

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BAVO MUYS, DIRK QUINTENS,  
JOZEF BOEYKENS, ETIENNE VAN THILLO,  
and GEERT DEFIEUW

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Appeal No. 1997-1922  
Application No. 08/356,573

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HEARD: Oct. 26, 2000

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Before KIMLIN, KRATZ, and DELMENDO, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-12, all of the claims remaining in the present application.

Claim 1 is illustrative:

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1. A method for preparing a biaxially oriented polyester sheet or web, with improved antistatic properties, comprising the steps of

(i) stretching said polyester sheet or web first in one direction and second in a direction perpendicular thereto

(ii) coating said hydrophobic polyester sheet or web, either before stretching or between said first and second stretching operation, on one or both sides, with a transparent antistatic primer layer, wherein the coating composition of said transparent antistatic primer layer comprises (1) a dispersion of a polythiophene with conjugated polymer backbone and a polymeric polyanion compound and (2) a latex polymer having hydrophilic functionality.

The examiner relies upon the following references as evidence of obviousness:

Tanabe et al. (Tanabe) 1972	3,683,060	Aug. 8,
Jonas et al. (Jonas) 1994	5,300,575	Apr. 5,

(filed Dec. 10, 1992)

Appellants' claimed invention is directed to a method for preparing a biaxially oriented polyester sheet wherein a transparent antistatic primer layer is coated on the sheet either before stretching or between the first and second stretching operations. The primer layer comprises a dispersion of a polythiophene with conjugated polymer backbone and a polymeric polyanion compound, along with a latex polymer having hydrophilic functionality. According to the

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appellants, "[t]he coating before or between the stretching operations implies that the polythiophene with conjugated polymer backbone has to withstand temperatures up to 200EC during heat setting and stretching without prohibitive coloration and without losing its conductivity" (page 3 of principal brief, second paragraph).

Appealed claims 1-12 stand rejected under 35 U.S.C. 103 as being unpatentable over Tanabe in view of Jonas.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejection.

The examiner appreciates that Tanabe, who discloses a method of biaxially-orienting polyester film by stretching the film in first and second directions, does not disclose coating the presently claimed antistatic composition on the polyester film, let alone before or between the first and second stretching operations. While there is no dispute that Jonas discloses coating appellants' antistatic composition on a polyester sheet, there is no teaching in Jonas of applying the antistatic composition either before stretching or between the first and second stretching operations. Hence, the issue

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before us is whether it would have been obvious for one of ordinary skill in the art to apply the antistatic composition of Jonas to the polyester sheet of Tanabe either before the stretching operations or between the first and second stretching operations.

Appellants contend that "there is nothing in the prior art which would suggest that a polythiophene with a conjugated polymer backbone could withstand high heat without prohibitive discoloration and without losing its conductivity" (sentence bridging pages 4 and 5 of principal brief). In the words of appellants, "the claims define an inventive advance in the discovery that polythiophene with conjugated backbone in the presence of a polymeric polyanion compound could withstand stretching at high temperatures without being affected adversely" (page 5 of principal brief). In support of their argument, appellants have cited an article in *Synthetic Metals* (Exhibit A) which, according to appellants, "establishes that there were, at the priority date of the present invention, serious concerns regarding the thermal stability of poly(alkylthiophenes) and establishes that thermal undoping was to be expected when polythiophene was subjected to

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elevated temperatures" (page 5 of principal brief, last sentence).

In response to appellants' arguments for nonobviousness, the examiner states the following at page 4 of the answer:

Appellants' suggestion that the compounds cannot withstand the temperatures and/or stretching of the processing in the film stretching without being adversely affected is a non-persuasive argument because the same compounds are being disclosed in the prior art as are being utilized in the instant invention as claimed and they would have the same property characteristics and the same associated ability to withstand temperature and/or stretching without being adversely affected. Since the same or similar materials are going to operate in the same or similar manner, with a reasonable expectation by one of ordinary skill in the requisite art, this combination of teachings renders the scope of the protection sought prima facie obvious.

Manifestly, the examiner's response begs the question of whether one of ordinary skill in the art would have reasonably expected that the antistatic compositions of Jonas would withstand the elevated temperatures associated with the biaxial stretching operations of Tanabe. Clearly, the same antistatic composition that is both presently claimed and disclosed by Jonas would have the same inherent properties and characteristics, but the examiner has pointed to no recognition in the prior art that the antistatic compositions

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of Jonas would be expected to avoid unwanted coloration and loss of conductivity during the elevated temperatures of biaxial orientation and heat setting. We note that the examiner has not addressed appellants' reliance on the article in *Synthetic Metals*.

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In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

	Edward C. Kimlin	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Peter F. Kratz	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	Romulo H. Delmendo	)	
	Administrative Patent Judge	)	

ECK:tdl

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