

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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 BART VERLINDEN and LUC DE BRABANDERE

Appeal No. 1999-0267
Application 08/744,268

HEARD: NOVEMBER 7, 2001

Before WARREN, KRATZ and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-20.

The subject matter on appeal is represented by claim 1,
set forth below:

1. A material for making a lithographic printing plate comprising on a glass support a surface capable of being differentiated in ink accepting and ink repellent areas in accordance with an image pattern, wherein said glass support has a thickness of not more than 0.5 mm, a failure stress of more than 4×10^7 Pa and a Youngs' modulus of not more than 10^{11} Pa.

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The references relied upon by the examiner as evidence of obviousness are:

Mizuno et al. (Mizuno)	4,046,071	Sep. 6, 1977
Leenders	5,378,580	Jan. 3, 1995
Hauquier et al. (Hauquier)	5,462,833	Oct. 31, 1995
De Keyzer et al. (De Keyzer)	5,536,618	Jul. 16, 1996

Claims 1, 3, 4, 10, 11, 15, 16 and 18 stand rejected under 35 U.S.C. § 103 as being obvious over Mizuno.

Claims 2, 5-9 and 12-20 stand rejected under 35 U.S.C.

§ 103 as being obvious over Mizuno in view of Leenders, Hauquier, and De Keyzer.

OPINION

For the reasons set forth in the brief and reply brief, and below, we reverse each of the above-noted rejections.

I. Claim interpretation

The preamble of appellants' claim 1 recites "[a] material *for making a lithographic printing plate* comprising on a glass support a surface capable of being differentiated in ink accepting and ink repellent areas in accordance with an image pattern".

We first note that claim 1 is drawn to a product. The language in italics, shown above, appears to be a method or process of use limitation of the product being

claimed, and we note that such a limitation has no significance in a product claim. Cf. In re Wiggins, 397 F.2d 356, 359 n.4, 158 USPQ 199, 201-202 n.4 (CCPA 1968). In the case of In re Wiggins, the court noted that a composition would not appear to be different in any material manner from the composition of appellants' claims no matter to what ultimate use it would be put. Id. Here, we find that appellants' claim 1 is a product claim directed to a material comprising, on a glass support, a surface capable of being differentiated in ink accepting and ink repellent areas in accordance with an image pattern, wherein the glass support has a particular thickness, a particular failure stress value, and a particular Youngs' modulus value.

In light of In re Wiggins, we see no patentable significance in the proposed use to which appellants' claimed material will be put, e.g., "for making a lithographic printing plate". The intended use does not make the material new and patentable. In re Thuau, 135 F.2d 344,347, 57 USPQ 324, 325-26 (CCPA 1943).

Hence, we interpret claim 1 as a product claim directed to a material comprising, on a glass support, a surface capable of being differentiated in ink accepting and ink repellent areas in accordance with an image pattern, wherein the glass support has the particularly claimed thickness, failure stress value, and Youngs' modulus value. In our analysis of the art rejections, set forth below, we apply this interpretation of claim 1.

II. The rejection under 35 U.S.C. § 103 over Mizuno

Appellants argue that Mizuno discloses glass as a support, but not for a lithographic plate. Appellants further argue that commercial glass can have different values for the failure stress. Appellants point out that their claimed invention requires a failure stress of more than 4×10^7 Pa, whereas Mizuno provides no guidance in this regard. (Brief, page 7).

Appellants further argue that when glass is thinner than 1.2 mm, it is possible to supply the glass on a roll, and thus the glass can be unwound and coated as a web in a continuous coating machine. Appellants state that this is particularly the case when the glass support has a Youngs' modulus equal to or lower than 10×10^{10} Pa. (Brief, page 8). Appellants point out that nothing in the reference to Mizuno would have led one skilled in the art to their particularly claimed glass support in this regard. (Brief, page 9).

The examiner argues that the failure stress value and Youngs' modulus value is inherent to the glass support of Mizuno. (Answer, page 4). The examiner also states that it would have been obvious to have used appellants' particularly claimed glass support because such a glass support "has been known and commercially available". (Answer, page 6).

With regard to the examiner's comments concerning inherency, we note that when an examiner relies upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent

characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd.Pat.App.Int. 1990). "Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Ex parte Skinner, 2 USPQ2d 1788, 1789 (Bd.Pat.App.Int. 1986). Here, we find that the examiner has not provided the required evidence or technical reasoning, but, rather has improperly relied upon the possibility that the glass in Mizuno has the claimed failure stress values and Youngs' modulus values.

With regard to the examiner's comments on obviousness, we find that the examiner has not provided an explanation of why one of ordinary skill in the art would have chosen appellants' claimed glass support and surface, having the particularly claimed combination of properties. It appears that the examiner's position is that because such a glass support is available in the marketplace, then it would have been obvious to have selected it. However, the examiner has not shown that the selection is so limited such that a choice would have been obvious. That is, a myriad of glass supports may be available, and the examiner has not explained why it would have been obvious to have selected appellant's particularly claimed glass support from the myriad of choices that are possibly available in the marketplace. On the record before us, we cannot find facts that show the selection is limited. We also cannot find facts that would have motivated the skilled artisan to have made

such a selection. Hence, we find that the examiner has not met his burden required for a *prima facie* case.

Accordingly, we reverse the rejection of claims 1, 3, 4, 10, 11, 15, 16 and 18 under 35 U.S.C. § 103 as being obvious over Mizuno.

III. The rejection of the claims under 35 U.S.C. § 103 over Mizuno in view of Leenders, Hauquier and De Keyzer

Appellants simply state that since these rejected claims are dependent upon claims which are patentable for the reasons given with regard to the previously mentioned art rejection, these claims are also patentable. (Brief, page 9). The examiner argues that the printing plate taught in Mizuno includes the use in a lithographic press. (Answer, pages 5-7).

As we noted above, our focus is on the glass support and surface, and the recited properties set forth in appellants' claim 1. In this context, we find that the examiner has not provided a technical explanation of why one of ordinary skill in the art would have been led to have chosen a glass support and surface having the combination of properties as claimed by appellants.

On page 6 of the answer, the examiner discusses that Leenders recognizes that any support can be used in a lithographic printing plate as long as the support is sufficiently oleophilic. Again, we refer to our aforementioned interpretation of claim 1, and in this context, we find that Leenders does not provide a teaching which would have motivated the skilled artisan

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to have selected appellants' particularly claimed material having the recited properties.

Hence, we also reverse the rejection of claims 2, 5-9 and 12-20 under 35 USC 103 as being unpatentable over Mizuno in view of Leenders, Hauquier, and De Keyzer.

IV. Conclusion

Each of the art rejections is reversed.

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

REVERSED

Charles F. Warren)
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