

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARKUS HAMULSKI,
ANDREAS HAGEMANN
and MATTHIAS PERICK

Appeal 2008-1080
Application 10/306,801
Technology Center 1700

Decided: March 24, 2008

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
CHARLES F. WARREN, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1, 4, and 5. We have jurisdiction under 35 U.S.C. § 6.

We REVERSE.

Appellants claim a monoaxially elastic laminate film comprising a core layer and a skin layer which has certain characteristics including the characteristic wherein the skin layer can be stretched by at least 50% in a preferred stretching direction at a certain tensile force while stretching in the crosswise direction is by less than 5% when the same force is applied.

Representative claim 1 reads as follows:

1. A monoaxially elastic laminate film comprising a core layer made of a thermoplastic elastomer and at least one skin layer co-extruded together with said core layer,

wherein said at least one skin layer comprises a thermoplastic plastic with a molecular lattice that becomes brittle when said lattice solidifies, said plastic stretching only slightly when a stretching force is applied and breaks without any transition when a predetermined tear force has been exceeded;

wherein said molecular lattice that becomes brittle when said lattice solidifies is irreversibly broken up by monoaxial stretching in the stretching direction, but is maintained perpendicular to the stretching direction, and thereby reinforces the film in the crosswise direction,

so that said skin layer can be stretched by at least 50% in a preferred stretching direction at a tensile force that is needed to stretch the core layer by 100%, while stretching in the crosswise direction is by less than 5% when the same force is applied;

wherein said skin layer is broken up only in certain regions, as a result of being stretched in the stretching direction; and

wherein said skin layer contains inorganic filler additives.

The references set forth below are relied upon by the Examiner as evidence of anticipation:

Schwinn (US ‘786)	6,312,786 B1	Nov. 6, 2001
Schwinn (DE ‘938) (as translated)	DE 19715938 A1	Oct. 22, 1998

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Schwinn DE ‘938.

Claims 1, 4, and 5 are rejected under 35 U.S.C. § 102(e) as being anticipated by Schwinn US ‘786.

With respect to each of these rejections, it is the Examiner’s position that, “since the reference teaches the same structure with the same chemical constituents, the multilayered extrudate of the reference would inherently have the same properties, such as brittleness, stretching, and breaking properties” (Ans. 3, 4).

We cannot sustain either of the Examiner’s § 102 rejections for the reasons expressed by Appellants in their Supplemental Appeal and Reply Briefs and for the reasons expressed below.

The Examiner’s aforequoted position suffers multiple deficiencies.

First, the Examiner has not provided adequate support for the finding that the same chemical constituents are used in the Appellants’ claimed laminate film and in the multilayer extrudates or sheets of the Schwinn references. Specifically, the Examiner has not identified any constituents used in the Schwinn DE ‘938 co-extrudates which are the same as the constituents used in Appellants’ claimed laminate film. Regarding Schwinn US ‘785, the Examiner has identified a polymer (i.e., polyolefin; Ans. 4) which is at least similar to a skin layer constituent used in Appellants’

claimed film (i.e., polyolefin made brittle by subsequent treatment; claim 5). However, there are a number of other constituents disclosed in Schwinn US ‘786 which are not the same as those used in the here-claimed film. At best, therefore, the composite sheet of Schwinn US ‘786 would contain at least a similar polymer as Appellants’ claimed skin layer constituent only by selectively picking and choosing from Schwinn’s disclosure. Such picking and choosing is improper in the context of a § 102 rejection. *In re Arkley*, 455 F.2d 586, 587-88 (CCPA 1972).

The Examiner’s position has a second deficiency. Namely, the position is based on the Examiner’s incorrect belief that the characteristics of the laminate film defined by claim 1 are solely due to the chemical constituents of which the film is made. As indicated previously, the skin layer of Appellants’ claimed film may be manufactured from a polyolefin made brittle by subsequent treatment (claim 5). While such treated polyolefin yields the skin layer stretch characteristics defined in claim 1, there is no reasonable basis to believe that these characteristics would be produced when using a non-treated polyolefin as proposed by the Examiner with respect to Schwinn US ‘786 (Ans. 4).

Finally, the Examiner’s inherency position is undermined by the fact that the articles claimed by Appellants and disclosed in the Schwinn references are used for different purposes. Appellants’ claimed laminate film is used as a waistband in, for example, diapers (Spec. 1). In contrast, the co-extrudate of Schwinn DE ‘938 is used for bonding non-woven fabric (Translation 3), and the composite sheet of Schwinn US ‘786 is used to produce fleeciness for improved feel or increased volume (col. 2, ll. 30-33). These disparate uses militate against the Examiner’s position that the

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respective Schwinn articles inherently possess the characteristics of Appellants' claimed laminate film. This is because there is no apparent reason for believing that articles adapted for the differing uses disclosed in the Schwinn references would inherently possess the same characteristics as the here-claimed laminate film adapted for use as a waistband.

In light of the foregoing, we cannot sustain either of § 102 rejections advanced by the Examiner on this appeal.

The decision of the Examiner is reversed.

REVERSED

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