

The opinion in support of the decision being entered today was **not** written for publication and 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 TSUKASA MATSUDA, KUNIO SAKURAI, TSUTOMU KURIHARA,
MASARU KATO and HARUMI WATANABE

Appeal No. 1999-2383
Application No. 08/573,487

HEARD: January 8, 2002

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

DECISION ON APPEAL

This is a decision on an appeal pursuant to 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3, 5, 7, 9, 11, 16, 18 and 20, which are the only claims remaining in this application (Brief, page 1).¹

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According to appellants, the invention is directed to an electrophotographic transfer paper comprising a base paper and a coating layer, where the coating layer is provided on at least one side of the base paper and includes a pigment and a binder (Brief, page 2). The pigment used in the coating layer comprises calcium carbonate with an average particle size of 1.5 to 8.0 microns, and the transfer paper has an air permeability (AP) of 10 to 90 seconds, a coefficient of paper-to-paper friction of 0.5 to 0.9 at 28°C. and 85% relative humidity, and a smoothness of 60 to 300 seconds (*id.*). A copy of illustrative independent claim 1 is attached as an Appendix to this decision.

The examiner has relied upon Hosomura et al. (Hosomura), U.S. Patent No. 4,778,711, issued Oct. 18, 1988, as evidence of obviousness. Accordingly, the claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hosomura (Answer, page 3).² We reverse the examiner's rejection for reasons stated

² The rejection, as restated on page 3 of the Answer, actually recites "Hosomura et al-4,778,487." However, the

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on pages 7-9 of the Brief, pages 1-4 of the Reply Brief, and the reasons set forth below.

OPINION

The examiner finds that Hosomura discloses electro-photographic image transfer paper comprising a paper sheet with a coating layer including a binder and a pigment, where the pigment includes both calcium carbonate and kaolin clay with a particle size of 1.5 microns or less (Answer, page 3). The examiner further finds that Hosomura teaches that the transfer paper has a surface roughness of not more than 2 microns, an electrical resistivity of at least about 8×10^8 ohms at 20°C. and a relative humidity of 85%, and an air permeability of less than or equal to 4000 seconds (*id.*).

The examiner concludes that "[a] 103 rejection has been established since the selection of 10-90 seconds in air permeability (AP) has to made [sic] from the range of less than 4000." Answer, page 4. The examiner considers this selection to have been obvious "since the reference does not put particular

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criticality on such a value, while the claimed [sic] is clearly embraced." *Id.* We disagree.

As correctly pointed out by appellants on pages 7-8 of the Brief and pages 2-4 of the Reply Brief, Hosomura qualifies the generic disclosure of an AP of 4000 seconds or less by teaching that, to avoid problems of low strength and drops in the gloss of solid image, the air permeability of the paper should be at least about 600 seconds (see Hosomura, col. 13, ll. 43-52). The examiner states that the reference "clearly establishes the fact that AP under 600 still gives a useable product, it is simply not an optimum product for their specific applications." Answer, page 5. The examiner finds that the examples of Hosomura show AP values of 490 and 450, while the comparative examples show AP values of 200 and 25. *Id.*

The examiner has the initial burden of establishing why one of ordinary skill in this art would have been led to AP values within the claimed range of 10-90 seconds. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The only

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13-14). However, appellants have submitted evidence that "Xerox L" is not a coated paper and thus the AP values are not comparable to those recited for the coated paper of claim 1 on appeal (Brief, page 9; see the Matsuda Declaration under 37 CFR § 1.132 dated Nov. 30, 1998, hereafter the Matsuda Declaration). We do not find any discussion of the Matsuda Declaration in the Answer.

The examiner admits that Hosomura fails to disclose the smoothness or friction limitations required by the claims (Answer, page 3). However, the examiner takes the position that one skilled in the art would expect these values "to be inherent" since "the inventions overlap and can be exactly the same." *Id.*

"Inherency, however, 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." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), quoting from *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). The initial burden rests with the examiner to provide a basis in fact and/or technical reasoning to reasonably

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pigment of Hosomura overlaps the claimed pigment particle size at one endpoint, i.e., 1.5 microns (Answer, page 3). As discussed above, Hosomura teaches away from the claimed AP values. The examiner has not shown by convincing evidence or reasoning, from this one finding that the pigment particle sizes overlap, that the properties of coefficient of friction and smoothness of the Hosomura paper would necessarily be the same as the claimed values.

For the foregoing reasons, based on the totality of the record, we determine that the preponderance of evidence weighs most heavily in favor of patentability in view of the reference evidence. Accordingly, the examiner's rejection of claims 1, 3, 5, 7, 9, 11, 16, 18 and 20 under 35 U.S.C. § 103(a) over Hosomura is reversed.

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The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TEDDY S. GRON)	APPEALS
Administrative Patent Judge)	AND
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THOMAS A. WALTZ)	
Administrative Patent Judge)	

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APPENDIX

1. Electrophotographic transfer paper comprising base paper and a coating layer including a pigment and a binder, said coating layer being provided on at least one side of said base paper, wherein said transfer paper has an air permeability in a range of 10 to 90 seconds, a coefficient of paper-to-paper friction in a range of 0.5 to 0.9 at 28°C and 85% relative humidity, wherein said pigment comprises calcium carbonate having an average particle size in a range of 1.5 μ m to 8.0 μ m, and wherein said transfer paper has a smoothness in a range of 60 to 300 seconds.