

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI TOKAILIN, HISAHIRO HIGASHI
and CHISHIO HOSOKAWA

Appeal No. 96-1122
Application 08/087,134¹

ON BRIEF

Before WINTERS, DOWNEY and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of

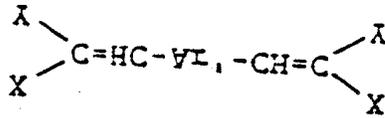
¹ Application for patent filed July 2, 1993. According to appellants, the application is a continuation of Application 07868,726, filed April 14, 1992, now abandoned; which is a division of Application 07.490,337, filed March 8, 1990, now U.S. Patent 5, 130,603.

claims 2, 3, 11, 22 and 23, which are all of the claims remaining in the application.

THE INVENTION

Appellants claim an aromatic dimethylidyne compound having a specified general formula. Appellants state (specification, page 1) that the compound is useful as an emitting material in an electrolu minescence device.

Claim 2 is illustrative and reads as follows:



2. An aromatic dimethylidyne compound of the formula:

wherein X and Y may be the same or different and are each an alkyl group having 1 to 4 carbon atoms, a phenyl group, a substituted phenyl group, a cyclohexyl group, a substituted cyclohexyl group, a naphthyl group, a substituted naphthyl group, a pyridyl group or a substituted pyridyl group, wherein the substituent [sic] is an alkyl group having 1 to 4 carbon atoms, an alkoxy group having 1 to 4 carbon atoms, or a phenyl group, and each substituted group may be substituted by a plurality of said substituent groups, and -Ar'- is

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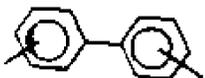
THE REFERENCES

Matsunaga et al. (Matsunaga) 1976	3,980,713	Sep. 14,
Ueda 1990	4,971,874	Nov. 20,

THE REJECTIONS

Claims 2, 3 and 11 stand rejected under 35 U.S.C. §§ 102(a) and 102(e) as being anticipated by Ueda. Claims 2, 3, 11, 22 and 23 stand rejected under 35 U.S.C. § 103 as being obvious over Ueda in view of Matsunaga.

OPINION



We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well founded. Accordingly, we reverse these rejections.

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Under the provisions of 37 CFR

§ 1.196(b), we introduce a new ground of rejection of claims 2, 3, 11, 22 and 23.

Rejection under 35 U.S.C. §§ 102(a) and (e) over Ueda

Ueda discloses an electrophotographic photosensitive member having a photosensitive layer which comprises, as a main component, a styryl compound having a specified general formula wherein group "A", which corresponds to "Ar'" in the formula in appellants' claim 2, is "an alkylene group, an aralkylene group, an arylene group or a bivalent heterocyclic group, each of which may have a substituent" (col. 1, lines 9-13; col. 1, line 53 - col. 2, line 9).

The examiner argues that "'A' may be aralkylene or arylene, which reads on diphenylene, either of which may have a substituent" (answer, page 3). As acknowledged by the examiner (*see id.*), Ueda does not disclose that group "A" can be diphenylene. Furthermore, the examiner has not explained, and it is not apparent, why the disclosure in Ueda that group "A" can be arylene, along with any preferences ascertainable from the remainder of Ueda's disclosure, would have led one of

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ordinary skill in the art to "diphenylene". See *In re Schaumann*, 572 F.2d 312, 316, 197 USPQ 5, 9 (CCPA 1978); *In re Petering*, 301 F.2d 676, 681, 133 USPQ 275, 279-80 (CCPA 1962). Consequently, we do not sustain the examiner's rejection under 35 U.S.C. §§ 102(a) and 102(e).

*Rejection under 35 U.S.C. § 103 over
Ueda in view of Matsunaga*

Matsunaga discloses fluorescent brighteners having a generic formula, and discloses species of the formula which differ from the compound in appellants' claim 2 only in that one of the end constituents of each of Matsunaga's vinyl radicals is hydrogen rather than one of the groups recited in appellants' claim 2 (abstract; cols. 15 and 16, formulas 59, 61 and 62). Matsunaga states that the fluorescent brighteners "can be used for fibers, fabrics, textiles, film, sheet, shaped articles, paint, ink etc.," (col. 5, lines 45-48) made of natural organic materials, semi-synthetic materials, and synthetic organic materials (col. 5, lines 30-41).

The examiner's statement of the rejection is as follows (answer, pages 3-4):

Ueda does not explicitly teach the arylene as

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being diphenylene. However, Matsunga [sic, Matsunaga] discloses processes for the production of bisstyryl compounds wherein a substituted aldehyde is condensed with an aromatic, bis-phosphorous acid diester or mono-phosphorous acid diester (column 1, lines 5-50). It would have been obvious to one skilled in the art to substitute Matsunga's [sic] bisstyryl as Ueda's arylene because varying the reactants of the condensation reaction of Matsunga [sic] one would obtain the claimed reaction products and Ueda's reaction products because the basic reactants are of the same or similar chemical classes. *In re Schwarze*, 190 USPQ 294.^[2]

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritsch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. *Id.* at 1266, 23 USPQ2d at

² In the phrase "substitute Matsunga's bisstyryl as Ueda's arylene" in the above statement, it appears that "bisstyryl" should be replaced by "biphenylene".

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1783-84.

We do not find such an explanation in the above statement of the rejection. In the "response to argument" section of the answer (page 4), the examiner argues that appellants indicate on page 16 of the specification that "arylene" includes "biphenylene", and that appellants indicate on pages 19-21 of their specification that the same process is used to produce essentially the same compounds claimed in the references and by appellants. The examiner does not explain, however, why the teaching from the prior art itself would have fairly suggested, to one of ordinary skill in the art, use of biphenylene as Ueda's group "A". See *Rinehart*, 531 F.2d at 1051, 189 USPQ at 147. Ueda is directed toward photosensitive layers of electrophotographic photosensitive members (col. 1, lines 9-13) and Matsunaga is directed toward fluorescent brighteners "for fibers, fabrics, textiles, film, sheet, shaped articles, paint, ink etc." (col. 5, lines 45-48). The examiner has provided no evidence that compounds which were known to be useful as fluorescent brighteners were known to be useful in photosensitive layers of electrophotographic

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photosensitive members, or provided any other reason why the references themselves would have motivated one of ordinary skill in the art to use Matsunaga's biphenylene group as Ueda's arylene. The motivation relied upon by the examiner comes solely from appellant's specification. Thus, the examiner used impermissible hindsight when rejecting the claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we do not sustain the examiner's rejection under 35 U.S.C. § 103.

Since no *prima facie* case of obviousness has been established, we need not address the experimental results in the declarations. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *Rinehart*, 531 F.2d at 1052, 189 USPQ at 147.

New ground of rejection under 37 CFR § 1.196(b)

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection of claims 2, 3, 11, 22 and 23.

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Claims 2, 3, 11, 22 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting over, respectively, claims 2, 3, 24, 16, and 17 of U.S. Patent 5,130,603 to Tokailin et al. (Tokailin).

Tokailin claims electroluminescence devices comprising light emitting materials which comprise specified compounds. The compounds in appellants' claims 2, 3, 11, 22 and 23 are recited, respectively, in Tokailin's claims 2 (where Ar' is biphenylene), 3, 24, 16, and 17. Hence, appellants' claimed compounds are unpatentable under the doctrine of obviousness-type double patenting over the respective claims of Tokailin. See *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 621-22 (CCPA 1970).

In the application which issued as the Tokailin patent, i.e., Application 07/490,337, a restriction requirement was made (paper no. 5) between a first group of claims directed toward luminescent compounds and electroluminescence devices thereof, and a second group directed toward a process for making the luminescent compounds. Appellants elected the first group and did not traverse the restriction requirement

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(paper no. 8, page 14). Since the claims in the present application are in the elected group of the Tokailin application, an obviousness-type double patenting rejection is appropriate regard less of the restriction requirement.

DECISION

The rejections of claims 2, 3 and 11 under 35 U.S.C. §§ 102(a) and 102(e) as being anticipated by Ueda, and claims 2, 3, 11, 22 and 23 under 35 U.S.C. § 103 as being obvious over Ueda in view of Matsunaga, are reversed. A new ground of rejection has been entered under the provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

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37 CFR § 1.196(b) also provides that the appellant,
WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise
one of the following two options with respect to the new
ground of rejection to avoid termination of proceedings
(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the
claims so rejected or a showing of facts relating to
the claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED, 37 CFR § 1.196(b)

SHERMAN D. WINTERS)
Administrative Patent Judge)
)
)
) BOARD OF PATENT

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MARY F. DOWNEY)	
Administrative Patent Judge)	APPEALS AND
)	
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