

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MINGLIANG LAWRENCE TSAI

Appeal No. 2001-1849
Application 09/138,376

ON BRIEF

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

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the refusal to allow claims 1-33 as amended after final rejection. These are all of the claims in the application.

THE INVENTION

The appellant's claimed invention is directed toward a multilayer flat film structure having fluorine-containing halopolymer and naphthalene-containing polymer layers bonded to each other by an intermediate adhesive layer. Claim 1 is illustrative:

1. A multilayer flat film structure which comprises at least one halopolymer layer which comprises at least one component selected from the group consisting of homopolymers and copolymers of fluoropolymers and chlorofluoropolymers, and at least one naphthalene containing polymer layer attached to the halopolymer layer by an intermediate adhesive layer.

THE REFERENCES

Kemski	4,341,825	Jul. 27, 1982
Kim et al. (Kim)	5,139,878	Aug. 18, 1992
Nägeli et al. (Nägeli)	5,353,985	Oct. 11, 1994

THE REJECTIONS

Claims 1-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kim in view of Nägeli or Kemski.

OPINION

We reverse the aforementioned rejections.

Each of the appellant's independent claims requires that a halopolymer layer containing at least one homopolymer and/or copolymer of a fluoropolymer or chlorofluoropolymer is bonded to

a naphthalene-containing polymer layer by an intermediate adhesive layer.

Kim discloses a multilayer film structure having at least one fluoropolymer layer bonded to at least one thermoplastic polymer layer by an intermediate adhesive layer (col. 2, lines 46-51). Kim does not disclose that the fluoropolymer layer can be bonded to a naphthalene-containing polymer layer.

Kemski discloses a fog-resistant film having a first layer, which can be poly(ethylene naphthalate), thermally bonded, without using an adhesive, to a second layer containing a readily heat sealable organic polymer and an alkyl phenyl polyethylene glycol ether as an antifogging agent (col. 2, lines 3-40; col. 3, lines 4-9; col. 5, lines 3-8). No halopolymer layer is disclosed.

Nägeli discloses a round or oval package which has one or more compartments and is suitable for containing food portions (col. 1, lines 4-15). The bottom and lid of the package comprise a polyolefin or polyester layer facing the inside of the package (col. 2, lines 42-44). The disclosed polyesters include polyethylene-2,6-naphthalene dicarboxylate (col. 2, line 61 - col. 3, line 2). The package can include plastic, foil and ceramic layers joined by glues and/or bonding agents (col. 4,

lines 51-55). No halopolymer layer is disclosed.

The examiner argues that polyalkylene naphthalate polyesters were well known in the art to have excellent mechanical and barrier properties, and that "it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice" (answer, page 5). In support of this argument the examiner relies upon *In re Leshin*, 277 F.2d 197, 125 USPQ 416 (CCPA 1960). In that case the court held that it would have been obvious to one of ordinary skill in the art to select known plastics to make containers which were known to be made of plastic, the selection being based upon the intended use of the containers. See *Leshin*, 277 F.2d at 199, 125 USPQ at 417-18.

In *Leshin* the suitability of each plastic for making a container for an intended use was considered by the court to be apparent to those of ordinary skill in the art. In the present case, for the substitution of the naphthalene-containing polymers of Kemski or Nægeli for Kim's polyesters to have been obvious to one of ordinary skill in the art, such a person would have had to consider the naphthalene-containing polymers to have the good strength in the final film product required by Kim (col. 3, lines 7-10) and to be suitable for being bonded to a

fluoropolymer layer by an adhesive. The present case differs from *Leshin* in that the record does not indicate that it was known in the art that the naphthalene-containing polymers of Kemski or Nægeli have suitable properties, i.e., the required strength and ability to be adhesive bonded to a fluoropolymer, for use in Kim's multilayer film. The examiner points out (answer, page 6) that Kim's thermoplastic polymers include polyesters (col. 3, lines 16-22), but has not established that naphthalene-containing polyesters have properties which would have led one of ordinary skill in the art to consider them to be suitable as substitutes for the polyesters disclosed by Kim. It is not sufficient to merely assert, as the examiner has done (answer, page 6), that Kim's polyesters and the naphthalene-containing polyesters of Kemski and Nægeli are similar.

For a *prima facie* case of obviousness to be established, the applied prior art must be such that it would have provided one of ordinary skill in the art with both a motivation to carry out the claimed invention and a reasonable expectation of success in doing so. See *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). The examiner has not provided evidence that the naphthalene-containing polyesters of

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Kemski or Nægeli have the optical, mechanical and gas barrier properties which, the examiner argues (answer, page 7), would have motivated one of ordinary skill in the art to substitute the naphthalene-containing polyesters of Kemski or Nægeli for Kim's polyesters, and the examiner has not set forth the required evidence that the applied references would have provided one of ordinary skill in the art with a reasonable expectation of success in making this substitution.

DECISION

The rejections of claims 1-33 under 35 U.S.C. § 103 over Kim in view of Nægeli or Kemski are reversed.

REVERSED

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TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PAUL LIEBERMAN)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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JEFFREY T. SMITH)	
Administrative Patent Judge)	

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Roger H. Criss
Allied Signal, Inc.
101 Columbia Road
Morristown, NJ 07962

tjo/ki