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for publication and is not binding precedent of the Board.

# UNITED STATES PATENT AND TRADEMARK OFFICE

---

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

---

Ex parte NOBUFUMI MORI
and
TAKASHI NAKAMURA

---

Appeal No. 2005-1229
Application No. 09/887,334

---

ON BRIEF[1]

---

Before FRANKFORT, PATE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13 to 16 and 19 to 22. Claims 1 to 12 have been withdrawn from consideration. Claims 17, 18 and 23 to 25, which are all of the other claims pending in this application, have been objected to as depending from a non-allowed claim.

We REVERSE.

---

[1]The hearing scheduled for September 13, 2005 has been vacated in view of this decision.

## BACKGROUND

The appellants' invention relates to a planographic printing method, an original printing plate and a planographic printing press. In particular, the appellants' invention relates to a simplified planographic printing method for making plates without any development, an original printing plate used therefor, and a printing press therefor (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellants' brief. Claim 13, the only independent claim under appeal, reads as follows:

> A planographic printing press, comprising:
> a mounting section which mounts an original printing plate having photo catalyst power;
> a processing section which hydrophobically processes the entire surface of said original plate on which a layer of a hydrophobic substance is provided;
> an activation light irradiation section which irradiates activation light one of on said original printing plate carrying the layer of said hydrophobic substance as per image and on the entire surface thereof;
> means for heating said original plate during irradiating said activation light so that the temperature of the surface of said original plate becomes 40 through 200°C one of as per image and on the entire surface thereof, so that a hydrophobic area and a hydrophilic area are formed on said original plate;
> a section which supplies ink to said hydrophobic area and which supplies a damping solution to said hydrophilic area; and
> a printing section which prints by bringing a printing surface, on which said hydrophobic area accepts the ink and said hydrophilic area accepts the damping solution, into contact with a surface to be printed.

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

| | | |
|---|---|---|
| Nakayama et al. (Nakayama) | US 6,048,654 | Apr. 11, 2000 |
| Suda | JP 2000-062335[2] | Feb. 29, 2000 |

Claims 13, 16 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Suda.

Claims 14, 15, 19, 21 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Suda in view of Nakayama.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (mailed June 25, 2003) and the answer (mailed March 15, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed January 26, 2004) and reply brief (filed May 7, 2004) for the appellants' arguments thereagainst.

---

[2]In determining the teachings of Suda, we will rely on the computer generated translation, of record, provided by the Japan Patent Office.

OPINION

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

**The anticipation rejection**

We will not sustain the rejection of claims 13, 16 and 20 under 35 U.S.C. § 102(b).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

The appellants argue that the "means for heating" limitation of claim 13 is not disclosed by Suda. In particular, the appellants point out that although Suda discloses a

dryer (at 17 in Figure 6), that dryer fails to perform the claimed function (i.e., "for heating said original plate during irradiating said activation light so that the temperature of the surface of said original plate becomes 40 through 200°C one of as per image and on the entire surface thereof, so that a hydrophobic area and a hydrophilic area are formed on said original plate").

The examiner argues that the recitation of heating the plate "during" irradiating does not distinguish the claimed "means for heating" from the dryer disclosed by Suda since both heat the surface of the plate. The examiner determined that the dryer disclosed by Suda is structurally capable of heating the plate during irradiating to the extent that the claimed means for heating is structurally capable of heating the plate during irradiating. In short, it is the examiner's position that the appellants have misconstrued the function of the means for heating so that the means for heating does not distinguish from the dryer disclosed by Suda.

In order to meet a "means-plus-function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d

1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989).

The claimed function of the "means for heating" is "heating said original plate during irradiating said activation light so that the temperature of the surface of said original plate becomes 40 through 200°C one of as per image and on the entire surface thereof, so that a hydrophobic area and a hydrophilic area are formed on said original plate." Clearly, Suda's dryer does not perform the identical function recited in the means limitation. Moreover, there is no disclosure in Suda that his printing machine is capable of heating the original plate **during** irradiating the activation light so that the temperature of the surface of the original plate becomes 40 through 200°C one of as per image and on the entire surface thereof, so that a hydrophobic area and a hydrophilic area are formed on the original plate. In that regard, Suda's printing machine could be designed to prevent the dryer from operating other than as described by Suda. Thus, we find the examiner's determination that the dryer disclosed by Suda is structurally capable of heating the plate during irradiating to be in error.

For the reasons set forth above, claim 13 is not anticipated by Suda. Accordingly, the decision of the examiner to reject claim 13, and claims 16 and 20 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Suda is reversed.

**The obviousness rejection**

We have reviewed the patent to Nakayama applied in the obviousness rejection of dependent claims 14, 15, 19, 21 and 22 but find nothing therein which makes up for the deficiencies of Suda discussed above with respect to independent claim 13. Accordingly, the decision of the examiner to reject claims 14, 15, 19, 21 and 22 under 35 U.S.C. § 103 as being unpatentable over Suda in view of Nakayama is reversed.

## CONCLUSION

To summarize, the decision of the examiner to reject claims 13, 16 and 20 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 14, 15, 19, 21 and 22 under 35 U.S.C. § 103 is reversed.

REVERSED

| | | |
|---|---|---|
| CHARLES E. FRANKFORT<br>Administrative Patent Judge | ) | |
| WILLIAM F. PATE III<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| JEFFREY V. NASE<br>Administrative Patent Judge | ) | |

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037

JVN/jg