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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte OFER THALER

Appeal 2012-000534
Application 11/741,632
Technology Center 1700

Before BRADLEY R. GARRIS, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision¹ finally rejecting claims 10 and 17-20.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The invention relates, in general, to “an adhesive toner for use in an electrographic printer” (Spec.³ 4:16-17), wherein the adhesive toner causes a visible toner image to adhere better to a printing medium (*id.* at 2:29-30). Claim 10, the sole independent claim on appeal, is representative of the invention and is reproduced below from the Claims Appendix to the Appeal Brief:

10. A set of toners comprising:

at least one visible toner comprising colored toner particles and carrier liquid having a first adhesion strength to a paper or plastic substrate; and

an adhesive toner comprising adhesive toner particles and carrier liquid having a second adhesion greater than the first adhesion to a paper or plastic substrate,

wherein the colored and adhesive toner particles comprise polymer materials and wherein the polymer composition of the colored and toner particles is different; and

wherein the colored and adhesive toner particles are charged with a same charge polarity.

The Examiner maintains the following grounds of rejection (*see generally*, Ans.⁴ 4-8):

1. claim 10 stands rejected under 35 U.S.C. §103(a) as obvious over

¹ Final Office Action mailed Feb. 9, 2011.

² Appeal Brief filed May 31, 2011 (“App. Br.”).

³ Specification filed Apr. 27, 2007.

⁴ Examiner's Answer mailed Jul. 27, 2011.

Golodetz (WO 03/065126, published Aug. 7, 2003) in view of Till (US 4,684,238, issued Aug. 4, 1987) and Webster's II (Webster's II New Riverside University Dictionary, p. 1176);

2. claims 17-19 stand rejected under 35 U.S.C. §103(a) as obvious over Golodetz, Till, and Webster's II in view of Tsubuko (US 5,759,733, issued Jun. 2, 1998); and

3. claim 20 stands rejected under 35 U.S.C. §103(a) as obvious over Golodetz, Till, Webster's II, and Tsubuko in view of Bhattacharya (US 5,744,269, issued Apr. 28, 1998).

Appellant's principal argument on appeal is that the Examiner reversibly erred in finding the applied prior art teaches or suggests toners having first and second adhesion strengths to a paper or plastic substrate as recited in independent claim 10.⁵ More specifically, the issue we consider is: did the Examiner reversibly err in finding one of ordinary skill in the art would have understood Golodetz's description of toners as having the characteristic of "tackiness" as a description of the toners' abilities to adhere to a substrate?⁶

We answer this question in the negative for the reasons expressed in the Answer and below.

Golodetz describes a printing method in which "[a] first and at least one additional liquid toner[] in [the] images, as transferred to the intermediate transfer member, have different characteristics of tackiness, rheology or cohesiveness at

⁵The separate arguments against the rejections of claims 17-19 and claim 20 are essentially based on Appellant's contention that Tsubuko and Bhattacharya fail to cure this alleged deficiency in the combination of references relied upon to reject claim 10. (See App. Br. 13-15.)

⁶ Any additional issues raised by Appellant have been fully addressed by the Examiner and are unpersuasive for the reasons expressed in the Answer.

[the] elevated temperature” of the intermediate transfer member. (Golodetz 4, last para.) The Examiner, relying on Webster’s II, interprets the term “tackiness,” as used in Golodetz, as meaning “somewhat adhesive.” (Ans. 4.) It is apparent from Golodetz that the toner images received by the intermediate transfer member must adhere to the intermediate transfer member until they are transferred to a final substrate. (*See generally* Golodetz 1, ll. 6-21.) Golodetz states that a suitable intermediate transfer member for use in the printing method is disclosed in Till. (Golodetz 13, last two lines.) Appellant does not dispute the Examiner’s findings that Golodetz’ set of toners are visible (Ans. 4; *see generally*, App. Br. 11-13) and that Till discloses an intermediate transfer member made of plastic (Ans. 6; *see* App. Br. 13 (“Till at most establishes the existence of plastic intermediate transfer members.”).)

The Examiner determines

the artisan would have found it obvious to prepare the toners of [Golodetz] such that one has a greater tackiness or adhesion to an intermediate plastic member than the other toner because [Golodetz] teaches that one of the colored toners is more adhesive than the other, [Golodetz] teaches the toner as in contact with the intermediate transfer member, and the WO document teaches Till as providing useful plastic intermediate transfer members.

(Ans. 6 (emphasis added).)

Appellant disagrees with the Examiner’s finding that Golodetz describes tackiness or adhesiveness of the toners with respect to a substrate, i.e., the transfer member. (App. Br. 11-12.) Appellant contends Golodetz uses the terms “tackiness” and “cohesiveness” to describe image integrity. (*Id.* at 12; *see also* Reply Br.⁷ 5 (“Appellant maintains that the Examiner has not demonstrated that the tackiness characteristic discussed in Golodetz means greater adhesion of a

⁷ Reply Brief filed Sep. 9, 2011.

separation to the transfer member or any substrate.”.)

The Examiner, in response, agrees the term “cohesiveness” describes image integrity, but argues Golodetz’ use of both “tackiness” and “cohesiveness” in the same sentence (*see e.g.* Golodetz 4 *supra* pp. 3-4; Golodetz 2, last four lines (“A general aspect of some embodiments of the invention is concerned with the use of toners having different characteristics (other than color), for example, rheology, tackiness and/or cohesiveness, for at least some of the different colored liquid toners used in a set of liquid toners.”)) supports the Examiner’s position that “tackiness” refers to a different property of the toner. (Ans. 9.) More specifically, the Examiner maintains

[i]n the context of [Golodetz], where “tackiness” is used to define its toners’ characteristics, the artisan would understand the toner’s “tackiness” to relate to the materials the toner comes in contact with. . . [T]he intermediate transfer member is one of a limited number of materials the toner contacts. As a result, the artisan would readily understand toner tackiness as relating to an intermediate member, which the evidence shows to include plastic belts.

(*Id.* at 10.)

Appellant has neither persuasively argued nor provided evidence that one of ordinary skill in the electrophotographic printing art would understand the term “tackiness” as used in Golodetz as referring to image integrity. To the contrary, based on our review of the related art, it appears the term “tackiness” is used in a manner consistent with its ordinary meaning of “somewhat adhesive” to a surface. (*See e.g.* US 5,361,089 col. 2, ll. 35-41, col. 3, ll. 51-63 (using the terms tack and tackiness to refer to adhesion to a surface), cited in Spec. 1:24-2:2; US 6,496,676 B1 col. 2, ll. 24-27 (noting poor cohesive behavior results in image smear during transfer), cited in Spec. 2:3-12.) As such, we are not convinced of reversible error on the part of the Examiner in finding the applied prior art teaches or suggests

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toners having first and second adhesion strengths to a paper or plastic substrate as recited in independent claim 10.

We affirm the Examiner's decision to reject claims 10 and 17-20.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED

kmm