

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 SERGE TAVERNIER, WERNER OP DE BEECK,
JEAN-PIERRE GHEKIERE, and MICHEL VERVOORT

Appeal No. 1998-2128
Application No. 08/628,281

ON BRIEF

Before GARRIS, PAK, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-11. Claim 1-12 are all of the claims pending in the application.¹

We AFFIRM.

1 Appellants indicate that the examiner acknowledged allowable subject matter in claim 12. The office action of Paper No. 10, on page 5, indicates that claim 12 has been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Hence, the status of claim 12 remains as being objected to by the examiner.

BACKGROUND

Appellants' invention is illustrated by claim 1, reproduced below:

1. Dry toner particles comprising a toner resin, wherein:
 - (i) said toner resin includes a mixture of two polymers (A and B), said polymers A and B being chosen such that an extruded slab with thickness 250 μm of a 50:50 mixture of both has a transmission density (D_M) being between 0.10 and 1.00 higher than the sum of half the transmission density of a 250 μm extruded slab of polymer A alone (D_A) and half the transmission density of a 250 μm extruded slab of polymer B alone (D_B),
 - (ii) said polymer A being a polyester and said polymer B being a polyester or a styrene-acrylic copolymer having a styrene content of more than 70 mol % and a weight average molecular weight (M_W) such that $7,000 < M_W < 50,000$,
 - (iii) said polymers A and B, included in said toner resin, are mixed in a weight ratio 5:1 to 1:5 and
 - (iv) said mixture of said two polymers A and B makes up at least 25 % by weight of said toner resin.

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

Horie	4,837,138	Jun. 06, 1989
Morimoto et al. (Morimoto)	5, 234, 787	Aug. 10, 1993

Claims 1-4, 6, and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Horie.

Claims 1-4 and 6-11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Morimoto.

Claims 1-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morimoto.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer for the examiner's complete reasoning in support of the rejections, and to the appellants' brief and reply brief for appellants' arguments thereagainst.

OPINION

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

Appellants submit that the claims do not stand or fall together, and group the claims as follows: Group I: claims 1-6, and Group II: claims 7-11 (brief, page 4). The examiner does not disagree with this grouping. (answer, page 2). Hence, we consider claims 1 and 7. 37 CFR § 1.192(c)(7) and (c)(8)(1997).

I. The rejection of claims 1-4, 6, and 7 under 35 U.S.C. § 102(b) as being anticipated by Horie

Appellants argue that the examiner's reasoning in reaching his conclusions (for example, that the weight average molecular weight of the styrene polymer of Horie inherently meets appellants' claim) are conjecture. (reply brief, page 2).

We note, however, that Horie's Example 7 discloses a composition prepared from 2 polyesters in amounts as recited in appellants' claim 1 (column 10, example 7). The similarities

between the blend of Example 7 and the mixture recited in appellants' claim 1 are notable.

In this context, with regard to the functional limitations of claim 1 (transmission density) and of claim 7 (polar character), we note that where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require appellants to prove that the subject matter shown in the prior art does not necessarily possess the characteristics relied on. In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ 2d, 1429, 1432 (Fed. Cir. 1997); *See also*, In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); and Ex Parte Gray, 10 USPQ2d 1922, 1925 (Bd. Pat. App. & Int. 1989).

Here, appellants argue at length that Horie's mixture is not their claimed mixture. (brief, pages 7-8). However, we find that Horie's Example 7 concerns a blend of polyester A and polyester B that appears to be identical or substantially identical to appellants' claimed mixture. In view of this similarity, proof, as discussed above, is needed to obviate the *prima facie* case of anticipation.

In absence of such proof, we affirm the examiner's rejection.

II. The rejection of claims 1-4, 6-11 under 35 U.S.C. § 102(e) as being anticipated by Morimoto

Appellants argue that the polyesters in Morimoto must have a softening point of at least 10°C apart, and that one of the polyesters is non-linear, while the other polyester is linear.

(brief, page 8). Again, we find such comments insufficient to rebut the examiner's *prima facie* case of anticipation in view of the apparent similarities between the blend set forth in Morimoto and appellants' claimed mixture. We reiterate that with regard to the functional limitations of claim 1 (transmission density) and of claim 7 (polar character), when the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require appellants to prove that the subject matter shown in the prior art does not necessarily possess the characteristics relied on. In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ 2d, 1429, 1432 (Fed. Cir. 1997); *See also*, In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); and Ex Parte Gray, 10 USPQ2d 1922, 1925 (Bd. Pat. App. & Int. 1989).

Absent such proof, we affirm the rejection.

III. The rejection of claims 1-11 under 35 U.S.C. § 103 as being unpatentable over Morimoto

The examiner's position is that the claimed ratio amount of 50:50 in appellants' claim 5 would have been obvious to achieve appellants' results. (answer, page 6). Appellants argue that the examiner does not provide a basis for such a conclusion. (brief, page 9).

In the instant case, absent evidence to the contrary, we find that the skilled artisan would have known to use the claimed ratio amount recited in claim 5 because Morimoto suggests that the ratio amount is a result effective variable for optimizing

the properties of the polymers as disclosed at column 8, lines 60-68 and at column 3, lines 19-24 of Morimoto. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Here, because appellants have not provided rebuttal evidence to obviate the *prima facie* case, we also affirm this rejection.

CONCLUSION

The rejections of record are affirmed.

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

AFFIRMED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
BEVERLY PAWLIKOWSKI)	
Administrative Patent Judge)	

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	Copies
APJ PAWLIKOWSKI	_____
APJ PAK	_____
APJ GARRIS	_____

DECISION: **AFFIRMED**

Prepared By: Team 7

DRAFT TYPED: 03 Jun 03

FINAL TYPED: