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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YARON GRINWALD, PERETZ BEN-AVRAHAM,
EYAL BECHAR, YIGAL BERSON, STELLA STOLIN RODITI,
MERAV SHAPIRA, PETER FORGACS, and ALBERT TEISHEV¹

Appeal 2015-005458
Application 13/382,518
Technology Center 1700

Before BRADLEY R. GARRIS, CHRISTOPHER C. KENNEDY, and
MONTÉ T. SQUIRE, *Administrative Patent Judges*.

KENNEDY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1–7, 9, and 10. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to the Appellants, the Real Party in Interest is Hewlett-Packard Development Company, LP (“HPDC”), which is a wholly owned affiliate of Hewlett-Packard Company. App. Br. 3. The general or managing partner of HPDC is HPQ Holdings, LLC. *Id.*

BACKGROUND

The subject matter on appeal relates to an ink composition. *E.g.*, Spec. 3:13–20; Claim 1. Claim 1 is reproduced below from page 22 (Claims Appendix) of the Appeal Brief:

1. An ink composition having a viscosity which is below about 50.0 cps and having, at least, 10 wt %, by total weight of the ink composition, of non volatile substances, the composition comprising:
 - a) carrier liquid,
 - b) dispersing agent,
 - c) and solid particles, which are dispersed in the carrier liquid and which comprise pigments embedded with resin polymers.

REJECTIONS ON APPEAL

1. Claims 1–6 and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by Sakasai (EP 1 605 025 A1, published Dec. 14, 2005).
2. Claims 7 and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sakasai.

ANALYSIS

After review of the cited evidence in the appeal record and the opposing positions of the Appellants and the Examiner, we determine that the Appellants have not identified reversible error in the Examiner's rejections. Accordingly, we affirm the rejections for reasons set forth below, in the Non-Final Action dated November 7, 2013 (“Non-Final Act.”),² in the

² In the Final Action, the Examiner states that “[r]ationales for the . . . rejections have been set forth in prior Office actions,” and does not repeat

Final Action dated October 1, 2014 (“Final Act.”), and in the Examiner’s Answer. *See generally* Non-Final Act. 2–6; Final Act. 2–5; Ans. 2–4.

Rejection 1

The Appellants’ arguments concern limitations appearing in claim 1. We select claim 1 as representative of the rejected claims. The remaining claims subject to Rejection 1 will stand or fall with claim 1.

The Examiner finds that “Sakasai discloses an ink composition . . . having a viscosity of 5 cps and 35 wt% of pigment-resin composite particles, said composition comprising a non-aqueous carrier liquid (Isopar-G), a dispersing agent, and solid particles which are dispersed in the carrier liquid and which comprise pigments embedded with resin polymers.” Non-Final Act. 4. The Examiner determines that Sakasai anticipates claim 1. *Id.*

The Appellants argue that “Sakasai does not anticipate the present claims because the ink composition taught by Sakasai does not include solid particles that comprise pigments embedded with resin polymers. Instead, Sakasai teaches pigment particles that have been surface treated with polymers.” App. Br. 12. The Appellants rely on the Declaration of Dr. Yaron Grinwald,³ a named inventor of the application involved in this appeal, for support. *Id.* at 13. The Appellants also argue that, because the manufacturing process taught by Sakasai is not identical to that taught by the Appellants’ Specification, the “processes would produce different results.” *Id.* at 15.

the rejections. *See* Final Act. 3. Thus, reference to the Non-Final Action dated November 7, 2013 is necessary for a full recitation of the rejections.

³ Declaration of Yaron Grinwald, dated August 11, 2014.

We are not persuaded by those arguments. The Examiner finds, and the Appellants do not dispute, that Sakasai teaches ingredients (i.e., carrier liquid, dispersing agent, pigments, and resin polymers) the same as those claimed. *See* Non-Final Act. 4. The Appellants admit that Sakasai discloses “[t]hree polymer treatments,” one of which is a “mechanical method involv[ing] mixing a polymer and a pigment so that the content of the pigment is 5–95%, then kneading the mixture with a kneader or a three-roll mill with heating, and pulverizing the kneaded product with a pin mill.” App. Br. 10–11 (citing Sakasai ¶ 46). The Appellants describe their own Specification as disclosing that “when the particles are described as pigments ‘embedded’ . . . in resin polymers, this refers to composites of pigments and resin polymers that have been generated by a mechanical process such as by milling” *Id.* at 9 (citing Spec. 6:27–33).

Given that Sakasai teaches ingredients the same as those claimed, and that Sakasai teaches a mechanical milling process that appears to be the same as or similar to the mechanical milling process that the Specification identifies as producing “pigments ‘embedded’ . . . in resin polymers,” *see* App. Br. 9; Spec. 7:5–10, the Examiner reasonably determined that a person of ordinary skill in the art would have expected Sakasai’s solid particles to “comprise pigments embedded with resin polymers,” as recited by claim 1. The burden shifted to the Appellants to identify a difference between Sakasai’s ink composition and the ink composition of claim 1. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (“[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.”); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (“Where, as here, the claimed and

prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.”).

The Appellants have not carried that burden. Although we have considered the declaration of Dr. Grinwald, and we have attributed some weight to the declaration, we ultimately do not find it to be persuasive. Dr. Grinwald is a named inventor. *Cf. In re Bulina*, 362 F.2d 555, 559 (CCPA 1966) (“[A]n affidavit by an applicant or co-applicant as to the advantages of his invention is less persuasive than one made by a disinterested person.”). More importantly, however, the declaration includes only a conclusory assertion that “the solid particles in the ink composition achieved in accordance with our Application are very different from the particles disclosed by Sakasai.” Grinwald Decl. at 3. The Appellants identify nothing in Dr. Grinwald’s declaration that would explain why the mechanical milling process of Sakasai would not result in “pigments embedded with resin polymers.” Nor do they identify anything in Dr. Grinwald’s declaration explaining any meaningful difference between Sakasai’s milling process and their own.

Although the Appellants do identify certain differences between other steps of Sakasai’s process and their own process, they provide no explanation or evidence as to why those differences would prevent Sakasai’s process from producing “pigments embedded with resin polymers,” as required by claim 1. *See App. Br.* 14–15. As explained above, the Appellants’ Specification suggests that it is the mechanical milling that results in pigments embedded with resin polymers. Sakasai teaches

mechanical milling of pigments and polymers. On this record, and in view of the arguments presented, we are not persuaded that Sakasai's process does not result in "pigments embedded with resin polymers."

The fact that Sakasai describes its methods as a "surface treatment" does not persuade us otherwise. *See* App. Br. 15–16. The Appellants provide no persuasive explanation as to why use of the language "surface treatment" is mutually exclusive with "pigments embedded with resin polymers." Pigments could, for example, be embedded with the surface of a resin polymer and be considered both a "surface treatment" and "pigments embedded with resin polymers."

The Appellants' arguments do not identify reversible error in the Examiner's rejection of claim 1. We affirm the rejection.

Rejection 2

The Appellants include a separate section in the Appeal Brief devoted to Rejection 2. The substantive arguments are the same as those discussed above. *See* App. Br. 19–20. We reject those arguments for reasons discussed above.

The Appellants also state that "the PTO has failed to show a sufficient rationale for combining the references in the way suggested by the Examiner," and that "unexpected results" rebut the prima facie case of obviousness. *See* App. Br. 19.

Those arguments are not persuasive because they are not accompanied by any explanation. The Examiner's rejection is a single-reference obviousness rejection. The Appellants' bald statement fails to identify any error in the rejection. *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (explaining that, even if the examiner had failed to make a prima facie case,

the Board would not have erred in framing the issue as one of reversible error because “it has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections”). Similarly, a naked assertion of unexpected results, without even an identification of any “results” that would allegedly have been unexpected, *see* App. Br. 19, is insufficient to show that secondary considerations support a conclusion of nonobviousness. *Cf. In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (undeveloped “naked assertion[s]” typically are not persuasive); *In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996) (“Once a prima facie case of obviousness has been established, the burden shifts to the applicant to come forward with evidence of nonobviousness to overcome the prima facie case.”).

We affirm the Examiner’s rejection of the claims subject to Rejection 2.

CONCLUSION

We AFFIRM the Examiner’s rejections of claims 1–7, 9, and 10.

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

AFFIRMED