

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHADI L. MALHOTRA, BRENT S. BRYANT
and ARTHUR Y. JONES

Appeal No. 1997-2308
Application 08/504,266¹

ON BRIEF

Before OWENS, KRATZ and SPIEGEL, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 3, 4, 6, 7, 9, 13-16 and 20-35. Claims 5, 18 and 19

¹ Application for patent filed July 19, 1995. According to the appellants, the application is a division of Application 08/196,605, filed February 15, 1994.

Appeal No. 1997-2308
Application 08/504,266

have been indicated allowable.² In the examiner's answer
(pages 2

and 4) the examiner withdrew the rejection of claims 25, 29,
31 and 32 and stated that the claims are objected to as being
dependent upon a rejected base claim.

THE INVENTION

Appellants claim an ink jet printing process wherein the
recording sheet includes a substrate having on at least one
surface thereof an image receiving coating containing a
biocide selected from a recited group. Claim 15 is
illustrative and reads as follows:

15. A printing process which comprises (1) incorporating
into an ink jet printing apparatus containing an aqueous ink a
recording sheet which comprises a substrate and an image
receiving coating situated on at least one surface of the
substrate, said entire image receiving coating containing a
biocide, and (2) causing droplets of the ink to be ejected in
an imagewise pattern onto the recording sheet, thereby
generating images on the recording sheet, wherein the biocide
is
5-chloro-2-methyl-4-isothiazolin-3-one, 2-methyl-4-
isothiazolin-3-one, 2-(thiocyanomethylthio) benzothiazole,

²The sole basis for allowance of claims 5, 18 and 19 is
the presence of the quaternary acrylic copolymer latex binder
(final rejection mailed on July 9, 1996, paper no. 8, page 3).

Appeal No. 1997-2308
Application 08/504,266

bis(trichloromethyl) sulfone, N-hydroxymethyl-N-methyl dithiocarbamate salts, 2-mercapto benzothiazole salts, mixtures thereof, or a mixture containing a quaternary ammonium salt and one or more of 5-chloro-2-methyl-4-isothiazolin-3-one, 2-methyl-4-isothiazolin-3-one, 2-(thiocyanomethylthio) benzothiazole, bis (trichloromethyl) sulfone, N-hydroxymethyl-N-methyl dithiocarbamate salts, or 2-mercapto benzothiazole salts.

THE REFERENCE

Vieira et al. (Vieira) 5,073,448 Dec. 17,
1991

THE REJECTION

Claims 3, 4, 6, 7, 9, 13-16, 20-24, 26-28, 30 and 33-35 stand rejected under 35 U.S.C. § 103 as being unpatentable over Vieira in view of appellants' admissions in the specification.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with the examiner that the invention recited in appellants' claims 3, 4, 6, 7, 9, 13-16, 20-24, 26-28, 30 and 33-35 would have been obvious to one of ordinary skill in the art at the time of appellants' invention over the applied prior art.

Accordingly, we affirm the aforementioned rejection. Under

Appeal No. 1997-2308
Application 08/504,266

the provisions of 37 CFR § 1.196(b), we enter a new ground of rejection of claims 25, 29, 31 and 32.

Rejection of claims 3, 4, 6, 7, 9,

13-16, 20-24, 26-28, 30 and 33-35

Appellants state that each of claims 21 to 35 is to be considered independently (brief, page 5). Appellants, however, do not provide a substantive separate argument as to the patentability of any of these claims. All of the claims, therefore, stand or fall together. *See In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); *In re Herbert*, 461 F.2d 1390, 1391, 174 USPQ 259, 260 (CCPA 1972); 37 CFR § 1.192(c)(7)(1995). Hence, we address only the sole independent claim, i.e., claim 15.

Vieira discloses an ink jet printing process wherein the recording sheet comprises a substrate having thereon an image receiving coating which can contain a biocide (col. 6, lines 53-58; col. 7, line 67 - col. 8, line 4).

Vieira does not disclose any specific biocides. To remedy this deficiency the examiner relies upon the acknowledgment in appellants' specification (pages 18-20) that

the biocides recited in claim 15 were commercially available biocides at the time of appellants' invention (answer, page 4). The examiner concludes that it would have been *prima facie* obvious to one of ordinary skill in the art to use as Vieira's biocide one of the commercially available biocides (*see id.*), and we agree with this conclusion.

Appellants do not challenge the *prima facie* case of obviousness. Appellants argue that their claimed invention is patentable because the data in their specification indicate that the claimed invention produces unexpected results (brief, page 7).

In the specification (pages 24-25) appellants compare coatings containing biocides recited in claim 15 with coatings containing anionic sodium benzoate as a biocide and coatings containing no biocide. The data show that the shelf lives of transparencies having coatings containing no biocide were 4 to 6 months whereas the shelf lives of transparencies having coatings containing 1 wt% anionic sodium benzoate were 10 months and the shelf lives of transparencies having a coating containing 25 ppm by weight of biocides recited in appellants'

Appeal No. 1997-2308
Application 08/504,266

claim 15 were 18 to 24 months. For the following reasons, these test results are not adequate for overcoming the *prima facie* case of obviousness.

It is not enough for appellants to show that the results for appellants' invention and the comparative examples differ. The difference must be shown to be an unexpected difference. See *In re Freeman*, 474 F.2d 1318, 1324, 177 USPQ 139, 143 (CCPA 1973); *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972). In the specification appellants do not even provide an assertion of unexpected results, much less an explanation as to why the claimed invention produces unexpected results, and appellants have presented no evidence to that effect. Appellants have provided mere attorney argument (brief, page 7) that the results would have been unexpected by one of ordinary skill in the art, and such argument cannot take the place of evidence. See *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); *In re Payne*, 606 F.2d 303, 315, 203 USPQ 245, 256 (CCPA 1979); *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978); *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646

Appeal No. 1997-2308
Application 08/504,266

(CCPA 1974).

Furthermore, in tests 9 to 11 wherein appellants' biocides are used, not only does the biocide differ from the comparative examples but the coating composition also differs. Thus, the cause-and-effect relationship which appellants desire to show between biocide composition and shelf life is lost in multiple unfixed variables. See *In re Heyna*, 360 F.2d 222, 228, 149 USPQ 692, 697 (CCPA 1966); *In re Dunn*, 349 F.2d 433, 439, 146 USPQ 479, 483 (CCPA 1965).

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 25, 29, 31 and 32 are rejected under 35 U.S.C. § 103 as being unpatentable over Vieira in view of the admissions in appellants' specification.

The processes recited in claims 25, 29, 31 and 32 would have been *prima facie* obvious to one of ordinary skill in the art for the reasons given above. The evidence relied upon by appellants for overcoming the *prima facie* case of obviousness is not adequate because, as discussed above, appellants have

Appeal No. 1997-2308
Application 08/504,266

not provided a showing that the results obtained using the biocides recited in appellants' claims would have been unexpected by one of ordinary skill in the art.

DECISION

The rejection of claims 3, 4, 6, 7, 9, 13-16, 20-24, 26-28, 30 and 33-35 under 35 U.S.C. § 103 over Vieira in view of appellants' admissions in the specification is affirmed. Under the provisions of 37 CFR § 1.196(b), a new ground of rejection of claims 25, 29, 31 and 32 has been entered.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellants may file a single request for

Appeal No. 1997-2308
Application 08/504,266

rehearing within two months from the date of the original decision. . . .

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion

Appeal No. 1997-2308
Application 08/504,266

of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED, 37 CFR § 1.196(b)

TERRY J. OWENS)
Administrative Patent Judge)
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Appeal No. 1997-2308
Application 08/504,266

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PETER F. KRATZ)	APPEALS AND
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Appeal No. 1997-2308
Application 08/504,266

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