

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL FRIEDMAN and LOUIS LAUCIRICA

Appeal No. 1999-1186
Application 08/440,366

ON BRIEF

Before OWENS, KRATZ, and JEFFREY T. SMITH, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 1-9 and 13-23 as amended after final rejection. These are

Appeal No. 1999-1186
Application 08/440,366

acrylate copolymer and an ethylene methyl acrylate copolymer.

Claim 1 is illustrative:

1. A transparent film having a peel test strength of at least 8N/cm, comprising a uniform blend of components (a) and (b), wherein (a) comprises an ethylene butyl acrylate copolymer (EBAC) having about 8 to 36% by weight of acrylate groups; and wherein (b) comprises an ethylene methyl acrylate copolymer (EMAC), having about 8 to 42% by weight of acrylate groups; and wherein the uniform blend of components (a) and (b) contains less than about 95%, by weight, of component (a) and greater than about 5%, by weight, of component (b).

THE REFERENCES

Gulf Res. & Dev. Co. (Batchelor) ¹ (Great Britain patent specification)	1,154,620	Jun. 11, 1969
Latiolais et al. (Latiolais) (PCT application)	WO 93/06137	Apr. 1, 1993

THE REJECTIONS

Claims 1-9 and 13-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Batchelor taken with official notice, and over Batchelor taken with official notice and Latiolais.^{2,3}

¹The examiner and the appellants refer to this reference as Batchelor. For consistency, we likewise do so.

Appeal No. 1999-1186
Application 08/440,366

OPINION

We reverse the aforementioned rejections. We need to address only claim 1, which is the sole independent claim.

Rejection over Batchelor taken with official notice

Batchelor discloses a transparent film made from an ethylene polymer having pendent carboxylate groups, preferably also having pendent amide groups, and optionally having pendent ester groups (page 2, lines 4-47; page 3, lines 10-17). The pendent ester groups can be, *inter alia*, those of methyl acrylate or butyl acrylate units which are present in the amounts recited in the appellants' claim 1 (page 2, lines 37-43, 48-50 and 73-77).

Thus, Batchelor discloses an ethylene alkyl acrylate copolymer which can have ester units including methyl acrylate and butyl acrylate, but does not disclose a blend of an ethylene methyl acrylate copolymer (EMAC) and an ethylene butyl acrylate copolymer (EBAC). The official notice taken by the examiner pertains to additives recited in dependent claims (answer, page 4) and, therefore, does not remedy this deficiency in

Appeal No. 1999-1186
Application 08/440,366

The examiner argues that it would have been obvious to one of ordinary skill in the art to blend at least 5 wt% EBAC with EMAC in order to provide enhanced impact strength (answer, pages 6-7).

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). Batchelor discloses obtaining high impact strength by use of a copolymer which can contain methyl acrylate and ethyl acrylate units (page 2, lines 37-39; page 3, lines 110-112). The examiner has not explained why the applied prior art itself would have led one of ordinary skill in the art to change from this copolymer to a blend of EMAC and EBAC copolymers. The record indicates that the motivation relied upon by the examiner for doing so comes from the appellants' description of their invention in the specification rather than coming from the applied prior art and that, therefore, the

Appeal No. 1999-1186
Application 08/440,366

(CCPA 1960). Accordingly, we reverse the examiner's rejection over Batchelor taken with official notice.⁴

Since no *prima facie* case of obviousness has been established, we need not address the experimental results. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *Rinehart*, 531 F.2d at 1052, 189 USPQ at 147.

*Rejection over Batchelor taken with
official notice and Latiolais*

Latiolais discloses a homogeneous blend of a polyolefin and an ethylene alkyl acrylate copolymer (page 5, lines 22-25). Mixtures of alkyl acrylate comonomers, including methyl acrylate and butyl acrylate, can be used to make the copolymer (page 11, line 33 - page 12, line 7). Latiolais teaches that "polyolefin" does not include the ethylene alkyl acrylate copolymers of Latiolais' invention (page 48, line 29 - page 49, line 6).

The examiner states that he relies upon Latiolais for a demonstration of the state of the art with respect to EMAC and EBAC and for a demonstration of a new method for making both of

Appeal No. 1999-1186
Application 08/440,366

these copolymers with precise alkyl acrylate comonomer contents (answer, pages 5 and 9). The examiner, however, does not rely upon Latiolais for a teaching which cures the above-discussed deficiency in Batchelor. Consequently, we reverse the rejection over Batchelor taken with official notice and Latiolais.

DECISION

The rejections of claims 1-9 and 13-23 under 35 U.S.C. § 103 over Batchelor taken with official notice, and over Batchelor taken with official notice and Latiolais, are reversed.

REVERSED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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Appeal No. 1999-1186
Application 08/440,366

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