



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/223,545	12/30/98	MURANO	A TAI197-01PA

IM62/1013
N. SCOTT PIERCE
HAMILTON BROOK SMITH & REYNOLDS
TWO MILITIA DR
LEXINGTON MA 02421-4799

EXAMINER

CHEN, V

ART UNIT	PAPER NUMBER
1773	16

1773

DATE MAILED:

10/13/00

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

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/223,545	Applic. No. MURANO
Examiner Vivian Chen	Group Art Unit 1773

Responsive to communication(s) filed on 6-13-00 and 7/21/00

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-96 is/are pending in the application.

Of the above, claim(s) 4-10, 12-15, 20, 21, 23-25, 44, 46-53, 56, 58-60, 62 are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-3, 11, 16-19, 22, 26-43, 45, 54, 55, 57, and 61-70 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper Not(s). 4, 5

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 09/2²3,545

Page 2

Art Unit: 1773

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Invention I and the species specified in Paper Nos. 9 and 10 is acknowledged.
2. Claims 4-10, 12-15, 20-21, 23-25, 44, 46-53, 56, 58-60, 71-96 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species and/or invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper Nos. 9 and 10.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Serial Number: 09/2²3,545

Page 3

Art Unit: 1773

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being by KURFMAN ET AL (US 4,115,619) *or* KURFMAN ET AL (US 4,211,822).

Both references disclose a formable, metallized thermoplastic sheet which retains its metallic appearance upon molding.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 11, 16-18, 26-43, 45, 54-55, 57, 61-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over KURFMAN ET AL (US 4,115,619) *or* KURFMAN ET AL (US 4,211,822) in view of EISFELLER (US 4,407,871) *or* DUNNING ET AL (US 4,101,698).

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by KURFMAN ET AL '619 and '822 as stated above. However, in the event the claims are not anticipated, the claims are obvious for the following reasons:

Both KURFMAN ET AL '619 and '822 discloses formable, metallized composites comprising of a first thermoplastic and/or elastomeric layer, a metallized layer, and a second

Serial Number: 09/23,545

Page 4

Art Unit: 1773

thermoplastic and/or elastomeric layer, said composite being suitable to attachment to a further substrate, wherein the first layer may be a polyolefin, a fluorinated polymer, wherein the second layer may be elastomeric polyurethane or an ethylene polymer, and wherein the first and/or second layers are transparent or optionally contain conventional additives such as dyes, pigments, and carbon black (KURFMAN ET AL '619, columns 3, 8) (KURFMAN ET AL '822, line 49, col. 3 to line 18, col. 4; column 9) as recited in claims 1-3, 11, 16, 28-34, 37-39, 45, 54-55, 57, 61-66, 69-70. The polymer layer to be metallized is optionally coated with an adhesive prior to metallization to better adhere the metal to the polymer surface (KURFMAN ET AL '619, lines 1-18, col. 6) (KURFMAN ET AL '822, lines 18-40, col. 7) as recited in claims 1, 17. The metal is typically indium, tin, copper, or alloys thereof (KURFMAN ET AL '619, lines 5-68, col. 4) (KURFMAN ET AL '822, columns 4-5) as recited in claims 26-27, 41-43. However, the reference does not disclose the recited discontinuous metallized layer.

EISFELLER '871 discloses that it is well known to apply discontinuous metallized layers to polymeric substrates and to encapsulate such metallized layers between two polymeric layers in order to form a laminate with improved interlayer adhesion, formability, and resistance to corrosion. DUNNING ET AL discloses that it is well known in the art to apply discontinuous metallized layers between layers of polymeric materials in order to form a laminate with improved formability without loss of metallic appearance or reflectivity.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize a discontinuous metallized layer as disclosed in EISFELLER '871 and

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.