 2, ll. 3-4, wherein the reference discloses that the sheeting thereof which is, or includes as a layer, a film prepared from “at least one polyamide and at least one polyolefin” (see, e.g., col. 1, ll. 43-46) is “not pierced when it is walked on, whereas a polyamide film of the same thickness becomes pierced” (brief, pages 13-14). In this respect, appellants argue that the reference “states that a polyamide film” like “a polyamide film of one or more layers” as claimed, “does not perform satisfactorily in Basset’s invention,” and further distinguishes “the polymer mixtures with polyolefin of Basset from other films made from essentially polyamide and polyethylene” (*id.*). Appellants further argue that “the unexpected mechanical properties of the polyamide film of the present invention when compared to existing systems” is described in their specification (*id.*, page 14). Appellants submit essentially the same “teaching away” arguments with respect to claims 8, 10 and 11 (*id.*, pages 14-16).

We cannot subscribe to appellants’ position. Whether Basset would teach away from the claimed method is not an argument that addresses the issue of anticipation. *See Celeritas Technologies Ltd. V. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998) (“[T]he question whether a reference ‘teaches away’ from the invention is inapplicable to an anticipation analysis.”). Furthermore, the appealed claims clearly encompass sheeting which is, or includes as a layer, a film prepared from “mixtures of a polyamide and one or more different polymer,” as we have interpreted the claims above, which limitation certainly includes the sheeting or layer prepared from a mixture of “at least one polyamide and at least one polyolefin” taught by Basset. We find no basis in the language of the appealed claims or in the written description in appellants’ specification on which to read into the claims any limitation with respect to mechanical properties of the claimed sheeting, *see Morris*, 127 F.3d at 1054-55, 44 USPQ2d at 1027; *Zletz*, 893 F.2d at 321-22, 13 USPQ2d at 1322, and whether a property of a claimed sheet would distinguish over the films of Basset is also not a consideration with respect to the issue of anticipation. *See, e.g., Spada*, 911 F.2d at 709, 15 USPQ2d at 1658; *In re*

Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974); *see also In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

Considering now the ground of rejection based on Percec, appellants again rely on a “teaching away” argument, pointing to Percec’s description of the disclosure of a particular United States Patent at col. 2, ll. 5-7 (brief, pages 17-18), which, of course, is not the multi-layer films specifically disclosed by Percec. Appellants also argue that the claimed sheeting is not similar to that of Percec because the former is a barrier for soil treating agents and the latter is a barrier film for packages, and therefore, “the packaging film of Percec would not be effective for the soil treating system of the present invention,” again relying on “unexpected mechanical properties” of the claimed polyamide films “compared to existing systems,” contending that “Percec teaches away from the use of polyamide as the main strengthening layer” (*id.*, pages 17-21).

Arguments with respect to “teaching away” and “unexpected mechanical properties” are not relevant to the issue of anticipation, as we discussed above. Furthermore, the examiner finds that specific multilayer films as disclosed by Percec contain polyamide in the outer and inner layers, including the combination of polyamide with different polymers, and that the films thus would fall within the claimed sheeting as a matter of fact (Office action, page 3). Appellants have not advanced argument established otherwise with respect to the relied on disclosure of the reference.

Accordingly, we have again considered the totality of the record before us, weighing all of the evidence of anticipation found in Basset and in Percec with appellants’ countervailing arguments for non-anticipation in the brief and reply brief, and based thereon, conclude that the claimed invention encompassed by appealed claims 1 through 8, 10 and 11 would have been anticipated as a matter of fact under § 102(b).

Turning now to the ground of rejection of appealed claim 9 under § 103(a) over Basset. We cannot agree with appellants’ argument that the disclosure at col. 2, ll. 3-4, of Basset, discussed above, and at col. 2, ll. 5-7, of the reference, which involves only a “comparison with a polyethylene film” and not “other films made from essentially polyamide and polyethylene” as appellants contend, would teach away from the film disclosed by Basset on which the examiner relies (brief, pages 17-18). In fact, the film of Basset falls within appealed claim 9, as we have

interpreted this claim above. In any event, we find that Basset discloses a sheeting which “may be between 20 and 150 μm ” and a bi-layer sheeting in which the polyamide layer can “[a]dvantageously” be “10 to 150 μm ” (col. 4, ll. 21-33). We determine that one of ordinary skill in this art routinely following the teachings of Basset to apply the sheeting taught therein as a gas barrier in soil treatment would have determined workable or optimum sheeting thicknesses for particular soil treatment conditions. *See In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (“[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”). Appellants allegation of “unexpected mechanical properties” is not supported by evidence vis-à-vis the films of Basset. *See In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) (“This court has said . . . that mere lawyers’ arguments unsupported by factual evidence are insufficient to establish unexpected results. [Citations omitted.]”); *In re Hoch*, 428 F.2d 1341, 1343-44, 166 USPQ 406, 409 (CCPA 1970) (evidence must provide an actual comparison of the properties of the claimed compositions with compositions of the reference).

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in Basset with appellants’ countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claim 9 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner’s decision is affirmed.

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Application 10/381,877

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2005).

AFFIRMED

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