

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SADAO OSAWA, EIICHI KATO,  
HIROYUKI OHISHI, KAZUO ISHII

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Appeal No. 2000-2258  
Application No. 08/888,759

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ON BRIEF

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Before JERRY SMITH, RUGGIERO, and LEVY, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

RELATED APPEAL

This appeal is related to Appeal No. 2000-0808 in Application Serial No. 08/906,815 decided concurrently herewith.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 2-8, which are all of the claims pending in the present application. Claim 1 has been canceled.

The claimed invention relates to a process for preparing an ink-jet system printing plate in which an ink composition that is

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solid at ordinary temperatures is heat-melted. An image is formed by spraying droplets of the ink composition in a melted state from the nozzles of a hot melt type ink jet system onto an image receiving layer of a hydrophobic, i.e., water-resistive, surface of a printing plate precursor. The non-image area of the image receiving layer is then subjected to a desensitizing treatment by a chemical reaction to form a planographic printing plate.

Appellants assert (specification, page 5) improved results as compared to a hot-melt type ink-jet system in which a hydrophobic ink image is formed on a water-receptive image receiving layer.

Claim 5 is illustrative of the invention and reads as follows:

5. A process for preparing an ink-jet system printing plate comprising:

heat melting an ink composition that is solid at temperatures of 35°C or lower, spraying droplets of the ink composition in a heat melted state from a nozzle onto an image receiving layer containing zinc oxide and a binder resin on a water-resistant support, the surface of the image receiving layer having a water-contact angle of 50° or more, and then

subjecting a nonimage area of the image receiving layer to a desensitizing treatment by a chemical reaction to prepare a planographic printing plate.

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The Examiner relies on the following prior art:

Zerillo	4,833,486	May 23, 1989
Kato et al. (Kato '705)	5,219,705	Jun. 15, 1993
Kanda et al. (Kanda)	5,582,106	Dec. 10, 1996 (filed May 11, 1995)
Nakayama et al. (Nakayama)	5,677,098	Oct. 14, 1997 (filed Dec. 27, 1995)
Kato et al. (Kato '250)	5,714,250	Feb. 03, 1998 (filed Dec. 28, 1995)

Claims 2-8 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Kato '250 or Kato '705, in the alternative, in view of Kanda and Zerillo with respect to claims 2, 3, and 5-8, and adds Nakayama to the basic combination with respect to claim 4.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>1</sup> and Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our

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<sup>1</sup> The Appeal Brief was filed December 13, 1999 (Paper No. 23). In response to the Examiner's Answer dated January 24, 2000 (Paper No. 24), a Reply Brief was filed March 28, 2000 (Paper No. 25), which was acknowledged and entered by the Examiner as indicated in the communication dated April 14, 2000 (Paper No. 26).

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decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 2-8. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825

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(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's obviousness rejection of independent claim 5, the sole independent claim on appeal, Appellants' arguments in response assert that the Examiner has failed to establish a prima facie case of obviousness. In particular, Appellants attack (Brief, page 6), the Examiner's reliance on the solid hot-melt ink teachings of Zerillo as providing a teaching to the skilled artisan to utilize a solid ink in the printing plate system of Kato '250 or Kato '705 as modified by Kanda.

After careful review of the Zerillo reference in light of the arguments of record, we are in agreement with Appellants' position as stated in the Briefs. As asserted by Appellants, and there is no disagreement by the Examiner, while Zerillo discloses various advantages of using a solid hot-melt ink in a printing plate

preparation process, the only disclosed application of such hot-melt ink by Zerillo is onto a hydrophilic, i.e., water-receptive, image receiving layer. The use of a hydrophilic image receiving layer as disclosed by Zerillo is in direct contrast to the hydrophobic, i.e., water-resistive, image receiving layers used by Kato '250 or Kato '705 and Kanda, as well as that specifically set forth in appealed claim 5.

While the Examiner suggests (Answer, pages 5 and 6) that the advantages of using a solid hot-melt ink (e.g. eliminating ink running) exist regardless of whether a hydrophilic or hydrophobic image receiving layer is used, we find no evidence provided by the Examiner to support such a conclusion.<sup>2</sup> The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the conclusion of obviousness. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). Given this lack of evidentiary support, we find ourselves in agreement with Appellants' contention (Brief, page 6) that no suggestion exists in the applied prior art that the improved print qualities achieved by

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<sup>2</sup> At page 6 of the Answer, the Examiner makes a passing reference to faxed copies of portions of references supplied to Appellants in preparation for an interview. As these documents are not part of any rejection before us, they merit no consideration in the formulation of this decision on appeal.

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Zerillo exist outside of Zerillo's specific disclosed combination of a hot-melt ink applied to a hydrophilic surface.

Further, in contrast to the lack of evidence supplied by the Examiner to support the conclusion of obviousness, we find clear evidence at Table I at page 41 in Appellants' specification of the improved results achieved with the presently claimed hot melt ink and hydrophobic surface combination as opposed to the hot melt ink and hydrophilic combination disclosed in the prior art. After considering the totality of evidence presented on the record, it is our opinion that any suggestion to modify the printing plate systems of Kato '250 or Kato '705 and Kanda by using the solid hot melt ink composition disclosed by Zerillo could only come from Appellants' own disclosure, and not from any disclosure in the prior art references themselves.

Lastly, we have reviewed the Nakayama reference which has been applied by the Examiner to address the support surface smoothness features of the appealed claim 4. We find nothing, however, in the disclosure of Nakayama which would overcome the innate deficiencies of Kato '250, Kato '705, Kanda, and Zerillo discussed supra.

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In conclusion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of independent claim 5, as well as claims 2-4 and 6-8 dependent thereon, is not sustained. Therefore, the decision of the Examiner rejecting claims 2-8 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOSEPH F. RUGGIERO	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

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**JUDGE RUGGIERO**

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APPLICATION NO. 08/888,759

APJ RUGGIERO

APJ LEVY

APJ SMITH, JERRY

DECISION: **REVERSED**

**PREPARED:** Aug 6, 2003

**OB/HD**

**PALM**

**ACTS 2**

**DISK (FOIA)**

**REPORT**

**BOOK**