

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRICUS J.J. GOERTZ,
and JOHANNES J. GUNS

Appeal 2008-3615
Application 10/473,177
Technology Center 1700

Decided: July 28, 2008

Before BRADLEY R. GARRIS, ROMULO H. DELMENDO, and KAREN M. HASTINGS, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-16 (Appeal Brief filed July 16, 2007, hereinafter “App. Br.” 1, 4).¹

¹ Claims 17-23, the other pending claims, have been withdrawn from further consideration (App. Br. 4; Examiner’s Answer, hereinafter “Ans.” 2).

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Appellants state they invented a process for making a plastic molded article with a decorated surface comprising the steps of: (a) introducing a specified decorated film in a mold; and (b) filling the mold with a plastic composition by means of injection molding (Specification, hereinafter “Spec.,” 1, ll. 6-9). According to Appellants, the surface of the resulting product “has a pleasant feel, i.e. it has a so-called soft-touch character,” making the product particularly useful for “housings of end-use products such as mobile telephones, pocket calculators, electronic organizers or personal digital assistants, kitchen machines and the like” as well as “vehicle components...such as a dashboard or parts thereof” (Spec. 2, ll. 6-13).

Claim 1 on appeal reads as follows:

1. Process for making a plastic moulded article with a decorated surface, comprising the steps of (a) introducing a decorated film in a mould; and (b) filling of the mould with a plastic composition by means of injection moulding; characterized in that the decorated film comprises at least one layer consisting essentially of a thermoplastic elastomer containing polyether segments.

The prior art references relied upon by the Examiner in rejecting the claims on appeal are:

Willemin	4,931,248	Jun. 5, 1990
Minnick	5,110,668	May 5, 1992
Hara	5,424,020	Jun. 13, 1995
Dous	5,811,046	Sep. 22, 1998
Schneider	6,677,010 B1	Jan. 13, 2004

The Examiner rejected claims 1-16 under 35 U.S.C. § 103(a) as follows: (i) claims 1-3, 5-7, and 9-12 as unpatentable over Willemin in view of Minnick; (ii) claims 4, 13, and 14 as unpatentable over Willemin,

Minnick, and Hara; (iii) claim 8 as unpatentable over Willemin, Minnick, and Dous; and (iv) claims 15 and 16 as unpatentable over Willemin, Minnick, and Schneider (Ans. 3-6).

ISSUE

Have Appellants demonstrated reversible error in the Examiner's determination that the subject matter of appealed claims 1-16 would have been obvious to a person having ordinary skill in the art in view of the applied prior art?

FINDINGS OF FACT

1. Appellants define "decorated film" as being understood by one skilled in the relevant art "to mean a film that serves to impart a different appearance to a moulded article" (Spec. 2, ll. 17-18).
2. Willemin describes a method of manufacturing an object of thermoplastics material having a decorative design, the method comprising: printing a design onto a surface of a support using a transferable ink able to separate from the support in response to heating; introducing the support after printing into a mold having the shape and dimensions of the object; and after introduction, injecting a thermoplastic material into the mold, the introduction of the support being carried out so that, at least during the injection, the support is applied against a wall of the mold with the surface turned facing the inside of the mold, and the injection being carried out while the thermoplastic material

is at a temperature equal to or greater than its melting point (col. 1, ll. 12-26).

3. Specifically, Willemin teaches (col. 2, ll. 62-68):

While the mold is still open, a film of material of a kind to be specified hereinbelow is then introduced into this mould in such a manner that during injection of the thermoplastics material of the object, which is carried out afterwards, it will be applied by the pressure of the material against the surface of the piece of the support sheet carrying the decorative design.

4. During injection, the thermoplastic material is said to heat the film, and “through it, the ink forming the decorative design carried by the piece of the support sheet” and that “[i]n response to this heating, this ink detaches from its support and deposits on the film or even, in some cases, penetrates into this film...” (col. 3, ll. 4-11).
5. Also, Willemin teaches that the film is introduced into the mold “in a position to be applied against” the printed surface of the support and that it must be selected such that it can strongly bond to the material injected into the mold, advantageously by chemical bonding (col. 3, ll. 34-43; col. 5, ll. 5-7).
6. Willemin further teaches “excellent results” have been obtained by using two different polyether-block-amides for the injected material and the film (col. 3, ll. 56-60).
7. Appellants’ Specification describes a polymer with polyether blocks and polyamide blocks (i.e., polyether-block-amide) as a suitable “thermoplastic elastomer containing polyether segments” (Spec. 3, ll. 5-27).

8. Appellants attempt to distinguish the claimed invention over Willemin as follows (Spec. 4, l. 36 to 5, l. 5):

It is true that EP-A-0296108 [European equivalent of Willemin] discloses a process wherein a copolyether amide film is employed, but that film is not decorated beforehand. In this known IMD process, as the mould is filled, the copolymer film is decorated by the transfer of ink, under the influence of heat, from a decorated support film, which support film is passed into the mould together with the copolyether amide film, but does not come to form part of the decorated moulded article.

PRINCIPLES OF LAW

On appeal to this Board, Appellants must show that the Examiner committed reversible error in finally rejecting the claims. *Cf. In re Kahn*, 441 F.3d 977, 985-986 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

“[T]o properly compare the [prior art] reference with the claims at issue, we must construe the [disputed] term . . . to ascertain its scope and meaning.” *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1997).

It is well settled that the United States Patent and Trademark Office (PTO) is obligated to give claim terms their broadest reasonable interpretation, taking into account any enlightenment by way of definitions or otherwise found in the specification. *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007)(“[T]he PTO must give claims their

broadest reasonable construction consistent with the specification . . . Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation.”); *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004)(“[T]he PTO gives a disputed claim term its broadest reasonable interpretation during patent prosecution.”).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007).

KSR reaffirms the analytical framework set out in *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1 (1966), which states that an objective obviousness analysis includes: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. *KSR*, 127 S. Ct. at 1734. Secondary considerations such as commercial success, long felt but unsolved needs, or failure of others ““might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”” *Id.* (*quoting Graham*, 383 U.S. at 17-18).

Anticipation is the epitome or ultimate of obviousness. *See, e.g., In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991).

ANALYSIS

Appellants have presented various arguments under separate subheadings that parallel each of the Examiner’s four rejections. We

address these arguments accordingly. To the extent that particular claims within each of the Examiner's rejections are not separately argued, these claims stand or fall together with the selected representative claim.
37 C.F.R. § 41.37(c)(1)(vii).

CLAIMS 1-3, 5-7, & 9-12:

We select claim 1 as representative.

Without undertaking a rigorous analysis as to claim construction and the scope and content of the principal prior art reference (Willemin), Appellants argue (App. Br. 8):

While it is true that Willemin discloses generally a method for making decorated moulded articles by introducing a decorated film in a mould and then filling the mould with a plastic composition by means of injection moulding, it is equally true that an ordinary skilled person would not consider it obvious to employ a thermoplastic elastomer containing polyester segments in such a process based on the secondary reference to Minnick.

Appellants' position appears to be based, at least in part, on the belief that appealed claim 1 requires a copolyether amide film that is "decorated beforehand" and that Willemin's film that contacts the support is not "decorated beforehand" (Fact 8; App. Br. 10).

Appellants are incorrect. We find nothing in appealed claim 1 that would support such a position. Appealed claim 1 merely recites "that the decorated film comprises at least one layer consisting essentially of a thermoplastic elastomer containing polyether segments." Prior to the injection molding step, Willemin describes a mold containing a two-layer structure of a support with ink thereon and a film of a polyether-block-amide, which Appellants describe as a "thermoplastic elastomer containing

polyether segments”² (Facts 2-7). Because Appellants have defined “decorated film” as being understood by one skilled in the relevant art “to mean a film that serves to impart a different appearance to a moulded article” (Fact 1) and the term “comprises” in the recitation “decorated film comprises . . .” fails to exclude Willemin’s support with ink thereon, Willemin’s two-layer structure is in fact a “decorated film” comprising a thermoplastic elastomer containing polyether segments. Indeed, even the polyether-amide-block film without any ink (which is different from the injected polyether-amide block) would “impart a different appearance to a moulded article,” as required by the term “decorated film.” While Willemin states that ink is transferred from the support to the polyether-block-amide during the injection molding step, appealed claim 1 does not preclude such an ink transfer. Appellants have not provided a satisfactory explanation, or otherwise directed us to any evidence, that compels a contrary interpretation.

In re Icon Health, 496 F.3d at 1379.

Because Willemin anticipates appealed claim 1, it follows that a person having ordinary skill in the art would have found it obvious to arrive at the claimed subject matter in view of Willemin’s teachings. *In re Baxter Travenol*, 952 F.2d at 391.

² Appellants have acknowledged that Willemin teaches a copolyether amide film (Fact 8). *In re Reuning*, No. 2007-1535, slip op. at 6 (Fed. Cir. April 25, 2008) (nonprecedential disposition). See also *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (“A statement in a patent that something is in the prior art is binding on the applicant and patentee for determinations of anticipation and obviousness.”); *In re Nomiya*, 509 F.2d 566, 571 n.5 (CCPA 1975) (It is a “basic proposition that a statement by an applicant, whether in the application or in other papers submitted during prosecution, that certain matter is ‘prior art’ to him, is an admission that that matter is prior art for all purposes . . .”).

We need not discuss the teachings of Minnick because they are unnecessary to support the Examiner’s obviousness determination of appealed claim 1.

CLAIMS 4, 13, & 14:

For claims 4, 13, and 14, Appellants rely on the same arguments advanced in support of claim 1. Accordingly, we uphold the rejection of claims 4, 13, and 14 for the same reasons given for claim 1.

CLAIM 8:

For claim 8, Appellants rely on the same arguments advanced in support of claim 1. Accordingly, we uphold the rejection of claim 8 for the same reasons given for claim 1.

CLAIMS 15 & 16:

Appellants advance the additional argument that the “use of a thermoplastic elastomer as such a decorated film in a IMD process as claimed results in advantages over the known IMD processes by avoiding pre-shaping of the decorated film” (App. Br. 12-13). But neither claim 15 nor 16 recites a limitation supporting this argument. Moreover, Appellants do not direct us to any persuasive evidence (e.g., comparative experiments) that substantiate such an argument. Accordingly, we also uphold this rejection.

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CONCLUSION

On this record, we determine that Appellants have failed to demonstrate any error in the Examiner's conclusion that a person having ordinary skill in the art would have found the subject matter of appealed claims 1-16 obvious over the applied prior art.

DECISION

The Examiner's decision to reject appealed claims 1-16 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).

AFFIRMED

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