

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YAPPING TAN

Appeal No. 98-2743
Application No. 08/504,100¹

ON BRIEF

Before MEISTER, ABRAMS, and GONZALES, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON A PPEAL

Yapping Tan (the appellant) appeals from the final rejection of claims 19-23. Claims 1-7, the only other claims present in the application, stand withdrawn from further consideration by the examiner under the provisions of 37 CAR § 1.142(b) as being directed to a nonelected invention.

¹ Application for patent filed July 19, 1995.

We REVERSE.

The appellant's invention pertains to a porous inking member for impact printers. Independent claim 19 is further illustrative of the appealed subject matter and a copy thereof may be found as an attachment to the brief under the heading of "CLAIMS ON APPEAL."

The references relied on by the examiner are:

Muller 1983	4,410,643	Oct. 18,
Sonobe et al. 1992 (Sonobe)	5,099,759	Mar. 31,

The appellant's admitted prior art depicted in Fig. 2 and described on pages 1, 2 and 6-9 of the specification (AAPA).

The claims on appeal stand rejected under 35 U.S.C. § 103(a) in the following manner:

(1) Claims 19-23 as being unpatentable over AAPA in view of Sonobe and Muller; and

(2) Claims 19-23 as being unpatentable over AAPA in view of Sonobe.

With respect to Rejection (2) the answer states that:

AAPA teaches the invention except for the porous ink member containing a peptizer. Muller teaches adding peptizer during the mixing process in order to aide [sic, aid] in the process of masticating the rubber

compound. It would have been obvious to one of ordinary skill in the art at the time of invention to have added peptizer to the porous ink member of AAPA, in light of the teachings of Muller, in order to increase the flexibility of the porous ink member and to facilitate mastication of the compound. Note that the starting form of the nitrile rubber in the process of manufacture thereof lends no patentable weight to the final inking member produced. [Page 4.]

With respect to Rejection (1), the examiner takes essentially the same position regarding the combined teachings of AAPA and Muller, but further relies on Sonobe for a teaching of using nitrile rubber in liquid form during the manufacture of an ink transferring surface.

We will not sustain either of these rejections. We initially note that the rejections are unclear as to whether the examiner intends to substitute peptizer (and liquid nitrile rubber in the case of Rejection (1)) for the volatile organic solvent in AAPA in view of the teachings of Muller (and Sonobe in the case of Rejection (1)), or whether the examiner simply intends to additionally add these components to AAPA, while still retaining the volatile organic solvent. In either case, we will not support the examiner's position.

The examiner's reference to "the starting form of the nitrile rubber in the process of manufacture lends no patentable weight to the final inking member produced" is presumably based upon the fact that a claim to a product drafted in product-by-process format is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. **See, e.g., *In re Thorpe***, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). The problem here, however, is that the resulting product is not the same. As the appellant has argued on page 5 of the brief:

In the prior art processes discussed in the specification on pages 1 and 2 and Figure 2 [i.e., AAPA], organic solvents are used to assist in masticating and swelling rubber for the incorporation of sodium nitrate. These organic solvents are removed before molding and leaching sodium nitrate from the rubber. Therefore, the organic solvent used is not present in the molded article such that the amount used does not significantly affect the properties of the molded porous articles. In contrast, peptizers [i.e., the peptizing agents] are not evaporated before molding a nitrile rubber or leaching the sodium nitrate therefrom such that the composition of molded/leached articles obtained from peptized nitrile rubber is distinct from the molded/leached articles prepared using a solvent.

In other words, in the claimed process of making the porous inking member the peptizing agents remain as a component of the finally formed porous inking member.

As the examiner apparently recognizes, there are no peptizing agents or peptizers in the porous inking member produced by the process of AAPA. In an attempt to overcome this deficiency, the examiner has relied on Muller for a suggestion of utilizing a peptizing agent in the process of AAPA in order masticate the nitrile rubber compound. Muller, however, is directed to making **erasable ball-pen inks** that include the steps of (a) selecting elastomeric material from synthetic rubbers not having the chemical structure of natural rubber, (b) masticating the selected elastomeric material by subjecting the same to high shearing stress (e.g., in a rubber mill), (c) coloring the masticated elastomeric material and (d) mixing the colored masticated elastomeric material with a solvent (see col. 4., lines 23-42). While Muller vaguely indicates that it is "helpful" during mastication of the elastomeric material by a two-roll rubber mill to add a peptizing agent or peptizer (see col. 6, lines 28-36), we do not find the vague teaching that a peptizer is "helpful" in

such a disparate context to be fairly suggestive of either (1) adding a peptizer or peptizing agent to the process of AAPA (while still retaining the volatile organic solvent) or (2) substituting a peptizing agent or peptizer for the volatile organic solvent of the process of AAPA.

As to Rejection (1), the examiner has additionally relied on Sonobe for a teaching of utilizing nitrile rubber in liquid form in the manufacture of an ink transferring surface, but this reference does nothing to overcome the deficiencies of AAPA and Muller that we have noted above.

The examiner's rejections of claims 19-23 under 35 U.S.C. § 103(a) are both reversed.

REVERSED

JAMES M. MISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN F. GONZALES)	
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