

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte YOSHIO KANAMORI

Appeal No. 2002-0146
Application No. 09/110,128

HEARD:
January 22, 2003

Before JERRY SMITH, RUGGIERO, and BARRY, 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 final rejection of claims 1-7, which constituted all the claims in the application. An amendment after final rejection was filed on March 30, 2001 and was entered by the examiner. This amendment added claims 8 and 9. Therefore, this appeal is directed to the rejection of claims 1-9.

The disclosed invention pertains to a master making device, including a thermal head including a plurality of heating

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elements arranged in an array in a main scanning direction, and a platen roller forming a nip between the platen roller and the thermal head and adapted for pressing a stencil.

Representative claim 1 is reproduced as follows:

1. A master making device, comprising:
a thermal head including a plurality of heating elements arranged in an array in a main scanning direction; and
a platen roller forming a nip between said platen roller and said thermal head and adapted for pressing a stencil, said platen roller being rotatable and adapted for moving a stencil in a subscanning direction perpendicular to the main scanning direction;
wherein a position of said array in the subscanning direction is downstream by 0.2 mm to 0.8 mm from a center of said platen roller in the subscanning direction and wherein said array is located entirely in a perpendicular projection of an area formed by said nip to thereby reduce a length of a perforated portion of the stencil to be moved in said nip.

The examiner relies on the following references:

Iwakawa et al. (Iwakawa)	JP 3-175056	July 30, 1991
Kobayashi	JP 7-156520	June 20, 1995

The admitted prior art described in appellant's specification.

Claims 1-9 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers the admitted prior art in view of Iwakawa with respect to claims 1, 4 and 7-9, and the examiner adds Kobayashi with respect to claims 2, 3, 5 and 6.

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 rejections 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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-7. We reach the opposite conclusion with respect to claims 8 and 9. Accordingly, we affirm-in-part.

Appellant has indicated that for purposes of this appeal the claims will stand or fall together in the following three groups: Group I has claims 1-3, Group II has claims 4-7, and Group III has claims 8 and 9 [brief, page 4]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims within each group. Accordingly, all

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the claims within each group 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).

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 (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).

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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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1, 4 and 7-9 based on the admitted prior art and Iwakawa. The examiner has indicated how he finds the invention of these claims to be obvious over the admitted prior art and Iwakawa [answer, page 3]. With respect to claim 1, appellant argues that the deviation of the center line of the thermal head from the axis of the platen roller in the claimed range solves a different problem than the

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deviation disclosed by Iwakawa. Thus, appellant argues that the claimed invention is patentable over the admitted prior art and Iwakawa because the claimed invention solves a completely different problem than the device of the applied prior art. Appellant also argues that he has shown that the claimed range is critical by showing that the claimed range achieves unexpected results relative to the range disclosed in the applied prior art [brief, pages 5-9]. The examiner responds that it is enough that Iwakawa teaches a range which overlaps or touches the claimed range. The examiner also responds that the criticality argument is not persuasive because the applied prior art discloses a deviation of the array within or touching the claimed range [answer, pages 4-5].

We will sustain the examiner's rejection of claim 1. Appellant's argument that the deviation of the heating array in Iwakawa is made for a different reason than in the claimed invention is not persuasive. Regardless of the reason for moving the heating array, the invention of claim 1 includes within its scope structures which are clearly taught by Iwakawa. The test for obviousness is whether the references would have suggested doing what appellants have done. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Thus, the absence of express

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suggestion or motivation in the applied prior art is not alone determinative. The prior art need not suggest solving the same problem set forth by appellants. In re Dillon, 919 F.2d 688, 692-693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc) (overruling in part In re Wright, 848 F.2d 1216, 1220, 6 USPQ2d 1959, 1962 (Fed. Cir. 1988)), cert. denied, 500 U.S. 904 (1991). Under the facts of this case, the prior art would have suggested moving the heating array downstream from the center of the platen even though the prior art moves the heating array in order to solve a different problem than the problem disclosed by appellant.

Thus, Iwakawa discloses moving the heating array downstream by 0.1-0.3 mm whereas claim 1 recites moving the heating array downstream by 0.2-0.8 mm. The range disclosed in Iwakawa, therefore, overlaps with the range of claim 1. As noted by the examiner, the overlapping of ranges is sufficient to establish a prima facie case of obviousness. Appellant's application presents a table in Figure 9 which shows that the range from 0.2-0.8 mm produces no unacceptable results with respect to the parameters of image dimension reproducibility, creasing, and local image omission. Appellant argues that this table is evidence of the criticality of the claimed range and

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that this claimed range achieves unexpected results relative to the prior art range. With respect to the criticality argument, the examiner has essentially ignored this data because the examiner finds that the prior art discloses a range within or touching the claimed range [answer, pages 4-5].

It was improper for the examiner to fail to consider the data submitted by appellant and appellant's arguments related to criticality and unexpected results. The overlapping ranges of the prior art and the claimed invention only establish a prima facie case of obviousness which can be overcome by appellant with evidence showing non-obviousness. Thus, appellant's evidence must be considered to determine if it overcomes the prima facie case of obviousness.

Despite the examiner's failure to consider the data submitted by appellant, we find that the evidence filed as part of appellant's specification does not establish the criticality of the claimed range nor does the data demonstrate that the results obtained over the claimed range are unexpected. The table of data merely indicates whether or not the movement of the heating array downstream from the center of the platen roller for certain distances produced desired, acceptable or unacceptable

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results. There is no discussion of what criteria were used to determine whether a given result was acceptable or not. There is also no comparison of the submitted data with equivalent tests using the prior art devices. The range described in Iwakawa may be limited to the desirable range rather than an acceptable range as used by appellant. Without a comparison of the claimed device with the prior art device and without a discussion of what type of result is deemed acceptable, there can be no determination made as to whether or not the data submitted in appellant's Figure 9 constitutes unexpected results for the claimed range. Therefore, appellant's arguments fail to overcome the examiner's prima facie case that the invention of claim 1 would have been obvious to the artisan over the applied prior art. Since claims 2 and 3 are grouped with claim 1, we sustain the examiner's rejection of claims 1-3.

With respect to claims 4-7, appellant argues that Kobayashi does not overcome the deficiencies of Iwakawa discussed above. Thus, appellant argues that these claims are patentable for the same reasons discussed above with respect to claim 1 [brief, pages 9-10].

Since appellant essentially relies on the patentability of claim 1 for these claims, and since we have determined that

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claim 1 is not patentable over the applied prior art for reasons discussed above, we also sustain the rejection of claims 4-7 for the reasons discussed above with respect to claim 1.

With respect to claims 8 and 9, appellant again notes that Kobayashi does not overcome the deficiencies of Iwakawa discussed above, however, Kobayashi was not applied in the rejection of claims 8 and 9. Appellant also argues that the applied prior art does not disclose or suggest moving the array downstream from the center of the platen roller by a range greater than 0.3 mm to 0.8 mm as claimed [brief, page 10].

The examiner never specifically addresses this limitation. In the rejection the examiner simply states that ranges that touch can render the claimed invention obvious [answer, page 3]. This statement is not understood because the claimed range of greater than 0.3 mm to 0.8 mm does not touch the range of Iwakawa which is 0.1 mm to 0.3 mm. In the answer the examiner simply states that the prior art need only disclose a range overlapping or touching the claimed range [id., page 4]. As just discussed, however, the claimed range does not overlap or touch the range disclosed in Iwakawa. Finally, the examiner states that the artisan would have a reasonable degree of expectation that numbers touching or only very slightly outside

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of the disclosed range would provide beneficial results [id., page 5].

We are of the view that the examiner's rejection of claims 8 and 9 fails to establish a prima facie case of obviousness. The examiner has failed to provide any support for his position that the non-overlapping and non-touching range of claims 8 and 9 would have been obvious over the range of Iwakawa. As argued by appellant, the range in Iwakawa is determined to solve a completely different problem than the range of the claimed invention. The examiner has provided no evidence or persuasive arguments as to why it would have been obvious to the artisan to move the array in Iwakawa outside the disclosed range. There is no reason to expect a beneficial result outside the range disclosed by Iwakawa. Since the examiner has not properly considered the range as claimed in claims 8 and 9, we do not sustain the examiner's rejection of these claims.

In summary, we have sustained the examiner's rejection of claims 1-7, but we have not sustained the rejection of claims 8 and 9. Therefore, the decision of the examiner rejecting claims 1-9 is affirmed-in-part.

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

AFFIRMED-IN-PART

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Joseph F. Ruggiero)	
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