

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID BATTAT, SANTOKH S. BADESHA, CLIFFORD O. EDDY,  
LOUIS D. FRATANGELO, ARMOLD W. HENRY and ALAN R. KUNTZ

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Appeal No. 2000-0291  
Application No. 08/873,958

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ON BRIEF

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Before ABRAMS, STAAB, and CRAWFORD, Administrative Patent  
Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 9, which are all of the claims pending in this application.

The appellants' invention relates to a method for reusing a fuser member comprised of an outer layer having an original

Appeal No. 2000-0291  
Application 08/873,958

fusing surface that is deficient. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art

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

Moxon	3,604,239	Sept. 14, 1971
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The prior art admitted by the appellants to be old appearing on pages 1 to 2 of the specification.

The rejections

Claims 1 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's Admitted Prior Art ("AAPA") in view of Moxon.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 10, June 7, 1999) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 9, filed May 24, 1999) for the appellants' arguments thereagainst.

OPINION

Appeal No. 2000-0291  
Application 08/873,958

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

The rejection in this case is made pursuant 35 U.S.C. § 103. We initially note that in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have

Appeal No. 2000-0291  
Application 08/873,958

led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

Appeal No. 2000-0291  
Application 08/873,958

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal. The examiner, in support of the rejection, states:

AAPA teaches that it is old and well known in the art to repair fuser members by removing the outer coatings and then applying new coatings to obtain a new fusing surface Moxon teaches that it is old and well known to repair rollers by removing the outer surface until the desired characteristics are reached, wherein material is removed from the surface but no additional material is added. It would have been obvious to one of ordinary skill in the art at the time the invention was made to Modify the method as taught by AAPA by only removing material to obtain a new working surface since to do so is old and well known in the art as taught by Moxon for the purpose of achieving an easier, simpler, less complicated, less time consuming process.[Final Rejection at page 2]

The appellants argue that neither Moxon nor AAPA discloses that there is no recoating of the outer layer with outer layer material and that persons skilled in the art would have no motivation to look to Moxon in regard to spent fuser members because Moxon is nonanalogous art.

Moxon discloses that particulate matter which accumulates on a rolling mill utilized to roll metal can be removed by

Appeal No. 2000-0291  
Application 08/873,958

flailing the working surface of the roll with flexible elements (Col. 1, lines 58 to 65). We agree with the appellants that the Moxon roll is recoated with outer layer material (See Col. 1, lines 43 to 44). In addition, neither Moxon nor AAPA discloses or suggests anything about renewing a spent fuser member which has a outer coating surface which is deficient due to scratches or gouges. There is no suggestion that the flailing method will be effective on a spent fuser member. Indeed, the outer coating of Moxon is particulate matter which accumulates on the roll and the outer coating of the fuser member is a surface layer of the fuser member itself. Therefore, is it our opinion that even if the Moxon reference is analogous art, there is no suggestion to use

the flailing method disclosed in Moxon on an AAPA spent fuser member. As such, we will not sustain the rejection of the examiner.

The decision of the examiner is reversed.

REVERSED

Appeal No. 2000-0291  
Application 08/873,958

NEAL E. ABRAMS	)
Administrative Patent Judge	)
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	) BOARD OF PATENT
LAWRENCE J. STAAB	)
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	)
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Appeal No. 2000-0291  
Application 08/873,958