

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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte MICHAEL HENNIG-CARDINAL von WIDDERN
and
GUNTER WEBER

Appeal No. 1998-0299
Application 08/301,523

HEARD: January 10, 2002

Before, JEFFREY T. SMITH, PAWLIKOWSKI and MOORE, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

Decision on appeal under 35 U.S.C. § 134

Applicants appeal the decision of the Primary Examiner finally rejecting claims 15 to 23, 25 to 29 and 31 to 34.¹ We have jurisdiction under 35 U.S.C. § 134.

¹ Claims 24 and 30 were rejected under 35 U.S.C. § 112, second paragraph; however, these rejections have been withdrawn by the Examiner. (See Supplemental Examiner's Answers paper no. 29, mailed October 15, 1996 and paper no. 32, mailed October 30, 1997). Claims 24 and 30 have not been rejected over prior art.

BACKGROUND

The invention is directed to a multi-layered, biaxially stretched tubular film comprising an inner layer which comprises an aliphatic polyamide, a water vapor barrier outer layer and an oxygen barrier core layer. The water vapor layer comprises an olefinic polymer and the oxygen barrier layer comprises an ethylene-vinyl alcohol copolymer or a partially aromatic polyamide. The tubular biaxially stretched film is said to be useful for filling with food products such as sausage fillings. (Brief, p. 2). Claim 15, which is representative of the claimed invention, is reproduced below:

15. A multilayered, biaxially stretched tubular film for covering goods in the liquid or pasty state, which undergo a heat treatment after the filling, the tubular film consisting of at least the three following strata:
- an outer stratum comprising at least one water vapor barrier layer of an olefinic polymer,
 - a core stratum comprising at least one oxygen barrier layer of an ethylene/vinyl alcohol copolymer or a partially aromatic polyamide, and
 - an inner stratum which comprises at least one layer containing an aliphatic polyamide.

As evidence of unpatentability, the Examiner relies on the following reference:

Oberle

4,855,183

Aug. 8, 1989

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THE REJECTIONS

The Examiner entered the following rejections:

Claims 15 to 17, 19 to 21, 23, 25 to 29 and 31 and 20-22 are rejected as unpatentable under 35 U.S.C. § 102(b) over Oberle. (Answer, p. 4).

Claims 18, 22 and 32 to 34 are rejected as unpatentable under 35 U.S.C. § 103 over Oberle. (Answer, p. 7).

OPINION²

Appellants have not indicated a grouping of the claims with regard to the new rejections entered in the Examiner's Answer. While Appellants request that claim 33 be taken as representative, Appellants have not provided an explanation why claim 33 is representative of all the rejected claims on appeal. (Reply Brief, p. 3). We will consider the claims separately only to the extent that separate arguments are of record in this appeal. Any claim not specifically argued will stand or fall with its base claim. Only claim 31 is argued with sufficient specificity to stand apart. Note *In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528

² We note Appellants consider that the Examiner has inserted a host of new rejections in the Answer. (Reply Brief, pp. 1-2). Questions regarding actions taken by the Examiner, such as the insertion of a new ground of rejection, is petitionable under 37 CFR § 1.181 to the Commissioner. Since Appellants has failed to timely file a petition, we will address the rejections as presented in the Examiner's Answer.

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(Fed. Cir. 1987); *In re King*, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). We start our analysis with claim 15.

We have thoroughly reviewed each of the arguments for patentability contained in the Examiner's Answer and Supplemental Examiner's Answers as well as in Appellants' Brief and Reply Briefs. We are in agreement with the Examiner that the claimed subject matter is anticipated or obvious within the meaning of §§ 102 and 103 in view of the applied prior art. Accordingly, we will affirm the Examiner's rejection of claims 15 to 23, 25 to 29 and 31 to 34.

We find Oberle is directed to a biaxially oriented multi-layered film which comprises food contact layer, abuse layers and barrier layers. (Col. 4, ll. 5 to 15). The food contact layer comprises a polyamide composition which has been subject to energetic radiation. (Col. 4, ll. 18 to 30). According to Oberle, the energetic radiation provides food adhering properties to the food contact layer. (Col. 5, ll. 7 to 14). Oberle discloses the irradiation of the food contact layer can occur simultaneously with the irradiation of the overall multilayer structure. (Col. 5, ll. 14 to 18). Oberle further describes a multilayered film which comprises a food contact layer containing a polyamide, layer A, a barrier layer comprising EVOH,

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layer D, and an abuse layer comprising LLDPE or VLDPE, layer E. (Cols. 10 and 11). Oberle discloses that during the cooking process the food contact layer bonds or adheres to the meat product contained therein. (Col. 5, ll. 1 to 5).

It is the Examiner's position that "Oberle teaches packaging of a raw food product which is subsequently cooked in the multilayer film and having the identically claimed inner food contact layer". (Answer, p. 6). We agree.

Appellants argue the multilayered film of Oberle is not the same as claim 15 because the inner layer is different. Appellants state "[n]ylon 6 per se is not food adherent. Irradiated nylon-6 is different. Simply, an 'irradiated polyamide' is not a polyamide any longer but something different." (Reply Brief, p. 5). The Examiner states the function of the irradiation is to crosslink the film and does not change the composition of the film. (Supp. Answer, p. 4). Appellants respond that the present application does not mention radiation treatment and therefore the claimed film is different from Oberle. (Supp. Reply Brief, p. 2)

We have not been directed to evidence which indicates that the composition of the film would change due to irradiation of the film. Furthermore, Appellants' argument does not appear to consider the disclosure of Oberle that the irradiation of the food contact layer can occur simultaneously with the irradiation of the

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overall multilayer structure. (Col. 5, ll. 14 to 18). Thus, prior to irradiation the multilayered film of Oberle is the same as claim 15. Furthermore, it is well settled that arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F. 2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Here, Appellants have not provided evidence showing that the multilayered film of Oberle is different from the claimed film.

With respect to claim 31, Appellants state: [w]ith regard to claims expressly identifying watering, e.g. claims 31 ff, the process by which made [sic, the product is made] is indeed important. A water-saturated tube performs differently from one not watered.” (Reply Brief, paragraph bridging pages 5 and 6). It is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed by the prior art, the burden is on the Applicants to prove that the prior art product does not necessarily or inherently possess characteristics attributed to the claimed product. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In the present case, Oberle describes a multilayered film which comprises the same layers as the invention of claim 31. Appellants have not

proffered convincing evidence that establishes the multilayered film of Oberle does not necessarily or inherently possess characteristics attributed to the claimed product.

Claims 18, 22 and 32 to 34 have been rejected as unpatentable under 35 U.S.C. § 103 over Oberle. (Answer, p. 7). Appellants, in the Reply Brief, did not specifically respond to the rejection under § 103 as stated on page 7 of the Examiner's Answer.³

We agree with the Examiner's conclusion that it would have been obvious for one with ordinary skill in the art to include mixtures of polyamides in forming the inner contact layer of Oberle. As stated above, Oberle discloses biaxially oriented multilayered film which comprises an inner food contact layer formed from polyamides. As pointed out by the Examiner, Oberle discloses a variety of polyamides are suitable for formation of the inner food contact layer. (Col. 5, ll. 24-58). The use of mixtures of polyamides in forming the inner food contact layer flows logically from their having been individually taught by Oberle, thus establishing a *prima facie* case of obviousness. *In re Kerkhoven*, 626 F.2d 846,

³ In the Reply Brief, Appellants' discussion of the Oberle reference directs us to pages 10 and 11 of the principal Brief (Reply Brief, p. 5). There is no indication that Appellants intended this to be the response to the rejection under § 103 over Oberle.

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850, 205 USPQ 1069, 1072 (CCPA 1980). One of ordinary skill in the art would reasonably expect that the use of mixtures of polyamides when used in combination, would each produce the same effect as when used individually and would supplement each other. “For obviousness under § 103, all that is required is a reasonable expectation of success.” *In re O’Farrell*, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). In light of the foregoing and for the reasons expressed in the Answer, it is our determination that the Examiner has established a *prima facie* case of obviousness with respect to the argued claims on appeal.

With respect to claims 32 and 34, as stated above when discussing claim 31, it is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed by the prior art, the burden is on the Applicants to prove that the prior art product does not necessarily or inherently possess characteristics attributed to the claimed product. Appellants have not proffered convincing evidence that establishes the multilayered film of Oberle does not necessarily or inherently possess characteristics attributed to the claimed product.

As stated above, Appellants do not specifically traverse the establishment of a *prima facie* case obviousness by the Examiner. However, in the principal Brief, the Appellants assert unexpected results provide evidence of non-obviousness.

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(Brief, pp. 11 and 12). Appellants assert the table appended to the principal Brief provides a comparison of (1) film which has been watered by the manufacture compared to (2) film watered by a sausage maker. According to Appellants, this table shows the claimed films provide improved elasticity and the absence of folds and creases which appear in the comparative examples. (Brief, p. 12).

Appellants' proffered showing is deficient in a number of respects.

Significantly, the appealed claims are not limited to the specific type of multilayered film described in the examples which are said by the Appellants to be responsible for producing allegedly superior results. Also, the Appellants have not provided a comparison of the closest prior art. That is, a comparison of an example which is representative of the Oberle invention.

It is well settled that evidence presented to rebut a *prima facie* case of obviousness must be commensurate in scope with the claims to which it pertains and that such evidence which is considerably more narrow in scope than the claimed subject matter is not sufficient to rebut a *prima facie* case. *In re Dill*, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979). As indicated above, the Appellants' proffered evidence is indeed considerably more narrow than the argued claims on appeal and, for this reason alone, is inadequate to rebut the *prima facie* case of obviousness established by the Examiner.

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CONCLUSION

The rejection of claims 15 to 17, 19 to 21, 23, 25 to 29 and 31 and 20-22 as unpatentable under 35 U.S.C. § 102(b) as anticipated by Oberle is affirmed.

The rejection of claims 18, 22 and 32 to 34 as unpatentable under 35 U.S.C. § 103 as obvious over Oberle is affirmed.

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Time for taking action

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

AFFIRMED

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JEFFREY T. SMITH)	
Administrative Patent Judge)	
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BEVERLY A. PAWLIKOWSKI)	APPEALS AND
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