

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNARD GRUSHKIN

Appeal No. 94-2794
Application No. 07/702,533¹

ON BRIEF

Before METZ, JOHN D. SMITH, and PAK, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 1, 2, 5 and 32 which are all of the claims pending in this application.

The subject matter on appeal is directed to a toner composition. The critical features of the toner composition

¹ Application for patent filed May 20, 1991.

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are the employment of about 30% to about 60% by weight of a mixture of soft and hard magnetite, with the hard magnetite accounting for about 10% of the total weight of the toner composition.

See specification, page 15 and 16. This toner composition is adequately illustrated in claim 1 which is reproduced below:

1. A toner composition comprising:
 - a) about 30% to about 70% by weight of a resin;
 - b) about 30% to about 60% by weight of a mixture of soft magnetite and hard magnetite; and
 - c) up to about 10% by weight of a lubricating component;

wherein said hard magnetite accounts for about 10% of the total weight of the toner composition, and wherein the retentivity of said toner composition is from about 3.0 emu/g to about 8.0 emu/g.

The sole reference of record relied upon by the examiner is:

Unno et al (Unno) ² 1990 (Japanese Kokai Patent Publication)	H2-181757	July 16,
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² Our reference to this publication is to the corresponding English translation of record.

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Claims 1, 2, 5 and 32 stand rejected under 35 U.S.C. § 102 (a) as anticipated by or, in the alternative under 35 U.S.C. § 103 as unpatentable over, the disclosure of Unno.

We reverse.

Appellant does not dispute that the Unno reference describes or would have suggested the claimed toner composition within the meaning of 35 U.S.C. § 102 (a) or § 103. Appellant, however, argues that the Rule 131 declaration of record executed by Grushkin, the sole inventor in this application, is sufficient to remove Unno as a prior art reference under 35 U.S.C. § 102(a) and § 103. The dispositive question is, therefore, whether the Rule 131 declaration is sufficient to establish that the claimed invention was made prior to the publication date of the Unno reference. We answer this question in the affirmative.

37 CFR § 1.131 states in relevant part:

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Here, the Rule 131 declaration evinces completion of a toner composition having about 53% by weight of styrene/n-butyl acrylate copolymer resin, 30% by weight of soft magnetite, 10%

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by weight of hard magnetite, 1% by weight of a charge control agent and 6% by weight of a polywax (lubricant). The Rule 131 declaration also indicates the criticality of employing a mixture of soft and hard magnetite, with the hard magnetite accounting for about 10% of the total weight of the toner composition. This toner composition, including its specific critical features, is included in the appealed claims. See, e.g., In re Stryker, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). Accordingly, we conclude that the Rule 131 declaration does show sufficient facts which establish completion of the claimed subject matter prior to the publication date of the Unno reference. It then follows that the Unno reference cannot be qualified as prior art under 35 U.S.C. § 102(a) or 35 U.S.C. § 103.

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In view of the foregoing, we reverse the examiner's
decision rejecting claims 1, 2, 5 and 32 under 35 U.S.C. §
102(a) or 35 U.S.C. § 103.

REVERSED

ANDREW H. METZ)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN D. SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CHUNK K. PAK)	
Administrative Patent Judge)	

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JENINE GILLIS

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Serial No.

Judge PAK

Judge METZ

Judge JOHN D. SMITH

Received: 03 Sep 98

Typed: 04 Sep 98

DECISION: REVERSED

Send Reference(s): Yes No
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 1507

Index Sheet-2901 Rejection(s): _____

Acts 2: _____

Palm: _____

Mailed: Updated Monthly Disk (FOIA): _____

Updated Monthly Report: _____

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