

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 97-1453
Application No. 08/196,672¹

ON BRIEF

Before KIMLIN, ELLIS and WALTZ, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-11 and 36. Claim 12 has been allowed by the examiner. Claims 13-30, the other claims remaining in the present application,

¹ Application for patent filed February 15, 1994. According to appellant, this application is a continuation-in-part of Application No. 08/034,943, filed March 19, 1993.

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stand withdrawn from consideration. A copy of illustrative claim 1 is appended to this decision.

In addition to the admitted prior art found in appellant's specification, the examiner relies upon the following references as evidence of obviousness:

Koike et al. (Koike)	4,948,719	Aug. 14, 1990
Ueno et al. (Ueno)	5,318,943	June 7, 1994
		(filed May 22, 1992)

Appellant's claimed invention is directed to a recording sheet for receiving printed images of an aqueous ink comprising a coating having an additive material selected from the recited compounds, e.g., oxazole compounds. The coating may optionally contain a binder selected from polysaccharides or quaternary acrylic copolymer latexes. According to appellant, the image-receiving coatings of the present invention exhibit rapid drying times when imaged with aqueous ink and reduced curling subsequent to being imaged with an aqueous ink.

Appealed claims 1-5 and 7-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koike. Claims 1 and 3-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ueno. In addition, claim 36 stands rejected

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under 35 U.S.C. § 102(b) as being anticipated by the admitted prior art.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejections.

Although the examiner apparently recognizes that none of the applied references teaches or suggests an image receiving coating comprising the claimed additive materials, it is the examiner's position that the appealed claims are merely reciting a newly discovered function or property of the coating that does not distinguish the coating over the coatings disclosed by the applied prior art. Therefore, the examiner considers it irrelevant that the coating of Koike which contains the claimed additive material is a subbing layer situated between an adhesive layer and a photosensitive emulsion, and that the coating layer of Ueno which contains the claimed additive material is an intermediate layer between a substrate and a director layer. According to the examiner, since Koike and Ueno disclose the claimed coating on a substrate, "if appellant's claimed article functions as a

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recording material, then the prior art articles also must function as recording materials" (page 5 of Answer).

The examiner's reliance on In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971) is misplaced, since, here, we are not left to ascertain whether the articles of the cited references inherently possess the ability to function as a recording sheet for receiving printed images of an aqueous ink. Manifestly, we find it reasonable to conclude that neither the photographic silver halide element of Koike nor the thermal transfer image receiving sheet of Ueno is intended to, or capable of, functioning as a recording sheet for receiving printed images of an aqueous ink. It is well settled that every claim limitation must be given consideration in determining patentability under 35 U.S.C. § 102 or 35 U.S.C. § 103,² and we agree with appellant that the claim language "[a] recording sheet for receiving printed images of an aqueous ink" is a meaningful limitation which lends life and vitality to the claimed invention.³

² In re Geerdes, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA 1974).

³ Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 480-81 (CCPA 1951).

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The examiner's rejection of claim 36 is based on the rationale that since the claimed additive materials are taught by appellant's specification to be known prior art compounds, "it is inherent that these known compounds have at some point come in contact with a substrate" (page 4 of Answer). Since, as discussed above, we find that the claim language "[a] recording sheet for receiving printed images of an aqueous ink" is a limitation which lends life and vitality to the claimed subject matter and, therefore, must be given patentable weight, it follows that we do not agree with the examiner that the presence of one of the claimed compounds on a substrate anticipates the claimed recording sheet. To use a hypothetical analogy for illustrative purposes, if a claim is directed to a tire comprising a particular rubber composition, we trust that the examiner would not consider the claimed tire anticipated by the existence of the claimed rubber composition on a substrate or in a reaction vessel.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

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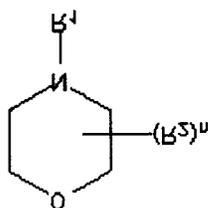
EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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JOAN ELLIS)	BOARD OF PATENT
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APPENDIX

1. A recording sheet for receiving printed images of an aqueous ink which comprises a substrate and an image receiving coating situated on at least one surface of the substrate, said coating comprising (a) a binder selected from polysaccharides or quaternary acrylic copolymer latexes and (b) an additive material selected from the group consisting of oxazole compounds, isooxazole compounds, oxazolidinone compounds, oxazoline salt compounds, morpholine compounds of the formula



wherein R₁ is hydrogen, alkyl, substituted alkyl, alkylene, aryl, substituted aryl, carbonyl alkyl piperazine, oxyalkylene, aldehyde, amino, or aniline, R₂ represents a substituent other than hydrogen bonded to one of the ring carbon atoms, by either a single or double bond, and n is an integer of 0, 1, 2, 3, 4, 5, 6, 7, or 8, wherein when more

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than one R_2 group is present, the R_2 groups may be either the same as each other or different from each other, and wherein the nitrogen atom may be positively charged, thiazole compounds, thiazolidine compounds, thiadiazole compounds, phenothiazine compounds, and mixtures thereof, said image receiving coating being suitable for receiving rapid drying images of an aqueous ink.