

The opinion in support of the decision being entered today  
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* LI-MIN TAU, PAK-WING S. CHUM,  
SEEMA KARANDE, and CLIVE BOSNYAK

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Appeal No. 2007-2665  
Application No. 11/216,805  
Technology Center 1700

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Decided: August 30, 2007

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Before CHUNG K. PAK, CATHERINE Q. TIMM, and JEFFREY T. SMITH,  
*Administrative Patent Judges.*

SMITH, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1-14. We have jurisdiction under 35 U.S.C. § 6. Claim 1 is illustrative:

1. A film comprising a first layer, the first layer comprising a first polymer, the first polymer comprising at least about:

(a) 50 weight percent propylene, and

(b) 5 weight percent ethylene;

the first layer characterized as having a:

- (1) machine direction tear of at least about 100 g/mil,
- (2) Haze value of less than about 10 percent,
- (3) 45° Gloss greater than about 65 percent, and
- (4) Dart value greater than about 200 g.

The Examiner relies upon the following reference in rejecting the appealed claims:

Genske EP 0 229 476 A1 Jul. 22, 1987

Appellants' claimed invention is directed to a film that comprises a first layer, comprising a first polymer that comprises at least about (a) 50 wt % propylene, and (b) 5 wt % ethylene. In addition, the first layer is characterized as having (1) a machine direction tear (MD-tear) of at least about 100 g/mil, (2) a haze value of less than about 10%, (3) 45° gloss greater than about 65%, and (4) a dart value greater than about 200 g.

## OPINION

Appealed claims 1-14 stand rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Genske.

We have thoroughly reviewed each of Appellants' arguments for patentability. However, we are in full agreement with the Examiner that the

claimed subject matter is unpatentable over the cited prior art. Accordingly, we will sustain the Examiner's rejection for the reasons set forth in the Answer.<sup>1</sup>

The Examiner has found that Genske discloses a multiplayer film which is a blend of 10 to 65 wt% of polyisobutylene and 35 to 90 wt% of a propylene copolymer. The propylene copolymer comprises 70-98 mole percent of propylene and 2-30 mole percent of ethylene (Answer 4-5). The Examiner determined that in view of the substantially identity between the first layer of the film of Genske and the first polymer of claim 1, there is a reasonable basis to believe that the claimed machine direction tear, haze, 45° gloss, and dart value properties are inherently possessed by Genske's film (Answer 5).

Appellants have not disputed the Examiner's determination that the propylene-based first layer of Genske appears to be identical or substantially identical to the claimed first polymer (Answer 4-8). Rather, Appellants argue that the claimed machine direction tear and dart value properties are not inherently possessed by Genske's film (Br 9-10). Indeed, the Examiner has admitted that Genske does not expressly disclose the claimed machine direction tear and dart value properties. However, mere recitation of a property or characteristic not disclosed by the prior art does not necessarily confer patentability to a composition or a method of using that composition. *See In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975). Where, as here, the Examiner has established a reasonable basis that the property or characteristic recited in the claims would have been inherent in the prior art product, the burden of proof properly shifts to Appellants to show that this characteristic or property is not possessed by the prior

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<sup>1</sup> Appellants have not presented separate arguments for the rejected claims. Thus, the claims stand or fall together. We will limit our discussion to claim 1.

art. *See In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990). However, Appellants have failed to meet their burden to establish that the claimed characteristics are not possessed by the Genske reference.

Appellants argue that the data of Table 13-3 of the Specification and the Declaration of Dr. Li-Min Tau establish that, in fact, the monomer composition, by itself, does not predict the properties of a film made from the monomers (Br. 10). The data presented in the Specification and the opinion presented in the Declaration are not persuasive. The data presented in Table 13-3 purports to compare examples that fall within the scope of the presently claimed invention to “various commercially or experimentally available Ziegler-Natta catalyzed random polypropylene resins” (Specification 85). However, there is no evidence that these “commercially or experimentally available” resins are comparable to the prior art product, i.e, Genske’s first layer. Nor has Dr. Tau (declarant) repeated the examples of Genske to determine whether Genske’s first layer does not necessarily possess the claimed properties. Dr. Tau’s statement that direct comparative evidence of Genske’s film cannot be reported because “Genske does not provide information regarding the manner in which the polypropylene used in the first layer of his multilayer film is prepared” is not supported by any objective evidence (Declaration ¶ 7).<sup>2</sup> *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir.

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<sup>2</sup> To the extent that Dr. Tau is asserting that the Genske reference is nonenabling, we do not agree. The disclosure of Genske is equivalent to the disclosure of the present Specification and claimed invention. The present Specification, page 50, states “[t]he polymers, including the P\* [propylene] and P/E [propylene/ethylene] polymers, used in the practice of this invention can be made by any convenient process.” As such, Appellants’ claimed invention does not specify specific processing conditions for producing the polymer films. The Declarant, who is the named inventor, is at least a person of ordinary skill in the art. As such, the

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1995) (*quoting In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed.Cir.1984)). (“Mere argument or conclusory statements in the specification does not suffice.”).

#### CONCLUSION

To summarize, the prior art rejection of claims number 1-14 has been 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).

AFFIRMED

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Declarant should have been able to reproduce the polymer films of Genske utilizing recognized processes. The failure of the Declarant to reproduce the invention of Genske raises questions as to whether the presently claimed invention is sufficiently enabled for a person of ordinary skill in the art to practice the invention without undue experimentation. In the event of further prosecution, the issues of the sufficiency of the Specification to support the claimed invention may need to be explored.