

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ZORAN SAVIC

Appeal 2007-3371
Application 09/946,960
Technology Center 1700

Decided: January 9, 2007

Before CHARLES F. WARREN, PETER F. KRATZ, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2-4, 6, 8, 10, and 15-18, the only claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

An oral hearing was held on December 20, 2007.

We affirm the Examiner's decision to reject claims 2 and 6 and reverse the Examiner's decision to reject claims 3, 4, 8, 10, and 15-18.

The invention relates to a multilayer tubular film for use in packaging food products. (App. Br. 2). In films of this type, it is generally necessary

to vary the composition of the inner polymer layer depending on the specific food product type being packaged. (App. Br. 3). Appellant has discovered a specific formulation for the middle polymer layer which allows for a wide variation of the inner polymer layer composition while consistently exhibiting good adhesion to the inner polymer layer. (App. Br. 4).

Claim 16 is illustrative of the invention and is reproduced below:

16. A multilayer seamless tubular film comprising

- an outer polymer layer in which the polymer comprises 70 to 100% by weight of aliphatic or partially aromatic polyamides or copolyamides or blends thereof, and 0 to 30% by weight of other polymers,

- a middle polymer layer which consists essentially of 50 to 80% by weight of ethylene-methyl acrylate copolymers, wherein the methyl acrylate content is 5 to 30% by weight, and 20 to 50% by weight of ethylene-maleic anhydride copolymers, which contain 0.15 to 5% by weight of maleic anhydride units, and

- an inner polymer layer in which the polymer comprises 40 to 100% by weight of aliphatic or partially aromatic polyamides or copolyamides or blends thereof, 0 to 60% by weight of carboxyl-containing ethylene copolymers or their salts and 0 to 20% by weight of other polymers, the total amount of which gives 100% by weight.

The Examiner relies on the following prior art references to show unpatentability:

Vicik	5,549,943	Aug. 27, 1996
Beckwith et al.	99/33653	Jul. 8, 1999

The Examiner made the following rejections:

1. Claims 3, 4, 8, 10, and 15-18 under 35 U.S.C. § 102(b) as anticipated by Vicik.
2. Claims 2 and 6 under 35 U.S.C. § 103 as unpatentable over Vicik in view of Beckwith.

Appellant contends that the Examiner failed to establish a *prima facie* showing of anticipation as to claims 3, 4, 8, 10, and 15-18, because “one must pick and choose from among many different copolymers as well as from among many different monomer percentage choices for any given copolymer, in order to arrive at the specific composition defined by the claims on appeal.” (Reply Br. 2).

We agree with Appellant. The Examiner has simply not demonstrated that Vicik describes the middle layer of the claimed multilayer tube with sufficient specificity to anticipate the claims within the meaning of 35 U.S.C. § 102(b). Therefore, we do not sustain the Examiner’s rejection of claims 3, 4, 8, 10, and 15-18 under 35 U.S.C. § 102(b) as anticipated by Vicik. *See In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (“[F]or the instant rejection under 35 U.S.C. 102(e) to have been proper, the . . . reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the *similarity* of the subject

matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.”).

Turning to the rejection of claims 2 and 6 under 35 U.S.C. § 103 as unpatentable over Vicik in view of Beckwith. The Examiner relies on Beckwith for a disclosure of a multilayer thermoset film for enclosing food products as recited in claim 2. The Examiner also relies on Beckwith for a teaching of a thermoset multilayer film with an outer layer having a composition similar to that of appealed claim 6. The Examiner maintains that although Beckwith does not disclose the identical outer layer of claim 6, it would have been a matter of routine optimization to achieve the claimed outer layer in order to obtain the desired characteristics, as taught by Beckwith. (Ans. 8).

Appellant argues that Vicik fails to disclose, either expressly or inherently, a multilayer film having the claimed middle layer. Appellant maintains that Vicik discloses a large group of suitable compounds for use in the claimed middle layer and that neither the teachings of Beckwith nor Vicik would direct one of ordinary skill in the art to select the specific components of the claimed middle layer from among this large group. (App. Br. 18-19). More specifically, Appellant argues that neither Vicik nor Beckwith provide motivation to select the specific components of the claimed middle layer, because neither reference is concerned with improving adhesion of a middle layer to different inner polymer layers to allow for variation of the inner polymer layer depending on a specific food product. (App. Br. 19-20). Appellant further argues that Beckwith does not “expressly teach the subject matter (specifically claimed co-polyamide) of

claims 2 and 6 . . . [and any] ‘optimization’ would involve impermissible hindsight.” (App. Br. 18).

Contrary to Appellant’s contention, we find that the Examiner properly identified a teaching in Vicik of each of the claimed middle layer components and provided a well-reasoned basis for combining them to achieve Appellant’s claimed multilayer tubular film (Ans. 3-4). As acknowledged by Appellant, anticipation and obviousness are based on different analyses. Thus, even though we concluded that the Examiner failed to identify a teaching of the claimed middle layer within the meaning 35 U.S.C. § 102(b), the Examiner’s findings of equivalence and overlapping ranges in Vicik provide an appropriate basis for the Examiner’s determination that it would have been obvious to one of ordinary skill in the art to have selected the claimed middle layer components from among Vicik’s list of suitable compounds. Vicik clearly teaches that any of the components disclosed therein, including the copolymers specified for the middle layer in claim 16, are useful in the disclosed multilayer film. *See, Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (“That the ‘813 patent discloses a multitude of effective combinations does not render any particular formulation less obvious. This is especially true because the claimed composition is used for the identical purpose. [Citations omitted.]”).

The Examiner, relying on Beckwith’s teaching that selection of the amount of the components depends on the desired characteristics of the component blend, also provided a well reasoned basis for his determination that it would have been obvious to have selected the outer layer components recited in claim 6. (Ans. 7-8). Appellant has not refuted the Examiner’s

findings with respect to Beckwith. *See, In re Boesch*, 617 F.2d 272, 275-76, (CCPA 1980) (the prior art would have suggested the experimentation necessary to achieve the claimed compositions as discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art); *In re Aller*, 220 F.2d 454, 456-58 (CCPA 1955) (it is not inventive to discover by routine experimentation optimum or workable ranges for general conditions disclosed in the prior art); *see also, KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007)(An obviousness analysis “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); *In re Kahn*, 441 F.3d 977, 985-88 (Fed. Cir. 2006); *In re Thrift*, 298 F.3d 1357, 1365 (Fed. Cir. 2002) (when a second reference identifies the benefits of adding a feature to the primary reference, an obviousness rejection is proper). Accordingly, we find that the Examiner established a prima facie showing of obviousness as to claims 2 and 6.

A prima facie case of obviousness may be rebutted by evidence of unexpected results or a showing that the prior art teaches away from the claimed invention in any material respect. *In re Geisler*, 116 F.3d 1465, 1469-70 (Fed. Cir. 1997). Appellant relies on an Experimental Report provided in the Evidence Appendix to the Brief as evidence of the advantageous properties of the claimed invention. (App. Br. 20-21). Appellant’s Experimental Report includes “certain test data achieved with the invention” (App. Br. 20). We do not find this evidence persuasive in establishing non-obviousness because it is impossible for us to evaluate whether Appellant’s data is “unexpected.” Appellant has not provided a basis for comparison of the claimed invention with the prior art, e.g., test

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data associated with the closest prior art multilayer tubular films or multilayer tubular films having compositions which fall outside Appellant's claimed ranges. *See In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972) (burden of analyzing and explaining data to support an argument of unexpected results rests on the party asserting it).

In view of the foregoing, we find that a preponderance of the evidence weighs in favor of the Examiner's conclusion of obviousness as to claims 2 and 6.

ORDER

The Examiner's decision rejecting claims 3, 4, 8, 10, and 15-18 under 35 U.S.C. § 102(b) as anticipated by Vicik is reversed.

The Examiner's decision rejecting claims 2 and 6 under 35 U.S.C. § 103 as unpatentable over Vicik in view of Beckwith 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)(i)(iv).

AFFIRMED-IN-PART

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FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007