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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEAN-MICHEL FOUET

Appeal 2019-006672
Application 15/424,956
Technology Center 2800

Before BEVERLY A. FRANKLIN, KAREN M. HASTINGS, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

ROBERTSON, *Administrative Patent Judge*.

DECISION ON APPEAL¹

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the Examiner's decision to reject claim 1. Appeal Br. 8–9. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ This Decision includes citations to the following documents: Specification filed February 6, 2017 (“Spec.”); Final Office Action mailed November 6, 2018 (“Final Act.”); Appeal Brief filed May 28, 2019 (“Appeal Br.”); Examiner's Answer mailed July 10, 2019 (“Ans.”); and Reply Brief filed September 10, 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 Xerox Corporation as the real party in interest. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Appellant states the invention relates to an architecture for a digital printer, such as a full-width ink-jet printer, that is suitable for modular configurations. Spec. ¶ 2. Claim 1, the only claim on appeal, is reproduced below (Appeal Br., Claims Appendix 11–12):

1. A printing apparatus comprising:

a housing;

a printing path disposed within the housing along a first level that is located at a first gravitational potential with reference to earth, the printing path defining a first portion having a first printhead associated therewith, and a second portion having a second printhead associated therewith;

a drying path, including a first dryer module and a second dryer module, the drying path being disposed within the housing along a second level that is located at a second gravitational potential with reference to earth, the second gravitational potential being less than the first gravitational potential;

a return path disposed within the housing along a third level that is located at a third gravitational potential with reference to earth, the third gravitational potential being less than the second gravitational potential, the return path being configured to convey a sheet passing from the portion of the drying path through the first dryer module to the return path; and

a first exit opening and a second exit opening in the housing, the first and the second exit openings being located at different positions in the housing;

whereby the printing apparatus can be operated to feed a sheet in one of:

(a) a first arrangement, in which a sheet is fed along the first portion of the printing path then along a first portion of the drying path through the first drying module and then through at least a portion of the return path and then through the second portion of the printing path that is co-linear with the first portion of the printing path and through the second drying module along

a second portion of the drying path that is co-linear with the first portion of the drying path and then to the first exit opening in the housing, and

(b) a second arrangement, in which a sheet is fed through the first portion of the printing path and then through the first drying module and then through the return path to the second exit opening in the printing apparatus.

REFERENCES

The prior art relied upon by the Examiner is:

| Name | Reference | Date |
|-------------------------------------|--------------------|--------------|
| Izawa et al. hereinafter "Izawa" | US 2012/0133715 A1 | May 31, 2012 |

REJECTIONS

1. The Examiner rejected claim 1 under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph as failing to comply with the enablement requirement. Final Act. 3–4.
2. The Examiner rejected claim 1 under 35 U.S.C. § 102(a)(1) as anticipated by Izawa. Final Act. 4–6.

OPINION

Rejection 1

The Examiner's Rejection

In rejecting claim 1, the Examiner determined that there was insufficient support in the Specification for the first and second exit openings recited in the claim. Final Act. 3. The Examiner further explains that there is no housing within the Application that comprises two exit

openings. Ans. 3–4. The Examiner stated that in Figure 1, there is a single housing with a single exit opening. *Id.* at 4. The Examiner then stated the embodiments of Figures 2–8 disclose self-contained housings with a single exit opening, such that one of ordinary skill in the art would not have been able to make and use the invention without undue experimentation as to the existence or placement of two exit openings in a single housing. *Id.*

Appellant’s contentions

Appellant contends the Examiner’s rejection is improperly based on disregarding other embodiments disclosed in the Specification, such as those depicted in Figs. 2–8. Appeal Br. 8, also citing Spec. ¶¶ 19, 21–28; Reply Br. 2. Appellant contends that a first exit opening is defined in Figure 1 when sheet S leaves apparatus 10, and that a second exit opening is defined when sheet S leaves the apparatus shown in Figure 2. *Id.* Appellant contends the Specification in describing the sheet S as going “out of apparatus 10,” is more than sufficient for a person of ordinary skill in the art to practice the printing apparatus of claim 1 without undue experimentation. *Id.* at 8–9, citing Spec. ¶¶ 19, 23–28, Figs. 1, 3–8.

Issue

Did the Examiner err in determining the recitation in claim 1 of “a first exit opening and a second exit opening in the housing” lacks enablement in the Specification?

Discussion

“To satisfy the enablement requirement of § 112, ¶ 1, a patent application must adequately disclose the claimed invention so as to enable a person skilled in the art to practice the invention at the time the application was filed without undue experimentation.” *In re Swartz*, 232 F.3d 862, 863 (Fed. Cir. 2000) (citation omitted).

The scope of the claims must not be broader than the scope of the enabling description in the specification. *See Nat’l Recovery Tech., Inc. v. Magnetic Separation Systems, Inc.*, 166 F.3d 1190, 1196 (Fed. Cir. 1999). “The scope of enablement, in turn, is that which is disclosed in the specification plus the scope of what would be known to one of ordinary skill in the art without undue experimentation.” *Id.* (citation omitted).

To determine whether the necessary experimentation is undue, we look at factors including “(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

Although Appellant contends that Figures 2–8 provide enablement for a first and second exit opening, we are not persuaded that such disclosures provide enablement for a printing apparatus having a housing where “the” housing has two separate exit openings. That is, the embodiments pointed to by Appellant appear to address situations where a printing apparatus contains an additional modular component in the form of an extension module (12) (Spec. ¶ 21, Figure 2) or multiple printing apparatuses (10, 10’)

(Spec. ¶ 22, Figs. 3–8). In particular, the extension module 12 is shown in Figure 2 to be a separate component from the other parts of the apparatus. Fig. 2. Moreover, if extension module 12 is attached inside the apparatus 10, then there would still be only one “exit opening” in the housing as the alleged “first exit opening” would not extend out of the housing and thus would not be an “exit” opening.

Thus, the embodiments pointed to by Appellant do not provide working examples of the particular embodiment recited in claim 1. Moreover, Appellant’s argument that the basic hardware may have the same configuration in apparatuses 10 and 10’ (Appeal Br. 8) would only inform the skilled artisan that the hardware components may be present in both apparatuses with certain modifications made to the motor or other hardware (*see* Spec. ¶ 22), and does not provide sufficient direction or guidance to one of ordinary skill in the art as to the configuration of exit openings recited in claim 1.

Accordingly, we affirm the Examiner’s rejection of claim 1 as lacking enablement.

Rejection 2

The Examiner’s Rejection

In rejecting claim 1 as anticipated by Izawa, the Examiner found Izawa discloses a printing apparatus comprising a printing path, drying path, and return path disposed within a housing at different gravitational levels as recited in claim 1. Final Act. 4–5. The Examiner found Izawa discloses a first exit opening (3a) and a second exit opening (3b) that are located in different positions in the housing. *Id.* at 6; Izawa Fig. 1. The Examiner

found Izawa discloses the printing apparatus may be operated to feed through a first portion of the printing path (first head H5), through the first drying module (5b), and through the return path to the second exit opening (3b) in the printing apparatus as recited in claim 1. *Id.*

Appellant's contentions

Appellant contends Izawa does not disclose a printer with co-linear first and second portions of a drying path as recited in claim 1. Appeal Br. 9. Appellant argues further that Izawa cannot disclose provide such co-linear drying portions because the two dryers in Izawa have circular drying paths through each one. *Id.* Appellant argues also that the printer disclosed in Izawa does not disclose an arrangement that includes two dryers and a second arrangement that includes only one dryer. *Id.*

Issue

Has Appellant demonstrated reversible error in the Examiner's position that Izawa anticipates a printing apparatus that can be operated to feed a sheet in one of a first arrangement and a second arrangement as recited in claim 1?

Discussion

We are not persuaded by Appellant's argument that Izawa does not anticipate claim 1 because Izawa does not disclose first and second co-linear drying path portions. As the Examiner points out in the Answer, the Examiner does not rely on the arrangement containing co-linear drying paths, the first arrangement recited in claim 1, but rather relies on the second

arrangement recited in claim 1. Ans. 4. As to Appellant's argument that Izawa does not disclose a second arrangement with only one dryer, such argument is not commensurate in scope with the claims, as the claims do not exclude situations where the apparatus contains two dryers, where in a particular arrangement or portion of a process, one dryer is used.

Accordingly, we affirm the Examiner's rejection of claim 1 as anticipated by Izawa.³

DECISION SUMMARY

In summary:

| Claims Rejected | 35 U.S.C. § | Reference(s)/Basis | Affirmed | Reversed |
|------------------------|--------------------|---------------------------|-----------------|-----------------|
| 1 | 112 | Enablement | 1 | |
| 1 | 102 | Izawa | 1 | |
| Overall Outcome | | | 1 | |

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

³ Appellant's arguments in the Reply Brief (Reply Br. 2–3) have not been considered as they are untimely, Appellant not having established good cause as to why such arguments made against the Examiner's rejection as stated in the Final Office Action could not have been presented in the Appeal Brief. *See* 37 C.F.R. § 41.41(b)(2).