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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for Karen A. MOFFAT and examiner CHEA, THORL.

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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* KAREN A. MOFFAT, DAVID J.W. LAWTON,  
MELANIE L. DAVIS, JUAN A. MORALES-TIRADO,  
and VARUN SAMBH

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Appeal 2019–001888  
Application 15/227,827  
Technology Center 1700

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Before BEVERLY A. FRANKLIN, N. WHITNEY WILSON, and  
SHELDON M. McGEE, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner’s decision to reject claims 1–2 and 5–21. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> 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 Xerox Corporation. Appeal Br. 2.

### CLAIMED SUBJECT MATTER

Claim 1 is illustrative of Appellant's subject matter on appeal and is set forth below:

1. An emulsion aggregation toner having toner particles comprising  
one single white colorant consisting of titanium dioxide having a specific gravity of from 3.6 to 4.3, wherein the single white colorant is present in an amount of from about 35 weight percent to 60 weight percent by weight of the toner;  
a crystalline polyester resin; and  
an amorphous polyester resin;  
wherein the toner exhibits a lightness ( $L^*$ ) of from about 75 to about 95 at a pigment mass per unit area of from about 0.2 mg/cm<sup>2</sup> to about 1.5 mg/cm<sup>2</sup> based on the surface area of a black substrate.

### REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Kadokura	US 2011/0183247 A1	July 28, 2011
Nosella	US 2012/0070776 A1	March 22, 2012
Sugitate	US 2012/0189950 A1	July 26, 2012

### REJECTIONS

1. Claims 1–2, and 5–21 are rejected under 35 U.S.C. § 112(a), first paragraph, as failing to comply with the written description requirement.

2. Claim 21 is rejected under 35 U.S.C. 112(b), second paragraph, as being indefinite.
3. Claims 1–2, 6, 8–10, 13–14, and 21 are under 35 U.S.C. § 103 as obvious over Sugitate in view of Kadokura or Appellant’s disclosure (Examples 1, 4–10).
4. Claims 5, 7, 11, and 12 are rejected under 35 U.S.C. § 103 as being unpatentable over Sugitate in view of Kadokura or Appellant’s disclosure (Examples 1, 4–10), as applied to claims 1–4, 6, 8–10, and 13–14 above, and further in view of Nosella.
5. Claims 15–20 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of the Sugitate in view of Kadokura or Appellant’s disclosure (Examples 1, 4–10), and further in view of Nosella.

#### OPINION

Upon consideration of the evidence and each of the respective positions set forth by each party, we find that the preponderance of evidence supports Appellant’s position in the record. We thus reverse the Examiner’s decision to reject the appealed claims for the reasons provided by Appellants in the record, and add the following for emphasis.

#### Rejection 1

It is the Examiner’s position that there is no written descriptive support for the claimed specific gravity values. Ans. 3–4. However, we agree with Appellant that the Specification discloses working examples of the inventive embodiments as comprising a single white colorant of titanium

dioxide having the specifically claimed gravity ranges. For example, Example 4 discloses the use of one single type of white colorant, namely TiO<sub>2</sub> R706, and Examples 1-3 and 5-10 disclose the use of one single type of white colorant, namely TiCO<sub>2</sub> R900. Spec., Table 1. Appeal Br. 14. Appellant submitted the vendor's publication as Exhibit A on September 21, 2017 showing the claimed specific gravity values associated with these commercially available products. Appeal Br. 15. We thus agree with Appellant that the inventor had possession of the claimed invention. We thus reverse Rejection 1.

#### Rejection 2

It is the Examiner's position that claim 21 is vague as it is uncertain how the word "type" is being used because it is uncertain if it is describing the white colorant or the titanium dioxide. Ans. 4-5. We agree with Appellant that the word "type" is an adjective for the white colorant. Appeal Br. 17. We note that a claim must be read in accordance with the precepts of English grammar. *In re Hyatt*, 708 F.2d 712, 715 (Fed. Cir. 1983). There is a heavy presumption that a claim term carries its ordinary and customary meaning. *Amgen, Inc. v. Hoechst Marion Rousel, Inc.*, 314 F.3d 1313, 1327.

We thus reverse Rejection 2.

Rejections 3–5<sup>2</sup>

We refer to pages 5–8 of the Answer for the Examiner’s stated position in the record for Rejections 3–5.

Appellant argues that the claims require only one single white colorant consisting of titanium dioxide. Appeal Br. 18. Appellant argues that Sugitate and Kadokura do not use only one single white colorant consisting of titanium dioxide. *Id.* It seems as though the Examiner is treating the different types of white colorant of the applied art as if they are one single white colorant because the types are sourced from TiO<sub>2</sub>. That is, the Examiner states that

[b]oth rutile type and anatase type titanium dioxide are both titanium dioxide, and the one single titanium dioxide colorant being claimed encompasses the scope of both rutile type and anatase type titanium dioxide taught in Sugitate.

Ans. 13.

The fact is, the different types of white colorants disclosed in Sugitate each represent a different white colorant, and thus collectively, more than one single white colorant consisting of titanium dioxide, is used in the invention of Sugitate. In the Answer, the Examiner does discuss certain comparative examples of Sugitate that use only one type of white colorant. Ans. 11. However, we are persuaded by Appellant’s arguments that certain teachings in Sugitate regarding singular use of a white colorant amount to a

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<sup>2</sup> We note that our determination with regard to Rejection 3 is dispositive for Rejections 4 and 5 because the additionally applied reference of Nosella does not cure the stated deficiencies in the combination of Sugitate in view of Kadokura or in view of Appellant’s disclosure.

teaching away. Appeal Br. 20. Reply Br. 4–5. *See also* Sugitate ¶ 13 (explaining the drawbacks of using only one of the rutile type or anatase type titanium oxide). We add that there is absent an explanation in the rejections as to how the applied art suggests to use only one single white colorant consisting of titanium dioxide as required by the claims. This is particularly necessary here in view of Sugitate’s disclosure that Comparative Examples 1 and 2—each containing one type of titanium oxide—exhibited “profound image cracking,” and the highest whiteness variation of the tested samples. Sugitate ¶¶ 212–223, 252–265.

The Examiner relies upon Kadokura or Appellant’s disclosure in an effort to meet the specific gravity values of the claim as well as the claimed lightness value. Ans. 6. Hence, the aforementioned deficiencies of Sugitate are not cured by any of the other references as applied by the Examiner in the rejections.

We thus reverse Rejections 3–5.

### CONCLUSION

We reverse the Examiner’s decision.

### DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Reversed</b>	<b>Affirmed</b>
1–2, 5–21	112(a), 1 <sup>st</sup> ¶	Written description	1–2, 5–21	
21	112(b), 2 <sup>nd</sup> ¶	indefiniteness	21	
1–2, 6, 8–10, 13, 14, 21	103	Sugitate, Kadokura,	1–2, 6, 8–10, 13, 14, 21	

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		Appellant's disclosure		
5, 7, 11, 12	103	Sugitate, Kadokura, Appellant's disclosure, Nosella	5, 7, 11, 12	
15-20	103	Sugitate, Kadokura, Appellant's disclosure, Nosella	15-20	
<b>Overall Outcome</b>			1-2, 5-21	

REVERSED