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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for 11/386,143 and examiner information for MATTHEW T. MARTIN.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL  
AND APPEAL BOARD

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*Ex parte* BRUCE MICHAEL HASCH

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Appeal 2011-013682  
Application 11/386,143  
Technology Center 1700

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Before LINDA M. GAUDETTE, MICHAEL P. COLAIANNI, and  
DONNA M. PRAISS, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 the final rejection of claims 2, 4-6, 9-13, 15, 16, and 18-25<sup>1</sup>. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM, but denominate our analysis as NEW GROUNDS OF REJECTION pursuant to 37 C.F.R. §41.50(b) for the reasons discussed *infra*.

Appellant's invention is directed to ethylene copolymer encapsulants for encapsulating photovoltaic solar cells (Spec. 1:4-5).

Claim 19 is illustrative:

19. A composition comprising an ethylene vinyl acetate copolymer blended with from about 150 to less than 500 parts per million by weight (ppm) of olefinic bisoleamide, based on the total weight of the composition, wherein the ethylene vinyl acetate copolymer comprises about 18 to about 55 wt% of vinyl acetate, based on the total weight of the ethylene vinyl acetate copolymer.

Appellant appeals the following rejections:

1. Claims 19 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (US 4,510,281 issued Apr. 9, 1985) in view of Powell (US 5,399,401 issued Mar. 21, 1995).
2. Claims 2, 4-6, 9-13, 15-18, 21, and 22 are rejected under 35 U.S.C. § 103(a), as being unpatentable over Kataoka (US 6,133,522 issued Oct. 17, 2000) in view of Smith and Powell.

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<sup>1</sup> Appellant states that claim 3 is on appeal, but claim 3 was canceled in the amendment filed February 3, 2010. Also, Appellants do not list claim 19 as being on appeal (App. Br. 1). However, Appellants do list claim 19 in the Claims Appendix to the Appeal Brief and also argue claim 19 in the Brief (App. Br. 3). Accordingly, we find that Appellants' omission of claim 19 from the claims on appeal is harmless error.

REJECTION (1)

Appellant argues claims 19 and 20 separately (App. Br. 3-7).

ISSUES

1. Did the Examiner reversibly err in finding that Smith's disclosure that ethylenebisoleamide may be present in a concentration of "about 500 to 10,000 ppm" overlaps Appellant's claimed range of 150 to less than 500 ppm olefinic bisoleamide so as render the composition of claim 19 obvious? We decide this issue in the negative.
2. Did the Examiner reversibly err in finding that a composition made according to Smith's disclosure would have a haze property as recited in claim 20? We decide this issue in the negative.

FINDINGS OF FACT & ANALYSIS

*Issue (1): Claim 19*

Appellant argues that Powell teaches using amounts of olefinic bisoleamide in amounts greater than 1000 ppm, which is outside the claimed range (i.e., 150 to less than 500 ppm) (App. Br. 5).

The Examiner responds that Powell teaches adding "small amounts" of bisoleamide as a slip additive to polymers to reduce haze in the polymer compositions (Ans. 5). The Examiner finds that Powell teaches to minimize the additives which would have suggested using amounts below 500 ppm in Smith's composition (*id.* at 9).

The Examiner also finds that Smith, alone, discloses using a concentration of bisoleamide from "about 500 to 10,000 ppm" which overlaps the claimed range of "150 to less than 500 ppm" (*id.* at 5, 7, 8-9).

The Examiner finds that, because the ranges overlap, the claimed invention would have been prima facie obvious over Smith (*id.* at 5).

We agree with Appellant that the rejection over Smith in view of Powell is not sustainable. Powell teaches using amounts of bisoleamide (from 0.1 to 0.8 wt.% which converts to 1000 to 8000 ppm) that are outside the claimed range (col. 3, ll. 34-36; Table 2). Accordingly, the Examiner's findings regarding small amounts of bisoleamide in Powell would include amounts outside the claimed range. We reverse the rejection based on the combination of Smith and Powell.

However, the Examiner's other line of reasoning in the rejection based on Smith, alone, is not addressed or disputed by Appellant. Indeed, Smith's bisoleamide range (i.e., "about 500 to 10,000 ppm") overlaps the claimed bisoleamide range (i.e., 150 to less than 500 ppm). Appellant does not dispute that "about 500 ppm" includes values such as 490 or 450 ppm as found by the Examiner that are within the claimed range (Ans. 7). Because the ranges overlap, a prima facie case of obviousness has been established and the burden is on Appellant to establish the invention would not have been obvious. *In re Peterson*, 315 F.3d 1325, 1329-30 (Fed. Cir. 2003).

Accordingly, we affirm the Examiner's rejection of claim 19 over Smith. Because we rely on facts found by the Examiner concerning Smith with regard to rejection (2) in our analysis, we denominate our analysis a new ground of rejection.

*Issue (2): Claim 20*

Appellant argues that Powell's Table 2 shows that adding fatty acid amide to ethylene vinyl acetate (EVA) produces worse haze, not better haze properties (App. Br. 7).

We understand the Examiner to rely on two lines of reasoning in addressing the subject matter of claim 20. First, the Examiner determines that it would have been obvious to manufacture the polymer according to Smith alone and the haze value would necessarily be less than 20 (Ans. 5). Second, the Examiner finds that it would have been obvious to manufacture the polymer according to Smith and Powell and thus arrive at a polymer having the claimed haze properties.

The Examiner's analysis regarding the rejection over Smith and Powell is faulty for the reasons discussed regarding claim 19. We reverse that rejection.

We agree with the Examiner's analysis of the subject matter of claim 20 with regard to Smith alone. Because the composition of Smith is identical to the claimed composition, we fail to see how the identical composition would not have the claimed haze value. *In re Papesch*, 315 F.2d 381, 391 (CCPA 1963) (A chemical compound and its properties are inseparable.). That Smith does not discuss haze values is of no moment as the discovery of a new property of a previously known composition, even when the property is unobvious, cannot impart patentability to claims to the known composition. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990).

Appellant argues that "even [when starting with the] same [two] compositions each containing the same A and B. . . , plaques made therefrom will not inherently have the same haze, depending on how [each] composition is produced" (App. Br. 4). Appellant contends that whether a

plaque has a certain haze value depends on a number of factors, including the degree of crystallinity, additives present in the composition, and process of making the composition. *Id.*

However, Appellant has not provided any evidence to substantiate the attorney argument that Smith's composition formed into a plaque and tested would not have had the claimed haze value. The claims are to a composition and Smith teaches that composition with an amount of bisoleamide that overlaps the claimed range of bisoleamide. We note that Appellant's Specification discloses that the bisoleamide may be blended with the ethylene vinyl acetate (EVA) by "any convenient technique . . . [such as] by the general techniques described in the literature, such as US 4,510,281 [to Smith]" (Spec. 11:8-19). Accordingly, Appellant admits that the claimed composition and Smith's composition are made by the same processes. Therefore, it is reasonable to presume that the haze properties for Smith's and the claimed composition would have been the same.

On this record, we reverse the Examiner's rejection of claim 20 over Smith and Powell. However, we affirm the Examiner's rejection of claim 20 over Smith, alone. Because our analysis includes new findings of fact regarding the processes and composition of Smith, we denominate our analysis as a new ground of rejection.

## REJECTION (2)

Appellant argues claims 2, 5, 6, 11, and 13 (App. Br. 7-11).

## ISSUE

Did the Examiner reversibly err in finding that the combined teachings of Kataoka and Smith<sup>2</sup> would have suggested the subject matter of claim 2? We decide this issue in the negative.

## FINDINGS OF FACT & ANALYSIS

Appellant argues that Kataoka does not teach using a transparent encapsulant 302a (App. Br. 9). However, this argument is contradicted by Kataoka's express disclosure that the top encapsulant 302a needs to be transparent (col. 11, ll. 3-10).

Appellant further argues that Smith does not teach that the composition can be used for an encapsulant that requires strong bonding to the adhesive (App. Br. 10). Appellant contends that Smith teaches that the composition has antiblocking properties (i.e., tendency to adhere to other layers) (*id.*). Appellant contends that Kataoka requires strong adhesion and Smith discloses less adhesion which teaches away from each other (*id.*).

Contrary to Appellant's arguments, Smith teaches that the pellet form of the polymer has antiblocking properties (Smith, col. 1, ll. 14-17). Smith describes problems with the pellets sticking together and sticking to the equipment (*id.* at col. 2, ll. 15-24). Smith further discloses that ethylene vinyl acetate (EVA) copolymers are known to impart adhesion and are used in adhesives (*id.* at col. 1, ll. 22-29). Thus, we do not agree with Appellant that Smith teaches that the final product produced from the pellets of EVA copolymers has antiblocking properties. Rather, Smith's focus is on forming

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<sup>2</sup> We limit our discussion to Kataoka and Smith. As noted in our discussion with regard to rejection (1), the rejections using Powell, including rejection (2), are reversed for the reasons discussed *supra*.

pellets that have antiblocking properties to prevent the pellets from adhering together or sticking to the equipment. We do not find that Smith teaches away from using the EVA copolymer as an adhesive encapsulant.

Whether or not Smith teaches using the EVA copolymer as an encapsulant is not controlling as Kataoka teaches EVA copolymers as encapsulants as noted by the Examiner (Ans. 6).

Appellant argues that Smith and Powell led one of ordinary skill away from an EVA composition with less than 500 ppm bisoleamide (App. Br. 10). However, as noted above, the Examiner does not rely solely on the combination of Powell and Smith to render the composition obvious. Rather, the Examiner relies on Smith, alone, to satisfy the composition and it is the rejection based on that analysis that we affirm as Smith's composition includes a bisoleamide concentration that overlaps the claimed range (Ans. 6-7).

Regarding claims 5 and 6, Appellant argues that the applied prior art does not teach using a bisoleamide concentration of 490 ppm or less (claim 5) or 450 ppm or less (claim 6) (App. Br. 10-11). However, the Examiner finds that Smith's "about 500 ppm" on the lower end of the range includes 490 ppm and 450 ppm (Ans. 7). Appellant does not dispute these findings.

Regarding claim 11, Appellant argues that the applied prior art fails to teach a flexible protective backsheet (App. Br. 11). Appellant's argument does not address the Examiner's finding that Kataoka discloses a flexible solar cell which implies a flexible backsheet (Ans. 7).

Regarding claim 13, Appellant argues that the applied prior art fails to teach the claimed haze property recited in the claim (App. Br. 11). This argument is not persuasive in light of our analysis regarding claim 20 *supra*.

Because our analysis regarding the rejection involves findings and explanations not clearly described by the Examiner, we denominate our analysis with regard to claims 2 and 13 as new grounds of rejection.

On this record and for the above reasons, we affirm the Examiner's rejections over Smith alone, or Kataoka in view of Smith. We reverse the Examiner's rejections over Smith in view of Powell and Kataoka in view of Smith and Powell.

#### DECISION

The Examiner's decision is affirmed and we denominate our analysis as a new ground of rejection.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). This section provides that "[a] new ground of rejection . . . shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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ORDER

AFFIRMED & NEW GROUND OF REJECTION  
PURSUANT TO 37 C.F.R. § 41.50(b)

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