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EXAMINER

HELVEY, PETER N.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MAURICIO BUNGE and HELMAR UTZ

Appeal 2015-000892
Application 12/063,612
Technology Center 3700

Before STEFAN STAICOVICI, WILLIAM A. CAPP, and
BRANDON J. WARNER, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 2–16 and 21–25. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

Appellants' invention relates to easy-to-open packaging. Spec. ¶ 1.
Claim 2, reproduced below, is illustrative of the subject matter on appeal.

2. Easy-to-open packaging (1) comprising an easy tearable multilayer laminate (8), said laminate comprising at least two polymer layer[s] wherein at least one of said polymer layer[s] comprises a scratched surface (6,6') forming a scratched polymer layer (11), said scratched surface (6,6') comprising a multitude of adjacent scratched lines parallel to an extrusion direction (2) of said scratched polymer layer (11), the scratched lines creating a predetermined tear direction of the packaging (1), wherein a depth of said scratched lines represents less than 50% of a thickness of said scratched polymer layer (11).

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Otsuka	US 5,312,659	May 17, 1994
Gotoh	US 5,538,345	July 23, 1996
Littmann	US 5,878,549	Mar. 9, 1999
Stefandl	US 2003/0156766 A1	Aug. 21, 2003

The following rejections are before us for review:

1. Claims 2–13, 15, and 21–25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Littmann and Otsuka.

2. Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Littman, Otsuka, and Stefandl.

3. Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Littman, Otsuka, and Gotoh.

OPINION

*Unpatentability of Claims 2–13, 15, and 21–25
over Littmann and Otsuka*

Claims 2–13, 15, and 21–24

Appellants argue claims 2–13, 15, and 21–24 as a group. Appeal Br. 4–11. We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015).

The Examiner finds that Littman discloses the claimed invention except for the roughened surface (i.e., scratches) being formed into a multitude of adjacent scratched lines of the claimed depth. Final Action 3; *see also* Littman, col. 5, ll. 47–48 (“The roughening can be embossed . . . scratches.”). The Examiner relies on Otsuka as teaching a multitude of adjacent lines with the claimed depth. *Id.* The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time of the invention to form the scratches taught by Littman as lines with the depths as taught by Otsuka. *Id.* at 3–4. According to the Examiner, a person of ordinary skill in the art would have done this to maintain appropriate tear properties without significantly affecting the strength of the film layer. *Id.* In addition, the Examiner concludes that it would have been a matter of design choice to make roughened portion of Littman’s package in whatever form or shape was desired or expedient, including the known shape of adjacent lines as taught by Otsuka. *Id.* at 4 (citing *In Re Dailey*, 357 F.2d 669 (CCPA 1966)).

Appellants traverse the Examiner’s rejection by arguing that Otsuka’s lines are not formed by “scratching.” Appeal Br. 4–5. Appellants argue that Otsuka’s lines are formed by contact with a press roller. *Id.* at 5. Appellants

argue that Otsuka teaches away from forming tear lines with a slit after a film is formed and cooled. *Id.*

In response, the Examiner states that Appellants' "scratch" limitation is a product-by-process limitation that does not patentably distinguish from score lines formed from other processes. Ans. 7. The Examiner cites *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985) for the proposition that the patentability of a product does not depend on its method of production.

In reply, Appellants argue that the process of Otsuka results in a structurally distinguishable product from that of Appellants' invention. Reply Br. 3. According to Appellants, Otsuka teaches that scoring by a slit cannot prevent fine nicks. *Id.* Essentially, Appellants distinguish the score lines of their invention from Otsuka by arguing that Otsuka's score lines are uniformly smooth while implying, without evidence, that Appellants' sand paper scratched score lines are not smooth. *Id.* at 2–3. Essentially, Appellants ask us to make a leap in logic that, because Otsuka discloses that score lines made by a slit have nicks, Appellants' roughened score lines, made for example with sand paper, necessarily have similar nicks.

The controlling law on the patentability of product-by-process claims is summarized by the Court in the case of *Amgen Inc. v. Hoffman-La Roche Ltd.*, 580 F.3d 1340 (Fed. Cir. 2009). "It has long been the case that an old product is not patentable even if it is made by a new process." *Id.* at 1366;¹

¹ Following and quoting *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 373 (1938); *Cochrane v. Badische Anilin & Soda Fabrik*, 111 U.S. 293, 311 (1884); *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317 (Fed. Cir. 2006); *Thorpe*, 777 F.2d at 697; and *Tri-Wall Containers, Inc. v. United States*, 408 F.2d 748, 750 (Ct. Cl., 1969)

see also In re Thorpe, 777 F.2d 695, 679 (Fed. Cir. 1985) (“If the product in a product-by-process claim is the same as *or obvious from* a product of the prior art, the claim is unpatentable even though the prior product was made by a difference process.”) (emphasis added). For purposes of the instant case, the key phrase used in *Thorpe* is “same as *or obvious.*” *Id.* Here, Appellants labor mightily to draw a structural distinction between a score line formed by scratching a polymer layer with a slitter and a score line formed by a press roller.

Otsuka describes formation of spatially discrete score lines in a laminated film at a temperature higher than the softening temperature of the film by contact with a press roller, then rapidly cooling the film. *See* Otsuka col. 2, lines 35-44 and col. 5, lines 1-15. Specifically, Otsuka recites that score lines are produced “in the film by driving the resin on the surface of the film away laterally on both sides so as to form grooves without cutting by a slitter.” Otsuka col. 3, lines 51-53. Otsuka makes very clear in its disclosure at col. 3, lines 44-54, that score lines produced in this manner are distinguished from other lines. Indeed, Otsuka recites that the “score lines formed according to the invention do not have nicks.” Thus, Otsuka expressly discloses and teaches a factual distinction between the formation of these two different types of lines, which results in an identified structural difference between the score lines of Otsuka and the scratched lines of claim 2. Accordingly, the score lines of Otsuka are unrelated to a “roughened surface” as asserted by the Examiner.

Appeal Br. 5. Assuming, for sake of argument, that Appellants’ invention forms score lines that are structurally different from those of Otsuka in terms of having “nicks,” Appellants never explain why such difference results in

an invention that, as a whole, is patentably non-obvious.² 35 U.S.C. § 103 specifically contemplates that a claimed invention may be different from the prior art and yet be obvious for purposes of patentability.

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.

Id.

Littman demonstrates that it was known in the art to make an easy open tear control feature by roughening a portion of the package with sand paper. *See* Littman, Abstract; col. 5, ll. 32–52. Such surface roughening is performed in-line on a roto press. *Id.* col. 5, ll. 32–33. Such roughening need not be along a set line and, thus, can be random. *Id.* col. 5, ll. 52–55. However, while the pattern can be random, we understand Littman as also including roughening along a set line. *Id.*

Otsuka demonstrates that it was known in the art, as of the time of Appellants' invention, to generate score lines with a slitter. Otsuka, col. 3, ll. 33–54. Otsuka then explains that creating score lines by press rolling, instead of with a slitter, produces score lines without nicks. *Id.* col. 3, ll. 50–54. Otsuka further explains that using score lines produced by a press roller and, therefore, without nicks, achieves superior shock resistance performance over packages with nicked score lines produced by a slitter. *Id.* col. 3, ll. 40–49. Otsuka is silent on the use of sand paper to create score

² In that regard, Appellants never address the Examiner's alternative rationale that it would have been obvious to make Littman's roughened portion any desired or expedient form or shape. Final Action 4.

lines. Appellants provide no evidence or persuasive technical reasoning to cause us, or a person of ordinary skill in the art, to believe that issues encountered with the use of a slitter would similarly manifest themselves if the surface were roughened with sand paper. In particular, Appellants do not claim “nicked” lines and present no evidence that their claimed lines are “nicked,” in contrast to the smooth lines of Otsuka. Thus, although Otsuka expresses a general preference for smooth (not nicked) score lines, we are not persuaded that forming “scratched” score lines by roughening with sand paper produces a product that is structurally distinct and non-obvious from that of the Examiner’s proposed combination.

Appellants’ teaching away argument is not persuasive. At most, Otsuka might be viewed as discouraging the use of a slitter to generate score lines when shock resistance of a package is important. As Littmann is concerned with ease of tearing features of a package (*see* Littmann, Abstract), we do not read Otsuka as criticizing, discrediting or otherwise discouraging the creation of score lines by roughening. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (A reference does not teach away if it merely discloses an alternative invention but does not “criticize, discredit, or otherwise discourage” investigation into the invention claimed).

Next, Appellants contend that the Examiner’s construction of the term “adjacent” is overly broad when applied to Otsuka as disclosing “adjacent” lines as claimed. Appeal Br. 6. In response, the Examiner points out that Appellants’ Specification does not describe the scratched lines as “adjacent” and, otherwise, provides no guidance as to the meaning of the term that would prohibit the Examiner’s interpretation. Ans. 9. The Examiner notes that Otsuka teaches score lines being as close as 1 mm apart. *Id.* According

to the Examiner, this meets the scope of being adjacent in accordance with a broad but reasonable construction of being “close to” or “lying near.” *Id.*

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Under the appropriate standard, claim terms are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). In the absence of guidance in the Specification as to the meaning of a term, we apply a broad interpretation. *See In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Appellants have not brought any language from the Specification to our attention that would warrant interpreting “adjacent” in a manner that excludes the 1 mm spacing taught by Otsuka. The Examiner’s position is supported by a broad, but reasonable, construction of “adjacent.”

Next, Appellants argue that the Examiner’s proposed combination lacks a reasonable expectation of success. Appeal Br. 8. The obviousness inquiry requires a determination that “a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.” *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1360 (Fed. Cir. 2012). “The presence or absence of a motivation to combine references in an obviousness determination is a [] question of fact.” *See Par Pharm., Inc. v. TWI Pharm., Inc.*, 773 F.3d 1186, 1196 (Fed. Cir. 2014). “The reasonable expectation of success requirement refers to the likelihood of success in combining

references to meet the limitations of the claimed invention.” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016). In other words, “one must have a motivation to combine accompanied by a reasonable expectation of achieving what is claimed.” *Id.*

We are not persuaded by Appellants’ expectation of success argument. Appellants’ argument is predicated on a hypothetical embodiment using a slitter that differs from the Examiner’s proposed combination of Littman and Otsuka. Littman indicates that a person of ordinary skill in the art would expect to achieve success by forming score lines by roughening with sand paper, wire brush, or an embossing roll. *See* Littman, col. 5, ll. 32–33 (“surface roughening in-line on a roto press”); ll. 47–52 (“sand paper”).

Finally, Appellants argue that a person of ordinary skill in the art would not be motivated to modify Littman by Otsuka because there is no deficiency evident in Littman that requires improvement. Appeal Br. 11. This argument is unpersuasive as it is well settled that the mere fact that a prior art reference may be complete does not prevent a person of ordinary skill in the art having a desire and motivation to improve it. *See Dystar Textilfarben GmbH & Co, v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006) (the desire to enhance commercial opportunities by improving a product or process is universal—and even commonsensical).

We have considered Appellants’ other arguments and find them to be without merit. Accordingly, we sustain the rejection of claims 2–13, 15, and 21–24.

Claim 25

Claim 25 depends from claim 2 and adds the limitation: “wherein the multitude of adjacent scratched lines form only a single tear location.”

Claims App. Appellants argue that Otsuka’s score line segments extend the entire length of the film. Appeal Br. 11. Appellants argue that Otsuka’s score lines do not create a single tear location. *Id.*

Littman discloses a roughened area 120. Littman, Fig. 13, col. 8, ll. 40–58. This constitutes a “single tear location” within the meaning of claim 25. Under the circumstances, we fail to understand how Appellants’ claimed invention is patentably distinguishable over the prior art.

We sustain the Examiner’s rejection of claim 25.

Unpatentability of Claims 14 and 16

Claims 14 and 16 depend from claim 2. Claims App. Appellants do not argue for the separate patentability of claims 14 and 16 apart from arguments presented with respect to claim 2 which we have previously considered and found unpersuasive. *See* 37 C.F.R. §41.37(c)(1)(iv). Appellants have waived the right to argue these claims separately and we, therefore, sustain the rejection of claims 14 and 16.

DECISION

The decision of the Examiner to reject claims 2–16 and 21–25 as unpatentable under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED