

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS E. LEWIS and SUSAN J. LANPHEAR

Appeal No. 1999-1164
Application No. 08/715,559

ON BRIEF

Before GARRIS, JEFFERY SMITH and PAWLIKOWSKI, **Administrative Patent Judges**.

GARRIS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-20. The only other claims remaining in the application, which are claims 21-36 have been withdrawn from further consideration by the examiner.

The subject matter on appeal relates to a method of imaging a lithographic printing member comprising (a) imagining a member by exposure to laser-generated

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heat thereby resulting in deposition of thermal byproducts and (b) rubbing the member with a liquid composition comprising a major proportion by weight of a non-solvent, at least a portion of the non-solvent providing mechanical lubrication, and a minor proportion by weight of a solvent for the previously mentioned byproducts.

This appealed subject is adequately illustrated by independent claim 1 which reads as follows:

1. A method of imaging a lithographic printing member having a layer of an ink-rejecting material and, disposed thereunder, a layer of an ink-receptive material, the method comprising the steps of:

a. imaging the printing member by exposing the member to laser-generated heat in an imagewise pattern to remove or facilitate removal of the ink-rejecting layer, such exposure resulting in deposition of thermal byproducts of the ink-rejecting material onto the ink-receptive layer and generation of thermal byproducts of the ink-receptive material; and

b. rubbing the printing member with a liquid composition comprising a major proportion by weight of a non-solvent for the ink-rejecting and ink-receptive materials, at least a portion of the non-solvent providing mechanical lubrication, and a minor proportion by weight of a solvent for byproducts of at least one of the ink-rejecting and ink-receptive materials.

The references relied upon by the examiner as evidence of obviousness are:

Herrmann et al. (Herrmann)	4,842,988	Jun. 27, 1989
Fuller et al. (Fuller)	5,148,746	Sep. 22, 1992
Leenders	5,378,580	Jan. 03, 1995
Lewis et al. (Lewis)	5,493,971	Feb. 27, 1996

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Scott Paper Company
(Great Britain)

1,489,308

Oct. 19, 1977

Research Disclosure, no. 19201, "Method and material for the production of a dry planographic printing plate", (April 1980).

Claims 1-10 and 12-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fuller in view of Lewis, Leenders, the British reference and Herrmann, and claims 1-20 stand correspondingly rejected over these references and further in view of the Research Disclosure reference.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above-noted rejections.

OPINION

For the reasons which follow, we cannot sustain either of these rejections.

The method defined by appealed independent claim 1 distinguishes over the method of Fuller by requiring that the here claimed rubbing step be practiced with a liquid composition comprising a major proportion of non-solvent, at least a portion of the non-solvent providing mechanical lubrication, and a minor proportion of solvent for byproducts of the ink-rejecting and the ink-receptive materials. While Fuller teaches a rubbing step which includes the use of cleaning fluids (e.g., see lines 21-38 in

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column 18), no details concerning the composition or characteristics of this cleaning fluid are disclosed. In essence, it is the examiner's ultimate conclusion that the here-applied secondary references would have suggested providing Fuller's method with a cleaning fluid of the type specifically defined by the appellants' independent claim.

We agree with the appellants' basic position, however, that the applied prior art contains no teaching or suggestion of providing Fuller's method with a liquid composition corresponding to the one defined by appealed independent claim 1. In support of his contrary view, the examiner urges that the Lewis and Herrmann references in particular would have suggested a liquid composition comprising a major proportion of non-solvent providing mechanical lubrication and a minor proportion of solvent as here claimed. More specifically, the examiner contends that "Herrmann . . . establishes that mixtures where the non-solvent material (isopropanol) constitutes more of the mixture than the solvent (aliphatic hydrocarbons) have been used to clean silicone based lithographic printing plates and that a useful printing plate resulted" (answer, page 11). With respect to the appealed claim 1 requirement that at least a portion of the non-solvent provide mechanical lubrication, the examiner "holds" that "the isopropanol [of Herrmann] inherently lubricates dry surfaces to some degree as it is a fluid" (answer, page 8). The examiner's viewpoint on this matter is not well taken.

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As correctly argued by the appellants in the brief and reply brief, even if the applied references were combined in the manner proposed by the examiner such that Herrmann's isopropanol/aliphatic hydrocarbon mixtures were used as the cleaning fluid in Fuller's method, the consequent method resulting from this combination would not correspond to the appellants' claimed method. This is because, notwithstanding the examiner's previously mentioned "holding", the isopropanol non-solvent of Herrmann cannot be regarded as "providing mechanical lubrication" in accordance with the here claimed method. In this regard, we reiterate the appellants' point that their specification on page 15 clearly reflects that isopropanol, while a non-solvent, does not provide mechanical lubrication in the context of the here claimed invention. For this reason, the isopropanol non-solvent must be provided with a lubricating non-solvent such as glycols, glycol ethers and phthalate esters (see lines 8-19 on specification page 15 as well as appealed claims 15-18).

In short, the examiner has improperly interpreted appealed claim 1 as encompassing isopropanol as a non-solvent which provides mechanical lubrication. Plainly, such an interpretation is improper because it is inconsistent with the appellants' specification disclosure. We here remind the examiner that, while application claims are to be given their broadest reasonable interpretation, this interpretation must be

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consistent with the specification. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

In light of the foregoing, we cannot sustain either of the § 103 rejections advanced by the examiner on this appeal.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JEFFREY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
BEVERLY A. PAWLIKOWSKI)	
Administrative Patent Judge)	

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