

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID H. PAN,
SANTOKH S. BADESHA,
ANTHONY YEZNACH
and
TREVOR J. SNYDER

Appeal No. 2004-2305
Application 10/177,910

ON BRIEF

Before KIMLIN, KRATZ, 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 1-20. Claims 1 and 9 are representative of the subject matter on appeal and are set forth below:

1. An offset printing apparatus for transferring a phase change ink onto a print medium comprising:

- a) a phase change ink component for applying a phase change ink in a phase change ink image;
- b) an imaging member for accepting said phase change ink image from said phase change ink component, and transferring the phase change ink image from said imaging member to said print medium, the imaging member comprising:
 - i) an imaging substrate, and thereover
 - ii) an outer coating comprising a silicone material and a Q-resin.

9. The offset printing apparatus of claim 1, wherein said outer layer has a hardness of from about 10 Shore D to about 60 Shore D.

The examiner relies upon the following references as evidence of unpatentability:

Titterington et al. (Titterington)	5,372,852	Dec. 13, 1994
Bui et al. (Bui)	5,389,958	Feb. 14, 1995
Henry et al. (Henry)	5,933,695	Aug. 3, 1999

Claims 1-8 and 10-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Titterington in view of Henry.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Titterington in view of Henry and further in view of Bui.

We consider claims 1 and 9 in this decision. We note that on page 5 of the brief, appellants group claims 1-8 and 10-20 together and claim 9 separately.

We have carefully reviewed appellants' brief and reply brief and the answer and the applied art. This review has lead us to conclude that each of the rejections is well-founded.

OPINION

I. The rejection of claims 1-8 and 10-20 under 35 U.S.C. § 103

We refer to the examiner's position regarding this rejection made on pages 3-7 of the answer. On page 5-11 of the brief, appellants argue this rejection. Appellants argue that Henry is not in the same field of endeavor and is nonanalogous art. Appellants also argue that as such, there would have been no expectation of success that an outer layer taught as useful for a rapid wake-up fuser member in an electrostatographic apparatus as taught by Henry would work well as an outer layer for an imaging member for a phase change ink apparatus as taught by Titterington. We refer to the examiner's rebuttal made on pages 8-9 of the answer and incorporate the examiner's position therein as our own, and add the following for emphasis.

We agree with the examiner that each of the references involves the use of rollers as supporting surfaces. The determination that a reference is from a nonanalogous art is two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

Following this test, one concerned with a printing apparatus would be chargeable with knowledge of Titterington and Henry. The apparatus in each of these references includes rollers. See, for example, Figure 13 of Titterington and Figures 1 and 2 of Henry. We are unpersuaded by appellants' comments that the examiner has broadened the field of endeavor outside the specific industry to include the use of all roller as a supporting surface. Hence, we agree with the examiner that the applied references are analogous art.

Furthermore, we disagree with appellants' comments made at the bottom of page 8 of the brief where appellants argue that there is no suggestion or motivation to modify or combine Titterington in view of Henry. As pointed out by the examiner on page 7 of the answer, Henry provides sufficient motivation (when a key resin is added to a silicon material, it accesses as a reinforcing agent that may cross-link with the silicon material making it more stable and increasing its strength, column 4, lines 42-46). One skilled in the art, charged with this knowledge, would have been motivated to add a key resin to the silicon material of Titterington to improve the stability and strength of the outer coating of Titterington. We appreciate appellants' arguments regarding that Titterington involves a phase change ink apparatus, whereas Henry involves a xerographic apparatus. However, these arguments are not persuasive as the motivation provided by the examiner is applicable to an apparatus utilizing an outer coating made of silicon material whether that apparatus is used for transferring a phase change ink or whether it is used for charging tone material. In either system, addition of the Q-resin ultimately improves the shelf-life of the silicon material by improving its stability and increasing its strength.

In view of the above, we therefore affirm the 35 U.S.C. § 103 rejection of claims 1-8 and 10-20 as being obvious over Titterington in view of Henry.

II. The 35 U.S.C. § 103 rejection of claim 9

We refer to page 7 of the answer regarding the examiner's position for this rejection.

Claim 9 requires that the outer layer has a hardness from about 10 Shore D to about 60 Shore D. On page 11 of the brief, appellants refer to the same arguments presented with regard to the previously mentioned rejection. Our response therefore is the same as discussed above. Appellants further argue that it would have been

obvious to have substituted the hardness of the layer of a pressure roller as taught by Bui as the hardness for the imaging member of the phase change ink machine as taught by Titterington. Brief, page 12. We are not persuaded by this argument. As pointed out by the examiner on page 10 of the answer, the teaching relied upon in Bui was used to illustrate that Shore D values of 40-45, for example, are characteristic of such coatings. Furthermore, absent evidence of criticality, the particularly claimed Shore D values recited in claim 9 are deemed obvious design expedients.

In view of the above, we therefore affirm the 35 U.S.C. § 103 rejection of claim 9 as being obvious over Titterington in view of Henry further in view of Bui.

III. Conclusion

Each of the rejections is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective Sept. 13, 2003; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat., Office 21 (Sept. 7, 2004)).

AFFIRMED

Edward C. Kimlin)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Peter F. Kratz)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
Beverly A. Pawlikowski)	
Administrative Patent)	
Judge)	

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