

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD G. RODICK

Appeal 2007-1906
Application 11/127,887
Technology Center 1700

Decided: June 29, 2007

Before CHUNG K, PAK, PETER F. KRATZ, and JEFFREY T. SMITH,
Administrative Patent Judges.

KRATZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 1-4, 6-8, 10, 15-18, 20-22, and 24-32, the only claims that remain pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 6.

Appellant presents an invention directed to a polymeric film that is conformable and useable as a facestock (Specification 4:2-6). The facestock is disclosed as being capable of accepting a holographic layer. *Id.* The facestock is such that the resulting holographic image suffers little cracking or flaking when employed as part of a label. *Id.* Claims 1 and 26, which are directed to a machine direction oriented polymeric film are illustrative and reproduced below:

1. A machine direction oriented only monolayer film comprising

(A) at least one propylene copolymer having a melt flow rate of at least about 4 g/10 min., and

(B) at least one polyethylene,

wherein the film has been oriented by stretching in the machine direction at a stretch ratio of about 2:1 to about 9:1 and then heat set or annealed to provide dimensional stability.

26. A machine direction only oriented multilayer film comprising

(A) a base layer having an upper surface and a lower surface, and comprising polyethylene, a propylene homopolymer, a propylene copolymer, or a blend of a propylene homopolymer and a propylene copolymer, and

(B) a first skin layer comprising a blend of

(B-1) at least one propylene homopolymer or propylene copolymer, and

(B-2) at least one polyethylene wherein said skin layer overlies the upper surface of the base layer, and

(C) a second skin layer having an upper surface and a lower surface wherein the upper surface of the second skin layer underlies the lower surface of the base layer, and the second skin layer comprises a blend of a polyethylene and a propylene homopolymer or copolymer, and the multilayer film has been oriented in the machine direction at a stretch ratio of from about 2:1 to about 9:1 and then heat set or annealed to provide dimensional stability.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Freedman US 6,461,706 B1 Oct. 8, 2002

Claims 1-4, 6-8, 10, 15-18, 20-22, and 24-32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Freedman. We affirm.

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *accord Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). However, anticipation by a prior art reference does not require that the reference recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. *See Verdegaaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987).

Anticipation under this section is a factual determination. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 390, 21 USPQ2d 1281, 1283 (Fed. Cir. 1991) (citing *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)).

Claims 1-4, 6-8 and 10 are argued as a group and claims 15-18, 20-22, and 24-34 are argued together as another group. We select claims 1 and 26

as the representative claims on which we shall decide this appeal as to these respective groupings of rejected claims.

Claims 1-4, 6-8 and 10

Representative claim 1 requires a machine direction oriented monolayer film comprising a propylene copolymer having a specified melt flow rate and at least one polyethylene, which can be an ethylene copolymer. The propylene copolymer ingredient can be a propylene-ethylene copolymer. The film is recited as possessing a specified stretch ratio and is recited as possessing some dimensional stability as a result of heat setting or annealing.

The base or core layer of Freedman can be made individually at least as an intermediate product film (col. 8, ll. 34-41 and 56-58). Appellant does not challenge with any particularity the Examiner's determination that Freedman discloses a polymeric machine direction oriented monolayer film having a stretch ratio and dimensional stability within the scope of representative claim 1 (*see* the Answer at 3 and 4 and the Brief in its entirety). Rather, Appellant contends that Freedman does not disclose that the propylene copolymers in the core layer film thereof can include an ethylene copolymer. The Examiner contends otherwise.

Thus, the principal issue raised in this appeal with respect to the Examiner's anticipation rejection of representative claim 1 is: has Appellant identified reversible error in this rejection by asserting that Freedman does not disclose that its core layer can include an ethylene copolymer? We answer this question in the negative and affirm the Examiner's anticipation rejection of representative claim 1 and the rejected claims grouped therewith.

The Examiner has essentially found that Freedman describes that the core layer can include a blend of one or more propylene copolymers and a propylene homopolymer, wherein the propylene copolymer blend includes ethylene as a co-monomer in one of the propylene copolymers and another higher alpha olefin monomer in another propylene copolymer; hence describing an embodiment that representative claim 1 reads on and is anticipated by (Final Office Action 3; Answer 3, 5, and 6; Freedman, col. 3, ll. 48-50; col. 4, ll. 21-31 and 34-39, and Table II).¹

Appellant does not dispute that their claimed polyethylene component is inclusive of a copolymer of ethylene, including and ethylene/propylene copolymer. Rather, Appellant maintains that the propylene and ethylene copolymer of Freedman is not an ethylene copolymer, as required to meet the polyethylene component (B) of representative claim 1. In this regard, Appellant argues that:

Freedman (as well as Appellant) has defined propylene copolymers as generally comprising copolymers of propylene and up to about 40% by weight of at least one alpha-olefin selected from ethylene and alpha olefins containing from 4 to about 8 carbon atoms. (Column 4, lines 20-25). Freedman refers to these copolymers which contain a major amount of propylene as being "propylene copolymers", not "ethylene copolymers".

¹ See *In re Schaumann*, 572 F.2d 312, 316-17, 197 USPQ 5, 9 (CCPA 1978) (prior art preferred genus which disclosed limited species, inclusive of claimed species, constituted description of the claimed species within the meaning of 35 U.S.C. §102(b)); *In re Petering*, 301 F.2d 676, 681, 133 USPQ 275, 280 (CCPA 1962) (prior art genus containing only 20 compounds inherently anticipated a claimed species within the genus because "one skilled in [the] art would . . . envisage each member" of the genus).

There is no teaching or suggestion in Freedman that the term "propylene copolymers" as used therein includes the copolymers known in the art as "ethylene copolymers." In fact, it should be clear from a reading of the entire Freedman specification that the term "propylene copolymers does not include ethylene copolymers". For example, Freedman teaches that the first skin layer consists essentially of at least one polyolefin having a density of about 0.940 g/cm^2 or less, and such polyethylenes generally are referred to in the art as low density or medium density polyethylenes. Column 5, lines 43-48. Low density polyethylenes, such as linear low density polyethylene (LLDPE) are known in the art to be copolymers of ethylene and a lesser amount of an alpha olefin containing from 3 to 20 carbon atoms. See, for example, Encyclopedia of Polymer of Science and Technology, Volume 2, pages 441-442, John Wiley & Sons, Inc. 2003, Attachment A, and the patents cited by Freedman in column 5, lines 54-55 which describe processes for preparing low density polyethylenes which are ethylene copolymers. Accordingly, Freedman makes a clear distinction between "propylene copolymers" and low density polyethylenes.

Since the Examiner has not cited any authority in support of his position that the propylene copolymers as described by Free[d]man would include ethylene copolymers, the rejection of claims 1-4, 6-8 and 10 should be reversed. These claims are novel and are not obvious over Freedman.

(Br. 7 and 8).

In other words, Appellant is of the view that the claimed polyethylene component includes only ethylene/propylene copolymers that require more ethylene than propylene content whereas the propylene/ethylene copolymer of Freedman is a copolymer that can include only a lesser amount of ethylene than propylene. We disagree with this contention.

It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent

with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Here, Appellant provides in the Specification, under a Detailed Description of a Preferred Embodiment heading, a description of propylene copolymers that may be used in the base layer as being copolymers that “generally comprise . . . up to about 40% by weight of at least one alpha-olefin selected from ethylene and alpha-olefins containing from 4 to about 8 carbon atoms” (Specification 8). Also, the Specification provides that the polyethylene component of the film “may comprise a polyethylene, such as low density, linear low density, high density, very high density polyethylene as well as ethylene copolymers” (Specification 10).

Clearly, these statements make it clear by the permissive term “may” that they are not limiting definitions for the claim terms “propylene copolymer” and “polyethylene” or “ethylene copolymer” for the disclosed preferred embodiment much less narrow definitions that must be applied to the claim terms in giving the appealed claims their broadest reasonable construction as they would be understood by one of ordinary skill in the art. Indeed, the Specification proclaims that:

While the invention has been explained in relation to its preferred embodiments, it is to be understood that various modifications thereof will become apparent to those skilled in the art upon reading the specification. Therefore, it is to be understood that the invention disclosed herein is intended to

cover such modifications as fall within the scope of the appended claims.

(Specification 29).

Moreover, the referred to selection from the Encyclopedia of Polymer Science and Technology (Br. Appendix B) directed to linear low density polyethylene does not serve to prove that Appellant's use of the claim term "polyethylene" would have been construed by one of ordinary skill in the art as excluding copolymers of propylene and ethylene, as disclosed by Freedman for use in the base (core) film layer.

From our perspective, the Examiner has properly construed the pending claims by giving them their broadest reasonable construction as they would be understood by one of ordinary skill in the art. The Examiner has correctly found that the claim term polyethylene is inclusive of ethylene copolymers, as evidenced by dependent claim 8. Furthermore, the Examiner has correctly determined that an ethylene copolymer, as claimed, is inclusive of copolymers of ethylene with other monomers, such as propylene, without any constraints on the relative amounts of the monomers employed therein.

Contrarily, Appellant has not persuasively explained why copolymers containing propylene and ethylene of the applied reference would not have been reasonably construed as ethylene copolymers within the scope of representative claim 1 (*see* dependent claim 8). Thus, Appellant has not identified any reversible error in the Examiner's anticipation rejection of representative claim 1 and the rejected claims grouped therewith.

Claims 15-18, 20-22, and 24-34

Representative claim 26 requires a multilayer film including a base layer and two skin layers. One skin layer overlies the upper surface of the base layer and the other skin layer underlies the lower surface of the base layer. Each of the skin layers comprises a blend of a polyethylene with at least one propylene polymer (either homopolymer or copolymer).

The Examiner has found that Freedman describes a machine direction oriented multilayer film including a core (base) layer and two tie (skin) layers (Answer 3, 6, and 7). The Examiner has found that the base layer of Freedman comprising a blend of polypropylene homopolymer and copolymer (Answer 3). Also, the Examiner has determined that the tie layer of Freedman is part of the skin layer and comprises a blend of a polyethylene and polypropylene, including propylene homopolymer (Answer 3).

Appellant does not dispute that the multilayer film of Freedman has been oriented in the machine direction with a stretch ratio and includes a base layer as claimed. Nor does Appellant contend that Freedman's film does not possess dimensional stability imparted thereto by heat or annealing. Nor does Appellant contend that the tie layer of Freedman does not include a polypropylene homopolymer and polyethylene. Rather, Appellant contends that the tie layer of Freedman is not part of the skin layer. Thus, it is contended that Freedman does not disclose a multilayer film with skin layers comprised of polyethylene and a propylene homopolymer, as required by representative claim 26.

Thus, the main issue raised in this appeal with respect to the Examiner's anticipation rejection of representative claim 26 is: has

Appellant identified reversible error in this rejection by asserting that Freedman does not disclose skin layers comprised of a blend of polyethylene and polypropylene homopolymer? We answer this question in the negative and affirm the Examiner's anticipation rejection of representative claim 26 and the rejected claims grouped therewith.

Representative claim 26 employs the transition term "comprising" in reciting the base layer, first skin layer, and second skin layer as being parts of the multilayer film. The transition term "comprising" leaves the claim open to the inclusion of other elements or materials. *See In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981). Thus, representative claim 26 is open to the presence of other layers in the multilayer film, including the presence of other skin layers.

Freedman discloses tie layers (36 and 37, Fig. 3) on opposite outside surfaces of base layer (32, Fig. 3). Freedman discloses that blends of propylene homopolymer and polyethylene are utilized in the tie layer (col. 7, ll. 30-37). Because the tie layers of Freedman are located outside of the base layer (over and under the base layer), the Examiner has reasonably found that the tie layers of Freedman correspond to the first and second skin layers of representative claim 26 (Answer 3, 6 and 7). While Freedman also discloses, first and second skin layers (34 and 36, Fig. 3) that are located outside of the tie layers, these outer skin layers do not take away from Freedman's disclosure of the tie layers, which are, in effect, inner skin layers that tie the outer skin layers (34 and 36) to the base layer (32).

Appellant's argument that the tie layers of Freedman are separate or distinct from the skin layers thereof and could not be considered as the here claimed skin layers is not persuasive. This is because representative claim

Appeal 2007-1906
Application 11/127,887

26 does not preclude the presence of other skin layers that are located outside of the recited first and second skin layers in light of the open transitional term “comprising” that is employed therein. *See In re Self*, 671 F.2d 1344, 1350-1351, 213 USPQ 1, 7 (CCPA 1982).

Accordingly, Appellant has not established reversible error in the Examiner’s anticipation rejection of representative claim 26 and the rejected claims that are grouped therewith.

It follows that we will sustain the Examiner’s anticipation rejection.

OTHER ISSUE

Prior to final disposition of this application, the Examiner should take appropriate action with respect to the Information Disclosure Statement filed June 06, 2007.

CONCLUSION

The Examiner’s decision to reject claims 1-4, 6-8, 10, 15-18, 20-22, and 24-32 under 35 U.S.C. § 102(e) as being anticipated by Freedman is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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Appeal 2007-1906
Application 11/127,887

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