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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL L. GRANDE, EDWARD J. GUTMAN
and JAMES J. FRANZEN

Appeal No. 1997-1801
Application 08/351,162¹

ON BRIEF

Before SCHAFER, LEE and TORCZON, Administrative Patent Judges.

SCHAFER, Administrative Patent Judge.

MEMORANDUM OPINION AND ORDER

Decision on Appeal under 35 U.S.C. § 134

I.

The following rejections are before us for decision:

¹ Application for patent filed November 30, 1994.

1. The rejection of claims 13 and 14 under 35 U.S.C. § 102(b) as anticipated by U.S. patents to Tomanek² and Nakano³;
2. The rejection of claims 13 and 14 under 35 U.S.C. § 102(e) as anticipated by a U.S. patent to Anderson⁴;
3. The rejection of claims 1-5 and 7-14 under 35 U.S.C. § 103(a) as unpatentable over the combination of Anderson and Nakamura⁵;
4. The rejection of claims 1-3 and 6-14 under 35 U.S.C. § 103(a) as unpatentable over the combination of Nakano and Nakamura.

The claimed subject matter is directed generally to a process for producing a multicolor toner or developer composition wherein toner pellets of different colors are mixed and then ground to form a colored toner powder which is a mixture of the different colors. The color toner pellets used in the process are said to be conventional and made by conventional methods such as extrusion. Specification, p. 3, p. 10. Applicants also claim the powdered multicolor toner made by the process.

II.

Applicants state that each of the claims is separately patentable but groups the claims into three

² U.S. Patent 3,236,776 issued February 22, 1966.

³ U.S. Patent 5,077,158 issued December 31, 1991.

⁴ U.S. Patent 5,370,962 issued December 6, 1994.

⁵ U.S. Patent 4,859,560 issued August 22, 1989.

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groups as follows (Brief, p. 4):

Group I: claims 1-7 and 10-14;

Group II: claim 8; and

Group III: claim 9.

Notwithstanding their statement with respect to separate patentability, applicants specifically address only the following claims:

Claim 1 (Brief, pp. 18-20),

Claims 13 and 14 (Brief, pp. 4-14);

Claim 8 (Brief, pp. 20-21); and

Claim 9 (Brief, pp. 20-21).

Section 1.192(c)(7) of 37 CFR provides:

(7) *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Accordingly, we select claim 1 as representative of claims 1-7 and 10-12, claim 13 as representative of claims 13 and 14 and separately treat claims 8 and 9. We reproduce these representative claims below:

1. A process for producing a color toner or developer composition, comprising grinding a mixture of pellets of at least one color toner material and pellets of at least one other color toner material to form a final powdered color

toner composition.

8. A process according to claim 1, wherein said pellets are mixed while said grinding is being conducted.

9. A process according to claim 1, wherein said mixture of pellets is formed before said grinding is conducted.

13. A powdered color toner composition prepared by the process of claim 1.

III.

Claims 13 and 14 are product-by-process claims. The primary examiner has rejected these claims under 35 U.S.C. § 102(b) relying on Tomanek and Nakano and under § 102(e) relying on Anderson. We affirm both rejections.

A.

Product-by-process claims are product claims, not process claims. Atlantic Thermoplastics Co. Inc. v. Faytex Corp., 970 F.2d 834, 844-45, 23 USPQ2d 1481, 1490 (Fed. Cir. 1992); In re Bridgeford, 357 F.2d 679, 682, 149 USPQ 55, 58 (CCPA 1966). The determination of the patentability of a product-by-process claim is based on the product not the process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985); In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). Thus, “[i]n determining patentability [of product-by-process claims] we construe the product as not limited by the process stated in the claims.” Scripps Clinic & Research Foundation v. Genentech Inc., 927 F.2d 1565, 1583, 18 USPQ2d 1001, 1016 (Fed. Cir. 1991). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Thorpe, 777 F.2d at 697, 227 USPQ at 966; In re Marosi, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); In re Fessman, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). The burden is then upon the applicant to come forward with evidence establishing that the

prior art product does not inherently possess the characteristics of the claimed product and that there are unobvious differences between the claimed product and the prior art product. Thorpe, 777 F.2d at 697, 227 USPQ at 966; In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); Brown, 459 F.2d at 535, 173 USPQ at 688.

B.

The examiner has found that each of the Tomanek, Nakano and Anderson patents teach a color toner which includes a mixture of at least two different colored powders which fall within claims 13 and 14.

Tomanek relates to developer compositions which have two distinguishable toners. Tomanek, col. 1, lines 50-54. The toners may be distinguishable by color. Tomanek, col. 1, lines 55-62. Examples 1-3 describe two-color toners and a method of making the toners. Each of the toners is separately made, ground in a ball mill and sieved to recover powders having the desired particle size. The powders are then mixed using glass balls to obtain the final two-color toner. Tomanek, col. 4, line 41 - col. 6, line 18.

Nakano describes a grey toner which is the mixture of a powdered black toner and a powdered white toner. The two toner powders are separately made and subsequently mixed. Nakano, col. 8, line 40 - col. 9, line 5.

Anderson relates to toners which are the comixture or blend of two or more different colored powdered toners. Anderson describes a process where two or more toner powders of different colors are comixed or blended in the presence of a blend compatibility additive. Anderson col. 4, line 68 - col. 5, line 10. Example 1 describes a two-color toner made by extruding the individual toners into pellets (strands) and subjecting the pellets to grinding and size classification to remove fines. The individual powders were then mixed and blended. Prior to mixing a blend compatibility component was added to each toner powder. Anderson, col. 12, line 67 - col. 13, line 41.

In the examiner's view the prior art multicolor toners appear to be no different than the toners made by applicants' process. We agree.

C.

Applicants' brief does not challenge that one skilled in the art would conclude that the multicolor toners described by Tomanek, Nakano and Anderson are the same as the toners claimed by applicants.⁶ Rather, applicants argue (1) that references do not anticipate because they do not teach the specific process steps required by the claims and (2) that declaration evidence shows that the powdered color toners of the claims are different than the powdered color toners taught in the prior art.

1.

Applicants' first argument is clearly inconsistent with the well established precedent that the patentability of product-by-process claims is based upon the product not on the process steps used to make that product. E.g., Thorpe, 777 F.2d at 697, 227 USPQ at 966. In support of their argument, applicants rely on Scripps, 927 F.2d at 1576, 18 USPQ2d at 1010 and In re Marshall, 578 F.2d 301, 198 USPQ 344 (CCPA 1978). Brief, pp. 4-9. Both cases are easily distinguished. The portion of the Scripps opinion to which applicants direct our attention states:

Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.

It is sometimes appropriate to consider extrinsic evidence to explain the disclosure of a reference. Such factual elaboration is necessarily of limited scope

⁶ Section 1.192(a) provides in relevant part:
Appellant must . . . file a brief in triplicate. The brief . . . must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

and probative value, for a finding of anticipation requires that all aspects of the claimed invention were already described in a single reference: a finding that is not supportable if it is necessary to prove facts beyond those disclosed in the reference in order to meet the claim limitations. The role of extrinsic evidence is to educate the decision-maker to what the reference meant to persons of ordinary skill in the field of the invention, not to fill gaps in the reference. If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not §102 anticipation, but §103 obviousness. Indeed, a publication on the Harris dissertation was included in the prior art statement filed by Scripps and was a cited reference under §103. [Citations omitted.]

Scripps, 927 F.2d at 1576, 18 USPQ2d at 1010. The Scripps case was an appeal from a civil action for infringement. The above-quoted statement relates to the district court's holding that Scripps claims 24, 26 and 27 were invalid for anticipation. Scripps, 927 F.2d at 1576, 18 USPQ2d at 1010. These claims, however, were product claims not product-by-process claims. Scripps, 927 F.2d at 1570, 19 USPQ2d at 1005. The Marshall case related to process claims. Marshall, 578 F.2d at 302-03, 198 USPQ 344-45. As we indicated above, the determination of the patentability of a product-by-process claim is based on the product not the process. Thorpe, 777 F.2d at 697, 227 USPQ at 966; Brown, 459 F.2d at 535, 173 USPQ at 688; Pilkington, 411 F.2d at 1348, 162 USPQ at 147. In fact, the Federal Circuit applied this principal to Scripps' product-by-process claims. With respect to Scripps product-by-process claims, the court stated: "In determining patentability we construe the product as not limited by the process stated in the claims." Scripps, 927 F.2d at 1583, 18 USPQ2d at 1016. Thus, the fact that the prior art does not describe applicants process steps does not show that the examiner's rejection was erroneous.⁷

2.

⁷ In light of the well established precedent on the patentability of product-by-process claims, applicants argument that the references did not anticipate the claims because the references did not disclose the process steps is frivolous.

Applicants also argue that the toners of the prior art and the toner's made according to applicant's process are different. In support of this position applicants present two declarations, both by Dr. Edward J. Gutman, one of the named inventors. In order to overcome, the prima facie case, the applicant must present evidence establishing that the prior art products are different than the products claimed. Thorpe, 777 F.2d at 697, 227 USPQ at 966; Fitzgerald, 619 F.2d at 70, 205 USPQ at 596; Best, 562 F.2d at 1255, 195 USPQ at 433-34; Brown, 459 F.2d at 535, 173 USPQ at 688. Neither of Dr. Gutman's declarations show that the products described in the prior art are different than products made according to the process of applicants claims. Dr. Gutman's declarations may show that for the specific brown colored toner compositions described in the declarations, toners that are made by separate grinding followed by mixing may have some different characteristics than toners that are made using grinding and mixed simultaneously. However, applicant's burden is to show that the prior art toners are different than those made by applicant's process. Applicant's declarations do not show that the two-color toners described by Tomanek, Nakano and Anderson would have different characteristics if made according to the process in claim 13.

D.

The rejection of claims 13 and 14 under 35 U.S.C. § 102 is affirmed.

IV.

The examiner also entered rejections of claims 1-5 and 7-14 under 35 U.S.C. § 103(a) as unpatentable over the combination of Anderson and Nakamura and of claims 1-3 and 6-14 under 35 U.S.C. § 103(a) as unpatentable over the combination of Nakano and Nakamura. We reverse these rejections.

Claim 1 requires the step of "grinding a mixture of pellets of at least one color toner material and pellets of at least one other color toner material" Neither Anderson nor Nakano teach the step of grinding a mixture of different color toner pellets as required by the claims. The Nakamura reference

appears to be consistent with the other prior art relied upon in showing mixing the different color toners subsequent to the grinding step. Thus, the references relied upon fail to suggest modifying the prior art process to grind a mixture of pellets to form a multicolor toner or developer. Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires consideration of whether the prior art would have suggested to those of ordinary skill in the art that they should carry out the claimed process. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, the examiner has failed to show that the subject matter of claim 1 would have been obvious. Since claims 8 and 9 depend from claim 1 the subject matter of these claims has likewise not been shown to have been obvious.

The rejections of claims 1-14 under 35 U.S.C. § 103(a) are reversed.

AFFIRMED -IN-PART

RICHARD E. SCHAFER
Administrative Patent Judge

JAMESON LEE
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

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