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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/575,768	07/27/2012	Detlef Hütt	074004-0186-US (286049)	9530
123223	7590	11/27/2019	EXAMINER	
Drinker Biddle & Reath LLP (WM) 222 Delaware Avenue, Ste. 1410 Wilmington, DE 19801-1621			PLESZCZYNSKA, JOANNA	
			ART UNIT	PAPER NUMBER
			1783	
			NOTIFICATION DATE	DELIVERY MODE
			11/27/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DETLEF HÜTT

Appeal 2019-002721
Application 13/575,768
Technology Center 1700

Before BEVERLY A. FRANKLIN, N. WHITNEY WILSON, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner’s decision to reject claims 15, 17, 18, 21–24, and 31–35. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ 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 Treofan Germany GmbH & Co. KG. Appeal Br. 2.

CLAIMED SUBJECT MATTER

Claim 15 is illustrative of Appellant's subject matter on appeal and is set forth below:

15. A transparent, multilayer, biaxially oriented polyolefin film comprising a base layer and at least one matt outer cover layer, wherein the outer cover layer consists essentially of two incompatible polymers and a polydialkyl siloxane with a viscosity from 150,000 to 400,000 mm²/s and has a surface roughness of at least 2.0 μm with a cut-off of 25 μm, and the surface of the matt outer cover layer has undergone corona surface treatment and wherein the surface tension of the surface of the outer cover layer is 37 to 50 mN/m after corona treatment and the mixture of incompatible polymers consists essentially of a propylene polymer and polyethylene polymer which is an MDPE.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Murschall '704	US 5,364,704	Nov. 15, 1994
Murschall '820	US 5,474,820	Dec. 12, 1995
Cretecos	US 6,472,077 B1	Oct. 29, 2002
Ambroise	US 2004/0023052 A1	Feb. 5, 2004

REJECTIONS

1. Claims 15, 17, 18, 21, 22, 24, and 31–35 are rejected under preAIA 35 U.S.C. § 103(a) as being unpatentable over Murschall '820 in view of Murschall '704 and Ambroise.
2. Claim 23 is rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Murschall '820 in view of Murschall '704 and Ambroise, and further in view of Cretecos.

OPINION

Upon consideration of the evidence and each of the respective positions set forth in the record, we find that the preponderance of evidence of record supports Appellant's position. We thus reverse the Examiner's decision to reject the appealed claims essentially for the reasons provided by Appellant, and add the following for emphasis, in which we focus on the dispositive issue in this case involving the claim element of the polyethylene polymer being an MDPE.

Appellant's claim 15 requires, *inter alia*, that the polyethylene polymer is an MDPE, as Appellant discusses on pages 15–16 of the Appeal Brief. Therein, Appellant argues that this feature is not mentioned in the description of the invention of Murschall '820. Appellant explains that although Murschall '820 mentions MDPE and HDPE in the background art, Murschall '820 does not mention the use of MDPE in making its subject invention. Appeal Br. 16. Appellant argues that Murschall '820 relates to tertiary mixtures of incompatible polymers, namely highly crystalline iPP homopolymer, highly crystalline polyethylene (PE) (high density polyethylene (HDPE)), and at best semicrystalline copolymer or terpolymer. Appeal Br. 15.

Appellant also argues that Murschall '704 similarly mentions MDPE and HDPE in the background art (as in Murschall '820), but Murschall '704 does not mention the use of MDPE in the description of its invention. Appeal Br. 16–17.

Appellant thus submits that Murschall '820 and Murschall '704 teach the importance of using HDPE in the composition of the respective

inventions. Appeal Br. 17. Appellant also submits that therefore MDPE and HDPE are not recognized as equivalent in such compositions. Appeal Br. 16.

On the other hand, it is the Examiner's position that the Ambroise reference indicates that HDPE and MDPE are interchangeable in multilayered thermoplastic oriented films. Ans. 4, 5, and 11. However, we find that the preponderance of evidence supports Appellant's position in the record. We agree with Appellant, for the reasons stated in the record, that Murschall '820 and Murschall '704 indicate, at least for the purposes of the respective inventions therein, that MDPE is not used, whereas HDPE is used, and thus not interchangeable, contrary to the Examiner's stated position. As such, there is no apparent reason to employ MDPE in place of HDPE as proposed by the Examiner. Setting forth a *prima facie* case of obviousness requires establishing that the applied prior art would have provided one of ordinary skill in the art with an apparent reason to modify the prior art to arrive at the claimed invention. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). "[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention." *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015).

On this record, the Examiner's proposed modification appears to be premised on an impermissible use of hindsight after review of Appellants' disclosure rather than on a supported reason to modify

Murschall '820 available to an ordinarily skilled artisan at the time of the invention and consistent with the teachings thereof. *KSR*, 550 U.S. at 421 (The fact finder must be aware “of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning”; citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (warning against a “temptation to read into the prior art the teachings of the invention in issue”)).

In view of the above, we reverse Rejection 1. We also reverse Rejection 2 as the Examiner does not rely upon the additional reference to cure the stated deficiencies of the combination applied in Rejection 1.

CONCLUSION

We reverse the Examiner’s decision.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
15, 17, 18, 21, 22, 24, 31–35	103(a)	Murschall '820, Murschall '704, Ambroise		15, 17, 18, 21, 22, 24, 31–35
23	103(a)	Murschall '820, Murschall '704, Ambroise, Cretekos		23
Overall Outcome				15, 17, 18, 21–24, 31–35

REVERSED