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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TAKESHI IGARASHI, YASUNORI YAMAMOTO, and
NAO WAKAYAMA

Appeal 2019-005914
Application 14/611,502
Technology Center 1700

Before ERIC B. GRIMES, LINDA M. GAUDETTE, and LILAN REN,
Administrative Patent Judges.

REN, *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 1–8, 10–16, and 18–22. *See* Final Act.

2. We have jurisdiction 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 the real party in interest as “NITTO DENKO CORPORATION of Osaka, Japan.” Appeal Br. 3 (the Appeal Brief lacks pagination and we therefore supply our own).

CLAIMED SUBJECT MATTER

“The present invention relates to a surface protective sheet substrate and a surface protective sheet.” Spec. ¶ 2. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A surface protective sheet comprising a surface protective sheet substrate and a pressure-sensitive adhesive layer,
wherein the substrate comprises a polyolefin resin which accounts for more than 50 % by weight of the entire substrate,
the substrate comprises a layer X that is a resin layer constituting a first surface being a back face of the substrate and a layer Y that is a resin layer constituting the second surface of the substrate, wherein the back face of the substrate is a release face,
the pressure-sensitive adhesive layer is provided on the layer Y,
the layer X is constituted with a resin composition having a tensile elastic modulus (E_x (MPa)) of 400 MPa or greater, but 750 MPa or less,
the layer Y is constituted with a resin composition having a tensile elastic modulus (E_y (MPa)) of 400 MPa or greater, but 750 MPa or less, and
when the layer X has a thickness t_x (μm) and the layer Y has a thickness t_y (μm), the substrate satisfies the next inequality:
 $0.5 \leq t_x \cdot E_x / t_y \cdot E_y \leq 1.5$; and
 t_x is equal to or smaller than t_y .

Claims Appendix (Appeal Br. 17).

REFERENCE

The prior art relied upon by the Examiner is:

Name	Reference	Date
Suzuki	US 2011/0126983 A1	June 2, 2011

REJECTION

Claims 1–8, 10–16, and 18–22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki. Final Act. 3–5.

OPINION

The Examiner rejects claim 1² finding that Suzuki teaches a protective sheet having the recited layers. Final Act. 3. Based on the structural identity, the Examiner finds that the prior art product would have the properties recited in claim 1. *Id.*

Appellant does not dispute the Examiner’s finding of structural identity but instead argues that Examples 1 to 6 of Suzuki have been evaluated and found to be lacking the recited properties. Appeal Br. 9, 14. More specifically, Appellant points to “responses submitted on February 28, 2018 and August 11, 2018” as evidence supporting this argument. *Id.*³

Appellant’s response of February 28, 2018 states that “it is reasonably expected that the tensile modulus of the back layer of Suzuki et al. is well above 750 MPa” and “even higher than 785 MPa” based on factors such as “the content of low-modulus material . . . in the back layer . . . is only half of that of the back layer” of an example in the Specification at issue, “the content of high-modulus [material] Novatec PP FY4 . . . is higher than that of the back layer of” the example in the Specification, and the inclusion of TiO₂ in Suzuki “which has a much higher modulus than Novatec PP FY4.” Response of February 28, 2018, 5–6.

² Appellant does not raise separate arguments for claims 2–8, 10–16, and 18–22. Appeal Br. 6–16. These claims stand or fall with claim 1. *See* 37 C.F.R. 41.37(c)(1)(iv).

³ The Appeal Brief does not provide pin point citations to either of these previous responses.

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Appellant's response of August 15, 2018 does not contain evidence showing that the film in Suzuki lacks the recited properties despite the structural identity. *See* Response of August 15, 2018, 1–6.⁴

Appellant's statement in the response of February 28, 2018 is insufficient to show that the prior art protective sheet lacks the recited tensile modulus properties. The Specification provides that “the tensile elastic modulus of a resin composition in the present description refers to a tensile elastic modulus measured based on JIS K 7161, using as a measurement sample a single-layer resin film formed with the resin composition.” Spec. ¶ 34. Appellant's statement in the response of February 28, 2018, on the other hand, is not based on such a measurement for tensile elastic modulus – but rather based on an approximation using the composition of the material. *See* Response of February 28, 2018, 5–6. Moreover, Appellant's statement in the response of February 28, 2018 lacks evidence showing that a skilled artisan would have approximated tensile elastic modulus as such. *See id.*

Where, as here, “the claimed and prior art products are identical or substantially identical . . . the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. . . . [The] fairness [of the burden-shifting] is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products.” *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). In this case, based on the undisputed structural identity between the recited product and that of the prior art, the Examiner reasonably concludes that an identical product would exhibit identical properties. *See In re Papesch*, 315

⁴ The response of August 15, 2018 lacks pagination and we therefore supply our own.

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F.2d 381, 391 (CCPA 1963) (“From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing.”). As discussed *supra*, Appellant’s argument that the prior art product does not possess the recited properties is unsupported by evidence and is therefore unpersuasive.⁵

Appellant’s argument that Suzuki “does not disclose or suggest the concept of balancing the rigidity between X and Y layers by means of adjusting the tensile elastic modulus and the thickness of each layer” (Appeal Br. 11) is unpersuasive because it is not based on the claim language and does not structurally distinguish the prior art.

Appellant lastly argues that Table 2 of the Specification shows the criticality of the recited correlation of $t_x \cdot E_x / t_y \cdot E_y$. Appeal Br. 15. To show criticality of a claimed range, “it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456 (CCPA 1955). “Only if the ‘results of optimizing a variable’ are ‘unexpectedly good’ can a patent be obtained for the claimed critical range.” *In re Geisler*, 116 F.3d 1465, 1469 (Fed. Cir. 1997) (internal citation omitted).

In this case, Appellant does not show that the recited correlation achieves unexpectedly superior results. *See* Appeal Br. 15; *see also Bristol-Myers Squibb Co. v. Teva Pharms. USA, Inc.*, 752 F.3d 967, 977 (Fed. Cir. 2014) (“To be particularly probative, evidence of unexpected results must

⁵ Because Appellant’s argument lacks evidentiary support and does not show that the tensile elastic modulus as recited is measured by the JIS K 7161 method specified by the Specification, we need not address Appellant’s argument that the Examiner reversibly erred in concluding that 785 MPa is sufficiently close to 750 MPa. *See* Appeal Br. 13–15.

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establish that there is a difference between the results obtained and those of the closest prior art, and that the difference would not have been expected by one of ordinary skill in the art at the time of the invention.”). We sustain the Examiner’s rejection as a result.

CONCLUSION

The Examiner’s rejection is affirmed.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–8, 10–16, 18–22	103(a)	Suzuki	1–8, 10–16, 18–22	

TIME PERIOD FOR 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