

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(2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MELVIN S. FREEDMAN  
and TIM PARKER

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Appeal No. 1997-3611  
Application 08/439,414<sup>1</sup>

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ON BRIEF

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Before PAK, OWENS, and DELMENDO, Administrative Patent Judges.  
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's  
refusal to allow claims 9 through 12 and 36 through 39. Claim

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<sup>1</sup> Application for patent filed May 11, 1995.

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9 was amended subsequent to the final Office action dated March 26, 1996. Claims 1 through 8 and 33 through 35 were withdrawn from consideration by the examiner as being directed to a nonelected invention.

The subject matter on appeal in this application is directed to in-mold labeled plastic bottles or other in-mold labeled articles. This appealed subject matter relates to the subject matter claimed in U.S. Application 07/839,369, Appeal No.

97-1282, which is directed to methods involving manufacturing and labeling particular labels and recycling labeled articles. Claim 9, which is representative of the subject matter on appeal in this application, reads as follows:

9. An in-mold labelled plastic bottle or other substrate comprising a substrate body, a label formed of a coextruded layered film material and containing within itself a separation interface, said label being applied to the substrate body, said layered film material comprising two polymeric film plies each comprising one or more film layers, said film plies being on contact with each other and presenting to each other surfaces of different composition at a pair of contacting interior faces joined at said separation interface, one of said film plies comprising printable in-mold label facestock, including a printable face layer, the other of said film plies comprising a core or stiffening layer of polymetric [sic, polymeric] film and a heat-activatable adhesive layer, said film plies adhering to each other at said

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separation interface to a sufficiently high degree to withstand the maximum process separation force imposed at said separation interface as said layered film material is printed and as labels cut therefrom are deployed from affixation on said substrate, said film plies adhering to each other at said separation interface to a sufficiently low degree to allow them to cleanly and readily separate from each other at said separation interface under the imposition of a separation force greater than said maximum process separation force.

Claims 9 through 12 and 36 through 39 stand rejected under 35 U.S.C. § 103 as unpatentable over the disclosure of U.S. Patent 4,925,714 issued to Freedman on May 15, 1990 (hereinafter referred to as "Freedman").

We have reviewed the claims, specification, and applied prior art, including all of the arguments and evidence advanced by the examiner and appellants in support of their respective positions. This review leads us to conclude that the examiner's § 103 rejection is not well founded. Accordingly, we will not sustain the examiner's § 103 rejection for essentially those reasons set forth at pages 6-13 of the Brief. We add the following primarily for emphasis.

The examiner states (Answer, page 3)that:

Freedman substantially discloses the instant claimed invention of a multilayered in-mold label stock containing within itself a separation interface comprising at least two polymeric films of a different composition, said composition is a polyolefin, polyethylene or polypropylene, or

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composition which are closely related (see col. 2, line 55 to col. 4, line 23, col. 5, lines 48-59 and col. 8, lines 11-18). Freedman further discloses that the labels are used on containers, bottles (see col. 4, lines 18-22 and col. 5, lines 56-59).

Recognizing that Freedman does not disclose the claimed heat-activatable adhesive layer, the examiner asserts (Answer, page 4) that:

Heat-activated adhesives and pressure-sensitive adhesives are functionally equivalent for the purpose of bonding. It would have been within the purview of one of ordinary skill in the art to select an adhesive for the desired properties in the end product such as peel strength including a heat-activated adhesive.

The examiner's assertion, however, is not supported by any factual evidence.<sup>2</sup> The Freedman reference relied on by the examiner is directed to "a method and means for using pressure sensitive adhesive label technology." See column 1, lines 8-16. One of the pressure-sensitive adhesives used may be a hot-melt material. See column 5, lines 60-63. Nowhere does the Freedman reference, however, teach or suggest that the pressure sensitive adhesive layers, including those made of a hot melt material, are equivalent to the claimed heat-

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<sup>2</sup> At page 3 of the Answer, the examiner similarly does not provide any evidence to support his assertions regarding dependent claim limitations involving label compositions.

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activatable adhesive layers **for its labeling process**. Nor does the Freedman reference indicate that the employment of the claimed heat-activatable adhesive layers is desirable or useful in the label of the type described in Freedman. Under this circumstance, we are constrained to agree with appellants that the examiner has not supplied sufficient evidence to demonstrate that one of ordinary skill in the art would have been led to use the claimed heat-activatable adhesive layer, in lieu of the pressure-sensitive adhesive layer, in the labeling process described in the Freedman reference. In other words, the Freedman reference would not have suggested forming in-mold labeled articles containing the claimed heat-activatable adhesive layer.

Moreover, as argued by appellants at pages 9 and 12 of their Brief, Freedman also fails to disclose the claimed coextrudate of two polymeric film plies, one of which comprising a printable label face layer. See Freedman in its entirety. Nowhere does Freedman indicate that its printable label face layer (face stock 30), for example, is extruded. See, e.g., Freedman, column 2, lines 55-65 and column 3, lines

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12-66, together with Freedman's Figures 1A to 2D. According to the examiner (Answer, page 4):

Appellant[s] is [sic, are] arguing process limitations which are given little or no weight in determining the patentability of the claimed product in the absence of a factual showing that the label of the claimed invention differs from that of the prior [art].

In so stating, the examiner ignores the fact that he has the initial burden of establishing the "virtual identity" between the claimed coextruded printable label face layer and the printable label face layer (face stock 30) described in the Freedman reference. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Thorpe, 777 F.2d 695, 697-98, 227 USPQ 964, 965-66 (Fed. Cir. 1985). The examiner has improperly shifted the burden to appellants, without meeting his own.

Thus, on this record, we conclude that the examiner has not established a **prima facie** case of obviousness regarding the claimed subject matter within the meaning of 35 U.S.C. § 103. Accordingly, we reverse the examiner's decision rejecting claims 9 through 12 and 36 through 39 under 35 U.S.C. § 103 as unpatentable over Freedman.

OTHER ISSUE

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U.S. Patent 5,242,650 issued to Rackovan on September 7, 1993 (hereinafter "Rackovan") is directed to an in-mold labeling process and in-mold labeled articles, wherein a label film to be employed, comprising a face layer 12, a core layer 16 and a heat-activatable adhesive (base) layer 14, is coextruded and then hot-stretched to avoid shrinking, relaxing or any distortion of the film which may interfere with the in-mold labeling process. See Rackovan, column 4, lines 6-27, and column 5, line 11. Rackovan also refers to US. Patent 4,837,075 issued to Dudley on June 6, 1989, which discloses an in-mold labeling process involving the use of polymeric label stock in the form of a multilayer coextrudate comprising a layer of heat-activatable adhesive. See Rackovan, column 3, lines 25-42. Although both Rackovan and Dudley do not appear to describe forming coextruded films having therebetween a peelable interface, Freedman does teach that the formation of such films having a peelable interface advantageously provides "renewable surfaces" for manufactured products as indicated ***supra***.

Upon return of this application, the examiner should:

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- (1) Determine whether Rackovan is qualified as "prior art" for purposes of 35 U.S.C. §§ 102 and 103; and
- (2) Determine whether Freedman taken together with Rackovan (if qualified as "prior art") and/or Dudley would have rendered the claimed subject matter obvious within the meaning of 35 U.S.C. § 103.

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CONCLUSION

In view of the foregoing, we reverse the examiner's § 103 rejection and return this application to the examiner to consider the above-mentioned references consistent with our instruction.

REVERSED

Chung K. Pak	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Terry J. Owens	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
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	)	
Romulo Delmendo	)	
Administrative Patent Judge	)	

CKP:tdl

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