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3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			WATKINS III, WILLIAM P	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID F. SLAMA,
GARTH V. ANTILA, STEVEN J. FLANAGAN,
BRENT R. HANSEN, and THOMAS P. HANSCHEN

Appeal 2019–004791
Application 14/772,094
Technology Center 1700

Before KAREN M. HASTINGS, MICHAEL P. COLAIANNI, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

DENNETT, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the Examiner’s decision to reject claims 1–13 of Application 14/772,094. *See* Non-Final Act. 1; Appeal Br. 2. We have jurisdiction under 35 U.S.C. § 6.

¹ In our Decision, we refer to the Specification filed September 2, 2015 (“Spec.”) of Application 14/772,094 (“the ’094 Application”); the Non-Final Office Action dated February 23, 2018 (“Non-Final Act.”); the Appeal Brief filed July 23, 2018 (“Appeal Br.”); and the Examiner’s Answer dated January 7, 2019 (“Ans.”).

² We use the word “Appellant” to refer to “Applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies 3M Company as the real party in interest. Appeal Br. 2.

For the reasons set forth below, we AFFIRM.

BACKGROUND

The '094 Application relates to perforated films, which have applications in the personal hygiene field, the food packaging industry, and in acoustics absorption. Spec. ¶ 1. According to the '094 Application, conventional processes for manufacturing perforated films tend to have limited film thicknesses and/or hole sizes and densities. *Id.* ¶ 2. The '094 Application describes a perforated polymeric multilayer film having adjacent, yet separable, films. *Id.* ¶¶ 6, 8.

Claims 1 and 5 are representative of the '094 Application's claims and are reproduced below from the Claims Appendix of the Appeal Brief with key limitations emphasized.

1. A co-extruded polymeric multilayer film having first and second generally opposed major surfaces, *adjacent first and second layers that are separable from each other*, and an array of indentations extending into the first and second layers.
5. A co-extruded polymeric multilayer film having first and second generally opposed major surfaces, an array of openings extending between the first and second major surfaces, and *at least first and second adjacent layers that are separable from each other*, wherein the openings each have a series of areas through the openings from the first and second major surfaces ranging from minimum to maximum areas, and wherein the minimum area is not at[] least one of the major surface[s].

Appeal Br. 13 (Claims Appendix).

REFERENCES

The Examiner relies on the following prior art in rejecting the claims on appeal:

Name	Reference	Date
Arrington	US 2009/0288764 A1	Nov. 26, 2009
Scheibner	WO 2011/081894 A1	July 7, 2011

REJECTION

The Examiner maintains the rejection³ of claims 1–13 under 35 U.S.C. § 103(a) as unpatentable over Scheibner in view of Arrington. Non-Final Act. 3–4.

DISCUSSION

Ground 1: Rejection of claims 1–13 as obvious over Scheibner in view of Arrington

The Examiner determines that claims 1–13 would have been rendered obvious over Scheibner in view of Arrington. Non-Final Act. 3–4.

Appellant argues the claims as a group based on limitations recited in claims 1 and 5. Appeal Br. 9–11. We select claim 1 as representative. Claims 2–4 and 13 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

A. The claimed “adjacent first and second layers that are separable from each other,” as recited in claim 1

With respect to claim 1, the Examiner finds that Scheibner teaches, indenting a film, chilling the indented film, and then perforating the chilled film by applying heat to the indentations. Non-Final Act. 3. The Examiner

³ Because this application claims priority to an application filed after the March 16, 2013, effective date of the America Invents Act, we refer to the AIA version of the statute.

finds Scheibner teaches that the perforated polymeric film may comprise a polyolefin, such as polyethylene. *Id.*

The Examiner finds that Arrington teaches separating very thin films, which have been co-extruded. *Id.* The Examiner finds that one of Arrington’s thin film layers may be polypropylene, “with no restriction on the type of polymer in the main layer.” *Id.*

The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to have used Arrington’s separable films in Scheibner’s process in order to perforate very thin films, which can be separated. *Id.* The Examiner determines that it also would have been obvious to an ordinarily skilled artisan to have used Scheibner’s polyethylene first layer and Arrington’s polypropylene support layer in a multilayer film. *Id.* at 3–4.

Analysis of a rejection under § 103 requires, *inter alia*, consideration of whether the prior art would have suggested to a skilled artisan that he or she should make the claimed composition, i.e., is there motivation, and whether the prior art would have revealed that in so making, a skilled artisan would have had a reasonable expectation of success. *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006). These are questions of fact. *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1289 (Fed. Cir. 2006).

Appellant’s arguments are not persuasive of reversible error by the Examiner.

Appellant argues that the Examiner has provided insufficient evidence that one of ordinary skill in the art would have been motivated to combine Scheibner and Arrington. Appeal Br. 9.

The Examiner finds that one of ordinary skill in the art would have been motivated to implement Arrington’s co-extruded multiple thin layer films because co-extrusion simplifies the processing of Scheibner’s individual films. Non-Final Act. 4.

Evidence of a motivation to combine prior art references “may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved.” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000). We note Scheibner teaches that “an additional flat film (or secondary film) may be introduced between the support surface and the embossed polymeric film.” Scheibner 13. Although Scheibner describes the extrusion of the polymeric film, the secondary film is implicitly pre-manufactured in a separate step. *Id.* at 20. We agree with the Examiner that one of ordinary skill in the art would have been motivated to implement Arrington’s co-extrusion process for manufacturing multilayer films simultaneously to avoid difficulties in processing each film individually. *See* Non-Final Act. 4.

Appellant argues that Arrington “recognizes that there can be difficulty separating its film and assist layers.” Appeal Br. 10 (citing Arrington ¶ 150). Appellant asserts that adding an array of indentations and openings, which extend through two film layers, would have “enhance[d] the uncertainty of two layers of a polymeric multilayer film being separable.” Appeal Br. 10. According to Appellant, the Examiner has not established that one of ordinary skill in the art would have recognized that the proposed combination provides a reasonable expectation of success. *Id.* 10–11.

“[O]bviousness does not require absolute predictability of success . . . all that is required is a reasonable expectation of success.” *In re Kubin*, 561 F.3d 1351, 1360 (Fed. Cir. 2009) (citing *In re O’Farrell*, 853 F.2d 894, 903–04 (Fed. Cir. 1988)). Here, a skilled artisan would have had a reasonable expectation of success that Arrington’s multilayer films could be separated if subjected to Scheibner’s film treatments because Scheibner teaches embossing and perforating both a polymeric film and a secondary support film and, thereafter, separating the polymeric and secondary films. *See* Scheibner 13, 20.

Arrington, furthermore, explicitly describes several techniques to address delamination in the event that it occurs. Arrington ¶ 150 (teaching that undesirable delamination “can be solved” by reducing the interpenetration of two layers, adding a release agent or talc, etc.). Appellant does not specifically rebut the Examiner’s finding that the level of the skill in the art needed to adjust for the potential delamination problems described in Arrington is high. Appeal Br. 11. A person with a high level of skill in the art of multilayer polymeric films would have understood and weighed the tradeoff of potential delamination with the benefits. *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000) (“The fact that the motivating benefit comes at the expense of another benefit, . . . should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.”).

We agree with the Examiner that there is sufficient evidence of record that a skilled artisan would have been motivated to manufacture the claimed

co-extruded polymeric multilayer film with a reasonable expectation of success. *See* Ans. 5.

We sustain the rejection of claim 1 over Scheibner in view of Arrington. For the reasons given above, we also sustain the rejection of claims 2–4 and 13.

B. The claimed “at least first and second adjacent layers that are separable from each other,” as recited in claim 5

Claim 5 is an independent claim, rejected over the same combination of prior art as claim 1. *See* Non-Final Act. 3–4. Claims 6–12 stand or fall with claim 5. *See* 37 C.F.R. § 41.37(c)(1)(iv). Appellant’s arguments for patentability of claim 5 do not differ substantively from those made in support of patentability of claim 1. *See* Appeal Br. 10–11.

We sustain the rejection of claim 5 over Scheibner in view of Arrington. For the reasons given above, we also sustain the rejection of claims 6–12.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–13	103(a)	Scheibner, Arrington	1–13	

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