

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* STEVE JARVIS,  
KEN WHITCOMB, and  
ERIC SEVERY

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Appeal 2007-3797  
Application 10/453,061  
Technology Center 1700

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Decided: September 18, 2007

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Before CHUNG K. PAK, PETER F. KRATZ, and LINDA M. GAUDETTE,  
*Administrative Patent Judges.*

KRATZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on an appeal from the Examiner's final rejection of claims 1-33, the only claims that remain pending in this application. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

Appellants' invention is directed to a business form including a laser printable paper sheet or stock and a moisture transport coating on a portion of at least one side of the paper. The coating is aimed at accelerating moisture transport through open pores of the paper and stabilizing the moisture content thereof to aid in the prevention and resolution of curling problems associated with handling the paper, particularly as a result of moisture loss after exposure of the paper to heat from a fusing station of a laser printer (Specification ¶¶ 0015- 0017). The business form is disclosed as a label/form combination (Specification ¶¶ 0010 and 0011). Claim 1 is illustrative and reproduced below:

1. A business form comprising:

a sheet of laser printable stock, the laser printable stock comprising bond paper having no heat activated image producing chemical coating thereon; and

a moisture transport accelerating and stabilizing coating on at least a portion of at least one side of the sheet of laser printable stock.

The Examiner does not rely on any prior art references as evidence in rejecting the appealed claims.

Claims 1-33 stand rejected under 35 U.S.C. § 112, first paragraph as lacking written descriptive support in the Specification, as filed.

We affirm the Examiner's rejection. Our reasoning follows.

Appellants argue the claims together as a group. Accordingly, we select claim 1 as the representative claim on which we decide this appeal as to this ground of rejection.

Here, the Examiner maintains that the amended language added to claims 1, 22, 26, and 29 (Amendment filed December 08, 2005) lacks § 112,

first paragraph written descriptive support in the Specification, as filed. The amended limitation at issue is: “paper having no heat activated image producing chemical coating thereon” (Claims 1, 22, 26, and 29).

The question that must be considered is whether the originally filed disclosure reasonably conveys to one of ordinary skill in the art that the inventor had possession at that time of the later claimed subject matter. *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The possession of the later claimed subject matter can be established by showing that the disclosed subject matter expressly, implicitly, and/or inherently (i.e., necessarily) satisfies the limitation in question. *See, e.g., Kennecott Corp. v. Kyocera Intern., Inc.*, 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987), *cert. denied*, 486 U.S. 1008 (1988). However, a disclosure that merely renders the later-claimed invention obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations. *See Tronzo v. Biomet Inc.*, 156 F.3d 1154, 1158-60, 47 USPQ2d 1829, 1832-34 (Fed. Cir. 1998); *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Winkhaus*, 527 F.2d 637, 639-640, 188 USPQ 129, 131 (CCPA 1975).

The written description inquiry is a factual one and must be assessed on a case-by-case basis. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). The Examiner bears the initial burden of establishing a prima facie case of a violation of the description requirements of § 112, first paragraph. *See In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

The Examiner has found that the amended claim language embraces business forms that are not described pursuant to § 112, first paragraph, in the Specification, as filed. The Examiner has found that the Specification does not furnish explicit written descriptive support for the added limitation “no heat activated image producing chemical coating thereon” in claim 1 (Answer 3 and 4). Moreover, the Examiner has found that the Specification, as filed, does not implicitly or inherently furnish written descriptive support for the added claim limitation by the disclosure of a laser printable stock or sheet of paper (Answer 4). The Examiner has determined that the added limitation in question is a negative limitation that changes the scope of the claimed invention (the limitation results in claims with a narrower scope by the exclusionary requirement) in a way that has no basis for written descriptive support, within the meaning of the first paragraph of 35 U.S.C. § 112, in the Specification, as filed (Answer 4 and 5). As the Examiner’s factual findings are supported by substantial evidence, we determine that the Examiner has established a prima facie case of a lack of written descriptive support for the rejected claims.

Appellants contend that the Specification expressly establishes that Applicants were in possession of the claimed subject matter requiring the absence of a heat activated image producing chemical coating on a paper recited as part of the business form throughout the Specification. Appellants cite Specification paragraphs 0002, 0005, 0010, 00012 and originally filed claims 22 and 26 as being exemplary of the explicit support found in the Specification, as filed (Br. 7). Appellants further refer to a Declaration under 37 CFR § 1.132 by Ken Whitcomb, a named co-inventor, and argue several differences between laser technology and papers useful for laser

printing with thermal technology and papers suitable therefor, which, in Appellants' view, establishes at least inherent or implicit support for the added claim language (Br. 7-9, Reply Br. 2-6). Appellants contend that the added claim language does not change the scope of the invention claimed because of an asserted laser printable stock or paper requirement (Br. 9-10, Reply Br. 6-8).

Appellants' arguments concerning express support do not persuasively rebut the prima facie case of a lack of descriptive support for the amended claim language furnished by the Examiner. This is because Appellants have not established that the Specification, including the portions of the Specification referred to by Appellants in the Brief, furnishes an explicit description of a business form having no heat activated image producing chemical coating on the paper establishing that the named inventors had possession of a business form that included no heat activated image producing chemical coating on the paper. However, such a business form is required by the amended claims.

The Whitcomb Declaration (Br., Exhibit A) distinguishes direct thermal paper from laser printable paper based on the laser printable paper having no chemical coating of the type employed on a direct thermal paper (Decl. ¶¶ 13-18). However, the amended claim language, "paper having no heat activated image producing chemical coating thereon" as found in all the independent appealed claims (claims 1, 22, 26, and 29) excludes image producing chemical coatings that can be heat activated at any temperature, including temperatures much higher than a paper subjected to direct thermal printing or than a paper subjected to a typical laser print head fuser may encounter. In this regard, we recognize that the Whitcomb Declaration

concludes that “laser printable sheets means that the paper is not coated with a chemical coating that reacts to heat to produce images. Such a coating would render the laser paper useless by reacting to the heat of the fuser turning the paper black.” (Decl. ¶ 19). However, that conclusion appears to be referring to the absence of coatings that would chemically react during the laser printing process (Decl. ¶ 16). Moreover, the Whitcomb Declaration is not accompanied by scientific literature or other documentary or experimental evidence that would serve to establish that all laser printable papers or stock would necessarily exclude all coatings containing chemicals that would react to form an image without limitation to the temperature environment the paper may experience, as the appealed amended claims require. Consequently, the arguments in the Briefs, together with the Whitcomb Declaration furnished in support thereof, asserting implicit or inherent support for the amended claim language based on the laser printing functionality or characteristics implicitly conveyed by the originally disclosed laser printable stock or paper are not persuasive of reversible error in the Examiner’s rejection.

We hold that the Examiner has correctly found that the amended claim language added after filing of the Application Specification includes subject matter via a negative claim limitation (*see Ex parte Grasselli*, 231 USPQ 393, 394 (Bd. Pat. App. & Int. 1983) that did not appear in the Specification as filed and, *prima facie*, involves a new concept which Appellants have not persuasively rebutted with the argumentation furnished in the Briefs together with the Specification passages and Whitcomb Declaration relied upon in support thereof. *In re Alton*, 76 F.3d at 1175, 37 USPQ2d at 1583-84.

Appeal 2007-3797  
Application 10/453,061

On this record, we affirm the Examiner's § 112, first paragraph rejection of the appealed claims for lack of the requisite written descriptive support in the Specification, as filed.

#### CONCLUSION

The decision of the Examiner to reject claims 1-33 under 35 U.S.C. § 112, first paragraph as lacking written descriptive support in the Specification, as filed is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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HAHN LOESER & PARKS, LLP  
ONE GOJO PLAZA  
SUITE 300  
AKRON, OH 44311-1076