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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HEINZ PUDLEINER, KLAUS MEYER, JOERG NICKEL, and
HANS BRAUN

Appeal 2015-002679
Application 12/481,162
Technology Center 1700

Before ADRIENE LEPIANE HANLON, N. WHITNEY WILSON, and
JENNIFER R. GUPTA, *Administrative Patent Judges*.

WILSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's April 8, 2014 decision finally rejecting claims 1–14 (“Final Act”). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify the Real Party in Interest as Bayer MaterialScience AG (Br. 2).

CLAIMED SUBJECT MATTER

Appellants' invention is directed to a film structure which may be used in connection with liquid crystal screens (Abstract). The claimed film structure includes at least one prism and/or diffuser film, and a multilayer optical film (*id.*). The outer layer of the optical film (which is directed at the prism/diffuser film) contains a transparent thermoplastic and a quaternary ammonium salt of perfluoroalkylsulfonic acid as a lubricant additive (*id.*). Details of the claimed invention are set forth in representative claim 1, which is reproduced below from the Claims Appendix of the Appeal Brief:

1. A film structure comprising at least one prism film and/or diffuser film and a multilayer optical film, wherein said multilayer optical film comprises at least one top film having an outer layer which is directed towards said at least one prism film and/or diffuser film and is prepared from a plastics composition comprising a transparent thermoplastic and at least one quaternary ammonium salt of a perfluoroalkylsulfonic acid as lubricant additive, wherein said outer layer has at least one coefficient of sliding friction of less than 0.30 relative to said at least one prism film and/or diffuser film measured in accordance with ASTM D 1894-06, with a roughness R3z of greater than 5 μm measured in accordance with ISO 4288.

REJECTIONS

I. Claims 1–14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen² in view of Pudleiner³ and Savu.⁴

II. Claims 1–14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Dobler,⁵ Pudleiner, and Savu.

DISCUSSION

Appellants do not offer separate arguments with respect to any individual claim (*see generally* Br. 5–12). Nor do Appellants offer separate arguments with regards to Rejections I and II. Accordingly, our discussion will focus on the rejection of claim 1 over Allen in view of Pudleiner and Savu.

The Examiner finds that Allen discloses each element of claim 1, except that Allen does not disclose the presence of a quaternary ammonium salt of a perfluoroalkylsulfonic acid (Final Act. 3, citing Allen, Abstract, 20:63–21:14, 23:15–63). The Examiner further finds that Pudleiner discloses a thermoplastic composition for diffusers of flat screens which comprises polycarbonate (a transparent thermoplastic) and 2 wt% of a quaternary ammonium salt of a perfluoroalkylsulfonic acid (Final Act. 3–4, citing Pudleiner ¶¶ 79–81). The Examiner also finds that Savu teaches that

² Allen et al., U.S. Patent No. 6,760,157 B1, issued July 6, 2004.

³ Pudleiner et al., U.S. Patent Pub. 2007/0054983 A1, published March 8, 2007.

⁴ Savu, *Fluorine-Containing Polymers, Perfluoroalkanesulfonic Acids*, Kirk-Othmer Encyclopedia of Chemical Technology 1–7 (2000).

⁵ Dobler et al., U.S. Patent Pub. 2003/0139503 A1, published July 24, 2003.

perfluoroalkylsulfonic acids behave as surface active agents which provide antistatic properties as well as the claimed slip properties (Final Act. 4, citing *Savu*, p. 3). The Examiner determines that it would have been obvious to use the materials of Pudleiner in the surface coating of Allen to provide Allen's coating with antistatic properties, which would also provide the claimed slip properties (Final Act. 4–5).

With regards to the claimed coefficient of sliding friction and roughness, the Examiner finds that the masterbatch disclosed in Example 2 of Pudleiner is essentially the same as the masterbatch shown in Example 1 of the application on appeal, and that the Specification describes using the same process as Pudleiner for forming a textured surface (Ans. 7–8). Therefore, according to the Examiner, the burden is on Appellants to demonstrate that the proposed combination of Allen and Pudleiner would not have the claimed roughness and coefficient of sliding friction (Ans. 8, citing *In re Spada*, 911 F.2d 705, 709 (Fed. Cir. 1990)).⁶

Appellants make two basic arguments seeking reversal of the rejections. First, Appellants contend that it is improper for the Examiner to rely on an inherency theory as part of an obviousness rejection (Br. 8). However, as correctly noted by the Examiner (Ans. 8), the question of obviousness is “based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently” *In re Zurko*, 258 F.3d 1379, 1383–84 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999);

⁶ The Examiner also states that the proposed combination of Pudleiner and Allen would inherently have the claimed roughness and coefficient of sliding friction (Final Act. 4–5; Ans. 7–9).

In re Napier, 55 F.3d 610, 613 (Fed. Cir. 1995)). Thus, the Examiner's reliance on a theory of inherency in an obviousness rejection is not grounds for reversal.

Second, Appellants argue that the Examiner provides no evidence that the proposed combination of Allen and Pudleiner would have had the claimed roughness and coefficient of sliding friction (Br. 8–10). However, as noted above, the Examiner found that the specific materials described in the Specification of the application on appeal were also used in Pudleiner. The Examiner has, therefore, provided a sound basis for believing that the film structure resulting from the proposed combination of Allen and Pudleiner would have the claimed properties. Thus, the burden is properly shifted to Appellants to demonstrate that the proposed combination would not have the claimed properties. *See, e.g., In re Spada*, 911 F.2d at 708; *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). In this instance, Appellants have not met this burden, or even addressed the Examiner's specific findings with regards to the similarities between the examples in Pudleiner and the instant Specification.

Thus, we determine that Appellants have not shown reversible error in the rejections.

CONCLUSION

We AFFIRM the rejection of claims 1–14 under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Pudleiner and Savu.

We AFFIRM the rejection of claims 1–14 under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Dobler, Pudleiner, and Savu.

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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