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| KANESAKA BERNER AND PARTNERS LLP<br>2318 MILL ROAD<br>SUITE 1400<br>ALEXANDRIA, VA 22314-2848 |             |                      | CULLER, JILL E      |                  |
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* HIROMITSU TAMURA, TSUYOSHI KUBOTA, and  
YUICHI AIHARA

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Appeal 2018-003750  
Application 13/811,055  
Technology Center 2800

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Before LINDA M. GAUDETTE, JEFFREY B. ROBERTSON, and  
JENNIFER R. GUPTA, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

The Appellant<sup>2</sup> appeals under 35 U.S.C. § 134(a) from the Examiner’s decision finally rejecting claims 1, 3–6, 19–25, and 27–39.<sup>3</sup>

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<sup>1</sup> This Decision includes citations to the following documents: Specification filed January 18, 2013 (“Spec.”); Final Office Action dated April 7, 2017 (“Final”); Appeal Brief filed August 29, 2017 (“Appeal Br.”); Examiner’s Answer dated December 15, 2017 (“Ans.”); and Reply Brief filed February 15, 2018 (“Reply Br.”).

<sup>2</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Toppan Printing Co., Ltd. and Nisca Corporation. Appeal Br. 2.

<sup>3</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

CLAIMED SUBJECT MATTER

The invention relates to a printing device and a method for transferring an image on a transfer film to a recording medium such as a plastic card. Spec. ¶¶ 1, 2. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A printing device for forming an image on a card-shaped recording medium, comprising:

a medium transport path in which the recording medium is transported;

an image formation section, provided on the medium transport path, having a platen;

a medium transport device for transporting the recording medium to the image formation section;

a film unit for transporting a transfer film to the image formation section, having a guide member supporting the transfer film;

a transfer roller for transferring an image formed on the transfer film to the recording medium;

a transfer roller up-and-down device for moving the transfer roller up and down between an actuation position in press-contact with the recording medium in the image formation section and a retracted position separated therefrom;

a peeling member disposed on a downstream side in a medium transport direction of the transfer roller, and adapted to support the transfer film with the guide member, the peeling member being adapted to peel off the transfer film of which the image is transferred in the image formation section from the recording medium;

a peeling member up-and-down device for moving the peeling member up and down between an actuation position for peeling off the transfer film of which the image is transferred to

the recording medium in which the peeling member contacts the recording medium through the transfer film, and a retracted position for supporting the transfer film in which the peeling member is separated from the recording medium; and

a control device for controlling the transfer roller up-and-down device and the peeling member up-and-down device,

wherein the control device transports the peeling member from the retracted position to the actuation position when the recording medium approaches the image formation section, performs an alignment processing for the recording medium and the transfer film to align, shifts the transfer roller to the actuation position, shifts the transfer roller from the actuation position to the retracted position after a rear end of the recording medium passes through the transfer roller, and shifts the peeling member from the actuation position to the retracted position after the rear end of the recording medium passes through the peeling member, and

when the peeling member is in the retracted position, the transfer film is positioned away from the medium transport path, and when the peeling member is in the actuation position, the transfer film is positioned in the medium transport path.

Appeal Br. 19–20 (Claims Appendix).

## REFERENCES

The Examiner relies on the following prior art as evidence of unpatentability:

| <b>Name</b> | <b>Reference</b>   | <b>Date</b>       |
|-------------|--------------------|-------------------|
| Baumgartner | US 2,737,089       | March 6, 1956     |
| Asakura     | US 4,887,096       | December 12, 1989 |
| Miyaji      | US 6,157,399       | December 5, 2000  |
| Kosaka      | US 6,640,717 B2    | November 4, 2003  |
| Araki       | US 6,801,236 B2    | October 5, 2004   |
| Honma       | US 2003/0025781 A1 | February 6, 2003  |

## REJECTIONS

1. Claims 1, 3–6, 19, 23–25, and 27–39 are rejected under 35 U.S.C. § 103(a) as unpatentable over Miyaji in view of Honma, Asakura, and Araki.
2. Claims 20 and 21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Miyaji in view of Honma, Asakura, Araki, and Kosaka.
3. Claim 22 is rejected under 35 U.S.C. § 103(a) as unpatentable over Miyaji in view of Honma, Asakura, Araki, and Baumgartner.

## OPINION

### *Claims 1, 3, 4, 6, 19, 23, 24, and 27–39*

Independent claim 1 recites a printing device and independent claims 19 and 27 recite printing methods that use a printing device. Appeal Br. 19, 21, 24 (Claims Appendix). Each of these claims requires that the printing device include a peeling member up-and-down device for moving a peeling member to an actuation position and to a retracted position. *See id.* at 19, 21, 25. The claims recite that in the actuation position, the peeling member contacts the recording medium through the transfer film, and in the retracted position, the peeling member supports the transfer film and is separated from the recording medium. *Id.* Independent claim 1 requires that “when the peeling member is in the retracted position, the transfer film is positioned away from the medium transport path.” *Id.* at 20. Independent claims 19 and 27 also recite a step of shifting the peeling member from the actuation position to the retracted position in which “the transfer film is positioned away from the medium transport path.” *Id.* at 22, 25.

The Examiner found that Miyaji discloses a printing device for forming an image on a recording medium that includes a peeling member up

and down means for moving the peeling member (14) between actuation and retracted positions. Final 3. The Examiner found that Miyaji does not disclose that the transfer film is positioned away from the medium transport path when the peeling member is in the retracted position. *Id.* at 4. The Examiner found that Asakura discloses a printing device that includes a peeling member up-and-down device (peeling lever 58) for moving the peeling member (peeling roller 54) between actuation and retracted positions. *Id.* at 5. The Examiner found that in the retracted position, the transfer film (ink ribbon 1) is positioned away from the medium transport path. *Id.* The Examiner found that the ordinary artisan at the time of the invention would have modified Miyaji's peeling member up and down means such that the transfer film was moved away from the medium transport path, as taught by Asakura, "in order to more efficiently replace the transfer film in the apparatus and move the peeling roller into and out of an operative position." *Id.* at 6.

The Appellant's sole argument in support of patentability of independent claims 1, 19, and 27 is that the applied prior art fails to disclose or suggest that in the retracted position, the peeling member supports the transfer film and is separated from the recording medium. *See* Appeal Br. 10–15. The Appellant argues that when Asakura's peeling roller 54 is in the retracted position, the transfer film (ink ribbon 1) is held in contact with the medium transport path (platen 10) by thermal head 25. *Id.* at 13 (providing an annotated copy of Asakura Figure 19A).

In response to the Appellant's argument, the Examiner argues that the claim language does not require a complete separation of the transfer film from the medium support path. Ans. 3. We agree. We have reviewed the

Specification and do not find any disclosure that supports the Appellant's narrow interpretation of the claim language as requiring a separation between the entire transfer film and the medium support path. In the Reply Brief, the Appellant does not dispute the Examiner's claim interpretation, but raises a new argument in support of patentability of independent claims 1, 19, and 27. *See* Reply Br. 1–3. We decline to consider this argument because the Appellant has not explained why the argument was not made in the Appeal Brief. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (“The reply brief is *not* an opportunity to make arguments that could have been made during prosecution, but were not. Nor is the reply brief an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.”).

The Appellant does not present separate arguments in support of patentability of dependent claims 3, 4, 6, 23, 24, and 28–39. Accordingly, for the reasons stated above, in the Final Office Action, and in the Answer, we sustain the rejection of claims 1, 3, 4, 6, 19, 23, 24, and 27–39 under 35 U.S.C. § 103(a) as unpatentable over Miyaji in view of Honma, Asakura, and Araki.

#### *Claims 5 and 25*

Dependent claims 5 and 25 depend indirectly from claims 1 and 19, respectively, and recite that the transfer roller comprises a heat transfer roller that includes a cover member. *See* Appeal Br. 20, 24. As to the cover member, the Examiner found that “this would be a common and obvious addition to the combined invention.” Final 11; *see also* Ans. 4.

We agree with the Appellant that the Examiner's statement is insufficient to satisfy the USPTO's burden of establishing a prima facie case of obviousness. *See* Appeal Br. 15. As explained by our reviewing court,

the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in “notify[ing] the applicant . . . [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” 35 U.S.C. § 132. That section “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990).

*In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (alterations in original).

Accordingly, we reverse the rejection of claims 5 and 25 under 35 U.S.C. § 103(a) as unpatentable over Miyaji in view of Honma, Asakura, and Araki.

#### *Claims 20 and 21*

Claim 20 depends from claim 1 and recites “wherein the peeling member is in the retracted position for preventing the recording medium from colliding with the peeling member when the recording medium is transported toward the reverse unit for printing on said another side of the recording medium.” Appeal Br. 22 (Claims Appendix). Claim 21 depends from claim 19 and recites a step of “transporting the recording medium toward a reverse unit after the transfer roller retracting step, . . . wherein the peeling member is in the retracted position for preventing the recording medium from colliding with the peeling member when transporting the recording medium toward the reverse unit.” *Id.* The Appellant argues that the Examiner failed to identify a prior art teaching of these claim limitations.

As to claim 20, the Examiner found that the ordinary artisan at the time of the invention would have modified Miyaji to include a reverse unit, as taught by Kosaka, in order to enable printing on both sides of the recording medium. Final 18. The Examiner further found that

the combined teachings of the cited prior art would [have] suggest[ed] that the peeling member be in the retracted position for preventing the recording medium from colliding with the peeling member when the recording medium is transported toward the reverse unit for printing on said another side of the recording medium in order to maintain the integrity of the recording medium.

*Id.* The Examiner made similar findings as to claim 21. *See id.* at 18–20. Specifically, the Examiner found that the ordinary artisan would have modified Miyaji’s method to include Kosaka’s reverse unit operational steps. *Id.* at 19. The Examiner found that “the combined teachings of the cited prior art would [have] suggest[ed] the claimed steps of moving the peeling member and the transfer roller in order to appropriately carry out the transfer and printing operations while maintaining the integrity of the recording medium.” *Id.* at 19–20.

Claim 20 is an apparatus claim. The claim 20 “wherein” clause recites a function of the peeling member. The patentability of an apparatus claim depends only on the claimed structure, not on the use or purpose of that structure, *Catalina Marketing Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002), or the function or result of that structure, *In re Danly*, 263 F.2d 844, 848 (CCPA 1959). Courts have interpreted functional language in an apparatus claim as requiring that the apparatus possess the capability of performing the recited function. *See Intel Corp. v. U.S. Int’l Trade Comm’n*, 946 F.2d 821, 832 (Fed. Cir. 1991).

The Examiner's finding that the prior art peeling member is capable of moving in the manner recited in the claim 20 "wherein" clause (*see* Final 3) is, therefore, sufficient to support a conclusion of obviousness as to claim 20. The Appellant has not explained why Miyaji's device, as modified by the secondary references, would not have been capable of preventing a collision between the recording medium and the peeling member when the peeling member is in the retracted position. Accordingly, we are not persuaded of reversible error in the Examiner's rejection of claim 20.

Unlike claim 20, claim 21, as a method claim, requires that the peeling member is moved to a retracted position during transport of the recording medium toward a reverse unit. We agree with the Appellant that the Examiner's unsupported statement that the prior art's combined teachings would have suggested moving the peeling member in the manner recited in claim 21 (*see* Final 19–20) is insufficient to satisfy the USPTO's burden to establish a *prima facie* case of obviousness. *See* discussion of claims 5 and 25 *supra* pp. 6–7. Accordingly, we sustain the rejection of claim 20 under 35 U.S.C. § 103(a) as unpatentable over Miyaji in view of Honma, Asakura, Araki, and Kosaka, but reverse the rejection of claim 21 over the same references.

#### *Claim 22*

The Appellant argues that Baumgartner fails to cure the deficiencies in the Examiner's rejection of claim 1 from which claim 22 depends. Appeal Br. 17. Because we are not convinced of reversible error in the Examiner's rejection of claim 1, we sustain the rejection of claim 22 under 35 U.S.C. § 103(a) as unpatentable over Miyaji in view of Honma, Asakura, Araki, and Baumgartner.

DECISION SUMMARY

| <b>Claims Rejected</b>   | <b>35 U.S.C. §</b> | <b>Reference(s)/Basis</b>                  | <b>Affirmed</b>                  | <b>Reversed</b> |
|--------------------------|--------------------|--|----------------------------------|-----------------|
| 1, 3–6, 19, 23–25, 27–39 | 103(a)             | Miyaji, Honma, Asakura, Araki              | 1, 3, 4, 6, 19, 23, 24, 27–39    | 5, 25           |
| 20, 21                   | 103(a)             | Miyaji, Honma, Asakura, Araki, Kosaka      | 20                               | 21              |
| 22                       | 103(a)             | Miyaji, Honma, Asakura, Araki, Baumgartner | 22                               |                 |
| <b>Overall Outcome:</b>  |                    |  | 1, 3, 4, 6, 19, 20, 22–24, 27–39 | 5, 21, 25       |

TIME PERIOD FOR RESPONSE

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 IN PART