

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL F. CUNNINGHAM and HADI K. MAHABADI

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Appeal No. 1997-3093  
Application 08/415,384<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, OWENS and ROBINSON, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is an appeal from the examiner's final rejection of claims 1-5, 7, 11 and 25-27, which are all of the claims remaining in the application.

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<sup>1</sup> Application for patent filed April 3, 1995.

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*THE INVENTION*

Appellants claim a process for making polymer powders for use in coating cores to form developer compositions used in electrostatographic or electrophotographic imaging systems, especially xerographic imaging and printing processes (specification, pages 1-2). Claim 1 is illustrative and reads as follows:

1. A process for the preparation of carrier powder polymer coatings consisting of the supercritical polymerization of two monomers and surfactant in a supercritical medium, and wherein the surfactant forms a layer on the polymer product and which surfactant layer is of a thickness of from about 0.05 to about 1.5 microns, and the powder polymer carrier coating is of a size of 0.05 to about 5 microns.

*THE REFERENCE*

DeSimone et al. (DeSimone)                      5,312,882                      May 17,  
1994

*THE REJECTIONS*

Claims 1-5, 7, 11 and 25-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as being obvious over DeSimone.

*OPINION*

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

*Rejection under 35 U.S.C. § 102(b)*

The examiner argues that DeSimone's process is sufficiently similar to that of appellants that there is a reasonable basis for believing that the product produced by DeSimone's process inherently has the characteristics recited in appellants' independent claims (answer, page 4).

When an examiner relies upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990). Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Ex parte Skinner*, 2 USPQ2d

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1788, 1789 (Bd. Pat. App. & Int. 1986).

In support of his argument, the examiner merely cites portions of DeSimone (answer, page 4). The examiner does not compare the process steps and conditions of DeSimone and those of

appellants and provide technical reasoning as to why the steps and conditions are sufficiently similar that it reasonably appears that DeSimone's process necessarily produces particles having the size and surfactant coating thickness recited in appellants' independent claims. The examiner, therefore, has not carried his burden of establishing a *prima facie* case of anticipation. Accordingly, we reverse the rejection under 35 U.S.C. § 102(b).

*Rejection under 35 U.S.C. § 103*

The examiner does not present an argument as to why it would have been obvious to one of ordinary skill in the art to modify the DeSimone process to arrive at the processes recited in appellants' claims 1-5, 7 and 11.

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As for claims 25-27, the examiner argues that selection of the recited process conditions would have required mere optimization (supplemental answer, page 2). The examiner, however, does not explain why optimizing the DeSimone process would produce particles having the size and surfactant layer thickness recited in appellants' independent claims. Appellants state that their particles are to be used to make developer compositions (specification, page 1), whereas DeSimone discloses

that his particles may be dissolved in a solvent and sprayed onto a surface to form a coating, or may be used to form molded articles such as valves, bottles, films, fibers, resins and matrices for composite materials (col. 7, lines 43-51). The examiner has not explained why the disclosed uses of DeSimone's particles are sufficiently similar to that of appellants that there is reason to believe that optimizing DeSimone's process would result in particles being produced which have the size and surfactant layer thickness recited in appellants' independent claims, or provided any other reason why optimizing DeSimone's process would produce particles

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having such a size and surfactant layer thickness.

For the above reasons, we conclude that the examiner has not carried his burden of establishing a *prima facie* case of obviousness of the process recited in any of appellants' claims. The rejection under 35 U.S.C. § 103, therefore, is reversed.

*DECISION*

The rejections of claims 1-5, 7, 11 and 25-27 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative,

under 35 U.S.C. § 103 as being obvious over DeSimone are reversed.

*REVERSED*

JOHN D. SMITH )  
Administrative Patent Judge )  
)

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PATENT	TERRY J. OWENS	) BOARD OF
	Administrative Patent Judge	) APPEALS AND
		) INTERFERENCES
		)
	DOUGLAS W. ROBINSON	)
	Administrative Patent Judge	)

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