UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THORBJORN ANDERSSON,
TOM KJELGAARD and IB LETH

Appeal No. 2006-1960
Application No. 10/380,877

HEARD: July 12, 2006

Before WALTZ, KRATZ and FRANKLIN, ***Administrative Patent Judges***.
WALTZ, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's refusal to allow claims 1, 4 through 7, and 9 through 11, which are the only claims pending in this application, as amended subsequent to the final rejection (see the amendments dated April 11, 2005, and June 10, 2005, entered as per the Advisory Actions dated May, 2, 2005, and July 7, 2005, respectively).

According to appellants, the invention is directed to packaging laminates of multilayer structures including a core layer, one or more gas barrier layers, one or more liquid tight layers, a binder/adhesive layer and a layer of a lamination or sealing agent, where the lamination agent is a polypropylene with a melting point of above 130°C. (Brief, pages 2-3). Claim 1 is illustrative of the invention and is reproduced below:

> 1. A packaging laminate for a retortable packaging container, comprising a core layer, outer, liquid-tight coatings and a gas barrier disposed between the core layer and one outer liquid-tight coating, wherein the gas barrier is bonded to the core layer by a layer of a lamination or sealing agent which has a higher melting point than a maximum temperature to which the retortable packaging container is to be subjected during a heat treatment in a retort, and wherein the core layer is a paper or paperboard layer, wherein the lamination or sealing agent is a polypropylene with a melting point of above 130°C.

The examiner has relied on Kato et al. (Kato), U.S. Patent No. 5,527,622, issued Jun. 18, 1996, as the evidence supporting the rejections on appeal (Answer, page 3). Claims 1, 5-7, and 9-10 stand rejected under 35 U.S.C. § 102(b) as anticipated by Kato (Answer, page 4). Claims 1, 4-7, and 9-11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kato (Answer, page 6).

We reverse both rejections on appeal essentially for the reasons stated in the Brief, Reply Brief, and for those reasons set forth below.

OPINION

The examiner finds that the packaging laminate disclosed by Kato in Figure 2(D) shows elements corresponding to every element as set forth in the claims (Answer, page 4, citing Table 1). With regard to the claimed limitation that the lamination agent is a polypropylene with a melting point above 130°C., the examiner finds that Kato discloses an adhesive layer (40) that can be ADMER, a commercial adhesive, which is the "same type of adhesive used by applicants" (Answer, page 5).

Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. *See In re King,* 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). The examiner fails to point to any express disclosure of Kato regarding the claimed limitation that the laminating agent is a polypropylene with a melting point above 130°C. (see the Answer in its entirety). Therefore we must presume that the examiner is relying on inherency, i.e., the inherent properties of ADMER since the examiner finds that both Kato and appellants use this commercial

adhesive. See Table 1 on page 4 of the Answer, where the examiner finds that the ADMER adhesive layer (40) of Kato corresponds to the claimed lamination adhesive (16).

As correctly argued by appellants (Brief, pages 6-7; Reply Brief, page 6), appellants only disclose ADMER as a suitable bonding agent for *binder* layers 15, 25 or 29 (specification, page 10, ¶[0037], and page 14, ¶[0057]), not as a specific material used for the laminating agent layer 16 or 26. As also correctly argued by appellants (Brief, pages 8-10; Reply Brief, page 3), the examiner has not established that the adhesive layer (40) of Kato would inherently possess a melting point above 130°C. *See In re Robertson,* 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(The examiner, if relying on a theory of inherency, must provide a basis in fact and/or technical reasoning to reasonably support a determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art). The only evidence on this record establishes that ADMER adhesives have melting points *above and below* 130°C. (Answer, page 9; Brief, Appendix IX). Thus we determine that the examiner has not established that the adhesive taught by Kato would necessarily possess the claimed property.

For the foregoing reasons and those stated in the Brief and Reply Brief, we determine that the examiner has not met the burden of establishing that each and every limitation of the claims is described, expressly or inherently, by Kato. Therefore we reverse the rejection of claims 1, 5-7, and 9-10 under section 102(b) over Kato.

With regard to the section 103(a) rejection over Kato, we adopt our remarks from above, as well as noting that the examiner has not established any reason one of ordinary skill in this art would have modified Kato to use adhesives with a melting point above 130°C. We also note, as correctly argued by appellants, that there would be no reason to modify Kato with adhesives melting at above 130°C. since the sterilization processes and drying taught by Kato use temperatures no higher than 80°C. (Reply Brief, pages 4-5; see Kato, col. 3, ll. 3-7, and col. 11, ll. 15-23). Accordingly, we cannot sustain the examiner’s rejection of claims 1, 4-7 and 9-11 under section 103(a) over Kato.

The decision of the examiner is reversed.

REVERSED

THOMAS A. WALTZ Administrative Patent Judge	)	
PETER F. KRATZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
BEVERLY A. FRANKLIN Administrative Patent Judge	)	

TAW/sld

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Prepared By:

DRAFT TYPED: 01 Aug 06

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