

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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAN C. TAM
and
EDWARD G. ZWARTZ

Appeal No. 1997-1053
Application No. 08/432,291

ON BRIEF

Before GARRIS, WALTZ, and KRATZ, **Administrative Patent Judges**.

WALTZ, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 32, which are all of the claims pending in this application.

According to appellants, the invention is directed to a migration imaging process (specification, page 1).

Illustrative claim 1 is reproduced and attached as an Appendix

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to this decision.

The examiner has relied upon the following reference as evidence of obviousness:

Tam et al. (Tam)	5,215,838	Jun. 1, 1993
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Claims 1-32 stand rejected under 35 U.S.C. § 103 as unpatentable over Tam (Answer, page 3). We reverse this rejection for reasons which follow.

OPINION

The examiner finds that Tam discloses the same migration imaging member and imaging process as recited in the claimed subject matter on appeal except that the uniform exposure of the migration element is made through a filter of the same infrared pigment as used in the migration element (Answer, page 3, citing Example 1 of Tam). The examiner states that use of such a filter in the Tam process would have been suggested based on the following facts: (1) the use of filters in photography and electrophotography is well known in order to allow certain wavelengths of light to pass while filtering out other wavelengths of light; (2) Tam, at col. 21, l. 58- col. 22,

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1. 33, discloses that certain phthalocyanine pigments transmit visible light of the green wavelength at about 490 nanometers; and (3) Example 3 of Tam shows imaging of the migration element with a uniform exposure with light of 490 nanometers and the imagewise exposure with infrared light of 780 nanometers (Answer, pages 3-5). The examiner concludes that, based on the facts above, the worker of ordinary skill in the art would have been led to use a source of light encompassing both wavelengths in which one of the exposures could be filtered out instead of using two different sources of light at different wavelengths as disclosed by Tam (Answer, pages 4-5).

Appellants submit that the filter recited in the claims on appeal results in many advantages, including little or no absorption of radiation by the infrared or red light sensitive pigment at the wavelength employed to expose the migration marking material (Brief, page 5). Appellants argue that nothing in the cited art teaches or suggests that the uniform exposure of the migration marking material to radiation should be carried out through an infrared or red light sensitive filter (Brief, page 10). We agree.

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The examiner has not established any convincing reasoning or evidence why one of ordinary skill in the art would have added a filter, as recited in the claimed subject matter on appeal, in the process of Tam. Appellants have not contested the examiner's finding that such filters as recited in the claims on appeal were well known in the art. However, the mere fact that these filters were well known does not suggest the desirability of incorporating these filters into the process of Tam, absent a suggestion, motivation or reason for this combination. See *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1361, 48 USPQ2d 1225, 1240 (Fed. Cir. 1998) ("The ultimate question is whether, from the evidence of the prior art and the knowledge generally available to one of ordinary skill in the relevant art, there was in the prior art an appropriate teaching, suggestion, or motivation to combine components in the way that was done by the inventor. [Citations omitted]"); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the

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modification. [Citations omitted]").

The examiner has not established, by convincing reasons or evidence, why it would have been desirable or needed to use the filter known in the art in the process of Tam. Merely because an infrared or red light sensitive filter *could* be incorporated into the process of Tam does not make the modification of Tam obvious. Accordingly, the rejection of the appealed claims under § 103 over Tam cannot be sustained.

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The decision of the examiner is reversed.

REVERSED

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BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

TAW:hh

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APPENDIX

1. A process which comprises (a) providing a migration imaging member comprising (1) a substrate, (2) an infrared or red light radiation sensitive layer comprising a pigment predominantly sensitive to infrared or red light radiation, and (3) a softenable layer comprising a softenable material, a charge transport material, and a photosensitive migration marking material predominantly sensitive to radiation at a wavelength other than that to which the infrared or red light sensitive pigment is predominantly sensitive; (b) uniformly charging the imaging member; (c) subsequent to step (b), uniformly exposing the charged imaging member to a source of activating radiation with a wavelength to which the migration marking material is sensitive, wherein a filter comprising the infrared or red light radiation sensitive pigment is situated between the radiation source and the imaging member; (d) subsequent to step (b), exposing the imaging member to infrared or red light radiation at a wavelength to which the infrared or red light radiation sensitive pigment is sensitive in an imagewise pattern, thereby forming an electrostatic latent image on the imaging member; and (e) subsequent to steps (c) and (d), causing the softenable material to soften, thereby enabling the migration marking material to migrate through the softenable material toward the substrate in an imagewise pattern.