

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUO TSUBUKO
and TUYOSHI ASAMI

Appeal No. 2001-1568
Application No. 09/099,078

HEARD: JULY 11, 2002

Before OWENS, LIEBERMAN and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-10. Claims 1-10 are all of the claims pending in this application.

The subject matter on appeal is represented by claim 1, set forth below:

1. An image forming process, comprising:
 - (a) contacting a latent image-bearing surface of a supporting member with a toner-containing liquid developer to develop said latent image with said liquid developer and to form a toner image covered with a layer of said liquid developer;

(b) treating a toner image-bearing surface with a squeezing member to squeeze said liquid developer layer therefrom; then

(c) treating said toner image-bearing surface with a voltage impressing member to impart a bias voltage to said-toner image; then

(d) transferring said toner image from said surface to an intermediate transfer medium; and then

(e) transferring said transferred toner image from said intermediate transfer medium to a transfer medium.

The references relied upon by the examiner as evidence of obviousness are:

Thompson	5,300,990	Apr. 5, 1994
Yoshino et al. (Yoshino)	5,666,616	Sep. 9, 1997
Kusaba et al. (Kusaba)	5,715,510	Feb. 3, 1998

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshino in view of Kusaba.

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshino in view of Kusaba, and further in view of Thompson.

For the reasons set forth in the brief, reply brief, and below, we will reverse each of the above-noted rejections.

OPINION

We go directly to the rebuttal evidence provided by appellants because we find the evidence rebuts a prima facie case of obviousness, for the following reasons even if one were to have been established.

Beginning on page 6 of the brief, appellants refer to (1) Table 3 on page 22 of the specification, and (2) the Declaration of July 10, 2000. Upon our review of this evidence, we conclude that we agree with appellants' assessment of this evidence as set forth on pages 7-8 of the brief. We further agree with appellants' comments regarding the examiner's position taken concerning the Declaration of July 10, 2000. That is, we agree that appellants' burden is not to compare their invention with the invention of Yoshino in view of Kusaba; rather appellants' burden is to compare their invention with the closest prior art. In re Merchant, 575 F.2d 865, 869, 197 USPQ 785, 788 (CCPA 1978); In re Blondel, 499 F.2d 1311, 1317, 182 USPQ 294, 298 (CCPA 1974); In re Swentzel, 219 F.2d 216, 220, 104 USPQ 343, 346 (CCPA 1955).

Table 3 on page 22 of appellants' specification is also set forth in the Declaration of July 10, 2000. In Table 3, Example I is representative of appellants' claimed invention. The procedure utilized in Example 1 is set forth on page 19 of the specification. This procedure involves the steps recited in appellants' claim 1. That is, the image forming device as shown in appellants' Figure 1 is used and a liquid developer is used to contact the surface to develop a latent image. The intermediate transfer member 9 of Figure 1 is also used.

On page 7 of the Declaration of July 10, 2000, appellants indicate that comparative Example 2 is representative of Yoshino. Comparative Example 2 omits the use of an intermediate transfer member. Comparative Example 3 omits both the intermediate transfer member and the voltage impressing roller.

Table 3 indicates that Example 1 achieves a resolution of 8.2 lines/mm, whereas comparative Example 2 achieves a resolution

of 7.2 lines/mm, and comparative Example 3 achieves a resolution of 6.4 lines/mm. Also, Example 1 achieves an image density of 1.40, whereas comparative Example 2 achieves an image density of 1.28, and comparative Example 3 achieves an image density of 1.25.

Appellants characterize the aforementioned results on page 7 of the Brief. Here, appellants indicate that from the comparison of the results of Example 1 with the results of Comparative Example 2, it is clear that the present process affords surprisingly superior uniformity image density and resolution as compared to the process of Yoshino, and thus one skilled in the art would have no motivation to expect such improvements from Yoshino.

The examiner, meanwhile, states, on page 14 of the answer, that appellants fail to rebut the obviousness rejections because appellants fail to make a comparison between their invention and the image forming process of Yoshino in combination with the intermediate transfer step of Kusaba. Hence, the examiner is requiring that appellants compare their invention with their invention (assuming that Yoshino view Kusaba set forth appellants' invention). This is in error because appellants' burden is to compare their invention with the closest prior art. Id. Because the examiner has not correctly or convincingly explained that appellants' rebuttal evidence fails to rebut a prima facie case, we cannot sustain the examiner's rejections.

Therefore, the rejections of record are reversed.

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CONCLUSION

In view of the above, we reverse each of the art rejections of record because we find that the comparative testing conducting by appellants is sufficient evidence to rebut a prima facie case.

REVERSED

Terry J. Owens)	
Administrative Patent Judge)	
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Paul Lieberman)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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