

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HYUN-CHEOL LEE

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Appeal No. 1996-3709  
Application 07/980,221<sup>1</sup>

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HEARD: January 11, 2000

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Before HAIRSTON, HECKER and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection<sup>2</sup> of claims 1 to 29.

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<sup>1</sup> Application for patent filed November 23, 1992.

<sup>2</sup> An amendment after the final rejection was filed [paper no. 16] and its entry approved [paper no. 17] for the purposes of this appeal.

The disclosed invention relates to an image information apparatus, and a method of operating the same, using an electrostatic writing method. The apparatus has a housing formed in two portions, an upper portion and a lower portion, hinged together. The lower portion houses a detachable developing device and the upper portion houses a detachable photosensitive drum. The upper portion is connected to the lower portion by a hinge such that the upper portion rotates about the hinge to gain access to the inner components of the apparatus. Since the hinge facilitates the opening and closing of the apparatus, and since the separate parts of the apparatus, i.e., the paper cassette, the developing device and the photosensitive drum can be readily disassembled from the apparatus, it is easy to remove paper which may be jammed in any portion of the apparatus. The invention is further illustrated by the following claim.

Representative claim 22 is reproduced as follows:

22. A method of removing a jammed sheet of paper from a paper path in an image formation apparatus, comprising:

disengaging an upper body of said image formation apparatus from a lower body of said image formation apparatus pivotally attached to said upper body, by pivoting said upper

body away from said lower body;

detaching a developing device detachably installed in said lower body to access a portion of said paper path, said portion of said paper path extending from a transferring device positioned opposite a photosensitive drum detachably installed in said upper body, to a lower roller means installed in said lower body for conveying a sheet of paper from a paper supply cassette to said transferring device; and

removing said jammed sheet of paper from said portion of said paper path when said jammed sheet of paper is located in said portion of said paper path.

The references relied on by the Examiner are:

Lawson	4,751,548	Jun. 14, 1988
Kando	4,772,915	Sep. 20, 1988
Tabuchi	5,089,846	Feb. 18, 1992
Ohsawa et al. (Ohsawa)	5,186,448	Feb. 16, 1993
	(Effective filing date: Feb. 17,	
1988)		

Tsukakoshi et al. (Tsukakoshi)	5,300,979	Apr. 5, 1994
	(Effective filing date: Oct. 7,	
1991)		

Claims 1 to 29 stand rejected under 35 U.S.C. § 103<sup>3</sup>. As evidence, the Examiner offers various combinations of Lawson, Kando, Tabuchi, Ohsawa and Tsukakoshi.

Reference is made to Appellant's briefs<sup>4</sup> and the

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<sup>3</sup>Claims 21 to 28 had also been rejected under 35 U.S.C. § 112, first paragraph, however, the Examiner has withdrawn this rejection of claims 21 to 28 [answer, page 4].

<sup>4</sup>A reply brief [paper no. 25] was filed and its entry into the record was approved [paper no. 26].

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Examiner's answers<sup>5</sup> for their respective positions.

**OPINION**

We have considered the record before us and we will reverse the rejection of claims 1 to 29.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In Re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (CCPA 1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching,

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<sup>5</sup>A supplemental answer was mailed as paper no. 26.

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suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. System., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In Re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Furthermore, the Federal Circuit states that "[the] mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In Re Fitch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In Re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or

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in view of the teachings or suggestions of the inventor.”  
Para-Ordnance Mfg. V. SGS Importers Int'l, 73 F.3d 1087, 37  
USPQ 2d at 1239 (Fed. Cir. 1995), citing W. Lish. Gore &  
Assocs., v. Garlock, Inc., 721 F.2d at 1551, 1553, 220 USPQ at  
311, 312-13 (Fed. Cir. 1983).

We now consider the various rejections.

Claims 1 to 10 and 12 to 20

The Examiner has rejected these claims over Tabuchi in  
view of Ohsawa, Tsukakoshi and Kando. Taking independent  
claim 1, we have reviewed the rejection spanning pages 4  
through 17 of the answer. The Examiner has employed Ohsawa,  
Tsukakoshi and Kando to modify Tabuchi to meet the limitations  
of claim 1. At places the Examiner has arbitrarily supplied a  
link to combine by asserting [answer, page 7] that “the  
direction in which the drum is removed from the upper body is  
considered to be an obvious matter of design choice to one  
having ordinary skill in the art.” Again, the Examiner  
contends [answer, pages 9 to 10] that “it is submitted that it  
is obvious to one having skill in the art that the cooperating  
paper supplying roller, conveying rollers and friction pad for

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feeding only the topmost sheet from the cassette of Ohsawa et al. can be used to feed the copy sheets from the cassette of Tabuchi in lieu of the single roller 15 shown by Tabuchi in the same manner that appellant's claimed supplying roller, conveying rollers and friction pad feeds the topmost sheet in his cassette (i.e., from left to right) ... ."

Appellant argues [brief, page 16] that "there is no suggestion in the art to make the proposed combination to address the problems remedied by the Appellant's invention." Appellant further argues [brief, pages 16 to 24 and reply brief, pages 6 to 8] that none of the applied references shows any teaching, explicit or implicit, to combine these references.

We are of the opinion that the Examiner has earnestly attempted to piece together a rejection, using bits and pieces from the various references. It appears to us that the Examiner is indulging in reconstructing the prior art to come up with the claimed invention and is using the invention as a blueprint in so doing. That is not allowed within the meaning of 35 U.S.C.

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§ 103 as we noted above in our discussion of the case law.

Even if we assume that these references were properly combinable, the resulting combination does not meet the limitation of claim 1. For example, the combination does not satisfy the limitation of "a developing device detachably installed in said lower body such that said developing device may be completely removed from said lower body for accessing said paper path" (claim 1, lines 10 to 11) or the limitation of "lower roller means ... and said second paper convey roller for receiving said individual sheet and conveying said individual sheet to said photosensitive drum" (claim 1, lines 13 to 21).

Therefore, we do not sustain the obviousness rejection of claim 1 over Tabuchi in view of Ohsawa, Tsukakoshi and Kando.

Regarding independent claim 5, we find that the combination does not show, for example, the limitations of "a photosensitive drum ... , said photosensitive drum being detachably combined with said upper body for complete removal from said upper body for accessing a paper path in said ...

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device" (claim 5, lines 9 to 12), and "said developing device being detachably installed in said lower body for complete removal from said lower body for accessing said paper path in said ... device" (claim 5, lines 15 to 17). Therefore, we do not sustain the obviousness rejection of claim 5 over Tabuchi in view of Ohsawa, Tsukakoshi and Kando.

With respect to independent claim 17, we again find that the combination does not show the limitation discussed above, namely, "said photosensitive drum being detachably housed in said upper body for complete removal from said upper body for accessing a paper path in ... said device" (claim 17, lines 10 to 11). Therefore, we do not sustain the obviousness rejection of claim 17 over Tabuchi in view of Ohsawa, Tsukakoshi and Kando.

With respect to independent claim 18, we note the same limitations as discussed above, i.e., "said photosensitive drum detachably housed ... for complete removal ... for accessing a paper path in ... device" (claim 18, lines 10 to 11) and "said developing device detachably housed ... for complete removal ... for accessing said paper path in ...

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device" (claim 18, lines 16 to 18). We do not find the suggested combination to teach these limitations. Therefore, we do not sustain the obviousness rejection of claim 18 over Tabuchi in view of Ohsawa, Tsukakoshi and Kando.

Regarding independent claim 20, we again find some of the same limitations as discussed above, namely, the limitations of "a photosensitive drum detachably mounted ... for complete removal ... for accessing a paper path in ... apparatus" (claim 20, lines 3 to 4) and "a developing device detachably installed ... for complete removal ... for accessing said paper path in ... apparatus" (claim 20, lines 7 to 8). Thus, we do not sustain the obviousness rejection of claim 20 over Tabuchi in view of Ohsawa, Tsukakoshi and Kando.

With respect to dependent claims 2 to 4, 6 to 10, 12 to 16 and 19, since each contains at least the same limitations as the respective independent claims discussed above, the obviousness rejection of these claims over Tabuchi in view of Ohsawa, Tsukakoshi and Kando is also not sustained.

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Claim 11

Claim 11 is rejected as being obvious over Tabuchi in view of Ohsawa, Tsukakoshi and Kando, and further in view of Lawson. We note that claim 11 depends on claim 5 and hence contains at least the limitations of claim 5 as discussed. The additional reference to Lawson does not cure the deficiencies of the combination of Tabuchi in view of Ohsawa, Tsukakoshi and Kando to

reject claim 5 above. Consequently, we do not sustain the rejection of claim 11 over Tabuchi in view of Ohsawa, Tsukakoshi, Kando and Lawson.

Claim 29

Claim 29 is rejected over Tsukakoshi in view of Kando. The Examiner contends [answer, page 18] that "[w]hether the exposing device is slidably mounted in the upper body ... does not have any affect [Sic] on the method steps being claimed ... ." Appellant argues [brief, pages 32 to 35] that the claimed steps require, for their operation, the various apparatus components to be positioned in the manner recited in

the claim.

We are convinced by Appellant's argument. For example, the steps of "forming an ... image on said photosensitive drum, said ... image being produced by ... photosensitive drum ... and an electrifying device ... said electrifying device installed to be detached with said photosensitive drum when said photosensitive drum is detached from said upper body" (claim 29, lines 9 to 14) and "forming said image by supplying toner to said photosensitive drum from a developing device detachably installed in said lower body" (claim 29, lines 14 to 15) dictate the recited position of the recited apparatus components. Without such positioning of the components, the claimed steps cannot be held to be obvious. Therefore, we do not sustain the rejection of claim 29 over Tsukakoshi in view of Kando.

Claim 22, 23 and 26

These claims are rejected as being obvious over Tsukakoshi alone. Taking independent claim 22, we evaluate the positions of the Examiner [answer, page 20] and Appellant [brief, pages 35 to 37]. We are of the view that, in

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Tsukakoshi, the developing device 22 does not need to be detached from the lower body to remove a paper jam and the photosensitive drum 4 similarly is not contemplated to be detachable from the upper body as claimed in claim 22, see lines 6 to 10 of claim 22. We are not persuaded by the Examiner's assertions to the contrary. Thus, we do not sustain the obviousness rejection of claim 22 and, hence, of dependent claims 23 and 26 over Tsukakoshi.

Claims 24, 25, 27 and 28

These claims are rejected as being obvious over Tsukakoshi in view of Tabuchi and Kando. Each of these claims depends on independent claim 22 discussed above and contains at least the same limitations. Neither Tabuchi nor Kando, singly or in

combination, cures the deficiency of Tsukakoshi. Therefore, we do not sustain the obviousness rejection of these claims over Tsukakoshi in view of Tabuchi and Kando.

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Claim 21

Claim 21 is rejected [answer, page 23] over the same references as claims 24, 25, 27 and 28. Appellant has not explicitly responded to this rejection. However, since the references applied in this rejection are the same as for claims 24, 25, 27 and 28, Appellant's arguments regarding claims 22, 23 and 26, and claims 24, 25, 27 and 28 equally apply here. The Examiner has correctly proceeded with this presumption and responded to Appellant's arguments accordingly [id. 23]. Nevertheless, we are not persuaded by the Examiner's assertions and do not sustain the rejection of claim 21 over Tsukakoshi in view of Tabuchi and Kando for the same reasons.

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In summary, the decision of the Examiner rejecting claims  
1 to 29 under 35 U.S.C. § 103 is reversed.

**REVERSED**

KENNETH W. HAIRSTON	)
Administrative Patent Judge	)
	)
	) BOARD OF PATENT
STUART N. HECKER	)
Administrative Patent Judge	) APPEALS AND
	)
	) INTERFERENCES
	)
PARSHOTAM S. LALL	)
Administrative Patent Judge	)

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