

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CHARLES E. BRINLEY

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Appeal No. 1997-0533  
Application No. 08/353,916<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, PAK, and WALTZ, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 20, which are all of the claims in this application.

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<sup>1</sup> Application for patent filed December 12, 1994.

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According to appellant, the invention is directed to a process for preparing an embossed metal foil laminate which may be used as an automotive or architectural decorative panel (Brief, page 3).<sup>2</sup> Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A process for preparing an embossed metal foil laminate, comprising:

providing a web of paper;

providing a metal foil;

extrusion coating a layer of molten resin onto the web of paper;

contacting the metal foil to the layer of molten resin, to form a layered structure comprising consecutively, the web of paper, the layer of molten resin, and the metal foil, and

passing the layered structure between a nip roll and an engraved chill roll, to laminate the layered structure, conduct heat from the molten resin quickly through the metal foil to the chill roll to solidify the resin, and emboss the metal foil.

The examiner has relied upon the following references as evidence of obviousness:

Anderson  
1963

3,075,864

Jan. 29,

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<sup>2</sup>All reference to the Brief is from the substitute Brief dated July 12, 1996, Paper No. 10.

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Andersson 1987	4,657,614	Apr. 14,
Brinley 1992	5,098,497	Mar. 24,

*Webster's New Collegiate Dictionary*, p. 577, G. & C. Merriam Co., 1973.

Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as unpatentable over Anderson in view of Andersson and Brinley or alternatively under § 103 as unpatentable over Anderson, Andersson and Brinley (Answer, page 3). We reverse this rejection for reasons which follow.

#### OPINION

The process of claim 1 on appeal recites, *inter alia*, contacting metal foil to a layer of molten resin to form a layered structure of paper, molten resin, and metal foil, and then passing the layered structure between a nip roll and an engraved chill roll to laminate the layered structure, solidify the resin, and emboss the metal foil.

The examiner finds that Anderson discloses a laminate comprising a metal foil bonded by an adhesive to a paper base where the metal foil is embossed after lamination and the adhesive resin is applied by coating (Answer, paragraph

bridging pages 3-4). The examiner further finds that it is conventional in the art to extrude a tie layer to bond a metal foil to a paper web, citing Andersson as support for this conventional bonding process step (Answer, page 4). Finally, the examiner finds that Brinley teaches embossing and laminating a polymer web to a paper film simultaneously (*Id.*). Accordingly, the examiner concludes that it would have been obvious "to perform the laminating and embossing steps simultaneously as suggested by Brinley to eliminate the separate lamination step in Anderson" as well as use the conventional extrusion method to tie layers as shown by Andersson (*Id.*).

Our reviewing court has stated the proper analysis under § 103 as follows:<sup>3</sup>

Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out,

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<sup>3</sup>*In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

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those of ordinary skill would have a reasonable expectation of success. [Citation omitted].

Accordingly, our analysis of the examiner's rejection under § 103 must first consider whether the prior art would have suggested to one of ordinary skill in the art that the claimed process should be carried out.

As noted by the examiner, Anderson teaches that the metal foil may be "imprinted" after its lamination (Answer, sentence bridging pages 3-4, citing Anderson, column 3, lines 33-35).<sup>4</sup> The examiner applies Brinley for the teaching of embossing and laminating the layers simultaneously (Answer, page 4). However, we do not agree with the examiner's analysis of these references. Anderson teaches that the backing layer **10** (which can be a metal foil or foil laminated to a paper backing) must be impervious and smooth (column 1, lines 71-72; column 2, lines 71-72; column 3, lines 5-7). Anderson also teaches that the applied polyethylene film should be embossed by contact with the scored or

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<sup>4</sup>The examiner has applied *Webster's New Collegiate Dictionary*, p. 577, to show the definition of "imprint" includes any mark or depression made by pressure and thus is equivalent to the claimed "embossing" step (Answer, page 5).

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patterned surface of the chilled roller **19** with the exposed surface of the polyethylene having a smooth configuration (column 4, lines 31-43). In the process disclosed by Anderson, any metal foil used never comes in contact with the surface of the chilled roller **19** (see Figure 3; column 3, lines 40-61).

Brinley is directed to the same process as the claimed subject matter on appeal except that the polymer film **5** of Brinley is embossed while the claimed process embosses a metal foil (compare Figure 1 of Brinley with the Figure of this application). The examiner has not pointed to any disclosure or suggestion of a metal foil in Brinley. The process of Brinley forms sequential layers of paper, molten resin, and polymeric film, where the heat of the molten resin is transferred to the outer polymeric film to raise the film above its plastic set temperature, i.e., the temperature above which an applied stress will cause permanent deformation of the film. Therefore the exposed surface of the polymeric film is able to assume the pattern of the engraved chill roll **7** (column 4, lines 16-27).

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Brinley is directed to embossing and laminating layers simultaneously so that the outermost polymeric film can reach its plastic set temperature and be easily and permanently deformed by the pattern on the chill roll. The examiner has not presented any evidence or reasoning as to why one of ordinary skill in the art would have expected the metal foil of Anderson to behave in a similar manner to the polymeric films of Brinley. Furthermore, the examiner has not presented any reasoning as to why one of ordinary skill in the art would have modified the method of Anderson by having the metal foil deformed by any engraved chill roll when Anderson does not show or suggest that the metal foil contacts the chill roll. The examiner also has not explained or presented reasons why Anderson teaches embossing the polyethylene layer by contact with a patterned chill roll but does not teach any process for "imprinting" the metal foil. Accordingly, the examiner has not established that the applied prior art would have suggested to one of ordinary skill in the art that the claimed process should be carried out. *Vaack*, 947 F.2d at 493, 20 USPQ2d at 1442.

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For the foregoing reasons, we determine that the examiner has failed to establish a *prima facie* case of obviousness in view of the reference evidence on this record. Therefore, the examiner's rejection of claims 1 through 20 under 35 U.S.C. § 103 over Anderson in view of Andersson and Brinley is reversed.

The decision of the examiner is reversed.

**REVERSED**

JOHN D. SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHUNG K. PAK	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	

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APJ WALTZ

APJ JOHN D. SMITH

APJ PAK

DECISION: REVERSED  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s):

Prepared: December 4, 2000

Draft            Final

3 MEM. CONF.    Y            N

OB/HD           GAU

PALM /ACTS 2/BOOK  
DISK(FOIA)/REPORT