

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte SHIN-ICHI SATA, YASUHIRO HIDAKA
KATSUTOSHI AOKI, HIROYUKI KAWAJI,
and MASAYUKI MARUTA

Appeal No. 1998-0468
Application 08/291,825

HEARD: February 22, 2001

Before, OWENS, KRATZ and JEFFREY T. SMITH, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

Decision on appeal under 35 U.S.C. § 134

Applicants appeal the decision of the Primary Examiner finally rejecting claims 1-10. We have jurisdiction under 35 U.S.C. § 134.

BACKGROUND

The invention is directed to a binder resin for a toner having (i) a hybrid resin made of a polyester resin and a vinyl resin as a matrix and (ii) a vinyl resin having a positive charge functional group as a dispersed domain within the above described matrix. Claim 1 which is representative of the invention is reproduced below:

1. A binder resin for a toner comprising:

(a) a resin (1) which forms a matrix in the toner, said resin (1) being a hybrid resin of a polyester resin and a vinyl resin; and

(b) a resin (2) which forms a domain dispersed in the matrix formed by the resin (1), said resin (2) being a vinyl resin having a positive charge functional group.

As evidence of obviousness, the Examiner relies on the following references:

Niki et al. (Niki)
European Patent Application

EP 0367265

May 9, 1990

Kawabe et al. (Kawabe)
European Patent Application

EP 0479275

Apr. 8, 1992

THE REJECTION

The Examiner entered the following ground of rejection:

Claims 1-10 are rejected as unpatentable under 35 U.S.C. § 103 over the combination of Kawabe and Niki. (Examiner's Answer, page 3).

Appeal No. 1998-0468
Application No. 08/291,825

OPINION

It is well established that the examiner has the initial burden under § 103 to establish a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). To that end, the examiner must show that some objective teaching or suggestion in the applied prior art, or knowledge generally available in the art would have led one of ordinary skill in the art to arrive at the claimed invention. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

We have carefully considered all of the arguments advanced by the appellants and the examiner. We reverse the rejection of claims 1-10 under section 103 as being unpatentable over the combination of Kawabe and Niki for the reasons which follow.

Kawabe discloses resin binders that comprise a polyester and vinyl resin. The binder is formed by concurrently polymerizing the polyester and vinyl resin including fumaric acid. The binder resin based on a combination of a polyester resin and vinyl resin yield developer compositions which provide fixed images of good environmental stability. (Page 3, lines 36-39). The binder is produced by blending in a reactor a raw monomer for a condensation polymerization and a raw monomer for a radical

Appeal No. 1998-0468
Application No. 08/291,825

(addition) polymerization. The condensation and addition polymerization reactions are conducted in the same reactor. (Page 3, lines 56-59). Kawabe discloses the binder resin can be produced by adding the vinyl resin along with a polymerization initiator to a mixture of raw monomers for the polyester. Kawabe discloses the binder resin can be used in toner preparations with a colorant, a charge control agent and magnetic material. (Page 6, line 41 to page 7, line 30). Kawabe does not indicate that the binder has properties which are the same as a polyester binder.

Niki discloses an electrophotography developer which comprises a carrier, toner particles, and a binder resin. The binder resin comprises (A) a polyester resin and (B) a styrene-acrylic resin obtained by polymerizing in the presence of a copolymerizing monomer having an amino group. (Page 4, lines 14-18). Niki discloses the combination of the polyester resin (A) and the styrene-acrylic resin (B) provide positively charged dry developers with improved stability. (Page 4, line 1-5). To establish a *prima facie* case of obviousness, an examiner must explain why the teachings of the prior art would have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976).

The Examiner asserts “EP ‘265 [Niki] teaches styrene/acrylic resins having a copolymerized amino group containing monomer as charge control agents for

Appeal No. 1998-0468
Application No. 08/291,825

polyester binders. The styrene/acrylic resin charge control agents have better stability and dispersibility when used in polyester binders than compounds conventionally used as charge control agents. In view of EP '265 [Niki], it would have been obvious to use a styrene/acrylic resin having a copolymerized amino group containing monomer as the charge control agent in the polyester binder taught by EP '275 [Kawabe] in order to obtain improved stability and dispersibility.” (Examiner’s Answer, page 3, lines 11-17).

We disagree. Niki discloses the properties for the combination of a polyester resin (A) and a styrene-acrylic resin (B). The hybrid resin binder of Kawabe comprises a combination of a polyester resin and vinyl resin. The Examiner asserts that the hybrid resin of Kawabe is formed of a preponderance of polyester resin. (Examiner’s Answer, paragraph bridging pages 3 and 4). Kawabe does not disclose the hybrid resin binder has the same properties as a polyester resin binder. It has not been established that the hybrid resin binder of Kawabe has the same properties as a polyester resin binder or the disclosed benefit of Niki would apply to a hybrid polyester resin. Thus, the *prima facie* case of obviousness has not been established on this record. The mere fact that the prior art could be modified as proposed is not sufficient to establish a *prima facie* case. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

In the absence of sufficient factual evidence or scientific rationale to establish why and how a skilled artisan would have arrived at the subject matter of claims 1-10 from the

Appeal No. 1998-0468
Application No. 08/291,825

applied references, we find that the initial burden of establishing the *prima facie* obviousness of the claimed subject matter has not been met. The 35 U.S.C. § 103 rejection of claims 1-10 is reversed.

Since we reverse for the lack of the presentation of a *prima facie* case of obviousness, we need not reach the issue of the sufficiency of the declaration evidence and evidence in the specification as allegedly demonstrating unexpected results. *See In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

Appeal No. 1998-0468
Application No. 08/291,825

CONCLUSION

The rejection of claims 1-10 as unpatentable under 35 U.S.C. § 103 over the combination of Kawabe and Niki is reversed.

REVERSED

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TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JEFFREY T. SMITH)	
Administrative Patent Judge)	

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Appeal No. 1998-0468
Application No. 08/291,825

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