

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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM LOOS

Appeal No. 1999-2851
Application No. 09/127,347

ON BRIEF

Before LALL, BLANKENSHIP, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 1, which is the only claim pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an apparatus for printing graphic images on sheet material having an ink web cassette with constant web tension. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A cassette for a thermal-transfer printing apparatus having a strip of sheet material for receiving the graphic images, wherein the sheet material defines a plurality of feed holes spaced relative to each other in opposed marginal portions thereof; a platen mounted adjacent to the sheet material for supporting the sheet material; a print head movable into engagement with an ink web of the cassette and sheet material along a line of contact extending in a lateral direction of the sheet for transferring printing ink from the ink web onto the sheet and printing the graphic images on the sheet; a take-up motor for driving the ink web of the cassette; a substantially constant-torque clutch drivingly connected to the take-up motor for generating a substantially constant motor torque; two sprockets rotatably mounted on opposite ends of the platen relative to each other, and engaging the feed holes of the sheet material upon passage between the platen and print head; a drive motor drivingly connected to at least one of the platen and sprockets for rotatably driving at least one of the platen and sprockets and moving the sheet material engaged by the platen and sprockets; and a controller electrically coupled to the drive motor and print head, wherein the controller tracks the rotational position of at least one sprocket to register the print head with the sheet material, and actuates the print head based on the rotational position of the at least one sprocket for printing the graphic images on the sheet material; wherein the cassette comprises:

a predetermined length of ink web; a supply spool mounted within the cassette and carrying the ink web, wherein the supply spool is releasably connectable to the thermal-transfer printing apparatus with the ink web interposed between the sheet material and print head for transferring printing ink from the ink web onto the sheet and printing the graphic images on the sheet; a take-up spool mounted within the cassette and connected to the ink

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web for receiving the ink web from the supply spool, wherein the take-up spool is drivingly connectable to the constant torque clutch for rotatably driving the take-up spool at a constant torque and winding the ink web thereon during printing operations, and wherein the take-up spool defines a predetermined, first overall diameter without receiving the ink web and a greater second overall diameter upon receiving the predetermined length of ink web, the predetermined length of the ink web and the predetermined first overall diameter of the take-up spool having values such that the second overall diameter is within approximately 10% of the first overall diameter for maintaining a substantially constant tension within the ink web, and in conjunction with the sprockets and controller thereby maintaining registration between the print head and sheet material during printing operations.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hevenor et al. (Hevenor)	EP 0 607 539 A2	Jul. 27, 1994
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Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hevenor.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 9, mailed May 25, 1999) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 8, filed May 12, 1999) and reply brief (Paper No. 10, filed Jun. 8, 1999) for the appellant's arguments thereagainst.

OPINION

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In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Appellant argues that the claimed invention is based upon the discovery that the tension of the ink web is a function of the overall diameter of the take-up spool, and that variations in the tension of the ink web create corresponding variations in the web velocity, and in turn adversely affect print registration and the quality of the printed image. (See brief at pages 4-5.) Appellant argues that the prior cassette construction was to provide as much ink web as possible to increase the operational life of the cassette which caused a significant change in the overall diameter of the take-up spool resulting in a degradation of the print quality. (See brief at page 5.) Appellant argues that the examiner, is conclusion of obviousness is based upon hindsight. (See brief at page 6.) We agree with appellant that the examiner has not provided a convincing line of reasoning to modify the prior art cassette construction. Appellant argues that the prior art cassette teaches away from the claimed invention. (See brief at page 6.) We disagree with appellant that the Hevenor teaches away from the claimed invention, but we do agree that Hevenor alone does not provide teaching or suggestion of the desirability of the invention as claimed.

The examiner relies upon logic and sound scientific principle to suggest the obviousness of keeping the diameter of the take-up spool substantially unchanged. (See final rejection at page 2.) While we agree with the examiner that logic and sound scientific principles are appropriate motivations for modifications of prior art teachings, we find nothing in Hevenor alone which would have suggested to the skilled artisan to look to logic and sound scientific principles to motivate change in the length of the ink web to keep the cassette within the claimed limitations. The examiner cites a teaching of a Japanese patent (Jp-02-069276) in the argument section of the final rejection to identify the recognition of the problem of diameter size and tension. Here, we disagree with the examiner's reliance upon a teaching which is not applied against the claim. As set forth in **In re Hoch**, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970), "[w]here a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection." Furthermore, the examiner maintains that this reference teaches the control of the drive source rather than maintaining the take-up spool in any specific relationship. The examiner maintains that the complicated system of the Japanese patent is not at issue here. We disagree with the examiner. If the teachings of the reference are to be applied by the examiner, then the reference as a whole and what it teaches is at issue. Since the examiner does not apply the complete teaching of the reference, it is clear that the

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examiner is improperly attempting to pick and choose teachings as the examiner finds appropriate to meet the language of independent claim 1. This is inappropriate; therefore, this argument/position is not persuasive. Here, the examiner goes on at great length that the claimed invention would have been obvious (answer at pages 4-5), but we find that the examiner has provided no teaching or recognition of the problem of poor print quality with significant change in the take-up spool diameter. Therefore, we find that the examiner's rejection is based upon speculation and lacks evidence to support the examiner's contention concerning maintaining the take-up spool diameter in a relation as recited in the claim. Therefore, we will not sustain the rejection of claim 1.

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CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. §
103 is reversed.

REVERSED

PARSHOTAM S. LALL)	
Administrative Patent Judge)	
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JOSEPH L. DIXON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
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HOWARD B. BLANKENSHIP)	
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