

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(2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* FRED Y. BRANDON, ROBERT A. CHRISTIANSEN, CURTIS R. DROEGE,  
LAWRENCE R. STEWARD, and GARY R. WILLIAMS

---

Appeal No. 1998-1595  
Application No. 08/439,912

---

ON BRIEF

---

Before THOMAS, HAIRSTON, 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 claims 15-19 and 21. Claims 1-14 and 20 have been indicated by the examiner as allowable, and claim 22 is objected to as being dependent upon rejected claim 21.

We AFFFIRM.

## BACKGROUND

The appellants' invention relates to a print head and method of making a print head by one-shot injection molding. Specifically the appealed claims are directed to the article of manufacture and the allowed claims are directed to the one step injection molding process. An understanding of the invention can be derived from a reading of exemplary claim 21, which is reproduced below.

21. A cartridge for an ink jet printer, said cartridge having an ink reservoir therein, said cartridge comprising:

a rigid monolithic frame having

an interior surface facing an opening extending through the frame from a first side to a second side, said interior surface comprising a peripheral wall of the ink reservoir,

an exterior surface which comprises a peripheral exterior surface of the cartridge, and,

first and second bonding surfaces spaced from each other and surrounding said opening, said first and second bonding surfaces facing said first and second sides, respectively;

first and second flexible films comprising first and second side walls, respectively, of said ink reservoir; and,

an adhesive bonding material securing said first and second flexible films to said first and second bonding surfaces, respectively.

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

Appeal No. 1998-1595  
Application No. 08/439,912

Scheffelin et al. (Scheffelin) 5,448,818

Sep. 12, 1995  
(filed Oct. 29, 1993)

Admitted prior art at pages 1 and 2 of the specification.

Claims 15-19 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Admitted prior art in view of Scheffelin.

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. 13, mailed Dec. 24, 1997) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 12, filed Oct. 3, 1997) for the appellants' arguments thereagainst.

### **OPINION**

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.

At the outset we note that the one step injection molding process has been indicated as allowable by the examiner, but the examiner has rejected the product claims of the process. Furthermore, we note that the specification as amended at page 9 states that "[t]he method of the present invention permits the making of cartridges in the same configuration as cartridges made by the method described with respect to

Figs. 5-8.” Therefore, we agree with the examiner that the admitted prior art teaches the structure of ink cartridge as recited in claim 21, except for the claimed feature that the flexible films are adhesively bonded to the first and second bonding surfaces. We agree with the examiner that Scheffelin teaches both the use of dry bonding with adhesive and hot melt bonding along with the use of various other methods. (See Scheffelin at columns 5 and 6.)

Appellants and the examiner are in dispute over the claim limitation relating to “a rigid monolithic frame.” Appellants argue that the examiner has not interpreted the claim properly in view of the definition recited in the specification at page 6. We note that this definition was amended by appellants in paper number 7, filed March 25, 1997. The originally filed text stated that “[t]he rigid frame 50 is a monolithic structure formed by plastic injection molding in a single molding step so as to have the configuration shown in figure 2.” Appellants amended the text at page 6 to further recite that “[t]he term ‘monolithic structure’ as used herein means a structure that is massively solid and uniform. That is, it consists of a single mass or piece and is substantially uniform in content, like an object obtained by injection molding.” The examiner has not questioned the further refinement of the term “monolithic” by appellants. The examiner maintains that the admitted prior art teaches a monolithic frame as recited in the amended definition in the specification. (See answer at page 6.)

Appeal No. 1998-1595  
Application No. 08/439,912

We agree with the examiner. Moreover, we find that the examiner has not been unreasonable in his definition of the term “monolithic” and that the definition generally correlates with that set forth in the specification as originally filed and as amended. Here, we note that the implied limitation of the product by the single step process of manufacture does not limit/distinguish the invention claimed in claim 21. Furthermore, we note that the language of claim 21 does not recite that the same material is used throughout the structure, but appellants rely upon the process step to limit the product. Therefore, this argument is not persuasive, and we sustain the rejection of claim 21.

With respect to claims 15-19, the citations provided by appellants clearly maintain that the process will not distinguish the product unless appellants provide evidence to support a difference in the product which cannot be claimed otherwise, due to the nature of the product. Here, there appears to be other options or alternatives for appellants to distinguish their product, and the burden has shifted to appellants since the examiner has set forth a *prima facie* case of obviousness. Appellants may either amend the claims or provide evidence that the claimed product by process is not the same as that in the prior art. Appellants have done neither, therefore, we will sustain the rejection of claims 15-19.

Appeal No. 1998-1595  
Application No. 08/439,912

**CONCLUSION**

To summarize, the decision of the examiner to reject claims 15-19 and 21 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED**

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
KENNETH W. HAIRSTON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

jld/vsh

Appeal No. 1998-1595  
Application No. 08/439,912

JOHN J. MCARDLE JR.  
LEXMARK INTERNATIONAL INC.  
740 NEW CIRCLE ROAD NW  
LEXINGTON , KY 40511-1876