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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH A. KRAFT

Appeal No. 96-2161
Application 08/227,024¹

ON BRIEF

Before HAIRSTON, MARTIN, and JERRY SMITH, 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 1-8, which constitute all the claims remaining in the application.

¹ Application for patent filed April 12, 1994.

The disclosed invention pertains to the art of photocopiers. Specifically, the invention relates to a method for copying a developed image from a source material to carbonless paper. A particular feature of the invention is that the carbonless paper is manufactured grain-short. The invention is said to improve the performance of the copier while permitting the use of paper having a lower basis weight.

Representative claim 1 is reproduced as follows:

1. A process for the transfer of an image comprising the steps of:
 - (a) generating a latent image on the surface of an imaging element;
 - (b) developing said latent image with toner;
 - (c) transferring said developed image to the surface of a sheet of carbonless paper manufactured grain-short; wherein said grain-short carbonless paper has a base sheet basis weight of from about 16 lbs to about 20 lbs.

The examiner relies on the following references:

Kraft	4,906,605	Mar. 6, 1990
Camis	5,115,277	May 19, 1992

Green, "Functional paper properties in xerography," Tappi, Vol. 64, No. 5, pages 79-81, May 1981.

Claims 1-8 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Kraft or Kraft in view of Green with respect to claims 1-4 and 8, and the examiner adds Camis with respect to claims 5-7.

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

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief 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 1-8. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 11]. Since there are several different rejections before us, appellant's grouping will be accepted as a representation that all the claims within each rejection will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3

(Fed. Cir. 1983). Accordingly, we will consider the rejections against a single claim from each separate rejection as representative of all the claims on appeal.

We consider first the rejection of claims 1-4 and 8 under 35 U.S.C. § 103 as unpatentable over Kraft or Kraft in view of Green. 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 (CCPA 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).

In applying Kraft alone, the examiner takes the position that the recitation in claim 1 that the carbonless paper is manufactured grain-short is an apparatus limitation which is entitled to little patentable weight in the method of claim 1 [answer, pages 3-4]. Appellant argues that he has provided substantial evidence to the effect that the form of the paper provides substantially new and unexpected results [brief, pages 12-13]. We will not sustain this rejection because the examiner has improperly ignored recitations in the claim.

In a method claim all aspects of each step must be fully considered. We cannot agree with the examiner that the step of transferring an image onto one type of paper is the same as transferring the image onto another type of paper. The method includes performing the transferring step using a specific type of paper, and since that paper forms part of the step, it must be considered for purposes of applying prior art. The examiner argues that the use of grain-short paper does not affect the transfer process, but rather, only affects the sheet feeding aspects of the invention. We find no merit in the examiner's distinction of where the improvement takes place. The claimed method of transferring an image includes everything that takes place between the placement of an original and the creation of a copy. The feeding of sheets for receiving the copies is part of this overall process. Therefore, the improvements noted by appellant are clearly part of the overall process

recited in claim 1. Since the examiner has not properly considered all the recitations of claim 1, we do not sustain this rejection of claims 1-4 and 8.

The examiner also rejected claims 1-4 and 8 under 35 U.S.C. § 103 based on Kraft and Green. This rejection was made by the examiner in recognition that it might be required that all the recitations of claim 1 be considered. Thus, Green is cited by the examiner as a teaching that it may be desirable in some circumstances to feed grain-short paper in a copier. The examiner asserts that it would have been obvious to the artisan to feed the carbonless paper of Kraft grain-short as taught by Green [answer, page 4].

Appellant argues that the Green teachings apply to plain paper copying, and the artisan would have found no motivation to apply Green's teachings to the carbonless paper of Kraft. Appellant notes that the coatings on carbonless paper give the paper properties which are unpredictable with respect to the properties of the plain paper base sheet [brief, page 14]. Appellant also repeats his previous argument that the examiner's obviousness rejection has been rebutted by an extensive showing of substantially improved results for the invention and a statement that such results were unexpected. The examiner responds that appellant's evidence is not persuasive of patentability because the disclosed benefits relate to the benefits of feeding grain-short papers through a copier rather than benefits related to the transfer process itself [answer, page 6].

First, we agree with appellant that Green would not have suggested to the artisan that carbonless paper manufactured grain-short should be used in Kraft's carbonless paper printing system. Green only suggests that the feeding direction of regular paper can affect the performance of the copier. We find nothing in Green or Kraft which suggests that carbonless paper should be manufactured grain-short as recited in claim 1. Second, it was error for the examiner to ignore appellant's evidence of nonobviousness as not related to the transfer process. As we noted above, the feeding of paper is part of the overall process of copying and unexpected benefits can occur anywhere within the process. The examiner should have at least considered the results of appellant's tests on the merits as a secondary consideration of nonobviousness. Therefore, we also do not sustain this rejection of claims 1-4 and 8.

With respect to claims 5-7, the examiner adds the teachings of Camis to Kraft alone or Kraft in view of Green. Since Camis does not make up for the deficiencies noted above in Kraft alone or Kraft in view of Green, we do not sustain either rejection of claims 5-7 under 35 U.S.C. § 103.

In summary, we have not sustained any of the rejections of the examiner under 35 U.S.C. § 103. Accordingly, the decision of the examiner rejecting claims 1-8 is reversed.

REVERSED

Appeal No. 96-2161
Application 08/227,024

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)
) BOARD OF PATENT
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Administrative Patent Judge) APPEALS AND
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