The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WATARU NAKABAYASHI, KAZUYA HONGO, KOICHI YASAKU, KAZUAKI AOKI, MASAAKI SUWABE, KIYOSHI HASHIMOTO and SATORU INAKAGE

Appeal No. 1998-1718
Application No. 08/479,862

ON BRIEF

Before KIMLIN, KRATZ and PAWLIKOWSKI, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 13-19 and 21-26. Claims 10-12, the other claims remaining in the present application, stand withdrawn from consideration. Claim 13 is illustrative:

13. A process for producing an electrophotographic photoreceptor comprising the steps of:

removing part of or all oxidants from an air atmosphere to form a treated air atmosphere; and

preparing a coating solution capable of forming a light-sensitive layer on an electroconductive base;

coating said coating solution on an electroconductive base; and

drying said coating to form a light-sensitive layer;

wherein said step of coating is performed in said treated air atmosphere.

The examiner relies upon the following references as evidence of obviousness:

Mimura et al. (Mimura)	4,492,745	Jan. 8, 1985
Herron et al. (Herron)	5,238,607	Aug. 24, 1993

Appealed claims 16, 18, 19 and 21 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 13-19, 21, 23 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mimura. In addition, claims 13, 14 and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Herron while claims 17 and 23-26 stand rejected under 35 U.S.C. § 102(e) or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Herron.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejections.

We consider first the examiner's rejection of claims 16, 18, 19 and 21 under § 112, second paragraph. According to the examiner, the claims "are indefinite in the concentrations of 80 ppb or 50 ppb because it is not clear what is the basis of said ppb" (page 4 of Answer). However, it is fundamental that claim language is not to be read in a vacuum but in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In the present case, we agree with appellants that the basis for the claimed concentrations would be understood by one of ordinary skill in the art to be atmospheric air that has been treated to remove the oxidants.

We will also not sustain the examiner's prior art rejections since we concur with appellants that neither the vacuum of Mimura nor the nitrogen atmosphere of Herron meets the claimed step in appellants' process of removing part of or

all oxidants from an air atmosphere to form a treated atmosphere. We also agree with appellants that since Mimura and Herron fail to disclose the claimed treated air atmosphere, the references do not describe within the meaning of § 102 performing the claimed coating step in the treated air atmosphere. In addition, the examiner has not established a prima facie case of obviousness for substituting the treated air atmosphere for the vacuum of Mimura or the nitrogen blanket of Herron. Also, we find that the examiner has not refuted appellants' derivation at page 9 of the principal brief, which demonstrates that the concentration of oxidants recited in claims 19 and 21 is not met by the vacuum of Mimura.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
PETER F. KRATZ	)	BOARD OF PATENT

Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
	)	
BEVERLY PAWLIKOWSKI	)	
Administrative Patent Judge	)	

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