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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* MASASHI YOKOGI, TAKU KITADE, MASAHIKO KAWANO  
and KAZUNARI KATSUHARA<sup>1</sup>

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Appeal 2015-000482<sup>2</sup>  
Application 13/601,298  
Technology Center 1700

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Before ROMULO H. DELMENDO, JEFFREY W. ABRAHAM, and  
JENNIFER R. GUPTA, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1–14. We have jurisdiction pursuant to 35 U.S.C. § 6(b). We affirm.

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<sup>1</sup> According to the Appeal Brief, the real parties in interest are Mitsubishi Chemical Corporation and Mitsubishi Plastics Inc. App. Br. 1.

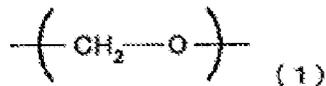
<sup>2</sup> We heard oral arguments from the Appellants' representative on November 10, 2016. A written transcript will be entered into the record when it is made available.

## BACKGROUND

Appellants' claimed invention relates to a laminate comprising a polycarbonate resin. Spec. ¶ 1.

Claim 1 is the only independent claim on appeal, and is reproduced below from the Claims Appendix (App. Br. 8):

1. A laminate comprising a layer of a polycarbonate resin which comprises 35 to 90 % by mol a structural unit derived from a dihydroxy compound having, as part of the structure thereof, a site represented by the following formula (1); and a structural other than said structural unit derive[d] from a dihydroxyl compound having a site represented by formula (1) which is unit derived from a dihydroxy compound having no aromatic ring, (layer A) laminated to a layer of an aromatic polycarbonate resin (layer B)



with the proviso that the site represented by the above formula (1) is part of -CH<sub>2</sub>-O-H is omitted.

The Examiner maintains, and Appellants appeal, the rejection of claims 1–10, 13, and 14 under 35 U.S.C. § 103(a) over Adams<sup>3</sup> and Kinoshita;<sup>4</sup> claim 11 under 35 U.S.C. § 103(a) over Adams, Kinoshita, and Komota;<sup>5</sup> and claim 12 under 35 U.S.C. § 103(a) over Adams, Kinoshita, and Roulin.<sup>6</sup>

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<sup>3</sup> Adams et al., US 4,927,675, issued May 22, 1990.

<sup>4</sup> Kinoshita et al., JP 2009-079190, published Apr. 16, 2009.

<sup>5</sup> Komota et al., JP 2007-062015, published Mar. 15, 2007.

<sup>6</sup> Roulin et al., US 5,624,036, issued Apr. 29, 1997.

Appellants do not separately argue the patentability of any dependent claim, and, therefore, claims 2–14 stand or fall with independent claim 1.

#### OPINION

We sustain the above rejections based on the Examiner’s findings of fact, conclusions of law, and rebuttals to Appellants’ arguments, as expressed in the Final Action and Answer. The following comments are added for emphasis.

The Examiner finds that Adams discloses a multilayer material comprising a thermoplastic core and two outer layers, wherein the core includes aromatic polycarbonates and the outer layers may be formed from any thermoplastic material that is transparent. Final Act. 2. The Examiner acknowledges that Adams “is silent with regard to a polycarbonate resin having the claimed dihydroxy compound,” but finds that these types of polycarbonates were known in the art in view of Kinoshita, and provide “excellent strength, scratch resistance, and solvent resistance.” *Id.* (citing Kinoshita ¶¶ 1, 11, 17–25). The Examiner determines that “it would have been obvious to one of ordinary skill in the art to use the surface protecting film taught by Kinoshita, which contains the presently claimed polycarbonate, as the outer layers of Adams to provide strength, scratch resistance, and solvent resistance to the multilayer material.” *Id.*

Appellants argue the Examiner committed reversible error in finding a person of ordinary skill in the art would have been motivated to combine the teachings of Adams and Kinoshita to arrive at the claimed invention. App. Br. 3. Appellants take the position that Adams discloses a multilayered article formed by co-extrusion, having outer layers that prevent migration of a material from its core. *Id.* at 3–4. Appellants argue that Kinoshita’s films

are designed to protect underlying layers from the outside world, as opposed to Adams' materials which protect the outside world from materials migrating from its core, and, therefore, Kinoshita and Adams are directed to "vastly different goals." *Id.* at 4–5. Appellants further argue that there is no evidence that the protective film of Kinoshita can be processed as a co-extrudate, as disclosed by Adams. *Id.*; Reply 1.

We are not persuaded by Appellants' arguments. We agree with the Examiner's finding that Adams is concerned with protective properties beyond preventing migration of materials from its core. Ans. 6–7. Namely, Adams refers to "applications where a heat-resistant and weather-resistant product having high dielectric strength, low water absorption, and good dimensional stability is desired" (Adams, 6:42–48), as well as "instances in which additional physical properties are desired, such as abrasion resistance" (*id.* at 9:3–7). *See* Ans. 6–7. Accordingly, both Adams and Kinoshita are directed to materials having properties that offer protection from the environment. *Id.*

Nor are we persuaded by Appellants' argument that Kinoshita fails to disclose that its film can be used to protect a layer comprised of an aromatic polycarbonate resin, or the argument that there is no evidence that the protective film of Kinoshita can be processed as a co-extrudate with a core material, such as an aromatic polycarbonate. App. Br. 4–5. The Examiner relies on Adams for its disclosure of a core layer comprised of an aromatic polycarbonate resin surrounded by protective outer layers. Final Act. 2; Ans. 5–6. Furthermore, Appellants do not direct us to evidence demonstrating sufficiently that Kinoshita's material cannot be processed as a co-extrudate. We note that Kinoshita states that its "manufacturing method

in particular is not limited,” and describes “melt kneading . . . using an extrusion machine” as a “preferable manufacturing method.” Kinoshita ¶ 44.

Appellants also contend that the Examiner erred because Adams and Kinoshita each fail to disclose an outer layer that excludes an aromatic ring-containing monomer. App. Br. 4, 6. As the Examiner correctly finds, however, Kinoshita does not require the use of a monomer having an aromatic ring, and discloses an example of a resin formed using a material that does not include an aromatic ring. Ans. 8–9; Kinoshita ¶¶ 23, 74 (using 1,3-propanediol). With regard to Appellants’ argument that Adams and Kinoshita fail to disclose the object of the claimed invention, namely a plastic laminate having high surface hardness, impact resistance, punchability, and yellowing resistance (App. Br. 4–5), we agree with the Examiner that these are not properties recited in the claims (Ans. 8).

In the Reply Brief, Appellants argue, for the first time, that “there is no suggestion in Adams et al. for the core and outer layers to be of different materials, as claimed,” and that Adams requires a surface layer that is physically and chemically compatible with the core layer. Reply 2. Appellants further argue that Kinoshita “fails to disclose any properties as to physical and chemical compatibility with the core material of Adams et al.” *Id.* at 3.

Rule 41, which provides for reply briefs, states that “[a]ny argument raised in the reply brief which was not raised in the appeal brief . . . will not be considered by the Board for purposes of the present appeal, unless good cause is shown.” 37 C.F.R. § 41.41(b)(1) and (2). Appellants did not present the aforementioned arguments regarding Adams and Kinoshita in the

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Appeal Brief, and have not shown good cause as to why we should consider the new arguments and evidence presented in the Reply Brief, especially considering that due to the failure to present these arguments earlier, the Examiner did not have an opportunity to address them. *Ex parte Borden*, 93 USPQ2d 1473 (BPAI 2010) (informative opinion) (“When new issues have been raised by the Appellant but not addressed by the Examiner, the Board, unless good cause is shown, will not consider those new issues.”). As a result, we decline to consider the new arguments raised in the Reply Brief.<sup>7</sup>

#### CONCLUSION

For the reasons set forth above, we affirm the decision of the Examiner to reject claims 1–14.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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<sup>7</sup> Even if we were to consider Appellants’ new argument regarding Adams, we note that Appellants’ argument is inconsistent with its characterization of Adams as “an invitation to laminate any thermoplastic material outer layer on to any thermoplastic filled core.” Reply 2 (emphasis omitted).