

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN T. COMPTON

Appeal No. 96-3102
Application 08/322,971¹

ON BRIEF

Before MEISTER, FRANKFORT and NASE, Administrative Patent Judges.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

John T. Compton (the appellant) appeals from the final rejection of claims 1-3 and 5-12.² Claim 13, the only other claim remaining in the application, stands allowed.

¹ Application for patent filed October 13, 1994. According to appellant, the application is a continuation of Application 07/968,952, filed October 29, 1992, now abandoned.

² Claims 1, 6, 10 and 12 have been amended subsequent to final rejection.

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We REVERSE.

The appellant's invention pertains to a thermal printing system adapted to compensate for changes in power supply voltage as a function of the number of resistance elements that are simultaneously energized, and to a method of operating such a thermal printing system. Independent claims 1 and 10 are further illustrative of the appealed subject matter and copies thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

Sasaki	5,109,235	Apr. 28, 1992
Bruch (European Patent Application)	0 458 507	Nov. 27, 1991

Claims 1-3 and 5-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over the European patent application in view of Sasaki.

The examiner's rejection is explained on pages 3-5 of the answer. The arguments of the appellant and examiner in support of their respective positions may be found on pages 4-

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6 of the brief and pages 5 and 6 of the answer.

OPINION

Having carefully considered the respective positions advanced by the appellant in the brief and the examiner in the answer, it is our conclusion that the above-noted rejection is not sustainable. In rejecting claims under 35 U.S.C. § 103 the examiner bears the initial burden of presenting a **prima facie** case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. *Id.* If the examiner fails to establish a **prima facie** case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Each of the independent claims on appeal requires that the energy applied to the resistance elements during

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successive drive pulses be determined or measured. The examiner recognizes that the European patent application does not teach such an arrangement and relies on Sasaki to overcome this deficiency. According to the examiner:

The secondary reference to Sasaki is also concerned with calculating and determining an appropriate amount of energy to apply to a thermal print element. Sasaki is added for completeness to explicitly shown [sic, show] an energy or heating determining means (see figures 1, 2, 4 and 8) as claimed. As shown in figure 8 and described in columns 6-7, Sasaki employs a "heating amount calculating section" (12) and a "pulse number converting section" (29) that perform the broadly recited function of determining the energy applied to the print elements as found in claim 1. Therefore given that both the primary and secondary references are concerned with thermal print pulse compensation as is conventional, it would have been obvious to one of ordinary skill in the art to modify '507 [the European patent application] with the energy determining means of Sasaki so that energy levels may be determined with a simple circuit and a detailed table of values requiring substantial memory space would be unnecessary. [Answer, pages 4 and 5.]

We will not support the examiner's position. In particular, we cannot agree with the examiner's finding that

the "heating amount calculating section" (12) depicted by Sasaki in Fig. 8 (and described in columns 6 and 7), and the pulse number converting section (29) "perform the broadly recited function of determining the energy applied to the print elements as found in claim 1." As we have noted above, each of the independent claims on appeal (including claim 1) require that the **energy** applied to the resistance elements **during successive drive pulses** be determined or measured. The "heating amount calculating section" (12) depicted by Sasaki in Fig. 8 (and described in columns 6 and 7), however, performs no such function as the examiner apparently believes. That is, in column 6, lines 60-62, Sasaki states (with respect to the embodiment of Fig. 8) that the "heating amount calculating section 12 have constructions similar to those in the above-mentioned embodiment." This "heat amount calculating section" 12 is in more detail described in the following manner:

Heating amount calculating section **12** is composed of a heating element (or heating resistor) number calculating section and calculates the number of operated heating elements at each gradation level on the

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basis of the level frequency counted by
level frequency counter **11**. [Column 3,
lines 62-67.]

See also Fig. 4 and column 4, line 56 through column 5, line 16, of Sasaki. As to the pulse number converting section (29), this section merely accumulates the **pulse numbers** calculated by the heating amount calculating section 12 (see Sasaki, column 6, line 62 through column 7, line 7).

From the above, it is readily apparent that the heat amount calculating section 12 of Sasaki simply calculates the **number** of heating elements operated at each gradation level and the pulse number converting section 29 merely accumulates the **numbers** calculated by the heat amount calculating section 12, and these sections do **not** measure or determine the **energy** applied to the resistance elements **during successive drive pulses**. This being the case, the examiner has not established a **prima facie** case of obviousness with respect to the subject matter defined by the claims on appeal.

The decision of the examiner to reject claims 1-3 and 5-

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12 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES M. MEISTER
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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