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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/651,797	06/12/2015	Igor ROMANO	3144-118	1541
6449	7590	06/02/2020	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 607 14TH STREET, N.W. SUITE 800 WASHINGTON, DC 20005			RODRIGUEZ, MICHAEL P	
			ART UNIT	PAPER NUMBER
			1715	
			NOTIFICATION DATE	DELIVERY MODE
			06/02/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte IGOR ROMANO

Appeal 2019-005074
Application 14/651,797
Technology Center 1700

Before JAMES C. HOUSEL, N. WHITNEY WILSON, and
MONTÉ T. SQUIRE, *Administrative Patent Judges*.

SQUIRE, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ In this Decision, we refer to the Specification filed June 12, 2015 (“Spec.”); Final Office Action dated May 30, 2018 (“Final Act.”); Advisory Action dated Oct. 22, 2018 (“Advisory Act.”); Appeal Brief filed Dec. 6, 2018, as corrected Jan. 24, 2019 (“Appeal Br.”); Examiner’s Answer dated Apr. 30, 2019 (“Ans.”); and Reply Brief filed June 13, 2019 (“Reply Brief”).

Appellant² appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 3, 5–12, and 20–22.³ We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on May 21, 2020.⁴

We REVERSE.

CLAIMED SUBJECT MATTER

The invention relates to a process for making a sheet for packaging foodstuff products. Spec. 1:1–6; Abstract. Claim 1 illustrates the subject matter on appeal and is reproduced below from the Claims Appendix to the Appeal Brief:

1. A process for making a package of a foodstuff product comprising the steps of:

- providing a sheet material having a first side and a second side opposite to one another; and

- providing on said first side a surface structure having an array of formations in relief such as to determine on said material a visual and tactile effect of roughness;

wherein said step of providing said array of formations in relief comprises application on said first side of a discontinuous coating and/or a coating having a variable thickness that forms said array of formations in relief, said coating being constituted of ***a paint containing mineral fillers, constituted by quartz and/or mica and/or silica***, and in that it comprises a step in which said sheet

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

³ Claims 2, 4, 13, 16, and 18 are cancelled and claims 14, 15, 17, 19, and 23 are withdrawn. Appeal Br. 3.

⁴ A written transcript of the oral hearing will be entered into the record when the transcript is made available.

material with said coating applied thereon is subjected to an operation of thermoforming, so as to undergo plastic deformation and assume the desired shape of the package or of a part of the package, or of heat-sealing, so as to close hermetically the foodstuff product inside it.

Appeal Br. 14 (key disputed claim language italicized and bolded).

REFERENCES

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

Name	Reference	Date
Milano	US 2008/0199570 A1	Aug. 21, 2008
Weiss et al. (“Weiss”)	US 2011/0000802 A1	Jan. 6, 2011
Glydon	US 2011/0278370 A1	Nov. 17, 2011
Toft et al. (“Toft”)	US 2012/0117921 A1	May 17, 2012

REJECTIONS

On appeal, the Examiner maintains (Ans. 3) the following rejections:

1. Claims 1, 3, 5–8, 10–12, and 20–22 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Weiss in view of Glydon and Milano (“Rejection 1”). Ans. 3–4.

2. Claim 9 is rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Weiss in view of Glydon and Milano as applied to claim 6, and further in view of Toft (“Rejection 2”). *Id.* at 5.

OPINION

Rejection 1

The Examiner rejects claims 1, 3, 5–8, 10–12, and 20–22 under § 103(a) as obvious over the combination of Weiss, Glydon, and Milano. Ans. 3–4.

The Examiner determines that the combination of Weiss, Glydon, and Milano suggests a method satisfying the steps of claim 1 and concludes the combination would have rendered the claim obvious. Ans. 3–4. Regarding the “mineral fillers, constituted by quartz and/or mica and/or silica” recitation of claim 1, the Examiner relies principally on Glydon for teaching that limitation of the claim. *Id.* at 3. The Examiner finds that Glydon is directed to the manufacture of packaging materials for consumable goods and teaches rotogravure application of coating materials having silica in order to confer aroma and flavor properties to the packaging to improve product appeal. *Id.* at 3–4 (citing Glydon, Abstract, ¶¶ 2, 3, 26, 48,105–107). In particular, paragraph 105 of Glydon teaches an embodiment wherein “the flavoring agent may be adsorbed onto silicas.” Based on Glydon’s teachings, the Examiner concludes

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the method of Weiss in the manufacture of confectionery product packaging, with the inclusion of silica in the coating material, in order to obtain packaged consumer goods with improved product appeal, as taught by Glydon.

Id. at 4.

Appellant argues the Examiner’s rejection should be reversed because one of ordinary skill in the art would not have combined the teachings of Weiss and Glydon to arrive at the claimed invention. Appeal Br. 4 (“**The**

combination of Weiss and Glydon is improper and does not teach the claimed invention”); *see also* Reply Br. 5 (“The combination relies on hindsight using the present disclosure as a roadmap, and is therefore improper.”). In particular, Appellant argues one of ordinary skill in the art would not have modified Weiss’s tinted varnish coating to include Glydon’s flavoring agent adsorbed onto silicas to serve as a mineral filler in a paint, as claimed. Appeal Br. 8 (arguing “silica with flavoring agents adsorbed onto it does not make such silica a mineral filler in a paint”).

The weight of the evidence supports Appellant’s argument. The Examiner has not established by a preponderance of the evidence of record that one of ordinary skill in the art would have combined the teachings of the cited art to arrive at Appellant’s claimed invention and would have had a reasonable expectation of success in doing so. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (holding that the examiner bears the initial burden of establishing a prima facie case of obviousness).

The Examiner does not direct us to persuasive evidence or provide an adequate technical explanation to evince why one of ordinary skill would have modified Weiss’s tinted varnish coating on the outer surface of its cigarette packaging to include Glydon’s flavoring agent adsorbed onto silicas as a mineral filler in paint. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (requiring “reasoning with some rational underpinning to support the legal conclusion of obviousness”) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Although paragraph 105 of Glydon describes a flavoring agent adsorbed onto silicas, there is no teaching or suggestion of such flavoring agents being suitable or used as “mineral fillers” in paint, as recited in the claim.

The Examiner also does not direct us to any teaching or suggestion in the prior art regarding the technical feasibility of Weiss's tinted varnish coating being modified to include a flavoring agent adsorbed onto silicas or adequately explain why one of ordinary skill in the art would have had a reasonable expectation of success in making such modification. Although Glydon discusses adding flavoring agents to confer aroma and flavor properties to its packaging to improve product appeal (Glydon ¶¶ 2, 3, 26), a preponderance of the evidence does not establish that modifying Weiss's tinted varnish coating to include Glydon's flavoring agents adsorbed onto silicas would be technically feasible and, even if feasible, whether such modification would negatively affect the structure and physical properties of Weiss's packaging or be detrimental to the packaging's product appeal. For example, the Examiner does not direct us to any teaching or suggestion in the prior art or provide any meaningful discussion as to how modifying Weiss's tinted varnish coating to include a flavoring agent adsorbed onto silicas would affect the tactile properties of Weiss's coating, which is an attribute Weiss teaches is required for its packaging. *See* Weiss ¶¶ 2, 4–6. Similarly, as Appellant suggests (Appeal Br. 8), the Examiner also does not adequately address or discuss how modifying Weiss's coating's composition to include flavoring agents adsorbed onto silicas would affect the pattern of raised features formed by applying Weiss's tinted varnish to the outer surface of the packaging which is an integral attribute of Weiss's tactile coating. *See* Weiss ¶¶ 7, 10, 12, 14, Fig. 1.

Thus, on the record before us, we are not persuaded that a preponderance of the evidence supports the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art to have combined

the teachings of Weiss and Glydon to arrive at the “mineral fillers, constituted by quartz and/or mica and/or silica” recitation of the claim.

Accordingly, we reverse the Examiner’s rejection of claims 1, 3, 5–8, 10–12, and 20–22 under pre-AIA 35 U.S.C. § 103(a) as obvious over the combination of Weiss, Glydon, and Milano.

Rejection 2

The Examiner’s rejects claim 9 under 35 U.S.C. § 103(a) as obvious over the combination of Weiss, Glydon, Milano, and Toft. Ans. 5. The foregoing deficiencies, however, in the Examiner’s analysis and conclusion regarding Rejection 1 and the combination of Weiss and Glydon are not remedied by the Examiner’s findings regarding the additional reference or combination of references cited in support of the second ground of rejection.

Accordingly, for principally the same reasons discussed above in reversing the Examiner’s Rejection 1, we reverse the Examiner’s rejection of claim 9 under 35 U.S.C. § 103(a) as obvious over the combination of Weiss, Glydon, Milano, and Toft.

CONCLUSION

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 3, 5–8, 10–12, 20–22	103(a)	Weiss, Glydon, Milano		1, 3, 5–8, 10–12, 20–22
9	103(a)	Weiss, Glydon, Milano, Toft		9
Overall Outcome				1, 3, 5–12, 20–22

REVERSED