

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID E. BRESSLER,
RICHARD W. CHESTNUT, and DANIEL CALIGARO

Appeal No. 1996-0903
Application 07/692,211¹

ON BRIEF

Before CALVERT, Administrative Patent Judge, McCANDLISH,
Senior Administrative Patent Judge, and JOHN D. SMITH,
Administrative Patent Judge.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

¹Application for patent filed April 26, 1991.

Appeal No. 1996-0903
Application No. 07/692,211

This is a decision on an appeal from the examiner's final rejection of claims 1 through 4, 7, 8, 19, 41 through 44, 47, 53

and 69.² The only other claims still pending in the application have been allowed or are considered to be allowable subject to being rewritten in independent form.

Appellants' invention relates to "[a] method of making a printing medium" (claim 41, line 1) and particularly to "[a] method of making a rotogravure printing medium" (claims 1 and 69, line 1) wherein a plastic composition is deposited on a member of the printing medium. All of the independent claims on appeal, namely claims 1, 41 and 69, recite that the plastic composition is "irreversibly curable" and further that the plastic composition is "engravable after curing to produce ink-retaining cells." Claim 41 is broader than claims 1 and 69 in that it relates to a "printing medium", generally, and thus is not limited to a rotogravure type printing medium.

²See the examiner's responses (Paper Nos. 27 and 29) to our remand dated August 6, 1998 (Paper No. 26) and our remand dated March 22, 1999 (Paper No. 28).

Appeal No. 1996-0903
Application No. 07/692,211

A copy of the appealed claims is appended to appellants' brief.

The following reference is relied upon by the examiner as evidence of obviousness in support of her rejection under 35 U.S.C. § 103:

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| Nakamura et al. (Nakamura) | 5,112,656 | May 12, 1992 (filed Oct. 11, 1988) |
|-------------------------------|-----------|---------------------------------------|

Claims 1 through 4, 7, 8, 19, 41 through 44, 47, 53 and 69 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nakamura. All of the other rejections of the appealed claims have been withdrawn. Accordingly, the only issue before us is the propriety of the examiner's rejection under § 103. Reference is made to the examiner's answer for details of this rejection.

The Nakamura patent discloses a method of making an electrophotographic printing medium in which plastic materials are applied to a cylindrical member 8 (which acts as a substrate) to provide a photosensitive coating on the member. The bottommost layer 4, which is deposited directly on the cylindrical member, is a plastic paint composition comprising an epoxy resin (see Nakamura, column 6, lines 41-46). The

Appeal No. 1996-0903
Application No. 07/692,211

applied paint pattern is self-leveling under the action of the diffusion force of the paint and the surface tension acting between the paint and the cylindrical substrate 8 (see Nakamura, column 7, lines 56-62). According to the examiner's findings (see page 3 of the answer), the epoxy resin, among others, is irreversibly curable. There is authority that supports this finding. According to The Condensed Chemical Dictionary (10th edition 1981), page 414 (copy attached), an epoxy resin is a thermosetting resin. Appellants concede on page 15 of their main brief that thermosetting resins, including epoxies, are irreversibly curable in that they are hardened as a result of a change in the chemical make-up of the composition, namely, a cross-linking chemical reaction.

Appellants' main argument supporting patentability is that Nakamura's plastic paint compositions are "reversible soluble solvent-based plastics" (main brief, page 16). Appellants contend that Nakamura's "plastics are not cured, i.e., hardened by a chemical reaction, but baked to remove the solvents, i.e., by drying the liquid plastic" (main brief, page 15).

Appeal No. 1996-0903
Application No. 07/692,211

Appellants have proffered no evidence to support the argument that Nakamura's plastic composition, which is disclosed as comprising an epoxy resin as noted supra, is reversibly curable rather than being irreversibly curable. Such arguments by counsel, however, cannot take the place of evidence. See In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Therefore, the examiner's finding as supported by The Condensed Chemical Dictionary stands unrebutted on the record before us.

Indeed, the independent claims do not even require that the plastic composition be irreversibly cured. Instead, the independent claims merely require that the plastic composition be capable of being irreversibly cured. The evidence shows that an epoxy resin as disclosed by Nakamura is capable of being irreversibly cured. Furthermore, the mere presence of a solvent does not necessarily preclude irreversible curing due to polymerization (which hardens the substance by a change in the chemical make-up of the composition and hence constitutes irreversible curing), as well as by solvent evaporation.³

³See Golding, Polymers And Resins, page 638 (D. Van Nostrand Company, Inc. 1959) (copy attached).

Appeal No. 1996-0903
Application No. 07/692,211

Because the independent claims on appeal recite that the method "comprises" the depositing step, those claims do not exclude the application of a solvent or other substances, for that matter.

We also are unpersuaded by appellants' argument that Nakamura lacks a disclosure of engraving the medium or, more particularly, the plastic composition on the substrate to provide ink-retaining cells (see, for example, page 19 of the main brief and page 6 of the reply brief). The appealed independent claims do not expressly recite the step of engraving the cured plastic composition for providing ink-retaining cells or for any other purpose, for that matter. The independent claims do not even provide for a printing step utilizing ink in the cells.

Instead, the independent claims merely recite that after curing, the plastic composition is "engravable" to produce the ink-retaining cells. When this claim language is given its broadest reasonable interpretation as required in In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), it is broad enough to read on a plastic composition that is

Appeal No. 1996-0903
Application No. 07/692,211

merely capable after curing of being engraved to produce ink-retaining cells. Being made of a plastic composition comprising epoxy resin, Nakamura's plastic coating or layer is inherently capable of being engraved to produce cells in the manner claimed, which is all that is required to meet this limitation in the independent claims. See In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981), In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971) and In re Yanush, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973).

The only other argument supporting patentability of the appealed independent claims is that Nakamura discloses a photographic printing medium utilizing electrical charges, not a rotogravure printing medium. Appealed claim 41, however, does not call for a rotogravure printing medium. Instead, this claim broadly calls for "a printing medium" without limitation as to the type of printing medium. Therefore, the provision of a rotogravure type printing medium may not be relied on to support the patentability of claim 41 over the applied reference, for it is well established patent law that features not claimed may not be relied upon to support patentability. See In re Self, 671 F.2d 1344, 1350-1351, 213

Appeal No. 1996-0903
Application No. 07/692,211

USPQ 1, 7 (CCPA 1982) and In re Richards, 187 F.2d 643, 645,
89 USPQ 64, 66 (CCPA 1951).

For the foregoing reasons, we are satisfied that there is sufficient evidence to support a prima facie case of obviousness, if not anticipation, as far as the subject matter of claim 41 is concerned. Accordingly, we will sustain the § 103 rejection of claim 41. We will also sustain the examiner's § 103 rejection of dependent claims 42 through 44, 47 and 53 since appellants have failed to argue the patentability of these dependent claims separately of claim 41. They therefore fall with claim 41. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and In re Burckel, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979).

We cannot, however, sustain the standing § 103 rejection of claims 1 and 69. Both of these claims expressly recite the step of depositing the irreversibly curable plastic composition on the member of a rotogravure printing medium. This affirmative step may not be dismissed, as the examiner has done here, as merely constituting an intended use of the article made by the claimed method. Claims 1 and 69 claim a

Appeal No. 1996-0903
Application No. 07/692,211

method, not an article. In the present case, the examiner has pointed to no reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to apply Nakamura's plastic composition to a member or substrate of a rotogravure printing medium. Accordingly, we cannot agree that the examiner has made out a prima facie case of obviousness with respect to claims 1 and 69 and the claims which depend directly or indirectly from claim 1. See e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-1532 (Fed. Cir. 1988). We must therefore reverse the § 103 rejection of claims 1 through 4, 7, 8, 19, and 69.

The examiner's decision rejecting the appealed claims is affirmed with respect to claims 41 through 44, 47 and 53, but is reversed with respect to claims 1 through 4, 7, 8, 19 and 69.

Appeal No. 1996-0903
Application No. 07/692,211

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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| | Ian A. Calvert |) | |
| | Administrative Patent Judge |) | |
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| | Harrison E. McCandlish, Senior |) | BOARD OF |
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| | John D. Smith |) | |
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Appeal No. 1996-0903
Application No. 07/692,211

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