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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for David A. Dellinger and examiner information for SHUKLA, KRUPA.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID A. DELLINGER, ELIE HELOU JR.,
DREW V. SPEER, and DWIGHT W. SCHWARK

Appeal 2018-008556
Application 13/740,025
Technology Center 1700

Before MICHAEL P. COLAIANNI, JEFFREY B. ROBERTSON, and
N. WHITNEY WILSON, *Administrative Patent Judges*.

WILSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s
September 14, 2017 decision rejecting claims 1–6, 8–12, and 24 (“Non-Final
Act.”).² We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We affirm.

¹ We use the word “Appellant” to refer to “applicant” as defined in
37 C.F.R. § 1.42. Appellant identifies Chamness Biodegradables, LLC, as
the real party in interest (Appeal Br. 2).

² Claims 13–23 and 25 were previously withdrawn from consideration.

CLAIMED SUBJECT MATTER

Appellant's disclosure relates to a moisture barrier coating that is biodegradable and compostable, which are said to increase moisture resistance and provide non-stick or release characteristics when applied to biodegradable and compostable disposable food packaging and food service items (Abstract). The coating includes a cellulose ester, a shellac, and a rosin (*id.*). Claims 1 and 24 are representative of the invention and is reproduced below from the Claims Appendix to the Appeal Brief:

1. A coating on a substrate comprising:

a cellulose ester of 40-65%,

a shellac of 25-45%; and

a rosin of 10-20%, wherein the cellulose ester comprises cellulose acetate propionate, cellulose acetate butyrate, cellulose acetate, or nitrocellulose.

24. A coating for application to a substrate comprising a cellulose ester of 40-65%, a shellac of 25-45%, a rosin of 10-20%, and a solvent, and optionally a wax, a plasticizer, or a release agent, wherein the cellulose ester comprises cellulose acetate propionate, cellulose acetate butyrate, cellulose acetate, or nitrocellulose, and the solvent comprises methyl acetate, ethyl acetate, propyl acetate, butyl acetate, ethanol, propanol, acetone, water, or hydrocarbons.

REJECTIONS

1. Claims 1, 2, 9–12, and 24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dellinger³ in view of Ando⁴ and Nakano.⁵

2. Claims 3–6 and 8 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dellinger in view of Ando and Nakano, and further in view of Battersby.⁶

Claims 13, 14, 18, 19, 21–23, and 25 were rejected on the grounds of non-statutory obviousness-type double patenting over claims 1–16 and 19–28 of US Patent No. 8,563,140. Because the claims subject to the obviousness-type double patenting rejection have been withdrawn from consideration (*see* Non-Final Act. 1), we believe that this rejection is not appealed, which is consistent with Appellant’s Appeal Brief which does not address the obviousness-type double patenting rejection, and the “Grounds of Rejection to be Reviewed on Appeal” section of the Reply Brief, which does not list the obviousness-type double patenting rejection.

DISCUSSION

Appellant does not argue any of the claims separately (*see, e.g.*, Appeal Br. 20, 22, and 25). Accordingly, we focus our analysis on the

³ Dellinger et al., US 2010/0203348 A1, published August 12, 2010.

⁴ Ando et al., JP 07-010148 A, published January 13, 1995. Because Ando is in Japanese, Appellant and the Examiner (and the Board) rely on the translation of record.

⁵ Nakano et al., JP 2004142426 A, published May 20, 2004. Because Nakano is in Japanese, Appellant and the Examiner (and the Board) rely on the translation of record.

⁶ Battersby et al., WO 2011/025858 A1, published March 3, 2011.

rejection of claim 1 over Dellinger in view of Ando and Nakano. The remaining claims stand or fall with claim 1.

The Examiner finds that Dellinger discloses a moisture resistant coating comprising a cellulose ester⁷, a wax, a plasticizer, and a rosin (Non-Final Act. 4, citing Dellinger, ¶¶ 23, 29, 32, and claim 1). The Examiner further finds that Dellinger discloses in one embodiment a coating comprising 65% of a cellulose ester and 20% of a rosin, each a value falling within the claimed ranges (Non-Final Act. 4, citing Dellinger, p. 5, Table 1, Sample 6).

The Examiner also finds that Dellinger does not teach that its coating contains a shellac, but that Ando discloses a water-proof and biodegradable resin layer which comprises shellac and a natural rosin (Non-Final Act. 4–5, citing Ando, Abstract, ¶ 8). The Examiner determines that it would have been obvious to incorporate Ando’s shellac into Dellinger’s coating to improve its waterproofness and biodegradability (Non-Final Act. 5).

With respect to the limitation that shellac is present in an amount of 25–45%, the Examiner finds that Nakano discloses a biodegradable water-proofing layer comprising a shellac resin, a hardener, a wax, a cellulose derivative, a filler, a plasticizer and a water repellent (Non-Final Act. 5, citing Nakano, Abstract, ¶¶ 8, 9). The Examiner further finds that Nakano teaches that the shellac resin is present in an amount from 23 wt% to 95.6 wt% (Non-Final Act. 5–6). The Examiner determines that in light of

⁷ In particular, the Examiner finds that Dellinger discloses the use of cellulose acetate, which is one of the cellulose esters recited in claim 1 (Non-Final Act. 4, citing Dellinger, claim 2).

the overlap in the range of shellac in Nakano and the coating of claim 1, the claimed amount of 25%–45% would have been obvious.

Appellant makes several arguments urging reversal of the rejection. First, Appellant argues that because the specific examples in Dellinger relied on by the Examiner as showing the use of 65% cellulose acetate also includes 15% of other components (in addition to rosin), the maximum amount of shellac which could be added in to the composition is less than the claimed 25%–40% (Appeal Br. 15). This argument is not persuasive because, as found by the Examiner, the specific example cited in the rejection is only used to show the presence of 65% cellulose ester (Ans. 10). The Examiner also finds that Dellinger specifically teaches the presence of 0–50% of rosin, a range which overlaps with, and therefore renders obvious – the claimed range of 10%–20% rosin (Ans. 10). It is axiomatic that a reference may be used for all it teaches, and is not limited to the teachings of specific examples.

Appellant also argues that Nakano does not teach the use of shellac, but only the use of a shellac resin derivative (Appeal Br. 17–18). This argument is not persuasive because the Examiner relies on Ando for the suggestion to include shellac in Dellinger's composition (Ans. 11).

Appellant further argues that because all of Nakano's examples show the use of a shellac derivative in amounts greater than 50%, it cannot suggest the claimed range of 25%–45% and, in fact, teaches away from such a range (Appeal Br. 18–19). This argument is not persuasive because, *inter alia*, the Examiner's findings that Nakano's disclosure teaches a range of 23 wt% to 95.6 wt% were not challenged by Appellant. Appellant merely argued that

Nakano's disclosed range was so broad that it could not have rendered the claim range obvious (Appeal Br. 19). This argument is not persuasive. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456 (CCPA 1955). A prima facie case of obviousness exists in situations where the claimed ranges overlap the ranges disclosed by the prior art. *See In re Geisler*, 116 F.3d 1465, 1469 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990).

Appellant also seeks to rely on data in the Specification to show that the claimed amounts of the components produces unexpected advantages (Appeal Br. 20). This showing is not persuasive because, inter alia, the showing is not commensurate in scope with the claims. It is well settled that Appellant has the burden of showing unexpected results. *In re Freeman*, 474 F.2d 1318, 1324 (CCPA 1973); *In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972). Such burden requires Appellant to proffer factual evidence that actually shows unexpected results relative to the closest prior art, *see In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991), and that is reasonably commensurate in scope with the protection sought by the claim on appeal, *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035 (CCPA 1980); *In re Hyson*, 453 F.2d 764, 786 (CCPA 1972). The extent of the showing relied upon by Appellant must reasonably support the entire scope of the claims at issue. *See In re Harris*, 409 F.3d 1339, 1344 (Fed. Cir. 2005). As explained by the Examiner (Ans. 12), the data relied on by Appellant is limited to a specific cellulose ester, a specific shellac and rosin, but claims are not limited to that

specific shellac or cellulose ester. Hence, the showing is not commensurate in scope with the claims and is not persuasive of patentability.

Appellant also argues that the use of the three claimed components produces synergistic results as compared to the individual components, which could not have been predicted from the prior art (Appeal Br. 21–23). This argument is not persuasive because, although the Cobb⁸ values of compositions falling within the scope of the claims are lower than the Cobb values of the individual components, Appellant has not adequately demonstrated through factual evidence that the effects are synergistic, rather than merely additive. In addition, the data is not commensurate in scope with the claims (because, as discussed above, data relied on by Appellant is limited to a specific cellulose ester, a specific shellac and rosin, but claims are not limited to that specific shellac or cellulose ester) and, thus, does not show the criticality of the claimed ranges.

Accordingly, the preponderance of the evidence of record supports the obviousness rejections.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
1, 2, 9–12, and 24	§ 103(a) Dellinger, Ando, and Nakano	1, 2, 9–12, and 24	

⁸ A Cobb test is a standard test to measure water absorption of paper and paperboard (Spec. ¶ 33).

Appeal 2018-008556
Application 13/740,025

Claims Rejected	Basis	Affirmed	Reversed
3-6 and 8	§ 103(a) Dellinger, Ando, Nakano, and Battersby	3-6 and 8	
Overall Outcome		1-6, 8-12, and 24	

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