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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS W. BECKER

Appeal 2018-005170
Application 14/109,288
Technology Center 1700

Before LINDA M. GAUDETTE, MARK NAGUMO, and
MERRELL C. CASHION, JR., *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL¹

The Appellant² appeals under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 1–11 and 13–20.³

We AFFIRM.

¹ This Decision includes citations to the following documents: Specification filed Dec. 17, 2013 (“Spec.”); Final Office Action dated May 22, 2017 (“Final”); Appeal Brief filed Oct. 16, 2017 (“Appeal Br.”); Examiner’s Answer dated Feb. 23, 2018 (“Ans.”); and Reply Brief filed Apr. 20, 2018 (“Reply Br.”).

² We use the word “Appellant” to refer to the “Applicant” as defined in 37 C.F.R. § 1.42(a). The Appellant identifies the real party in interest as ImageWorks Interactive. Appeal Br. 2.

³ We have jurisdiction under 35 U.S.C. § 6(b).

CLAIMED SUBJECT MATTER

“Th[e] invention relates generally to molded products and more particularly to a full graphics in-mold label[.]” Spec.1:20–21. The Specification discloses that “[i]n-mold labeling involves the application of decorative labels during the molding process of plastic products. . . . For proper adhesion, the in-mold label, which includes a substrate, ink, and sometimes a coating, must contain similar properties to that of the plastic product.” *Id.* at 1:24–28. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An in-mold label consisting of:

a single-layer substrate having a first surface on one side of the substrate and a second surface on an opposite side of the substrate, wherein, when the in-mold label is molded on to, or into, a plastic product that is composed of styrene acrylonitrile (SANS), the first surface faces outward with respect to the plastic product to make contact with a molding tool and the second surface faces inward with respect to the plastic product, wherein the single-layer substrate is composed of one or more of styrene, SANS, and a styrene mix; and

a full graphics area located on the second surface where ink is applied to produce a full color or single color graphics image, wherein when the second surface is subjected to material used to produce the plastic product and the first surface is subjected to the molding tool, the full color or single color graphics image from the ink is molded onto the plastic product along with the substrate, in which the substrate and the ink have complementary property to a property of the plastic product.

REFERENCES

The Examiner relies on the following prior art as evidence of unpatentability:

Polhemus	US 5,205,444	Apr. 27, 1993
Balaji	US 6,726,969 B1	Apr. 27, 2004
Nishizawa	US 2007/0218227 A1	Sept. 20, 2007
Emond	US 2010/0052215 A1	Mar. 4, 2010

Ullman's Encyclopedia of Industrial Chemistry (Vol. 29. Polystyrene and Styrene Copolymers. Wiley Online Library. P. 487, "Ullman").

REJECTION

1. Claims 1–11 and 13–19 are rejected under 35 U.S.C. § 103(a) over Emond in view of Nishizawa, Balaji, and Polhemus.
2. Claim 20 is rejected under 35 U.S.C. § 103(a) over Emond in view of Nishizawa, Balaji, Polhemus, and Ullmann.

OPINION

The Examiner found that Emond discloses an in-mold label consisting of a single-layer substrate as recited in independent claims 1, 10, and 16, with the exceptions that Emond does not disclose explicitly that the markings on the label are applied as ink (*see* Emond ¶ 17 (“Such a label can provide the labeling, or markings for the container”)), and that the substrate is composed of one or more of styrene, SANS, and a styrene mix (*see id.* ¶ 29 (“Label 16 is formed of a plastic film.”)). Final 3–6, 8–10. The Examiner found that one of ordinary skill in the art would have applied Emond's markings using ink based on Nishizawa's use of ink to provide a graphic or marking to a plastic product. *Id.* at 5, 9 (citing Nishizawa ¶¶ 49, 86). The Examiner found that one of ordinary skill in the art would have made the label from SANS, based on Balaji's teaching that SANS is a common and suitable compound for an in-mold label in a heat seal layer. *Id.* at 6, 10 (citing Balaji 5:30–54, 10:24–43).

The Appellant’s arguments in support of patentability of the appealed claims are based on limitations common to claims 1 and 10. *See* Appeal Br. 10. The Appellant argues that Emond discloses graphics on a single-layer substrate surface that is intended to face outward when the substrate is applied to a plastic product, whereas the claims require graphics on the substrate surface that is intended to face inward with respect to the plastic product. Appeal Br. 7–8. The Appellant contends that the Examiner failed to explain sufficiently why the ordinary artisan would have looked to Nishizawa, as Nishizawa relates to a multi-layer label. *Id.* at 9. The Appellant further argues that the invention as recited in claim 1 would not result from the combined teachings of Emond and Nishizawa because in each of Nishizawa’s embodiments, the graphics are on the label surface facing outward from the product, and “Nishizawa fails to include any disclosure of applying ink to an inside label surface such that the label [sic, graphic] can be read through the label when the opposing surface faces outward.” *Id.*

We agree with the Examiner that these arguments are unpersuasive of reversible error for the reasons stated in the Answer. *See* Ans. 12–15. We add the following comments for completeness.

“Claims drawn to an apparatus must distinguish from the prior art in terms of structure rather than function.” *In re Danly*, 263 F.2d 844, 848 (CCPA 1959) (citations omitted). The independent claims recite an in-mold label consisting of a single-layer substrate that *may be* molded onto a SANS product. *See* claims 1, 10, 16 (“wherein, *when* the in-mold label is molded on to, or into,” a product composed of styrene acrylonitrile (emphasis

added)).⁴ Thus, although the Examiner identified prior art teachings or suggestions of the claim recitations relating to the use or function of the in-mold label, in the present case, it was necessary for the Examiner to provide only sufficient evidence and explanation to support a finding that the combination of Emond in view of Nishizawa, Balaji, and Polhemus would have resulted in an in-mold label that possessed the capability of performing the recited functions. *See Intel Corp. v. U.S. Int’l Trade Comm’n*, 946 F.2d 821, 832 (Fed. Cir. 1991). The Examiner has met this burden of proof, and the Appellant has not provided persuasive argument or evidence identifying reversible error in the Examiner’s fact finding and reasoning.

The Appellant’s arguments also are directed to features that are not recited in the claims. For example, the Appellant argues that the “label must . . . be non-opaque, so that the printed image can be seen through the label” and Emond’s embodiments utilize an opaque substrate. Reply Br. 3–4. The claims, however, do not include limitations relating to opacity, but require

⁴ We find no basis to interpret the preambles of claims 10 and 16—“A finished plastic product” and “A styrene acrylonitrile (SANS) article,” respectively—as limiting. “Preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim.” *In re Fought*, No. 2019-1127, 2019 WL 5687699, at *2 (Fed. Cir. Nov. 4, 2019) (internal citations and quotation marks omitted); *see also Boehringer Ingelheim Vetmedica v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003) (“An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.”). Moreover, even if the preambles were limiting, we find no support in the Specification—e.g., a definition of “finished plastic product” or “styrene acrylonitrile (SANS) article”—for a narrow construction of the preamble language as requiring that the in-mold label is molded on to or into the plastic form (claim 10) or the SANS cup or jar (claim 16). *See generally* Spec.

only that the “single-layer substrate is composed of one or more of styrene, SANS, and a styrene mix.” Claims 1, 10, 16. The Appellant does not contend that the Examiner erred in finding that one of ordinary skill in the art would have made the label from SANS, based on Balaji’s teaching that SANS is a common and suitable compound for an in-mold label. *See* Final 6, 10; Appeal Br. 10.

In sum, for the reasons stated in the Final Office Action, the Answer, and above, we are not convinced of reversible error in the Examiner’s conclusion of obviousness as to claims 1–11 and 13–20. Accordingly, we sustain both grounds of rejection.

CONCLUSION

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–11, 13–19	103(a)	Emond, Nishizawa, Balaji, Polhemus	1–11, 13–19	
20	103(a)	Emond, Nishizawa, Balaji, Polhemus, Ullmann	20	
Overall Outcome			1–11, 13–20	

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

AFFIRMED