

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 MICHAEL B. ECKARD, ERIC J. JOHNSON,
CHRISTOPHER TAYLOR and ANTONI MURCIA

Appeal No. 2006-2842
Application No. 09/773,054

ON BRIEF

Before THOMAS, KRASS, and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from twice-rejected claims 9, 12, 21, 25, and 34-44. Claims 5-8, 14-16, 19, 20, 22, 27, 30-33, 45, and 46 have been allowed and claims 1-4, 10, 11, 13, 17, 18, 23, 24, 26, 28, and 29 have been cancelled.

The invention pertains to servicing an ink jet printer, best illustrated by reference to representative independent claim 9, reproduced as follows:

9. A method for servicing an inkjet printer including an inkjet printhead with a nozzle plate and a first service module removably installed on the printer, comprising:

identifying a printhead-related service condition not adequately addressed by servicing the printer with the first service module being in an un-worn condition;
providing a second service module with a service function different from the first service module and adapted to address said printhead-related service condition, the second service module removably installable on the printer and with respect to the first service module;
providing a set of instructions for using the second service module with the inkjet printer to the printer user, wherein the step of providing a set of instructions includes providing a set of human-readable instructions for using the second service module.

The examiner relies on the following references:

Garcia et al. (Garcia)	6,042,216	Mar. 28, 2000
Wojcik	6,250,736	Jun. 26, 2001 (filed Aug 04, 1999)

Claims 9, 21, and 34-44 stand rejected under 35 U.S.C. § 102(e) as anticipated by Garcia.

Claims 12 and 25 stand rejected under 35 U.S.C. § 103 as unpatentable over Garcia in view of Wojcik.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the

invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

At pages 3-5 of the answer, the examiner sets forth the reasoning for rejecting claims 9, 21, and 34-44 under 35 U.S.C. § 102(e).

Appellants' response is to argue that the examiner's rejection fails to address all the features of the instant claims under rejection. In particular, appellants contend that the module in Garcia is dedicated solely to a single printhead and can be removed and replaced at the same time the printhead is removed (referring to Garcia, column 8, line 61, through column 9, line 7), and that Garcia lacks many of the features of the instant claims for reasons set forth at pages 6-10 of the principal brief.

We have carefully considered the evidence before us, including, inter alia, the disclosure of Garcia as well as the arguments of appellants and the examiner, and we conclude therefrom that the examiner has not established a prima facie case of anticipation. Accordingly, we will not sustain the rejection of claims 9, 21, and 34-44 under 35 U.S.C. § 102(e).

All of the independent claims, except for claims 25 and 40, require that a second service module has a "service function" that is different from the first service module. While Garcia discloses the replacement of a first service module with a second service module, wherein the service modules incorporate multiple functions in each single unit,

there is no disclosure or suggestion in Garcia that the replacement service module has a different service function than the replaced module. It would appear that they are similar modules but, in any event, it would be speculation to conclude that the replacement module has a service function any different from the service function of the replaced service module and the examiner has pointed to nothing in Garcia to convince us otherwise.

In fact, the examiner appears to focus on the wipers 234 and cap 236, shown in Garcia's Figure 23, for example, and uses this exploded isometric view of a service station module to conclude that the wipers 234 and cap 236 are removably installable. We are a bit confused as to why the examiner thinks that wipers 234 and/or cap 236 constitute a "service station module," but, in any event, we agree with appellants that even if we were to interpret these elements as a "service station module," they are not described in Garcia as being "removably installable." The fastener holding the cap 236 is not necessarily removable after assembly because, as appellants point out, it may be a rivet. Wipers 234 may, in fact, be attached to the service station module 230 by an adhesive and not be removable. Garcia is not clear on this, and while it might have been obvious, in some sense, to attach the cap with a screw, or to attach wipers 234 with no adhesive, the rejection of claims 9, 21, and 34-44 is under 35 U.S.C. § 102(e), so all of the elements must be taught by the reference. As far as Garcia's Figure 23 is concerned, this is an exploded view and certainly does not, in any way, show separately removable components, absent some description in the specification that any such components are "removably installed," either by an explicit disclosure of such or, implicitly, by the

manner in which such components are connected. But, in any event, as we say, we are confounded by the examiner's interpretation of wipers 234 and/or cap 236 as the claimed "second service module" and do not view this as a reasonable interpretation.

Thus we will not sustain the rejection of claims 9, 21, and 34-39 under 35 U.S.C. § 102(e).

Since Wojcik does not provide for this deficiency in Garcia, we also will not sustain the rejection of claim 12 under 35 U.S.C. § 103.

With regard to the rejection of claim 25 under 35 U.S.C. § 103 and the rejection of claim 40 under 35 U.S.C. § 102(e), these claims require the first and second service modules to be "different," but they do not require the modules to have "different functions." Therefore, as in Garcia, a first service module may be replaced with a second service module of like kind, having the same function, and this would meet the language of the claims.

However, each of these claims, like other claims, does require that the second service module be able to address a printhead-related service condition that is not adequately addressed by the first service module being in an unworn condition. This means that the functions of the two modules must be different since they are able to address different conditions.

Therefore, for reasons similar to those supra, we will not sustain the rejection of claim 25 under 35 U.S.C. § 103 nor will we sustain the rejection of claim 40 under 35 U.S.C. § 102(e).

Since we have not sustained any of the examiner's rejections, the examiner's decision is reversed.

REVERSED

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James D. Thomas)	
Administrative Patent Judge)	
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Errol A. Krass)	
Administrative Patent Judge)	APPEALS AND
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Joseph F. Ruggiero)	
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