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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/223,545 12/30/98 MURANO

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EXAMINER

IM22/0227

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ART UNIT

PAPER NUMBER

1773

DATE MAILED:


02/27/01

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

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No. <b>09/223,545</b>	Applicant(s) <b>MURANO</b>
Examiner <b>Vivian Chen</b>	Group Art Unit <b>1773</b>



Responsive to communication(s) filed on 12-1-00

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) 2-96 is/are pending in the application.
- Of the above, claim(s) 44, 46-53, 56, 58-60, and 71-96 is/are withdrawn from consideration.
- Claim(s) 2-37 is/are allowed.
- Claim(s) 38-43, 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 No(s) \_\_\_\_\_
- 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 ---

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#### DETAILED ACTION

1. Claim 1 has been cancelled.

#### *Election/Restriction*

2. Claim 2 is generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 4-10, 12-15, 20-22, 23-25, directed to the nonelected species are no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim. However, claims 44, 46-53, 56, 58-60, directed to nonelected species remain withdrawn from consideration since these claims do not depend upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

***Claim Rejections - 35 USC § 103***

3. Claims 38-43, 45, 54-55, 57, 61-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over EISFELLER (US 4,407,871).

EISFELLER '871 discloses a formable laminate comprising a continuous elastomeric cover layer which contains a discontinuous metallized layer therein and a thermoplastic layer adjacent to the discontinuous metal layer (lines 14-30, col. 5; lines 49-68, col. 6) as recited in claim 38, 54-55, 68, wherein said metallized layer comprises indium, zinc, tin, and alloys (lines 22-38, col. 6) as recited in claims 40-43, the cover layer may be urethane (lines 32-42, col. 7) as recited in claim 45, the thermoplastic layer may be a polyolefin (lines 49-68, col. 6) as recited in claim 57. The laminate may be adhered to a polyolefin or urethane substrate (lines 60-68, col. 6) as recited in claims 69-70. However, the reference does not explicitly disclose a thermoplastic cover layer.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize a thermoplastic cover layer material over the discontinuous metallized layer as disclosed in EISFELLER '871 in order to increase the formability and ease of manufacture of the composite material. One of ordinary skill in the art would have incorporated conventional additives such as dyes, pigments, and carbon black in one or more layers of the composite as indicated in claims 61-66 depending on the particular visual effect and appearance desired for a specific application. It is well known in the art to shape thermoplastic articles by embossing

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and/or folding as indicated in claims 67-68. It would have been obvious to use conventional elastomeric resins such as polyvinyl fluoride as indicated in claim 57 over the discontinuous metal layer in order to form a durable protective layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Response to Arguments***

4. Applicant's arguments filed 12/1/2000 have been considered but are moot in view of the new ground(s) of rejection.

***Allowable Subject Matter***

5. Claims 2-37 are allowable over the prior art of record.

6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to disclose or suggest a metallized composite comprising a first thermoplastic layer, an intermediate discontinuous metal layer in an adhesive, and a second thermoplastic layer. Specifically, KURFMAN ET AL '619 and '822 fail to disclose a laminate containing a discontinuous metal layer.

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