

\ ***THIS OPINION WAS NOT WRITTEN FOR PUBLICATION***

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN BARES and
NERO R. LINDBLAD

Appeal No. 96-2878
Application 08/313,631¹

ON BRIEF

Before THOMAS, BARRETT and HECKER, *Administrative Patent Judges*.

HECKER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 5, 11 through 15, 19

¹ Application for patent filed September 27, 1994. According to the appellants, this application is a continuation of Application 08/112,924, filed August 30, 1993, now U.S. Patent No. 5,424,820, issued June 13, 1995.

through 23 and 29 through 33, all of the claims pending in the present application.

The invention relates to an electrophotographic printer and increasing the useable capacity of the cleaner sump. In particular, referring to Figure 1, cleaner sump 30 is adjacent to the photoreceptor drum 10. A cleaning blade 20 contacts the imaging surface 11 of drum 10, and waste magnetic toner 70 falls via gravity into sump 30. Appellants have increased the useable capacity of sump 30 by placing magnet 40 in an area removed from the cleaning blade 20. Magnet 40 attracts toner further away from blade 20 than gravity would have provided, thus more sump 30 space is utilized. In an alternative embodiment, Appellants move waste toner 70 via a rotating magnet 60 as depicted in Figure 4.

Representative independent claim 1 is reproduced as follows:

1. An apparatus for cleaning magnetic material from a surface, comprising:

a housing defining a chamber for storing magnetic material removed from the surface with the chamber having under utilized areas for storing magnetic material; and

a magnet positioned to attract and move the magnetic material into the under utilized areas for tighter packing of the magnetic material stored in the chamber of said housing, increasing storage capacity of the chamber of said housing.

The Examiner relies on the following references:

Schnall et al. (Schnall)	4,251,155	Feb. 17, 1981
Yamashita et al. (Yamashita)	4,496,240	Jan. 29, 1985

Claims 1 through 5, 11 through 15, 19 through 23 and 29 through 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schnall in view of Yamashita.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

After a careful review of the evidence before us, we will not sustain the rejection of claims 1 through 5, 11 through 15, 19 through 23 and 29 through 33 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

With regard to the rejection of claims 1 and 19, the Examiner states that Schnall discloses a cleaning arrangement in an electrophotographic copying machine, and uses a rotating bar 7 to move toner into a collection compartment (i.e., cleaner sump) 11. The Examiner further states (answer, page 4): “The reference, however, does not disclose a magnet for attracting and moving magnetic material into a storage chamber.” Yamashita is then combined with Schnall for both (1) its use of a magnetic toner and (2) a magnetic roller 10 for moving the magnetic toner to a developer tank 6. (Answer at page 4). On page 5 of the answer, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a magnetic feeding arrangement, such as described by Yamashita, et al., for the polygonal bar 7 of Schnall, et al., if magnetic toner were involved This substitution is considered obvious to the ordinary routineer in the art since both the rotating bar of Schnall, et al. and the rotating magnet of Yamashita et al. are used for the same purpose, i.e. transporting toner from one location to another.
[Emphasis added]

Whether the substitution of the magnetic feeder of Yamashita for the bar 7 of Schnall is obvious begs the question. One must first explain why it would have been obvious to use a magnetic toner in Schnall.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Claims 1 and 19 both recite "magnetic material" five times throughout each claim. Schnall is devoid of any mention of magnetic material. And, the Examiner makes no statement, other than "if",

regarding the use of magnetic material in Schnall. It appears that the Examiner has used hindsight to modify Schnall to use magnetic toner in order to provide the reason for substituting a magnetic feeding arrangement. For these reasons, we will not sustain the rejection of claims 1 and 19. The remaining claims on appeal also contain the above limitations discussed with regard to claims 1 and 19 and thereby, we will not sustain the rejection as to these claims.

In addition, we note that the Examiner states on page 5 of the answer:

The manner, however, in which the magnetic toner is stored in the chamber is considered to be the desired function and thus entitled to no patentable weight.

Without more, it is unclear what claim language the Examiner has in mind. Appellants have argued that the references fail to teach or suggest “increasing storage capacity”, “under utilized areas” and “tightly packed thereby”. After a thorough review of Schnall and Yamashita, we also find no mention of these terms, expressly or implicitly. Claims 1 and 19 recite these terms, at least some of which go beyond a “desired function” because they have structure to perform the function and are entitled to patentable weight. We would also not sustain the rejection of claims 1 and 19, and thereby the remaining claims, since the Examiner is silent on these claim terms.

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We have not sustained the rejection of claims 1 through 5, 11 through 15, 19 through 23 and 29 through 33 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
)	APPEALS AND
LEE E. BARRETT)	INTERFERENCES
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