

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DENNIS O. FALAAS and HOWARD C. RASCHKE

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Appeal No. 1996-2472  
Application 08/075,297<sup>1</sup>

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HEARD: JANUARY 10, 2000

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Before JOHN D. SMITH, OWENS and KRATZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is an appeal from the examiner's final rejection of claims 1, 2, 4-10, 17 and 18, which are all of the claims remaining in the application.

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<sup>1</sup> Application for patent filed June 11, 1993.

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*THE INVENTION*

Appellants claim a metallized film comprised of an opaque layer of metal in direct contact with an aliphatic polyurethane substrate which is derived from an aqueous urethane dispersion and has glass transition and melting temperatures within recited ranges. Claim 1 is illustrative and reads as follows:

1. A metallized film comprising a continuous, opaque layer of metal in direct contact with an aliphatic polyurethane substrate that has a glass transition temperature of about 25E to 110EC, a melting temperature greater than or equal to 200EC, and which is derived from an aqueous urethane dispersion.

*THE REFERENCES*

Muroi et al. (Muroi)	4,305,981	Dec. 15, 1981
Watai et al. (Watai)	4,393,120	Jul. 12, 1983
Waugh	4,446,179	May 1, 1984
Ellison et al. (Ellison)	4,810,540	Mar. 7, 1989

*THE REJECTIONS*

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1, 2, 4-10, 17 and 18 over Watai; claims 1 and 2 over Muroi; claims 1, 2, 4-10, 17 and 18 over Watai in view of Waugh and Ellison; claims 1 and 2 over Muroi in view of

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Waugh and Ellison; and claims 1, 2, 4-10, 17 and 18 over  
Waugh.

*OPINION*

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

Appellants' claim 1, which is the sole independent claim, requires that the polyurethane is derived from an aqueous urethane dispersion and has glass transition and melting temperatures within recited ranges. The examiner argues that one of ordinary skill in the art would have arrived at an aqueous urethane dispersion and the recited temperature ranges through routine optimization (answer, pages 7 and 9; supplemental answer, pages 3 and 6).<sup>2</sup> This is mere

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<sup>2</sup> The examiner presents no evidence or reasoning which shows that an aliphatic polyurethane substrate made by a method other than one using an aqueous urethane dispersion would be the same or substantially the same as one made using

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speculation, and such speculation is not a sufficient basis for a *prima facie* case of obviousness. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA 1962). 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). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. See *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84. The examiner has not provided such an explanation. Consequently, we do not sustain the examiner's

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an aqueous urethane dispersion.

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rejection.

*DECISION*

The rejections under 35 U.S.C. § 103 of claims 1, 2, 4-10, 17 and 18 over Watai, claims 1 and 2 over Muroi, claims 1, 2, 4-10, 17 and 18 over Watai in view of Waugh and Ellison, claims 1

and 2 over Muroi in view of Waugh and Ellison, and claims 1, 2, 4-10, 17 and 18 over Waugh, are reversed.

*REVERSED*

JOHN D. SMITH )  
Administrative Patent Judge )  
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	TERRY J. OWENS	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	PETER F. KRATZ	)	
	Administrative Patent Judge	)	

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