

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WEI H. CHANG, SHAW-CHANG
CHU and JAMES A. JOHNSON, Jr.

Appeal No. 94-2995
Application 07/976,827¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge and GARRIS and
WEIFFENBACH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 1, 3 through 8 and 10 through 17 as amended subsequent to the final rejection. The only other claim remaining in the application, which is claim 9, stands withdrawn from further consideration by the examiner.

¹ Application for patent filed November 16, 1992.

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The subject matter on appeal relates to a multilayer metallized film comprising a substrate layer having a layer of a polymer blend on at least one surface thereof. The blend contains (a) a polyvinyl alcohol homopolymer or copolymer and (b) a vinylidene chloride copolymer. The layer of this polymer blend is effective to reduce transmission of oxygen and moisture. This appealed subject matter is adequately illustrated by independent claim 1 which read as follows:

1. A multilayer metallized film comprising

a substrate layer of oriented propylene homopolymer or copolymer, capable of transmitting oxygen and moisture, wherein the substrate layer has two surfaces at least one surface of said polymer substrate layer having a layer of a blend of (a) a polyvinyl alcohol homopolymer or copolymer and (b) a vinylidene chloride copolymer, said layer of said blend being on at least one of said two surfaces; and

wherein said layer of said blend is effective to reduce transmission of said oxygen and said moisture.

The references relied upon by the examiner as evidence of obviousness are:

Scopp	3,725,184	Apr. 3, 1973
Migliorini	5,153,074	Oct. 6, 1992

All of the claims on appeal are rejected under 35 USC § 103 as being unpatentable over Migliorini in view of Scopp.

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We refer to the main Brief and Reply Brief and to the Answer for a complete exposition of the respective viewpoints advocated by the appellants and the examiner concerning the above noted rejection.

This rejection cannot be sustained.

On page 6 of the Answer, the examiner expresses his conclusion of obviousness as follows:

One of ordinary skill, motivated by an expected enhancement in resulting adhesive layer bonding properties, would look to the secondary reference where the presence of a very similar adhesive composition improved the resulting adhesion of the formed laminated film, and substitute the aforementioned PVOH-PVC containing adhesive blend disclosed in Scopp in place of the EVOH adhesive of Migliorini, and if desired, further modify the substituted Scopp adhesive composition through a substitution of "equivalents", i.e., polyvinylidene chloride for the substituted polyvinyl chloride composition, thereby forming the claimed genus of laminated films, the resulting film further also possessing the clearly inherent claimed property of being "effective to reduce transmission of [said] oxygen and [said] moisture".

Even when viewed in its most favorable light, the examiner's obviousness conclusion is quite plainly deficient in that the applied references contain no teaching or suggestion concerning

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the here claimed vinylidene chloride copolymer. More specifically, while it is possible that the applied prior art would have suggested a blend of polyvinyl alcohol and polyvinyl chloride, this prior art contains no teaching or suggestion concerning a blend of polyvinyl alcohol and polyvinylidene chloride. According to the examiner, an artisan with ordinary skill would have found it obvious to, "if desired, further modify the substituted Scopp adhesive composition [i.e., polyvinyl alcohol and polyvinyl chloride] through a substitution of 'equivalents' i.e., polyvinylidene chloride for the substituted polyvinyl chloride composition, thereby forming the claimed genus of laminated films, the resulting film further also possessing the clearly inherent claimed property of being 'effective to reduce transmission of [said] oxygen and [said] moisture'". The examiner's position is not well taken.

On the record before us, the examiner has supplied no evidence that polyvinylidene chloride and polyvinyl chloride are "equivalents" in the adhesive blend environment under consideration.² In addition, the applied prior is silent regarding the here claimed feature of reducing transmission of

² Moreover, equivalency is not the test for obviousness under 35 USC § 103. See, for example, In re Flint, 330 F.2d 363, 367, 141 USPQ 299, 302 (CCPA 1964) and In re Scott, 323 F.2d 1016, 1019, 139 USPQ 297, 299 (CCPA 1963).

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oxygen and moisture. Concerning these matters, we find merit in the following viewpoint expressed by the appellants on page 2 of the Reply Brief:

Polyvinylidene chloride is not described in the applied art for any purpose. However, the PTO reasons that a prima facie case has been established on the grounds that the undescribed polyvinylidene chloride is an equivalent of polyvinylchloride and the described polyvinylchloride [sic, the undescribed polyvinylalcohol/polyvinylidene chloride blend] would inherently function in a way undescribed by the applied art.

. . . obviousness can not be predicated on the unknown; findings, here under the statute, must be based on prior art evidence. The [examiner's] findings of equivalency and inherency are based on the rejected, appealed claims, not on the applied prior art.

In essence, we consider the examiner's obviousness conclusion to be based upon impermissible hindsight derived from the appellants' own disclosure rather than a teaching, suggestion or incentive derived from the applied prior. It follows that the § 103 rejection of the appealed claims as being unpatentable over Migliorini in view of Scopp cannot be sustained.

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The decision of the examiner is reversed.

REVERSED

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BRUCE H. STONER, Jr., Chief)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
BRADLEY R. GARRIS)	
Administrative Patent Judge)	APPEALS AND
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CAMERON WEIFFENBACH)	
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