

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 HANS-RUDOLF NAGELI, FRANZ KOLB,
WERNER HAMMON and WERNER HARTMANN

Appeal No. 2006-1246
Application No. 09/726,372

HEARD: June 06, 2006

Before KIMLIN, JEFFREY T. SMITH and FRANKLIN, Administrative Patent Judges.
JEFFREY T. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 28 to 55, all of the pending claims. We have jurisdiction under 35 U.S.C. § 134.

BACKGROUND

The present invention relates to a process for the production of an aluminum foil coated with a sealable and sterilizable plastic. (Brief, pp. 2-3).

Representative claim 28, as presented in the brief, appears below:

28. A process for production of an aluminum foil (10) coated with a sealable and sterilizable plastic (14) based on polypropylene (PP) or polyethylene (PE), comprising coextruding the plastic (14) with an adhesion-promotion agent (6) [sic., (16)], to form a coextrudate, combining the coextrudate of plastic (14) and adhesion-promotion agent (16) with an aluminum foil (24) between two rollers (20,22), the temperature of the coextruded-coated aluminum foil being such that the temperature at outer surface of the plastic (14) of the coextrudate of the plastic (14) and the adhesion-promotion agent (16) lies below the crystallite melt point (T_K) of the plastic (14), then passing continuously the coextruded-coated aluminum foil (10), to increase the adhesion strength between the aluminum foil (24) and the plastic coating (14), through an oven (26) with temperature (T_o) set so that the temperature at the outer surface of the plastic (14) of the coextrudate of the plastic (14) and the adhesion-promotion agent (16) lies above the crystallite melt point (T_K) of the plastic (14), and cooling the coextruded-coated aluminum foil (10) heat-treated in this way, after emerging from the oven (26), in a shock-like manner such that the crystalline portion of at least in the outer surface area of the cooled plastic coating (14) and the crystal grains in this outer surface area are as small as possible.

In addition to the prior art cited on page 3 of the specification, the Examiner relies on the following reference in rejecting the appealed claims:

Heyes et al. (Heyes)	5,093,208	Mar. 03, 1992
Takano et al. (Takano)	5,837,360	Nov. 17, 1998

GROUND OF REJECTION

(a) Claims 28 to 55 stand rejected under 35 U.S.C. § 112 first paragraph, as lacking an adequate written description in the specification as originally filed.

(b) Claims 28, 29, 51, 52 and 55 stand rejected under 35 U.S.C. § 102(b) as anticipated by the Heyes.

(c) Claims 30 to 50, 53 and 54 stand rejected under 35 U.S.C. § 103(a) as obvious over Heyes and Takano.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejections, we make reference to the Answer (mailed December 15, 2005) for the Examiner's reasoning in support of the rejections, and to the Brief (filed October 19, 2005) for the Appellants' arguments they're against.

OPINION

Upon careful review of the respective positions advanced by Appellants and the Examiner, we affirm the rejection under § 112, first paragraph. We enter a new ground of rejection and reverse the remaining rejections on procedural basis.

112 First Paragraph Rejection

Claims 28 to 55 stand rejected under 35 USC § 112 first paragraph, as lacking an adequate written description in the specification as originally filed.

It is well settled that a specification complies with the 35 U.S.C. § 112, first paragraph, written description requirement if it conveys with reasonable clarity to those

skilled in the art that, as of the filing date sought, the inventor was in possession of the invention. See Vas Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563 64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Edwards, 568 F.2d 1349, 1351 52, 196 USPQ 465, 467 (CCPA 1978); In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

It is the Examiner's position that the following phrase of independent claims 28 and 55 is not described in the specification as originally filed: "that the temperature at [outer] surface of the plastic [(14) of the coextrudate of the plastic] (14) and the adhesion-promotion agent (16) lies below the crystallite melt point (T_K) of the plastic (14)." See Answer, page 3.

Appellants' argue, Brief pages 37-38, the following statement filed in the November 26, 2002 amendment establishes written descriptive support for the amendment to the record:

"Applicants extrude a coextrudate onto the aluminum foil and then heat the aluminum foil with the coextrudate thereon by continuously passing it through an oven at a temperature set so that the temperature of the surface of the polypropylene coating and the acid-modified polypropylene lies above the crystallite melt point of the polypropylene. The coextruded-coated aluminum foil is then immediately shock-like cooled (e.g., at least 10°C) so that the crystalline proportion at least in the surface area of the cooled polypropylene coating and the crystal grains in this area are as small as possible."

"Since the oven heating requires that the temperature of the surface of the polypropylene coating and the acid-modified polypropylene of the exiting coextruded-coated aluminum coating lies above the crystallite melt point of the polypropylene, the temperature of the surface of the polypropylene coating and the acid-modified polypropylene of the coextruded-coated aluminum entering the oven lies below the crystallite

melt point of the polypropylene. This is implicit disclosure in applicants' specification. Original independent process Claim I, for example, did not recite increasing the crystalline melt point temperature of the polypropylene, so the temperature (of the surface of polypropylene and the acid-modified polypropylene) had to be below the crystalline melt point temperature of the polypropylene. In this manner, applicants' process is substantially and unobviously different from the process of Takano et al." [Page 10, line 26, to page 11, line 15]

Upon careful examination of the drawings, the specification and Appellants' arguments we conclude that the person of ordinary skill in the art would readily correlate the points of intersection of the first lines and second lines as markers, identified by Appellants as indicia 54, 56 and 58.

We determine that the disclosure as originally filed does not reasonably convey to one of ordinary skill in the art that Appellants, was in possession of the invention as presently claimed.

The written description requirement of § 112, first paragraph, entitles the Appellants to claim only that which is disclosed in application, and does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. Cf. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991)("[T]he applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed."). In the present case Appellants argue that the disputed subject matter

is “implicit” in the original disclosure. (Brief, p. 37). The Appellants have not directed us to evidence in the specification or in the drawings that describes the temperature of the aluminum foil and coextruded plastic prior to combining and exiting the oven. We have not been directed to portions of the record that explain that the temperature of the aluminum foil lines and coextruded plastic necessarily was below the crystalline melting point of polypropylene prior to entering the oven. While it might have been possible that the temperature of the aluminum foil lines and coextruded plastic was below the crystalline melting point of polypropylene prior to entering the oven, this is not the proper standard for determining if the record provides an adequate written disclosure. In view of the above, the present specification and drawings do not provide descriptive support for claims 28 and 55 in the manner provided for in the first paragraph of § 112.

Appellants’ arguments regarding claim 47, have been considered. Specifically Appellants state:

Claim 47 requires that the temperature of the aluminum foil be at room temperature when the aluminum foil and the coextrudate are combined. Since specific embodiments/examples and Figures in appellants' disclosure do not spell out the temperature of the aluminum foil, scientific and technical convention (plus a C.C.P.A. decision) attributes room temperature thereto (unless otherwise shown by circumstances, etc.). Therefore, Claim 47 has been shown to not involve new matter, and does not rise or fall with any other claim.

Appellants in the Brief have not directed us to a particular C.C.P.A. decision or the specific scientific principle that provides support for this argument. As such, these arguments are not persuasive for the reasons stated above.

We now turn to the remaining rejections.

The initial inquiry into determining the propriety of the Examiner's §§ 102(b) and 103(a) rejections is to correctly construe the scope of the claimed subject matter. Gechter v. Davidson, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032 n.3 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Upon careful review of the claimed subject matter in light of the specification, it is apparent to us that the metes and bounds of the claimed subject matter cannot be ascertained. Therefore, we are unable to determine the propriety of the Examiner's § 102(b) rejection. To do so would require speculation with regard to the metes and bounds of the claimed subject matter for reasons set forth below. See In re Wilson, 424, F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Accordingly, we procedurally reverse the Examiner's §§ 102(b) and 103(a) rejections¹ and enter a new ground of rejection against the claims on appeal as shown below:

¹ This procedural reversal is not based upon the merits of the Examiner's §§ 102(b) and 103(a) rejections.

Pursuant to the provisions of 37 CFR § 41.50(b)(2004) claims 28 through 55 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the appellants regard as his invention.

A principal purpose of the second paragraph of § 112 is to provide those who would endeavor, in future enterprises, to approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

As the court stated in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of § 112 is

To determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [Footnote omitted.]

Upon review of Appellants' disclosure (which includes Figures 1 and 2), we cannot find a clear depiction of the crystal grains in the outer surface area. There is no indication of an acceptable size for the crystal grains in the outer surface area. As such, it is not possible to determine the size of the grains in the outer surface and whether these grains

are as small as possible. Thus, the claims, as presently written, do not circumscribe the boundaries of the claims with a reasonable degree of particularity.

In light of the above noted inconsistencies in each of the independent claims on appeal, i.e., claims 28 and 55, we are of the view that one of ordinary skill in the art cannot ascertain the boundaries of protection sought by the claims on appeal. Thus, we determine that the appealed claims run afoul the requirements of the second paragraph of § 112.

CONCLUSION

The rejection of claims 28 to 55 under 35 U.S.C. § 112 first paragraph, as lacking an adequate written description in the specification as originally filed is affirmed. In view of the new rejection set forth above, the Examiner's §§102(b) and 103(a) rejections are procedurally reversed. All the claims stand newly rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides a[n] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.

37 CFR § 41.50 (b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

TIME FOR TAKING ACTION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

Affirmed

EDWARD C. KIMLIN
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

BEVERLY A. FRANKLIN
Administrative Patent Judge

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