Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte EIICHI KATO, SADAO OSAWA, HIROYUKI OHISHI and KAZUO ISHII

Appeal No. 2000-0808
Application No. 08/906,815

ON BRIEF

Before JERRY SMITH, LEVY, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

RELATED APPEAL

This appeal is related to Appeal No. 2000-2258 in Application Serial No. 08/888,759 decided concurrently herewith.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-7, which are all of the claims pending in the present application. An amendment filed February 19, 1999 after final rejection was approved for entry by the Examiner.

The claimed invention relates to a process for preparing an ink-jet system printing plate in which an ink composition that is

solid at ordinary temperatures is heat-melted. An image is formed by spraying droplets of the ink composition in a melted state onto a intermediate transferer and then transferred by contact to the hydrophobic, i.e., water-resistive, surface of a printing plate precursor. Appellants assert (specification, page 4) improved results as compared to a hot-melt type ink-jet system in which a hydrophobic ink image is formed on a water-receptive image receiving layer.

Claim 1 is illustrative of the invention and reads as follows:

1. A process for preparing an ink-jet system printing plate, wherein an image is formed according to a hot melt type ink-jet system by heat-melting an ink composition that is solid at temperatures of 35˚C or lower, spraying droplets of the ink composition in a hot melt state from nozzles onto an intermediate transferrer to form an image, and contact-transferring the image on the intermediate transferrer to an image receiving layer of a planographic printing plate precursor, the image receiving layer being provided on a water-resistive support and containing zinc oxide and a binder resin and having a surface with a water-contact angle of 50˚ or more and thereafter, a nonimage area of the image receiving layer is desensitized by chemical reaction treatment to prepare a planographic printing plate.

The Examiner relies on the following prior art:

Zerillo	4,833,486	May 23, 1989
Schneider et al. (Schneider)	5,072,671	Dec. 17, 1991
Kanda et al. (Kanda)	5,582,106	Dec. 10, 1996 (filed May 11, 1995)
Nakayama et al. (Nakayama)	5,677,098	Oct. 14, 1997 (filed Dec. 27, 1995)
Kato et al. (Kato)	5,714,250	Feb. 03, 1998 (filed Dec. 28, 1995)

Claims 1-7 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Kato in view of Kanda, Zerillo, and Schneider with respect to claims 1-3 and 5-7, and adds Nakayama to the basic combination with respect to claim 4.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs[1] and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the 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] The Appeal Brief (revised) was filed August 24, 1999 (Paper No. 18). In response to the Examiner's Answer dated October 1, 1999 (Paper No. 19), a Reply Brief was filed December 6, 1999 (Paper No. 20), which was acknowledged and entered by the Examiner as indicated in the communication dated December 27, 1999 (Paper No. 21).

1-7. Accordingly, we reverse.

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. 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).

With respect to the Examiner's obviousness rejection of independent claim 1, the sole independent claim on appeal, Appellants' arguments in response assert that the Examiner has failed to establish a prima facie case of obviousness. In particular, Appellants attack (Brief, page 6), the Examiner's reliance on the solid hot-melt ink teachings of Zerillo as providing a teaching to the skilled artisan to utilize a solid ink in the printing plate system of Kato as modified by Kanda.

After careful review of the Zerillo reference in light of the arguments of record, we are in agreement with Appellants' position as stated in the Briefs. As asserted by Appellants, and there is no disagreement by the Examiner, while Zerillo discloses various advantages of using a solid hot-melt ink in a printing plate preparation process, the only disclosed application of such hot-melt ink by Zerillo is onto a hydrophilic, i.e., water-receptive, image receiving layer. The use of a hydrophilic image receiving layer as disclosed by Zerillo is in direct contrast to the hydrophobic, i.e., water-resistive, image receiving layers used by Kato and Kanda, as well as that specifically set forth in appealed claim 1.

While the Examiner suggests (Answer, page 5) that the advantages of using a solid hot-melt ink (e.g. eliminating ink running) exist regardless of whether a hydrophilic or hydrophobic image receiving layer is used, we find no evidence provided by the Examiner to support such a conclusion. The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the conclusion of obviousness. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). Given this lack of evidentiary support, we find ourselves in agreement with Appellants' contention (Brief, page 6) that no suggestion exists in the applied prior art that the improved print qualities achieved by Zerillo exist outside of Zerillo's specific disclosed combination of a hot-melt ink applied to a hydrophilic surface.

Further, in contrast to the lack of evidence supplied by the Examiner to support the conclusion of obviousness, we find clear evidence at Table I at page 41 in Appellants' specification of the improved results achieved with the presently claimed hot melt ink and hydrophobic surface combination as opposed to the hot melt ink and hydrophilic combination disclosed in the prior art. After considering the totality of evidence presented on the record, it is our opinion that any suggestion to modify the printing plate

systems of Kato and Kanda by using the solid hot melt ink composition disclosed by Zerillo could only come from Appellants' own disclosure, and not from any disclosure in the prior art references themselves.

Lastly, we have reviewed the Schneider and Nakayama references which have been applied by the Examiner to address the intermediate transferer and support surface smoothness features of the appealed claims. We find nothing, however, in the disclosures of either of these references which would overcome the innate deficiencies of Kato, Kanda, and Zerillo discussed supra.

In conclusion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of independent claim 1, as well as claims 2-7 dependent thereon, is not sustained. Therefore, the decision of the Examiner rejecting claims 1-7 is reversed.

REVERSED

JERRY SMITH Administrative Patent Judge	)	
JOSEPH F. RUGGIERO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
STUART S. LEVY Administrative Patent Judge	)	

JFR/lp

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JUDGE RUGGIERO

APPEAL NO. 2000-0808

APPLICATION NO. 08/906,815

APJ RUGGIERO

APJ LEVY

APJ SMITH, JERRY

DECISION: **REVERSED**

PREPARED: Jul 22, 2003

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK