

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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL D. MATZINGER and G. FREDERICK HUTTER

Appeal No. 2001-2465
Application No. 09/167,878

ON BRIEF

Before GARRIS, OWENS, and LIEBERMAN, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 1 and 3-31 as amended subsequent to the final rejection¹. These are all of the claims remaining in the application.

¹ The Examiner has failed to make an explicit statement as to whether the amendment filed March 15, 2001, subsequent to the final rejection, has been entered. However, the file record for this application clearly reflects that the amendment has been entered.

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The subject matter on appeal relates to an ink-jet printing ink composition comprising a colorant, a carrier medium, and a cationic, water-soluble resin composition comprising specific first, second and third monomers. Further details of this appealed subject matter are set forth in representative independent claim 1 which reads as follows:

1. An ink-jet printing ink composition comprising a colorant, a carrier medium, and a cationic, water-soluble resin composition comprising a first monomer, a second monomer, and a third monomer wherein the first monomer is N-vinylpyrrolidinone, the second monomer is selected from the group consisting of N-methylolacrylamide, N-methylolmethacrylamide, N-isobutoxymethylacrylamide, and mixtures thereof, and the third monomer is represented by the formula:



wherein R is a hydrogen atom or a methyl group; Y is O or NH; n is an integer from 1 to about 4; R', R'', and R''' are hydrogen or alkyl or aralkyl groups independently containing from 1 to about 18 carbon atoms; and X is an anion such as chloride, bromide, tosylate, or alkylsulfate.

The references set forth below are relied upon by the Examiner as evidence of obviousness:

Maslanka et al. (Maslanka)	4,235,982	Nov. 25, 1980
Mitchell et al. (Mitchell)	5,026,427	June 25, 1991
Nakashima et al. (Nakashima)	5,126,392	June 30, 1992
Bermes et al. (Bermes)	5,431,723	July 11, 1995
Kashiwazaki et al. (Kashiwazaki)	5,439,514	Aug. 8, 1995
Kappele et al. (Kappele)	5,656,071	Aug. 12, 1997
Sano et al. (Sano)	5,690,723	Nov. 25, 1997
Lin	5,851,274	Dec. 22, 1998
Nagasawa et al. (Nagasawa)	5,861,447	Jan. 19, 1999

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Claims 1-8, 10-15, 18-20, 22, 24-26, 30 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kappelé in view of Maslanka and Nakashima. The remaining claims on appeal are correspondingly rejected over these references and further in view of various combinations of the other references listed above.

OPINION

On the record before us, none of the rejections advanced by the Examiner can be sustained.

We share the Appellants' fundamental position that the rejection of claim 1, the sole independent claim on appeal, is based upon impermissible hindsight derived from the Appellants' own disclosure rather than a teaching, suggestion or incentive derived from the applied prior art. W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). This is because it is only the Appellants' own disclosure which provides any reason for combining the applied reference teachings in such a manner as to yield the composition defined by appealed independent claim 1.

In this regard, it is the Examiner's position that one with ordinary skill in the art would have provided the ink-jet printing ink composition of Kappelé with a cationic, water-soluble resin

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composition of the type here claimed in view of Maslanka's teaching of a cationic water soluble prepolymer. However, we perceive no basis in the applied references for so combining the teachings thereof. By way of explanation, the cationic prepolymer of Maslanka is not used by patentee as an ingredient, per se, in an ink composition. Instead, this prepolymer is used as a reactant in forming the graft copolymer particles of Maslanka which are used as organic pigments and particularly as paper fillers (e.g., see lines 3-12 in column 2). Furthermore, these graft copolymer particles are explicitly disclosed as being water insoluble (e.g., see lines 13-16 in column 4 and line 1 of patent claim 1).

In light of the foregoing, it is apparent that Maslanka would not have suggested providing Kappel's ink-jet printing ink composition with a cationic water-soluble resin composition of the type here claimed as the Examiner seems to believe. Arguably, an artisan would have derived from Maslanka a teaching and suggestion to use Maslanka's cationic prepolymers to produce patentee's graft copolymer particles for use as organic pigments in the ink compositions of Kappel. However, the resulting composition would not correspond to the composition defined by appealed independent claim 1. This is because the graft copolymer particles would not

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constitute a cationic resin composition and would not be water soluble in accordance with the here claimed composition.

For the above stated reasons, we cannot sustain the rejection as formulated and applied by the Examiner against appealed claim 1 as being unpatentable over Kappel in view of Maslanka and Nakashima. None of the other rejections before us, as formulated by the Examiner, cure the above discussed deficiency of the claim 1 rejection. It follows that we cannot sustain any of the section 103 rejections advanced on this appeal.

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The decision of the Examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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PAUL LIEBERMAN)	
Administrative Patent Judge)	

BRG/jrg

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TERRY B. MCDANIEL
WESTVACO CORPORATION
5600 VIRGINIA AVE
P. O. BOX 118005
CHARLESTON, SC 29423-8005

