

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT(S): Thomas R. Pickering EXAMINER: Vajda, Peter L.  
SERIAL NO.: 11/445,360 GROUP: Art Unit 1795  
FILING OR 371(C) DATE: May 31, 2006 DATED: June 25, 2010  
TITLE: TONER COMPOSITION HAVING COATED  
STRONTIUM TITANATE ADDITIVE

Mail Stop APPEAL BRIEF-PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

*Filed Via EFS-Web*  
Confirmation No.: 8035

**REPLY BRIEF**

Dear Sir/Madam:

This Reply Brief is in response to the Examiner's Answer dated April 28, 2010 in the above-identified patent application.

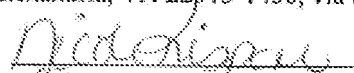
As set forth below, it is respectfully submitted that the references cited by the Examiner are not sufficient to establish a *prima facie* case of obviousness. See MPEP §2142.

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**CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. §1.8(a)**

I hereby certify that this correspondence is being transmitted on the date below with the United States Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450, via electronic submission.

Dated: June 25, 2010

  
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Nicole Rispono

I. Claims 1, 3-4, 8, 16-18, and 22-25

In the Examiner's Answer, the Examiner asserts "Nishihara teaches the addition of silica particles, titania (titanium oxide) particles, and strontium titanate particles (Col. 9 ln. 48-57)." (Examiner's Answer, page 4.)

While Appellant believes the above-cited section of Nishihara is in error, the Examiner also points to Examples 3, 4, and 9<sup>1</sup> of Nishihara as disclosing the use of at least a second external additive. The Examiner then argues that Appellants citation of Example 9, for its disclosure of inferior results, is a "dubious allegation," asserting that Appellant "cherry-picked" the one inventive example using strontium titanate showing an inferior result to draw this conclusion." (Examiner's Answer, page 9.) However, both Example 9 and Example 26 demonstrate issues where these additives were used. In view of the conflicting results of the Examples, it is respectfully submitted that Nishihara cannot be construed as suggesting benefits to be obtained with a combination of strontium titanate and titanium oxide, as well silica, as presently asserted by the Examiner.

Moreover, as admitted by the Examiner, Nishihara does not teach particle sizes for the silica or titanium oxide particles or the use of sol gel silica.

Yamazaki fails to cure the deficiencies of Nishihara no matter how these references may be combined. While Yamazaki discloses rutile-anatase type titanium dioxide having a major axial diameter of 10 to 100 nm, nowhere does Yamazaki disclose or suggest a toner comprising a resin and having on a surface thereof, a first additive

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<sup>1</sup> As Example 3 does not combine titanium oxide and strontium titanate with silica, it is not seen how this example relates to the present claims and therefore is not addressed further herein.

comprising polydimethylsiloxane-coated strontium titanate having a particle size of from about 60 to about 100 nm present in an amount of from about 0.5 to about 3 percent by weight of the toner, a second additive comprising titanium oxide having a particle size of from about 12 to about 40 nm present in an amount of from about 0.1 to about 5 percent by weight of the toner, and a third additive comprising sol gel silica and having a particle size of from about 50 to about 120 nanometers present in an amount of from about 0.1 to about 5 percent by weight of said toner, as recited in claim 1. Nor does Yamazaki disclose or suggest a toner comprising a resin and having on a surface thereof, a first additive comprising polydimethylsiloxane-coated strontium titanate having a particle size of from about 60 to about 100 nm present in an amount of from about 0.5 to about 3 percent by weight of the toner, a second additive comprising titanium oxide having a particle size of from 12 to 40 nm present in an amount of from about 0.1 to about 5 percent by weight of the toner, and a third additive comprising a sol gel silica and having a particle size of from about 120 to about 140 nanometers present in an amount of from about 0.1 to about 5 percent by weight of said toner, as recited in claim 25.

With respect to Combes, according to the Examiner, "Combes specifically teaches that sol gel silica exhibits improved properties over conventional types of silica"

(Examiner's Answer, p. 11). However, Combes states that:

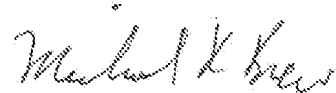
Use of the **treated** sol-gel metal oxide provides significant benefits to the toner compositions. The **treated** sol-gel metal oxide allows for improved cleaning of residual toner from the photosensitive member. The **treated** sol-gel metal oxide also prevents filming of the photosensitive member. [Emphasis Added.]

The sol-gel silica of the present claims is not the "treated" sol-gel metal oxide of Combes. The Examiner argues that it would have been obvious to *replace* the fumed silica of Nishihara with the sol gel silica of Combes. (Examiner's Answer, p. 11.) Such a replacement would not result in the toner of independent claims 1 and 25.

II. Conclusion

In view of the foregoing, Appellants submit that independent claims 1 and 25 are not rendered obvious by any of the cited references, whether taken alone or in any combination. Claims 3, 4, 8, 16-18, and 22-24 depend, either directly or indirectly, from claim 1 and incorporate all of its limitations therein. Therefore, it is respectfully submitted that claims 1, 3, 4, 8, 16-18, and 22-24, are in condition for allowance.

Respectfully submitted,



Michael R. Brew  
Reg. No. 43,513  
Attorney for Applicants

**CARTER, DELUCA, FARRELL & SCHMIDT, LLP**  
445 Broad Hollow Road - Suite 420  
Melville, New York 11747  
Phone: (631) 501-5700  
Fax: (631) 501-3526  
*MRB/mr*