

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUDERSHAN K. BHATEJA, JOHN A. MARTENS
and KURT F. FEIL

Appeal No. 1997-0085
Application 08/335,892

ON BRIEF

Before GARRIS, PAK and LIEBERMAN, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-21. The only other claims in the application, which are claims 22-24, stand withdrawn from further consideration by the examiner.

Appeal No. 1997-0085
Application 08/335,892

The subject matter on appeal relates to a photosensitive plate which has a thermal distortion which is limited to specified values. This appealed subject matter is adequately illustrated by independent claims 1 and 3 which read as follows:

1. A photosensitive plate suitable for use as a flexographic printing plate comprising a dimensionally stable, flexible, polymeric substrate and a photosensitive elastomer layer, wherein the plate has a thermal distortion in both the machine and the transverse directions which is less than 0.03% when the plate is exposed to actinic radiation and, after exposure, is developed at temperatures between 100 and 180EC.

3. A photosensitive plate suitable for use as a flexographic printing plate comprising a dimensionally stable, flexible, polymeric substrate and a photosensitive elastomer layer, wherein said polymeric substrate experiences less than 0.07% distortion in any planar direction when heated to temperatures from 110 to 180EC.

The references set forth below are relied upon by the examiner in the rejections before us:

Locey et al. (Locey)	4,160,799	Jul. 10, 1979
Worns et al. (Worns)	4,686,172	Aug. 11, 1987
Gibson, Jr. et al. (Gibson)	5,085,976	Feb. 4, 1992
Martens	5,215,859	Jun. 1, 1993

Lu, Research Disclosure 19809, (Oct. 1990).

Claims 1-7 and 9-11 are rejected under 35 U.S.C. § 102(b)

Appeal No. 1997-0085
Application 08/335,892

as being unpatentable over Martens.

Claims 1-8, 10 and 11 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Gibson or Worns.

Claims 1-7 and 9-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Martens in view of Lu or Locey.

Finally, claims 1-8 and 10-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Gibson or Worns in view of Lu or Locey.

We cannot sustain any of the above noted rejections.

Each of the § 102 rejections before us on this appeal is based upon the examiner's proposition that the respective plates of the applied references inherently possess limited distortion within the here claimed ranges because the prior art and here claimed plates may be manufactured from the same polymeric material, namely, polyethylene terephthalate. The appellants point out, however, that polyethylene terephthalate printing plates which are not annealed in accordance with their disclosed invention (i.e., the plates of Martens, Gibson or Worns) do not necessarily and inherently possess distortion

Appeal No. 1997-0085
Application 08/335,892

values within the appealed claim ranges as evidenced by Example 4 including Table IV on pages 13 and 14 of the subject specification. Significantly, the examiner has not responded meaningfully to the appellants' point on this matter.

It is well settled that inherency may not be established by probabilities or possibilities and that inherency is not established merely because a certain thing may result from a given set of circumstances. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(citing Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)). Under the circumstances recounted above, it is clear that the record before us on this appeal reflects that polyethylene terephthalate printing plates which have not been subjected to the annealing process disclosed by the appellants, that is, the plates of the references under consideration, do not necessarily and inherently possess the appellants' claimed distortion values.

It follows that we cannot sustain the examiner's § 102 rejection of claims 1-7 and 9-11 as being anticipated by Martens or his § 102 rejection of claims 1-8, 10 and 11 as being anticipated by Gibson or Worns.

Appeal No. 1997-0085
Application 08/335,892

As for the examiner's § 103 rejections, we perceive substantial merit in the appellants' arguments against the examiner's conclusion of obviousness. In particular, we agree with the appellants that even if the plates of the primary references were subjected to the treatments of the secondary references, the resulting plates cannot be regarded as possessing distortion values of the type defined by the independent claims on appeal. Indeed, the examiner points to nothing and we find nothing independently in the secondary references which reflects that the treatments of Lu or Locey would be even capable of producing the here claimed distortion values.

In light of the foregoing, we also cannot sustain the examiner's § 103 rejection of claims 1-7 and 9-21 as being unpatentable over Martens in view of Lu or Locey or his § 103 rejection of claims 1-8 and 10-21 as being unpatentable over Gibson or Worns in view of Lu or Locey.

The decision of the examiner is reversed.

REVERSED

Appeal No. 1997-0085
Application 08/335,892

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
PAUL LIEBERMAN))
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Appeal No. 1997-0085
Application 08/335,892

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