

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHADI L. MALHOTRA, BRENT S. BRYANT
and DORIS K. WEISS

Appeal No. 95-3783
Application 08/034,917¹

ON BRIEF

Before KIMLIN, JOHN D. SMITH and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-3, 5-14, 16-22, 25 and 26, all the claims remaining in the present application. A copy of illustrative claim 1 is appended to this decision.

In addition to the admitted state of the prior art, the examiner relies upon the following reference in the rejection of the appealed claims:

¹ Application for patent filed March 19, 1993.

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Nagai

5,013,634

May 7, 1991

Appellants' claimed invention is directed to a recording sheet comprising a base sheet and a phosphonium compound of the recited formula. The claimed sheet finds utility as a receiving element for printed images.

Appellants present separate arguments for patentability for claims 2 and 3. Accordingly, with the exception of claims 2 and 3, all the appealed claims stand or fall together. In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); Ex parte Schier, 21 USPQ2d 1016, 1017-19 (Bd. Pat. App. & Int. 1991). See also 37 CFR § 1.192(c)(7) and (c)(8) (1995).

Appealed claims 1-3, 5-14, 16-22, 25 and 26 stand rejected under 35 U.S.C. § 112, first paragraph.² Claims 1-3, 5-7 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the admitted state of the art found in the present specification. In addition, claims 1, 3, 5, 6, 8-10 and 25 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 unpatentable over Nagai.

² We consider the examiner's statement of the rejection at page 2 of the Answer as under 35 U.S.C. § 103 to be harmless, inadvertent error.

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We consider first the examiner's rejection of the appealed claims under 35 U.S.C. § 112, first paragraph. It is the examiner's position that appellants' amendment to page 8 of the original specification, deleting the language "two coating layers," results in a specification that does not provide descriptive support for the claimed subject matter. According to the examiner, appellants' invention described in the original specification requires two coating layers to be present either on one surface or on both surfaces. In the examiner's opinion, the dip coating process described by Example 1 necessarily results in a coating on each surface of the base, thereby resulting in two coating layers. We will not sustain this rejection because the original sentence in the specification, before amendment, read "[t]he recording sheets of the present invention comprise a substrate and at least two coating layers on one or both surfaces of the substrate." In our view, a reasonable understanding of this sentence is that either one or both surfaces contain two coating layers, i.e., either one surface has two coating layers or both surfaces have two coating layers, totaling four layers, or that each surface has one coating layer, for a total of "two coating layers." The dip coating process exemplified by appellants results in one coating layer on both surfaces, not two

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coating layers on one surface or two coating layers on both surfaces. Moreover, the original claims are not limited to any number of coating layers.

We will sustain the examiner's rejection of claims 1-3, 5-7 and 25 under § 102(b) over the admitted state of the prior art disclosed in the present specification. Appellants' specification acknowledges that the claimed phosphonium compounds are old and within the prior art. Since the appealed claims define a recording sheet comprising only a base sheet and a phosphonium compound, we agree with the examiner that the prior art phosphonium compounds, especially in powder form, as acknowledged by appellants, would necessarily exist in the prior art as coated on a base sheet. As explained by the examiner, conventional preparation of such phosphonium compounds would reasonably include the compounds coated on filter paper or plastic sheets. To the extent the appealed claims broadly define a recording sheet as comprising a base sheet and a phosphonium compound, we agree with the examiner that the prior art bases coated with the phosphonium compounds qualify as a recording sheet. The appealed article claims do not recite any structure which would distinguish the claimed articles from prior art sheets supporting the phosphonium compounds. As for the preambular language of intended use "for receiving printed

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images," we concur with the examiner that filter paper and plastic sheets or bags coated with the phosphonium compounds may receive a printed image.

We will also sustain the examiner's rejection of claims 1, 3, 5, 6, 8-10 and 25 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 over Nagai. Appellants do not dispute the examiner's factual determination that Nagai discloses a recording medium comprising the claimed phosphonium compounds on a base. Nor do appellants dispute that the quantities of phosphonium compound recited in some of the appealed claims overlap the amounts disclosed by Nagai. Consequently, since Nagai discloses a recording sheet comprising the claimed phosphonium compounds on a base, it necessarily follows that the recording medium of Nagai is capable of receiving printed images, although Nagai only discloses the recording of optical information. We are not persuaded by appellants' argument that Nagai is non-analogous art since, as noted, it is reasonable to conclude that the recording sheet of Nagai is fully capable of receiving a printed image, and appellants have advanced no argument or objective evidence to the contrary. The non-analogous art argument is particularly irrelevant since we find that Nagai describes the claimed recording sheet within the meaning of § 102.

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In conclusion, based on the foregoing, the examiner's rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 are sustained, whereas the rejection under 35 U.S.C. § 112, first paragraph, is reversed. Accordingly, the examiner's decision rejecting claims 1-3, 5-10 and 25 is affirmed, and the examiner's rejection of claims 11-14, 16-22 and 26 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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JOHN D. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
THOMAS A. WALTZ)	
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APPENDIX

1. A recording sheet for receiving printed images which comprises (a) a base sheet, (b) a phosphonium compound selected from the group consisting of



wherein R is an alkyl group, X is an anion, and all four R groups are the same:



wherein R is an alkyl group, wherein all three R groups are the same, wherein R is not the same as R', X is an anion, and R' is selected from the group consisting of alkyl groups, substituted alkyl groups, arylalkyl groups, and substituted arylalkyl groups;



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wherein Ar is an aryl group or a substituted aryl group, X is an anion, and all four Ar groups are the same;



wherein Ar is an aryl group or a substituted aryl group, wherein all three Ar groups are the same, X is an anion, and R' is selected from the group consisting of alkyl groups, substituted alkyl groups, arylalkyl groups, and substituted arylalkyl groups; and mixtures thereof, (c) an optional pigment, and (d) an optional binder.

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