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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte XAVIER GASSO PUCHAL, XAVIER BRUCH,
JEFFREY ALLEN WAGNER and GONZALO GASTON LLADO

Appeal 2019-000891
Application 15/329,386
Technology Center 2800

Before ROMULO H. DELMENDO, N. WHITNEY WILSON,
and MICHAEL G. McMANUS, *Administrative Patent Judges*.

McMANUS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ seeks review of the Examiner's decision to reject claims 1, 2, 5, 7–9, 12, and 14. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant, Hewlett-Packard Development Company, L.P., is also identified as the real party in interest. Appeal Brief (June 14, 2018) (“Appeal Br.”) 2. Appellant further states that Hewlett-Packard Development Company, LP, is a wholly-owned affiliate of HP Inc. *Id.*

CLAIMED SUBJECT MATTER

The claims are directed to a printer such as an inkjet printer. Specification (Jan. 26, 2017) (“Spec.”) ¶ 14. Inkjet printers include “a number of nozzles from which a fluid such as ink is ejected.” *Id.* A quantity of fluid may be left in the area of the nozzle after ejection. *Id.* ¶ 15. This may have undesirable effects. *Id.* ¶ 16–17. The Specification describes such undesirable effects as follows:

The evaporation of some of the components of the fluid may produce changes in the fluid that is being ejected. Specifically, as pigmented ink, for example, dries in an inkjet printhead, a pigment-ink-vehicle separation (PIVS) may take place, which results in the ink in the nozzle bores being substantially devoid of a colorant.

Id. ¶ 16.

The Specification teaches to limit such evaporation by “applying a cap to a printhead comprising selectively applying an immiscible fluid to a surface of a printhead in which the immiscible fluid caps a number of nozzles on a number of nozzles defined within the printhead.” *Id.* ¶ 18.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A printer comprising:
 - a printhead comprising a number of nozzles;
 - an immiscible fluid applicator; and
 - a processor to instruct the immiscible fluid applicator to apply a layer of immiscible fluid to the surface of the printhead.

Appeal Br. 18 (Claims Appendix).

REFERENCE(S)

The prior art relied upon by the Examiner is:

Name	Reference	Date
Moynihan	US 7,344,220 B2	Mar. 18, 2008
Rosenstock	US 4,148,041	Apr. 3, 1979

REJECTIONS

1. Claims 1, 2, 5, 7–9, 12, and 14 are rejected under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor regards as the invention. Final Act. 2.

2. Claims 1, 2, 5, 7–9, 12, and 14 are rejected under 35 U.S.C. § 103 as being unpatentable over Moynihan in view of Rosenstock. *Id.* at 2–4.

OPINION

Rejection 1

The Examiner maintains the rejection of claims 1, 2, 5, 7–9, 12, and 14 as indefinite. *Id.* at 2. The Examiner determines that the phrase “an immiscible fluid” (found in all claims) renders the claims indefinite. *Id.* The Examiner finds that “a fluid by itself cannot be immiscible. A fluid can only be immiscible with respect to another fluid.” *Id.* Accordingly, the Examiner determines “to claim simply that one fluid is itself immiscible is indefinite.” *Id.* In the Answer, the Examiner states that, “because every fluid is both immiscible with respect to a first set fluids and miscible with

respect to a second set of fluids, to simply say that a fluid is immiscible is totally ambiguous.” Answer 3.

Appellant argues that such rejection is in error. Appeal Br. 9. Appellant argues that the Specification defines “immiscible fluid” “broadly as any fluid that does not mix with another fluid.” *Id.* (citing Spec. ¶ 24). Accordingly, Appellant reasons, one of ordinary skill in the art would understand that “immiscible fluid” means “any fluid that does not mix with another fluid.” *Id.*

In its Reply Brief, Appellant argues that “[a]n immiscible fluid may be determined to be immiscible as to another fluid through routine experimentation that is not undue.” Reply Brief (Nov. 13, 2018) (“Reply Br.”) 4–5. Appellant further asserts that “the Answer itself indicates that immiscibility is easily determinable.” *Id.* at 5.

During prosecution, a claim is examined for compliance with section 112(b) by determining whether the claim meets threshold requirements of clarity and precision. *In re Skvorecz*, 580 F.3d 1262, 1268 (Fed. Cir. 2009) (quoting MPEP § 2173.02). A claim should be rejected as indefinite when it is amenable to two or more plausible claim constructions. *See In re Packard*, 751 F.3d 1307, 1324 (Fed. Cir. 2014) (“There are good reasons why unnecessary incoherence and ambiguity in claim constructions should be disapproved”).

The Federal Circuit, however, has held that “[m]erely claiming broadly does not render a claim insolubly ambiguous, nor does it prevent the public from understanding the scope of the patent.” *Ultimax Cement Mfg. Corp. v. CTS Cement Mfg. Corp.*, 587 F.3d 1339, 1352 (Fed. Cir. 2009) (“a claim to a formula containing over 5000 possible combinations is not

necessarily ambiguous if it sufficiently notifies the public of the scope of the claims”).

Here, the Specification states that “the term ‘immiscible fluid’ is meant to be understood broadly as any fluid that does not mix with another fluid.” Spec. ¶ 24. The Specification further states that “[i]n one example, the immiscible fluid does not mix with ink. In another example, the immiscible fluid does not chemically react with a fluid present in a printer cartridge.” *Id.* Appellant, however, has not limited the term “immiscible” by reference to the immiscibility of ink or another fluid present in a printer cartridge. Absent such a point of reference, the term at issue lacks any point of comparison necessary to determine miscibility. To the extent that Appellant argues that the claim should be construed to mean any fluid that does not mix with any other fluid, such construction may, at its outer periphery, require one to test all fluids ever known to exist. This would require undue experimentation to determine the proper scope of the claim. *See Geneva Pharms., Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1383–84 (Fed. Cir. 2003) (citing *In re Halleck*, 422 F.2d 911, 914 (CCPA 1970)).

We further observe ambiguity arising from the Specification’s teaching that “[i]n another example, the immiscible fluid does not chemically react with a fluid present in a printer cartridge.” Spec. ¶ 24. Whether or not one fluid will react with another fluid is typically considered separately from miscibility. The cited portion of the Specification suggests a special definition where a fluid that is soluble with another fluid, but does not chemically react with such fluid, may be “immiscible.” However, the claim language does not elucidate whether such a special definition should be applied, which is an additional reason to affirm the § 112(b) rejection.

Rejection 2

We do not reach the merits of the Examiner's rejection for obviousness under 35 U.S.C. § 103 at this time. Rather, we reverse *pro forma* the outstanding rejection because the appealed claims fail to satisfy the requirements of the second paragraph of 35 U.S.C. § 112. Before a proper review of the prior art rejection can be performed, the subject matter encompassed by the claims on appeal must be reasonably understood without resort to speculation. *See* Appeal Br. 11 (arguing that Moynihan's solvent is not an "immiscible fluid"); Ans. 4 (countering Appellant's argument).

Presently, speculation and conjecture must be utilized by us and by the artisan inasmuch as the claims on appeal do not give adequate notice as to the scope of the disclosed invention. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (A prior art rejection cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of claim language.); *see also In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) ("If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious-the claim becomes indefinite.").

This should not be construed as a decision on the merits of the § 103 rejection.

CONCLUSION

The Examiner's rejection of claims 1, 2, 5, 7-9, 12, and 14 as indefinite is affirmed. The Examiner's rejection of claims 1, 2, 5, 7-9, 12, and 14 is reversed *pro forma*.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	References/ Basis	Affirmed	Reversed
1, 2, 5, 7-9, 12, 14	112(b)	Indefiniteness	1, 2, 5, 7-9, 12, 14	
1, 2, 5, 7-9, 12, 14	103	Moynihan, Rosenstock		1, 2, 5, 7-9, 12, 14
Overall Outcome			1, 2, 5, 7-9, 12, 14	

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED