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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-JACQUES ELTGEN

Appeal No. 98-0978
Application 08/505,650[1]

HEARD: May 6, 1999

Before MEISTER, PATE and GONZALES, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

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[1] Application for patent filed July 21, 1995. According to appellant, the application is a continuation of Application 08/181,434, filed January 14, 1994, abandoned.

This is an appeal from the examiner's refusal to allow claims 1, 5, 9 through 11, 14, 16, 18, 20, and 22 through 24 as amended after final rejection. Claims 12, 19 and 26 stand

allowed. Claims 3, 4, 6, 7, 13, 15, 21 and 25 stand withdrawn from consideration as directed to a non-elected invention. Claims 2, 8 and 17 have been cancelled. These are all the claims in the application.

The claimed invention is directed to an apparatus and process of printing using an endless web or belt of low thermal inertia. The printing image is formed by fixing a hardenable substance on the web or belt. The hardenable substance, when fixed on the web, forms zones with an affinity for the colorant and zones without an affinity for the colorant. Thereafter, the image is transferred to the media to be printed and the image formed on the web is removed so that the web is available for another image to be placed thereon.

The claimed printing process of claim 1 and the claimed printing apparatus of claim 10 can be further understood with reference to the appealed claims appended to the appellant's brief.

The prior art of record relied upon by the examiner as evidence of obviousness is:

Love	4,718,340	Jan. 12, 1988
Kanck	5,213,041	May 25, 1993
Kubokawa et al. (Kubokawa)[2] (Japanese kokai)	63-135,248	June 7, 1988

THE REJECTION

The examiner has rejected claims 1, 5, 9 through 11, 14, 16, 18 through 20, and 22 through 24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 9 through 11, 14 and 24 stand rejected under 35 U.S.C. § 103 as unpatentable over Kanck in view of

[2] Our understanding of the Japanese kokai is via an English translation, a copy of which is attached to this decision.

Love. According to the examiner, Kanck teaches the method steps as recited in claim 1 with the exception of the use of an endless web. The examiner is further of the opinion that Love teaches a method similar to Kanck with the provision of using an endless web. The examiner notes that Love does not show a material hardenable by heat. The examiner reaches the conclusion that:

> [i]t would have been obvious to one of ordinary skill in the art to provide the method of Kanck with an endless web in view of Love to print a continuous image and eliminate printing gaps and shocks caused by conventional cylinder mounted printing plates
>
> and immediately make a new transfer element so as to print an image longer than the length of the web [Examiner's Answer, page 5].

The examiner is further of the opinion that Kanck and Love also would have rendered obvious the apparatus claim 10 to the extent that claim 10 claims the step of enabling formation of a new intermediate transfer element. According to the examiner, this does not require the actual formation of the element but only that the web of Love would have been able to perform this function due to its thermal inertia properties.

The examiner has rejected claims 1 and 9 under 35 U.S.C. § 103 as unpatentable over Kubokawa in view of Kanck and Love. According to the examiner, Kubokawa teaches the method as recited in the claims with the exception of 1) removing the hardenable material by melting and 2) using an endless web. Therefore, the examiner is of the opinion that since Kanck teaches the desirability of removing the hardenable material by melting and Love teaches the endless web structure for printing, the combined teachings of these three references would have rendered the method of claims 1 and 9 prima facie obvious.

The examiner has rejected claims 10, 11 and 24 under 35 U.S.C. § 103 as unpatentable over Kubokawa in view of Love.

According to the examiner, it would have been obvious to one of ordinary skill to provide the press of Kubokawa with an endless metallic web in view of Love to enable the printing of a continuous image that is longer than the length of the web.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have determined that the applied prior art does not establish a prima facie case of obviousness with respect to the subject matter on appeal, and the claims are not indefinite under 35 U.S.C. § 112, second paragraph. Our reasons follow.

Turning first to the rejection under 35 U.S.C. § 112, second paragraph, the examiner points to the language of claim 1 and states that it cannot be determined how the material of the web enables the formation of a new transfer element. We have carefully considered the language pointed to by the examiner but have reached the conclusion that one of ordinary skill could determine the metes and bounds of claim 1 notwithstanding the language noted by the examiner. Use of the term "enables" merely designates that this process uses a structure capable of

performing some function. While broad, this limitation is not indefinite. With respect to claim 10, the examiner states that it cannot be accurately determined if the properties of the web or the spacing between the removal and depositing stations are responsible for the special feature claimed for the apparatus of the claim. In our view, however, the fact that either one of these may be responsible merely denotes that the claim is broad rather than indefinite. Finally, with respect to claim 18, the recitation of a magnetic hardenable material, even if a double inclusion from the hardenable material limitation of claim 10, does not render the claim indefinite, inasmuch as the metes and bounds of the invention can be readily determined.

Turning to the three rejections based on prior art, it is our finding that the prior art of record is silent with respect to the necessity of providing a web with low thermal inertia. The prior art also does not recognize that the low thermal inertia feature is necessary to permit the change of the depositing pattern with each cycle of the web.

Turning to a consideration of the rejection of Kanck in view of Love, we are in agreement with the examiner that Kanck does not teach using an endless web of low thermal inertia or making a new transfer element on the next crossing of the

depositing station. With this admission by the examiner, we are at a loss to see how the examiner can argue that the combined teachings of Kanck and Love would have taught the endless web of low thermal inertia. This is because, as admitted by the examiner, Kanck does not teach low thermal inertia and Love does not use heat to harden the deposited material.[3] Since Love does not use heat, it can in no manner provide a teaching of a web with low thermal inertia.

Turning to a consideration of the rejection of claims 1 and 9 over Kubokawa in view of Kanck and Love, we note that

[3] Love uses a method of coating the entire web and selectively removing the coating by electric spark or laser.

Kubokawa removes the hardenable material using a cleaner and solvent. For this reason, Kubokawa, when considered with the combined teachings of Kanck and Love, cannot add the feature of an endless web with a low thermal inertia. Thermal inertia is of no consideration to Kubokawa in that his hardenable material will be removed by a solvent process.

Similarly, the rejection of claims 10, 11 and 24 as unpatentable over Kubokawa in view of Love cannot be sustained. The combined teachings of Kubokawa and Love can in no manner

teach the low thermal inertia limitation of the independent claim 10.

For these reasons, the rejections of all claims on appeal are reversed.

REVERSED

JAMES M. MEISTER)
Administrative Patent Judge)
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) BOARD OF PATENT
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