



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/054,278	10/15/2013	Eric Fresnel	6758-0016	6435
35301	7590	11/26/2019	EXAMINER	
MCCORMICK, PAULDING & HUBER LLP			FIGG, LAURA B	
CITY PLACE II			ART UNIT	
185 ASYLUM STREET			PAPER NUMBER	
HARTFORD, CT 06103			1781	
			NOTIFICATION DATE	
			DELIVERY MODE	
			11/26/2019	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@ip-lawyers.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERIC FRESNEL

Appeal 2019-000416
Application 14/054,278
Technology Center 1700

Before JAMES C. HOUSEL, CHRISTOPHER C. KENNEDY, and
LILAN REN, *Administrative Patent Judges*.

REN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The record on appeal includes the Specification of October 15, 2013 (“Spec.”), the Examiner’s Non-Final Action of September 21, 2017 (“Non-Final Act.”), Appeal Brief of August 27, 2018 (“Appeal Br.”), the Examiner’s Answer of September 10, 2018 (“Ans.”), and the Reply Brief of October 18, 2018 (“Reply Br.”).

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the Examiner's decision to reject claims 1 and 3–20. Non-Final Act. 3, 7.³ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

The claims are directed to a multilayer heat-shrink plastics material film. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A multilayer heat-shrink film, characterized in that it comprises:
 - a central first layer made up of a first composition comprising at least one polyolefin;
 - intermediate second layers made up of a second composition and covering respective faces of the first layer, the second composition comprising a styrene-based resin, the resin of the second composition comprising at least one thermoplastic elastomer based on a styrene-butadiene block copolymer; and
 - outer third layers made up of a third composition and covering respective ones of the intermediate second layers, the third composition comprising at least one polyester.

Claims Appendix (Appeal Br. 14).

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

³ The record reflects at least Non-Final Rejections of August 14, 2014 and of January 20, 2016, respectively, as well as Final Rejections of August 16, 2015 and of October 6, 2016, respectively.

the Non-Final Office Action and the Answer. We add the following primarily for emphasis.

The Examiner rejects claim 1⁵ under 35 U.S.C. § 103(a) (pre-AIA) based on Frauenhofer. Non-Final Act. 3. More specifically, the Examiner finds that Frauenhofer teaches a heat-shrink multilayer film with a core polyolefin layer, a polyester skin layer, and a styrene block copolymer tie layer. Non-Final Act. 3 (citing various portions of Frauenhofer). The Examiner finds that Frauenhofer teaches a butadiene based copolymer as the second block of the tie layer. *Id.* (citing Frauenhofer ¶ 37). The Examiner further finds that Frauenhofer “teaches an explicit 5 layer embodiment of the pattern skin/tie/core/tie/skin[.]” *Id.* (citing Frauenhofer ¶ 17).

⁵ Appellant does not present separate arguments for the obviousness rejections of claims 3–20. *See, e.g.*, Appeal Br. 9–13. The obviousness rejections of claims 3–20 therefore stands or falls with that of claim 1. *See id.*; *see also* 37 C.F.R. § 41.37(c)(1)(iv). Appellant raises, for the first time, arguments for the rejection of claim 20 in the Reply Brief. *Compare* Reply Br. 6 (arguing that the Examiner erred for stating “at page 6 of the Answer” that “claim 20 is unpatentable over Frauenhofer because the claim ‘requires one polyester’”), *with* Non-Final Act. 6 (providing an analysis of the rejection of claim 20) and Ans. 6 (repeating the same analysis).

An argument raised for the first time in a Reply Brief can be considered waived if Appellant does not explain why it could not have been raised previously. *See Ex parte Nakashima*, 93 USPQ2d 1834 (BPAI 2010) (informative) (explaining that arguments and evidence not timely presented in the principal Brief will not be considered when filed in a Reply Brief, absent a showing of good cause explaining why the argument could not have been presented in the Principal Brief); *Ex parte Borden*, 93 USPQ2d 1473, 1477 (BPAI 2010) (informative) (“Properly interpreted, the Rules do not require the Board to take up a belated argument that has not been addressed by the Examiner, absent a showing of good cause.”). In this case, the Reply Brief lacks such an explanation and we decline to consider these arguments.

Appellant does not dispute the Examiner's findings but argues instead that "to derive Applicant's claimed film from the disclosure of Fraunhofer, the Examiner must make seven selections and choose one particular composition among at least 1500 possibilities." Appeal Br. 9. According to Appellant, the "at least 1500 possibilities" are necessitated by seven steps of selecting various components, i.e., from "[f]irst, one must select a solvent sealable material for the skin layer from the two possibilities" to "[s]eventh, one must choose butadiene as the block B of the styrenic block copolymer from the five disclosed in Paragraph [0037]." *Id.*

Claim 1, a composition claim, does not recite the seven-step process described by Appellant which starts with first selecting a skin layer and ends with selecting the butadiene copolymer tie layer. Appellant's argument does not structurally distinguish the prior art composition, and is instead directed to elements (i.e., the sequential steps of "[f]irst, one must select" ending with a seventh step) not recited in claim 1. We are accordingly not persuaded that reversible error has been identified. *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) (holding that unclaimed features cannot impart patentability to claims).

Moreover, we note that "disclos[ing] a multitude of effective combinations does not render any particular formulation less obvious. This is especially true because the claimed composition is used for the identical purpose taught by the prior art." *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989). In this case, similar to Fraunhofer which "is directed to films, . . . , and most particularly, shrink sleeve films that are ideal for use with highly contoured containers such as, for example, shampoo and detergent bottles, and drink containers" (Fraunhofer ¶ 15),

claim 1 “relates to . . . a film adapted to making heat-shrink sleeves for covering articles made of polyethylene terephthalate (PET), such as bottles.” Spec. ¶ 1. Appellant’s argument is therefore unpersuasive of patentability. *See Merck*, 874 F.2d at 807.

Appellant also argues that the file history of Frauenhofer teaches away from claim 1 “in which the outer skin layer is a polyester and the intermediate layer is a styrene-butadiene block copolymer” because the file history “enables only films in which the tie and skin layers are either both styrene-butadiene copolymers or both polyolefins.” Appeal Br. 10. To the extent that Appellant’s argument is that Frauenhofer is a non-enabling reference, “a prior art printed publication cited by an examiner is presumptively enabling barring any showing to the contrary by a patent applicant.” *In re Antor Media Corp.*, 689 F.3d 1282, 1288 (Fed. Cir. 2012). The record before us lacks such a showing and we are not persuaded that Frauenhofer is not an enabling reference.

To the extent that Appellant’s argument is that Frauenhofer teaches away because it does not disclose the specific composition recited in claim 1, “[u]nder the proper legal standard, a reference will teach away when it suggests that the developments flowing from its disclosures are unlikely to produce the objective of the applicant’s invention.” *Syntex (U.S.A.) LLC v. Apotex, Inc.*, 407 F.3d 1371, 1380 (Fed. Cir. 2005). The record before us does not show such a suggestion in Frauenhofer – and Appellant does not argue so. We are therefore not persuaded that Frauenhofer teaches away from the Examiner’s undisputed findings in support of the rejection.

We are also not persuaded by Appellant’s argument that Song – a reference not used as basis for the rejection – teaches away from the claims. Appellant argues that Song states that “polyester containing skin layers generally suffer from poor interlayer adhesion to adjacent tie layers and functional layers of dissimilar materials such as polyolefin based polymers” which teaches away from the recited composition having dissimilar materials in the respective layers. Song ¶ 11 (cited in Appeal Br. 11–12); Appeal Br. 11–12.

“[I]n general, a reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Given that Song is not a reference cited in support of the rejection, its disclosure does not teach away from the claim. Moreover, as the Examiner points out, Song “directly teaches the reason one would select a styrene-butadiene copolymer tie layer between polyolefins and polyesters” (Ans. 11) which is consistent with the teaching of Fraunhofer. Appellant does not dispute the Examiner’s finding that Song teaches such a reason but only argues that “Song does not teach styrene-butadiene copolymers are among the preferred polymers for adhesion between polyolefins and polyesters.” Reply Br. 5–6. Appellant’s argument identifies no reversible error in the Examiner’s finding with regard to Fraunhofer which forms the basis of the rejection.

CONCLUSION

The Examiner’s rejection is affirmed.

More specifically,

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1, 3–6, and 20	pre-AIA 35 U.S.C. § 103(a)	Frauenhofer	1, 3–6, and 20	
7, 8	pre-AIA 35 U.S.C. § 103(a)	Frauenhofer, Kwack, Godfrey, Kurian	7, 8	
Overall Outcome			1, 3–20	

FINALITY AND RESPONSE

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