

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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ARNOLD B. FINESTONE and GILBERT BLOCH

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Appeal No. 1998-2317  
Application No. 08/327,601

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ON BRIEF

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Before OWENS, WALTZ, and LIEBERMAN, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1, 3 through 6, 8 and 10 through 12 as amended subsequent to the final rejection (see the amendment dated Feb. 24, 1997, Paper No. 10, entered as per the Advisory Action dated Mar. 21, 1997, Paper No. 11). Claims 1, 3-6, 8 and 10-12 are the only claims remaining in this application.

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According to appellants, the invention is directed to a pouch or container for forming an envelope to protectively package a product such as a food substance (Brief, page 2).<sup>1</sup> A copy of illustrative claim 1 is attached as an Appendix to this decision.

The examiner has relied upon the following references in support of the rejections on appeal:

Stillman	4,309,466	Jan. 5, 1982
Ossian et al. (Ossian)	Re. 31,137	Feb. 1, 1983
Murray, Jr. et al. (Murray)	4,777,085	Oct. 11, 1988

Claims 1, 3, 5, 8, 10 and 11 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Stillman (Answer, page 4). Claims 4 and 12 stand rejected under 35 U.S.C. § 103 as unpatentable over Stillman (Answer, page 6). Claim 6 stands rejected under 35 U.S.C. § 103 as unpatentable over Stillman in view of either Murray or Ossian (*id.*).<sup>2</sup> We reverse all of the

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<sup>1</sup>All reference to the "Brief" is to the substitute Brief dated Sep. 16, 1997, Paper No. 16.

<sup>2</sup>The final rejections under 35 U.S.C. § 112, first and second paragraphs, and all rejections containing Murray as the primary reference have been withdrawn by the examiner (Answer, pages 2-3; see also the Advisory Action dated Mar. 21, 1997, (continued...))

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examiner's rejections essentially for the reasons stated in the Brief and the reasons below.

#### OPINION

The examiner finds that Stillman discloses a pouch fabricated from a laminate sheeting comprising an outer ply of oriented synthetic plastic film and an inner ply of synthetic plastic film where the surfaces of each ply can be corona discharge treated to render them wettable and more receptive to adhesives (Answer, page 4). The examiner further finds that the outer ply of Stillman can be laminated to the inner ply "with an acrylic copolymer adhesive" (*id.*, citing col. 3, l. 58) which the examiner finds "reads on appellant's [sic, appellants'] claimed water-based adhesive" since claim 3 on appeal requires

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<sup>2</sup>(...continued)  
Paper No. 11). We note that the examiner has recognized that appellants have not specifically addressed the rejections of claims 4, 6 and 12 involving Stillman alone or in view of Murray and Ossian (Answer, sentence bridging pages 2-3). However, as noted by the examiner (Answer, page 3), appellants state that the patentability of the claims should be considered as a single group and measured against independent claim 1 (Brief, page 4). Accordingly, we consider the rejections as based on Stillman,

with appellants not contesting the application of the secondary references to Murray or Ossian.

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that the water-based adhesive is an acrylic copolymer adhesive (Answer, page 5). Furthermore, it is the examiner's position that the pouch of Stillman is identical to or only slightly different than the pouch claimed because both pouches use the same materials for the outer ply, the inner ply, and the *laminating adhesive* (Answer, page 9, emphasis added). The examiner dismisses the Firestone Declaration under 37 CFR § 1.132 (see Appendix B of the Brief) as "an opinion declaration" since the declarant states that Stillman does not use water-based adhesives while claim 3 on appeal recites the same adhesives as Stillman. The examiner further finds that Stillman additionally discloses saran adhesives "which are known to be water-based adhesives." Answer, page 9.

It is well settled that a rejection for anticipation or lack of novelty requires, as a first step, that all the elements of the claimed subject matter be described in a single reference. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). It is equally well settled that the initial burden of proof in establishing a *prima facie* case of unpatentability, whether anticipation or obviousness, rests with

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the examiner. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We determine that, on this record, the examiner has not met this initial burden. The adhesives disclosed by Stillman are not "acrylic copolymer adhesives" as found by the examiner (Answer, page 4) but are "conventional adhesives used to effect lamination, for example, polyethylene or *ethyl acrylic acid copolymers*." See Stillman, col. 3, ll. 56-58, emphasis added. Accordingly, the ethyl acrylic acid copolymer adhesive taught by Stillman is not the same material as the acrylic copolymer recited in claim 3 on appeal. Accordingly, the examiner has not met the burden of proof for an anticipation rejection that all the elements of the claimed subject matter are described by the single reference. Furthermore, the effect of substituents on the acrylic acid group, as well as the amount of acrylic acid monomer in the copolymer composition, could alter the water solubility of the adhesive. The examiner has failed to establish that the specific adhesives taught by Stillman necessarily are water-based adhesives within the scope of claim 1 on appeal. At col. 3, l. 59, Stillman also teaches that saran adhesives may be

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used. The examiner, on this record, has not shown any convincing argument or evidence to support the allegation that these adhesives of Stillman are "water-based adhesives" as required by claim 1 on appeal.

The declarant in the Declaration under 37 CFR § 1.132 specifically states that the adhesives described by Stillman are extrusion laminating adhesives and are not water-based adhesives (¶5). The examiner's only rebuttal of this statement is that "claim 3 of the present application requires that the adhesive is an acrylic copolymer, and Stillman discloses the use of acrylic copolymers." Answer, page 9. The examiner's rebuttal is in error since, as previously discussed, Stillman does *not* disclose acrylic acid copolymers as adhesives but teaches the use of *ethyl* acrylic acid copolymer adhesives (col. 3, l. 58). Furthermore, the acrylic acid copolymer of claim 3 depends upon claim 1, which requires the adhesive to be a "water-based" adhesive while the adhesive of Stillman is not necessarily a water-based adhesive, depending on the ethyl substituent and the other monomer(s) used to form the copolymer.

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For the foregoing reasons, we determine that the examiner has failed to present a *prima facie* case of anticipation or obviousness in view of Stillman. We note that Murray and Ossian were applied by the examiner for their disclosure of oriented polyester films as the outer ply of a laminate and thus do not remedy the deficiencies discussed above with respect to Stillman. Even assuming *arguendo* that the examiner has established a *prima facie* case of obviousness, based on the totality of the record, including appellants' arguments and evidence, we determine that the preponderance of evidence weighs most heavily in favor of non-obviousness. Accordingly, the examiner's rejection of claims 1, 3, 5, 8, 10 and 11 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 over Stillman is reversed. The rejection of claims 4 and 12 under 35 U.S.C. § 103 over Stillman is also reversed. The rejection of claim 6 under 35 U.S.C. § 103 over Stillman in view of either Murray or Ossian is reversed.

The decision of the examiner is reversed.

**REVERSED**

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TERRY J. OWENS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
THOMAS A. WALTZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
PAUL LIEBERMAN	)	
Administrative Patent Judge	)	

TAW/jrg

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**APPENDIX**

1. A pouch or container for forming an envelope to protectively package a product such as a flowable or solid food substance, said envelope being formed of two superposed panels marginally sealed to better define a pocket to accommodate said product, each panel being fabricated from a laminate sheeting comprising:

A. an outer ply of oriented synthetic plastic film having a glass transition temperature and a first surfaces which is are corona-discharge treated to render it wettable and receptive to a waterbased adhesive; and

B. an inner ply of synthetic plastic film having a lower glass transition temperature than the glass transition temperature of the outer ply, the inner ply further having a first surface that faces the first surface of the outer ply, with the first surface of the inner ply being corona-discharge treated to render it wettable and receptive to a water-based adhesive, and further being adhesively cold laminated by a water-based adhesive to the first surface of the outer ply at ambient temperature to produce a laminate having high tensile strength and tear resistance, whereby when w the two panels are superposed, the inner plies are then in contact with each other, and when the superposed panels are marginally sealed together by heat and pressure applied thereto, the inner plies are then caused to fuse but the outer plies are unaffected by the heat and the orientation of the outer plies is unaffected.

