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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SONIA RONDON *and* KEVIN RAY

Appeal 2019-002225
Application 15/221,996
Technology Center 1700

Before GEORGE C. BEST, JULIA HEANEY, and
MICHAEL G. McMANUS, *Administrative Patent Judges.*

HEANEY, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the Examiner's decision to reject claims 27–40.³ We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

The claimed subject matter relates to a three-layer printing member having a central polymeric layer including nonconductive carbon black particles. Spec. ¶ 7.

Claim 27, reproduced below, is the sole independent claim:

27. A lithographic printing member comprising:
- (a) a first layer presenting a hydrophilic or oleophobic lithographic affinity;
 - (b) a second layer for ablating in response to an imaging pulse, the second layer consisting essentially of a polymeric matrix and, dispersed therein, nonconductive carbon black particles at a loading level sufficient to confer at least partial ablatability with formation of water-compatible imaging debris; and

¹ In this Decision, we refer to the Specification dated July 28, 2016 (“Spec.”), the Appeal Brief dated Oct. 17, 2018 (“Appeal Br.”), the Examiner’s Answer dated December 12, 2018 (“Ans.”), and the Reply Brief dated January 15, 2019 (“Reply Br.”).

² We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Presstek, LLC. Appeal Br. 2.

³ The Examiner withdrew all rejections under 35 U.S.C. § 112 in the Answer. Ans. 5–6.

(c) a third layer presenting an oleophilic lithographic affinity, the second layer being disposed between the first and third layers.

Appeal Br. 11 (Claims Appendix).

REFERENCES

The Examiner relies upon the following prior art:

Name	Reference	Date
Goto	US 2003/0228540 A1	Dec. 11, 2003
Lewis	US 6,055,906	May 2, 2000

REJECTIONS

The Examiner maintains the following rejections:

1. Claims 27–40 as a matter of res judicata over the Board’s decision in Appeal 2014-007839 (“the ’839 Decision”) in parent application 12/697,536 (“the parent ’536 application”). Ans. 3.
2. Claims 27–34 and 36–40 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Goto. Ans. 3.
3. Claim 35 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Goto in view of Lewis. Ans. 5.

OPINION

Res Judicata

The Examiner finds that claims 27–40 correspond directly to claims 1–14 of the parent ’536 application, and are substantially the same as those claims. Ans. 3. Specifically, the Examiner compares the following

limitations from claim 27 on appeal⁴ and claim 1 of the parent '536 application, with underlining indicating the difference in claim language:

Claim 27:

(b) a second layer for ablating in response to an imaging pulse, the second layer consisting essentially of a polymeric matrix and, dispersed therein, nonconductive carbon black particles at a loading level sufficient to confer at least partial ablatability with formation of water-compatible imaging debris;

Claim 1:

(b) a second layer for ablating in response to an imaging pulse, the second layer consisting essentially of a polymeric matrix and, dispersed therein, nonconductive carbon black particles at a loading level sufficient to provide at least partial ablatability and water compatibility following ablation;

Ans. 7–8.

In prosecution of the parent '536 application, the Examiner found that the claim language “to provide at least partial ablatability and water compatibility following ablation” recites an intended use of the nonconductive carbon black (Ans. 7–8), and rejected claims 1–14 as unpatentable over Goto, because Goto taught the same nonconductive carbon black as the claimed invention. Ans. 8 (citing *In re Spada*, 911 F.2d 705, 709 (Fed. Cir. 1990)). The Board affirmed the Examiner’s rejection in the '839 Decision. Based on the '839 Decision and the Examiner’s finding that claims 27–40 are unchanged from claims 1–14, the Examiner determines that patentability of claims 27–40 is a matter of res judicata.

⁴ The Examiner’s reference to claim 28 (Ans. 7) appears to be a typographical error. We understand the intended reference to be claim 27.

Appellant does not dispute that the invention of claims 27–40 is substantially the same as the invention of claims 1–14 of the parent ’536 application. Appellant argues that res judicata is inapplicable because the ’839 Decision turned on the absence of evidence and did not foreclose all avenues of further prosecution. Appeal Br. 5. Appellant argues that two declarations under 37 C.F.R. § 1.132 submitted in this case, the First Ray Declaration filed August 11, 2016 and the Second Ray Declaration filed February 14, 2018, provide the evidence that the ’839 Decision stated was missing. Appeal Br. 5; Reply Br. 9.

We agree with Appellant that res judicata does not apply here, where Appellant has properly submitted new evidence in the present continuation application. Although the claims are substantially the same as those of the parent application and the Examiner’s § 103 rejection is based on the same prior art, the evidence presented in the First and Second Ray Declarations creates a new record that presents a different issue of patentability from the ’839 Decision. Under these circumstances, res judicata is inapplicable. *In re Herr*, 377 F.2d 610, 611–612 (CCPA 1967).

Obviousness

The Examiner finds that Goto teaches a printing plate precursor comprising three layers that correspond to the layers of the printing member recited in appealed claim 27: (1) a hydrophilic silicon rubber layer (Ans. 4 (citing Goto ¶¶ 21–22, 86)); (2) a heat sensitive layer including a binder polymer and carbon black in amounts from 0.5 to 40 wt % (Ans. 3–4 (citing Goto ¶¶ 24, 28, 35, 72–76)); and (3) a substrate comprising polyester or metal having oleophilic lithographic affinity (Ans. 4 (citing Goto ¶¶ 112–113)). The Examiner acknowledges that Goto does not explicitly disclose

that its carbon black particles are nonconductive, but determines it would have been obvious to a person of ordinary skill in the art to select nonconductive carbon black, after standard testing and without the exercise of inventive skill. Ans. 4.

Appellant argues that the appealed claims are patentable over Goto because the binder polymer in Goto's heat sensitive layer includes additional components to enhance adhesion, which materially affect a basic and novel characteristic of Appellant's claimed invention. Appeal Br. 5–6. Appellant argues, therefore, that the transition phrase “consisting essentially of” excludes Goto's binder polymer. Appellant argues that according to the Specification, the “basic and novel characteristics” of the invention are those that overcome the problem of “damage to the fine features of an imaged plate, leading to unacceptable print-work” (Reply Br. 3–4 (citing Spec. ¶¶ 5, 7, 9)), and that the twenty examples described in the First Ray Declaration demonstrate the additional components in Goto's binder polymer, i.e., an active-hydrogen compound and a metal chelate compound, resulted in a damaged, unusable plate when they were added to the polymer in Example 10 of Appellant's Specification. Appeal Br. 6–9. Appellant argues that the experimental data in the First Ray Declaration spans the range of concentrations of metal chelate and active-hydrogen compounds taught in Goto, and that across the range of concentrations and in all of the examples, the result was an unusable plate. *Id.* Appellant further argues that the Second Ray Declaration confirms that the examples of the First Ray Declaration are fully representative of all of the active-hydrogen and metal chelate compounds listed in Goto. Appeal Br. 6–7.

Additionally, Appellant argues that Goto teaches away from using a binder polymer that omits metal chelate and active-hydrogen compounds, because it states that at less than 5 pbw of metal chelate, “image formation becomes difficult,” and at less than 5 pbw of active-hydrogen compound, “printing plate sensitivity is lowered.” Appeal Br. 8 (citing Goto ¶¶ 58, 71).

The Examiner’s response discusses one example from among the twenty examples in the First Ray Declaration and states that the result, “poor silicone adhesion in unimaged plate areas after only 25 impression[s],” is unclear. Ans. 12–13. The Examiner further responds by noting that the polymer compound in Goto’s second layer adds an active hydrogen group-containing compound to promote crosslinking, just as Appellant’s Specification also contains a cross-linker to promote crosslinking. Ans. 13–14 (citing Goto ¶ 63, Spec. ¶ 65). The Examiner reasons that because Goto and the polymer compound of the appealed claims both use cross-linkers “[t]he compounds of both the reference and the instant claims perform the same function. Crosslinking would indeed materially affect the inventive layer as well as the reference layer.” Ans. 14. The Examiner, therefore, determines that the “consisting essentially of” transition phrase does not exclude the additional components of Goto’s binder polymer. *Id.* Similarly, the Examiner determines that Goto does not “require exactly what appellant’s claims exclude” because “Appellant’s cross-linker would be expected to crosslink its layers and as such would not be considered to behave differently than the cross-linker of Goto.” Ans. 14–15.

The Examiner’s response is not persuasive because it does not adequately consider Appellant’s evidence that the additional components in Goto’s cross-linked polymer, i.e., the metal chelate and active-hydrogen

compounds, materially affect a basic and novel characteristic of the claimed invention. The Examiner's conclusion that "the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness" (Ans. 13), upon reviewing one example out of the twenty in the First Ray Declaration, is not supported. Further, the Examiner incorrectly characterizes the metal-chelate and active-hydrogen compounds in Goto's heat sensitive layer as cross-linkers, but in fact, Goto describes them as additional components (*see* Goto ¶¶ 36–85) and Goto does not support equating the additional components with the polymeric matrix of the appealed claims. Therefore, the Examiner's conclusion that Goto's compounds and the appealed claims must perform the same function because they are both crosslinked polymers (Ans. 14) is unsupported. On review of the entire record, we agree with Appellant that the evidence in the First and Second Ray Declarations outweighs the Examiner's findings as to the compounds used in Goto's heat sensitive layer, and therefore, the rejection fails to provide the requisite factual basis for obviousness. *See In re Warner*, 379 F.2d 1011, 1016–17 (CCPA 1967) (the Examiner has the initial duty of supplying the requisite factual basis for obviousness).

Because we find reversible error, we need not reach Appellant's additional arguments for reversal. Further, we need not address the dependent claims subject to the additional obviousness rejection, which do not overcome the deficiency discussed above.

CONCLUSION

The Examiner's rejections are reversed.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
27–34 and 36–40	103(a)	Goto		27–34 and 36–40
35	103(a)	Goto, Lewis		35
Overall Result				27–40

REVERSED