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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG D. DEWEY

Appeal No. 1998-0488
Application No. 08/496,234

ON BRIEF

Before JERRY SMITH, FLEMING, and LALL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-20, which constitute all the claims in the application.

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The invention pertains to a method and apparatus for determining color misregistration in a multi-color printing press. More particularly, the invention relates to a printing press in which three separate printing stations, such as cyan, magenta and yellow, cooperate to produce process black. A process black registration mark is formed at a desired location on a web where an image is to be printed. The process black registration mark is examined to determine if the separate printing stations have properly produced the process black registration mark.

Representative claim 1 is reproduced as follows:

1. A method of determining color misregistration in a multi-color printing press having a plurality of printing stations that each include a plate cylinder and that each prints a color image on a web with a predetermined color of ink, wherein the colors printed by the plurality of printing stations cooperate to produce process black, said method comprising the steps of:

identifying an area of the desired image that is intended to be printed in black;

forming registration images on the plate cylinders of the printing stations, said registration images being positioned on the plate cylinders such that, during subsequent printing operations, they will produce color registration marks that cooperate to print a process black registration mark on the web in

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the identified area when the printing stations are in registration;
 applying ink to the plate cylinders;
 forming the color images on the web;
 examining the identified area with an apparatus capable of distinguishing the colors printed by the printing stations; and
 generating an error signal if the examining apparatus senses that the color registration marks are not in a desired registration to form the process black registration mark.

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The examiner relies on the following references:

Brovman 1985	4,534,288	Aug. 13,
Kishner et al. (Kishner) 1985	4,546,700	Oct. 15,
Brunner 1989	4,852,485	Aug. 1,
Harrington 1994	5,331,438	Jul. 19,

(filed Nov. 30,
1992)

Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on an inadequate disclosure. Claims 1-20 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Brunner in view of Harrington and further in view of Brovman and Kishner.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner, the arguments in support of the rejections and the evidence of obviousness relied upon by the examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into

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consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure in this application describes the claimed invention in a manner which complies with the requirements of 35 U.S.C. § 112. We are also of the view that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-20. Accordingly, we reverse.

We consider first the rejection of claims 1-20 as being based on an inadequate disclosure. The rejection points to the specification as failing to provide an enabling disclosure of the invention. Thus, the rejection is based on the enablement portion of the requirements of 35 U.S.C. § 112. The examiner points to several recitations of the claimed invention which, in the examiner's view, have not been enabled by the supporting disclosure. Appellant has argued that the

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recitations of the claimed invention are primarily implemented in the very same manner as set forth in the disclosures of the applied prior art references. Appellant has also submitted two declarations in support of his position that the present specification is enabling for the claimed invention. The examiner has found all of appellant's arguments and evidence to be unpersuasive of enablement.

To comply with the enablement clause of the first paragraph of 35 U.S.C. § 112, the disclosure must provide an adequate description such that the artisan could practice the claimed invention without undue experimentation. In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 303 (CCPA 1974); In re Brandstadter, 484 F.2d 1395, 1407, 179 USPQ 286, 295 (CCPA 1973). The burden is initially upon the examiner to establish a reasonable basis for questioning the sufficiency of the disclosure. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982). Enablement is not precluded by the necessity for some experimentation. However, experimentation needed to practice the invention must not be undue experimentation. The key word is "undue", not

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"experimentation." In re Wands, 858 F.2d 731, 736-37, 8
USPQ2d 1400, 1404 (Fed. Cir. 1988).

When we apply the above-noted case law to the facts of this case, we cannot escape the conclusion that the examiner has failed to support his position that the disclosure in this application is insufficient to support the claimed invention. The determination of what constitutes undue experimentation in a given case requires the application of a standard of reasonableness, having due regard for the nature of the invention and the state of the art. In our view, every step and means recited in the appealed claims is essentially the same as set forth in the applied prior art except that the claimed invention makes decisions based on a process black registration mark rather than some other form of registration mark. The examiner's position appears to suggest that since the claimed invention is alleged to be different than the prior art, then the prior art teachings cannot support the claimed invention. The error in the examiner's position, however, is that the steps of forming registration images, examining registration marks, generating error signals, and adjusting printing stations for example, are all performed in

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the applied prior art, but not with respect to a process black mark.

The examiner has not offered any convincing rationale why the use of a process black registration mark as claimed would cause problems for the artisan who is already familiar with controlling registration based on black marks and color marks. We are of the view that the claimed invention is disclosed in a manner that would clearly have enabled the artisan to make and use the invention. Therefore, we do not sustain the rejection of the claims under the first paragraph of 35 U.S.C. § 112.

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We now consider the rejection of claims 1-20 under 35 U.S.C. § 103 as unpatentable over the teachings of Brunner, Harrington, Brovman and Kishner. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.

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Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

The rejection points to general teachings of the applied prior art, but does not address the specific language of the claims. Independent claim 1 recites that an area of the desired image which will be printed in black must be identified, and a process black registration mark must be formed within that area of the image. We cannot find even a

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remote suggestion within any of the applied references for forming a process black registration mark in such a specific location. Although the examiner concludes that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to select and evaluate any desired mark relative to any other mark in Brunner for register evaluation and correction, including those which are conventionally formed by printer black or process black" [answer, page 14], there is no evidence on this record that a process black registration mark should be formed and examined in the manner recited in claim 1. Therefore, we do not sustain the rejection of claims 1-4.

With respect to independent claim 5, we find teachings in the applied prior art that three separate color printing stations can cooperate to produce process black and that misregistration of the printing stations can be determined by individually comparing each color printed with a corresponding printer black mark, however, we find no teaching of the printing stations having registration images positioned thereon that will produce a process black registration mark as recited in claim 5. Although the examiner asserts that

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Brovman and Kishner teach distinguishing a black ink reference indicator from process black for the purpose of misregistration, the two references only teach distinguishing marks made by each of the printing stations separately and not as a process black mark. Therefore, we do not sustain the rejection of claims 5-8.

Independent claim 9 recites the examination of a process black registration mark and making color evaluations of this process black registration mark. Although the examiner is of the view that the applied prior art performs these steps, we do not agree. As noted above, the applied prior art teaches the color evaluation of separately located color registration marks with respect to a printer black registration mark. There is no suggestion that the misregistration should be evaluated based on a process black registration mark as claimed. Therefore, we do not sustain the rejection of claims 9-15.

Independent claim 16 essentially contains all the features of claim 9 with the additional recitation of printing and examining a black ink registration mark along with the process black registration mark. Therefore, we do not sustain

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the rejection of claims 16-20 for at least the reasons discussed above with respect to claim 9.

We note that appellant has argued several of the dependent claims separately. Since we have not sustained the rejection of any of the independent claims, we need not discuss in detail the limitations of these dependent claims. We do observe, however, that the examiner has essentially ignored these limitations of the dependent claims in formulating the rejection and in responding to appellant's arguments. Therefore, we agree with appellant that these claims would have been separately patentable even if we had agreed with the examiner's rejection of the independent claims.

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In summary, we have not sustained the examiner's rejection of the claims under either 35 U.S.C. § 112 or § 103. Therefore, the decision of the examiner rejecting claims 1-20 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
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PARSHOTAM S. LALL)	
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APJ FLEMING

REVERSED

Prepared: December 8, 2000