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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LIAT TAVERIZATSHY, OR BRANDSTEIN,
EFRAT SOROKER, and EYLAN COHEN

Appeal 2011-010984
Application 11/602,581
Technology Center 1700

Before TERRY J. OWENS, DEBORAH KATZ, and JAMES C. HOUSEL,
Administrative Patent Judges.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 3-9, 11-18, 20, 21, 23-26 and 28-37. Claims 10, 22, 27 and 38, which are all of the other pending claims, stand objected to by the Examiner. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The Appellants claim inkjet inks and inkjet printing methods which use the inks. Claims 1 and 26 are illustrative:

1. An ink-jet ink, comprising:
water, and
at least 35 wt% solids, said solids including pigment particulates and silica particulates dispersed in the ink-jet ink, as well as solid humectant substantially dissolved in the ink-jet ink, said ink-jet ink formulated such that pigment particulates, silica particulates, and solid humectant substantially remain with a dried image printed with said ink-jet ink.

26. An ink-jet ink, comprising:
water, and
at least 20 wt% solids, said solids including pigment particulates and silica particulates dispersed in the ink-jet ink, as well as solid humectant substantially dissolved in the ink-jet ink, said solid humectant including at least one member selected from polyethylene glycol, glucose, and methoxypolyethylene glycol, said ink-jet ink being formulated such that pigment particulates, silica particulates, and solid humectant substantially remain with a dried image printed with said ink-jet ink.

The References

Aida	US 5,716,435	Feb. 10, 1998
Nohr	US 2002/0149656 A1	Oct. 17, 2002

The Rejections

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1, 3, 4, 6-9, 11-18, 20, 23-26 and 28-37 over Aida and claims 5, 21 and 28 over Aida in view of Nohr.

OPINION

We reverse the rejections. We need to address only the independent claims, i.e., claims 1, 18, 26 and 37.¹

Claims 1 and 18

Claims 1 and 18 require an inkjet ink comprising at least 35 wt% solids.

Aida discloses an inkjet ink comprising 0.1-10 wt% of coated organic pigment particles obtained by a salt-milling treatment wherein a pigment derivative and a resin are coated onto organic pigment particles (col. 3, ll. 10-22, 28-36; col. 6, ll. 28-34; col. 7, ll. 9-18, 52-56). The inkjet ink also can comprise 0.5-10 wt% water-based resin, up to 4 wt% water-insoluble dye, and undisclosed amounts of urea (which the Examiner relies upon as corresponding to the Appellants' solid humectant (Ans. 5))² and silica (used as an extender pigment in combination with the organic pigment in the salt-

¹ The Examiner does not rely upon Nohr for any disclosure that remedies the deficiency in Aida with respect to the independent claims (Ans. 6-9, 11).

² The Appellants do not challenge the Examiner's finding that Aida's urea is a solid humectant (Br. 13-14).

milling step or in a subsequent dispersing step) (col. 3, ll. 60-65; col. 8, ll. 36-37; col. 10, ll. 15-18, 37).

The Examiner argues that “the ranges of components taught by Aida et al appear to overlap the claimed range of solid, absence [sic] tangible evidence to the contrary” (Ans. 5).

The Examiner has the initial burden of establishing a prima facie case of obviousness. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976). The Examiner has not explained how Aida would have rendered prima facie obvious, to one of ordinary skill in the art, an inkjet ink comprising at least 35 wt% solids. The Examiner’s mere assertion that Aida’s solids content appears to overlap the Appellants’ recited range is not sufficient to establish a prima facie case of obviousness.

Claims 26 and 37

The Appellants’ claims 26 and 37 require a “solid humectant including at least one member selected from polyethylene glycol, glucose, and methoxypolyethylene glycol”. The Appellants indicate that “solid” means solid at room temperature and that at room temperature polyethylene glycol is solid if its molecular weight is at or above 1000 and liquid if its molecular weight is below 1000 (Spec. 8:1-10).

Aida’s inkjet ink can contain 0-50 wt% of a water-based solvent which can be polyethylene glycol (col. 8, l. 57 – col. 9, l. 3).

The Appellants argue “that there is no indication that Aida teaches the unusual step of using solid PEG to make a solvent” (Reply Br. 6).

The Examiner argues that “because the reference broadly discloses polyethylene glycol, any polyethylene glycol may be present which would not exclude the higher molecular weight polyethylene glycol” (Ans. 10).

The Examiner has not provided evidence that an inkjet ink solvent comprising solid polyethylene glycol was known in the art or that one of ordinary skill in the art would have had an apparent reason to use solid polyethylene glycol in making Aida’s inkjet ink. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Merely pointing out that Aida does not exclude solid polyethylene glycol is not sufficient to establish a prima facie case of obviousness.

For the above reasons we reverse the Examiner’s rejections.

DECISION/ORDER

The rejections under 35 U.S.C. § 103 of claims 1, 3, 4, 6-9, 11-18, 20, 23-26 and 28-37 over Aida and claims 5, 21 and 28 over Aida in view of Nohr are reversed.

It is ordered that the Examiner’s decision is reversed.

REVERSED

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