

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL G. R. ZOBEL

Appeal No. 1996-4035
Application No. 08/257,431

ON BRIEF¹

Before STAAB, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10 and 13-25, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

¹ On July 31, 2000, the appellant waived the oral hearing (see Paper No. 34) scheduled for September 13, 2000.

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BACKGROUND

The appellant's invention relates to a polymeric film for the storage or packaging of plant material. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 22-25 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 2-3, 5, 6 and 9-12 of copending Application No. 08/041,190.²

Claims 1, 4-10 and 13-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schirmer³ in view of Isaka et al.⁴ (Isaka) and Wavin⁵.

² On November 10, 1998, Application No. 08/041,190 issued as U.S. Patent No. 5,832,699.

³ U.S. Patent No. 3,471,597 issued October 7, 1969.

⁴ U.S. Patent No. 4,876,146 issued October 24, 1989.

⁵ European Patent Application 0 155 035 published September 18, 1985. The examiner and the appellant have referred to this reference by the applicant's name rather than the inventor's name. We will do likewise.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schirmer in view of Isaka and Wavin as set forth above, and further in view of Mathues⁶ and the appellant's admission on page 5, line 10 of the specification.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 29, mailed May 30, 1996) and the supplemental answer (Paper No. 32, mailed September 4, 1996) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 27, filed April 1, 1996) and reply brief (Paper No. 30, filed July 30, 1996) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective

⁶ U.S. Patent No. 3,085,608 issued April 16, 1963.

positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The obviousness-type double patenting rejection

We sustain the provisional rejection of claims 22-25 under the judicially created doctrine of obviousness-type double patenting over claims 2-3, 5, 6 and 9-12 of copending Application No. 08/041,190.

The appellant's only argument as to the merits of this rejection is that this rejection is moot in this appeal since the rejection is provisional and no claims have been allowed (brief, p. 3). The appellant then states that they "will take appropriate action once there is an indication of allowable subject matter in one of the applications."

We do not agree with the appellant that this rejection is moot for the following reasons. First, a predecessor of our reviewing court expressed its approval of a provisional

rejection in the context of an obviousness-type double patenting rejection. In re Wetterau, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). As explained in Wetterau, the provisional nature of this type of rejection means that if a patent did not issue on the related application, the provisional rejection would evaporate. The court noted in the obviousness-type double patenting context of that case that certain benefits inured to applicant and the PTO through use of such a provisional procedure, i.e., by making applicant aware at the earliest possible time of the existence of a double patenting issue, applicant has an opportunity to elect which application to let issue, while prosecution in the PTO is hastened. Second, as to the appellant's argument that no claim has been allowed, we refer to Ex parte Karol, 8 USPQ2d 1771 (Bd. Pat. App. & Int. 1988) as to the propriety of imposing a provisional obviousness-type double patenting rejection based upon an application lacking allowed claims. Lastly, we note that on November 10, 1998, Application No. 08/041,190 issued as U.S. Patent No. 5,832,699.

For the reasons set forth above, the decision of the examiner to provisionally reject claims 22-25 under the judicially created doctrine of obviousness-type double patenting is affirmed.

The obviousness rejections

We will not sustain the rejection of claims 1-10 and 13-25 under 35 U.S.C. § 103.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art

to make the modifications necessary to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

With this as background, we turn to the examiner's rejection of claim 1.⁷

Claim 1 recites a polymeric film for the storage or packaging of plant material, the film having from 10 to 1000 perforations per square meter therein, wherein the perforations have a mean diameter of 20 to 100 microns, the film having a water vapor permeability of not more than 800 g m⁻² day⁻¹ and an oxygen permeability of not more than 200000 cm³ m⁻² day⁻¹ atmosphere⁻¹, both permeabilities being measured at 25°C with a relative humidity of 75 percent.

The examiner's rationale for the rejection of claim 1 (answer, p. 4) is that (1) Schirmer teaches a plastic film

⁷ Claims 2-10 and 13-25 incorporate all the limitations of claim 1 by referring back to claim 1.

with a "myriad of tiny holes" used to package items like vegetables which must "breathe" when packaged; (2) Isaka teaches olefin films for packaging plants having permeabilities within the claimed ranges; and (3) Wavin teaches that the gas flux through perforations may be calculated. From these teachings the examiner then concludes that it would have been obvious to one of ordinary skill in the art to size the tiny holes of Schirmer to produce the permeabilities of Isaka in order to preserve packaged vegetables with average respiration rates because of the teachings of Wavin and Isaka.

The appellant argues that a prima facie case of obviousness from the combined teachings of the applied prior art has not been established. We agree. It is our opinion that the combined teachings of the prior art relied upon by the examiner, would not have suggested the claimed micron sized perforations required by the claims on appeal. That is, the claimed limitation that the polymeric film has from 10 to 1000 perforations per square meter therein and the

perforations have a mean diameter of 20 to 100 microns is not taught or suggested by the applied prior art.⁸ In that regard, while Wavin does teach a polymeric film having perforations with a mean diameter of 50 to 100 microns, Wavin teaches that such perforations are provided at greater than 1000 perforations per square meter. It is our opinion that the examiner has not established the obviousness of a polymeric film having from 10 to 1000 perforations per square meter therein and the perforations having a mean diameter of 20 to 100 microns.

In summary, we see no motivation in the applied prior art of why one skilled in the art would have modified the device of Schirmer to make the modifications necessary to arrive at the claimed invention. Thus, the examiner has failed to meet the initial burden of presenting a prima facie case of

⁸ In fact, the examiner never determined that these claimed limitations would have been obvious at the time the invention was made to a person having ordinary skill in the art.

obviousness.⁹ Thus, we cannot sustain the examiner's rejection of appealed independent claim 1 and claims 4-10 and 13-25 which refer back to claim 1.

We have also reviewed the prior art applied in the rejection of claims 2 and 3 but find nothing therein which makes up for the deficiencies of Schirmer, Isaka and Wavin discussed above with respect to claim 1. Accordingly, we cannot sustain the examiner's rejection of appealed claims 2 and 3 under 35 U.S.C.

§ 103.

CONCLUSION

To summarize, the decision of the examiner to provisionally reject claims 22-25 under the judicially created doctrine of obviousness-type double patenting is affirmed; the decision of the examiner to reject claims 1-10 and 13-25 under 35 U.S.C.

§ 103 is reversed.

⁹ Note In re Rijckaert, supra; In re Lintner, supra; and In re Fine, supra.

No time period for taking any subsequent action in connection with this appeal May be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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