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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEN HASHIMOTO, IZURU MATSUI,
TOSHITAKE YUI and FUMINORI KOIDE

Appeal No. 1997-1004
Application No. 08/095,479[1]

ON BRIEF

Before McKELVEY, **Senior Administrative Patent Judge** and
TORCZON, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 5, 6, 8 and 10-21, which are all of the claims pending in this application.

We REVERSE.

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[1] Application for patent filed July 23, 1993. According to appellants, this application is a continuation of application serial number 07/737,900, filed Jul. 26, 1991, which is a continuation of application serial number 07/487,051, filed Mar. 5, 1990.

BACKGROUND

The appellants' invention relates to a process of printing/recording an image on plain paper and applying pressure to forcibly penetrate the ink into the plain paper. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.[2]

> 1. An ink recording method for forming an image on a plain paper comprising:
>
> printing the plain paper having a weight of from about 60 to 90 g/m^2 with an aqueous ink having a surface tension of 30 to 65 dyne/cm, and
>
> immediately thereafter, within 60 seconds after printing, applying from 1 to 300 Kg/cm^2 pressure on the plain paper, whereby the ink is penetrated forcibly into the plain paper

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Roteman et al. (Roteman)	3,846,151	Nov. 05, 1974
Brenneman et al. (Brenneman)	3,854,975	Dec. 17, 1974
Maekawa et al. (Maekawa)	4,308,542	Dec. 29, 1981
Iwata et al. (Iwata)	4,931,810	Jun. 05, 1990 (Eff. Filing date- Dec. 22, 1987)
Koike et al. (Koike '980)	5,067,980	Nov. 26, 1991 (Eff. Filing date- Dec. 23, 1987)
Koike et al. (Koike '036)	5,257,036	Oct. 26, 1993 (Eff. Filing date- Dec. 01, 1987)
Suzuki	JP-63221046	Sep. 14, 1988

[2] We note that the specification contains a number of spelling and grammatical errors, e.g., "shelf" at p. 4, line 22; "dyne" at p. 6 et seq.; "various", at p. 15, line 24; "Hewlett" at p. 19, line 22.

Claims 1, 3, 5, 8, 14-18 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Suzuki in view of Koike ‘980, Koike ‘036 and Maekawa. Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Suzuki, Koike ‘980, Koike ‘036, and Maekawa, further in view of Brenneman. Claims 10-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Suzuki, Koike ‘980, Koike ‘036, and Maekawa, further in view of Roteman. Claims 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Suzuki, Koike ‘980, Koike ‘036, and Maekawa, further in view of Iwata.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 35, mailed March 17, 1996), the first supplemental examiner's answer (Paper No. 37, mailed June 13, 1996) and the second supplemental examiner's answer (Paper No. 39, mailed August 28, 1996) for the examiner's reasoning in support of the rejections, and to the appellants’ brief (Paper No. 34, filed January 30, 1996), reply brief (Paper No. 36, filed May 20, 1996) and supplemental reply brief (Paper No. 38, filed August 13, 1996) for the appellants’ arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Assuming arguendo that the combination of references is proper, the combination of Suzuki, Koike '980, Koike '036 and Maekawa do not teach or suggest the invention as set forth in the language of claim 1 with respect to "immediately thereafter, within 60 seconds after printing, applying from 1 to 300 Kg/cm^2 pressure on the plain paper, whereby the ink is penetrated forcibly into the plain paper." Appellants argue that Suzuki does not apply a pressure in the claimed range within the claimed time period. (See brief at pages 9-13.) We agree with appellants.

Appellants have provided evidence in a declaration under 37 CFR 1.132 with respect to operation of the various rollers under various pressures and the resultant performance with respect to blurring of the recorded image. (See Hashimoto declaration, paper no.29, filed Sep. 29, 1995; and brief at pages 13-16.)

Appellants argue that

> [t]he Examiner has not made any showing that the ink of Suzuki would have been inherently forcibly penetrated into the [plain] paper because

> there is no teaching or suggestion of a pressure in Suzuki sufficient to achieve such penetration. Suzuki relates to a method of removing excess recording liquid remaining on the recording medium to a roller member. Therefore, this method, does not relate to the present technique of forcibly penetrating ink into paper. Appellants advise that it appears that ink penetrated in paper by Suzuki would be only a spontaneously absorbed portion (not including a forcibly penetrated portion) as in conventional techniques. (Emphasis in original).

(See supplemental reply brief at page 5.) We agree with appellants. Appellants have presented evidence of the operation of the roller member used to remove excess liquid ink as taught by Suzuki. (See Hashimoto declaration at pages 2-4.) The Hashimoto declaration states that the pressure applied by spring 15 in the Suzuki reference is more likely than not to be "close to zero" where no blurring occurs. The examiner has not adequately rebutted this evidence presented by appellants, The examiner merely states that the "spring pressure would inherently be at least 1 Kg/cm[^{2}] in order to form a removing contact. It is noted that a pressure of 1 Kg/cm[^{2}] is approximate[ly] atmospheric pressure. Thus, the claimed application of pressure is suggested by Suzuki." (supplemental answer, page 2). We disagree with the examiner. The Federal Circuit recently discussed inherency and whether an aspect of a claimed invention would be necessary from the disclosure in **In re Robertson**,169 F.3d 743, 745, 49

USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Federal Circuit stated "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is

necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' " (citing **Continental Can Co. v. Monsanto Co.**, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991).) The Federal Circuit further stated "[i]herency, 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." **Id.** at 1269, 20 U.S.P.Q.2d at 1749 (quoting **In re Oelrich**, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).) Clearly, from the factual evidence as presented by the examiner and the evidence presented by appellant in the Hashimoto declaration, it would not be "necessary" that the pressure applied to the plain paper be in the range of "1 Kg/cm^2 to 300 Kg/cm^2" as set forth in the language of claim 1. The examiner further states that "Suzuki does not specify particulars as to the type of ink, paper, pressure or time used. One of ordinary skill in the ink jet art, seeking to make and use the Suzuki method would be motivated by the lack of such particulars to employ well known specifics found in the ink jet art. The secondary references . . . are cited to evidence the claimed ink, paper, pressure, time, etc. are known." (See answer at page 5.) We disagree with the examiner. Appellants

argue that the examiner is "picking and choosing" from the references and using the claimed invention as a template to reconstruct the claimed invention from the prior art references. (See brief at page 18.) We agree with appellants.

Furthermore, the additional references applied by the examiner against independent claim 1 do not remedy the deficiencies in Suzuki. The Maekawa reference does not teach or fairly suggest the application of the claimed pressure to plain paper, but only to synthetic pulp paper. (See Maekawa at col. 6.) Similarly, the Koike ‘980 and ‘036 references do not teach or suggest the application of the claimed pressure to forcibly penetrate ink into plain paper. The examiner maintains that the rubbing as disclosed by Koike would have been a disclosure of the application of pressure within a set time period. (See supplemental examiner’s answer at page 1; and second supplemental examiner’s answer at page 1.) We agree with this statement by the examiner, but disagree that the disclosure of Koike ‘980 or Koike ‘036 would have taught or suggested the application of a pressure within the claimed range of pressures and within the time period to forcibly penetrate the ink into plain paper. Therefore, we will not sustain the rejection of claim 1 or its dependent claims 3, 5, 8, 14-18 and 21.

Similarly, the additional references to applied Roteman, Brenneman, and Iwata do not remedy the deficiencies in the above combination. Therefore, we will not sustain the rejection of claims 6, 10-13, 19 and 20.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 5, 6, 8 and 10-21 under 35 U.S.C. § 103 is reversed.

REVERSED

FRED E. McKELVEY Senior Administrative Patent Judge	)
RICHARD TORCZON Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)

vsh

FINNEGAN, HENDERSON, FARABOW
GARRETT and DUNNER
1300 I STREET, N.W.
WASHINGTON, DC 20005-3315