

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEREK D. CHAPMAN, RAMANUJ GOSWAMI
and CSABA A. KOVACS

Appeal No. 1997-2271
Application 08/588,969

ON BRIEF

Before JOHN D. SMITH, OWENS and LORIN, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's rejection of claims 1-5, which are all of the claims in the application.¹

¹ The rejection appealed from is a first action rejection. However, because the subject matter on appeal is essentially the same as in the parent case and because the same references

THE INVENTION

Appellants' claimed invention is directed toward an optical recording element which contains a specified metallized azo-ether dye having an alkoxy substituent at the 2-position of a phenyl nucleus, and toward a method for recording optical information using this recording element.

Claim 1 is illustrative and reads as follows:

1. An optical recording element comprising in the following order, a light transmitting substrate, a recording layer containing a dye and a light reflective layer wherein the dye is:

(a) selected so that the real part of the complex reflective index (N) of the unwritten light absorptive layer measured with 780 nm light source is greater than 2.0 and the imaginary part (k) is 0.01 to 0.10 and

(b) a metallized azo-ether dye having an azo group linking a 3-hydroxy-pyridine nucleus to a phenyl nucleus wherein the phenyl nucleus has an alkoxy substituent at its 2-position.^[2]

as in the parent case are applied, we agree with appellants (brief, page 3) and the examiner (answer, page 1) that, in effect, the claims have been twice rejected and that, therefore, we have jurisdiction to decide the appeal.

² There is no clear antecedent basis for "the unwritten light absorptive layer" in claims 1 and 5. Appellants and the examiner should provide clear antecedent basis for this term.

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THE REFERENCES

Bailey et al. (Bailey) 1982	4,358,527	Nov. 9,
Komamura et al. (Komamura '422) 1984	4,425,422	Jan. 10,
Kovacs et al. (Kovacs) 1993	5,272,047	Dec. 21,
Komamura et al. (Komamura '092) ³ 1992 (Japanese Kokai)	4-62092	Feb. 27,

THE REJECTION

Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Kovacs, Komamura '092, Bailey and Komamura '422.

OPINION

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

Kovacs discloses an optical recording element comprising,

³ Citations herein are to an English translation of this reference, a copy of which is provided to appellants with this decision.

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in order, a light transmitting substrate, a recording layer containing a dye, and a light reflecting layer (col. 11, lines 25-28). Preferably, the real part of the complex

refractive index (N) of the unwritten recording layer measured with a 780 nm light source is not less than 1.8 and the imaginary part (k) is not greater than 0.15 (col. 11, lines 33-36). The dye is a metal complex of a tridentate azo dye ligand containing on one side of the azo linkage an aminohydroxypyridine group, and on the other side an aromatic ring including an electron withdrawing substituent (col. 2, lines 32-36). The dye differs from appellants' dye in that it has an oxygen atom attached to the phenyl ring at the 2-position (col. 3, lines 26-30) whereas, at this position, appellants' dye has an alkoxy group.

Komamura '092 discloses a method for forming an image by laminating a layer of a heat-sensitive transfer material on an image-receiving material, wherein 1) the heat-sensitive layer contains a chelating pigment, 2) metal ions are present in either the image-receiving material or in a heat-fusible layer

applied to the surface of the heat-sensitive layer, and 3) heat is applied to cause a reaction to take place between the pigment and the metal ions to form a chelate dye (pages 5 and 11). The pigment has an azo group linking a 3-hydroxy-pyridine nucleus to a phenyl nucleus which can have an alkoxy substituent at its 2-position (page 5).

Bailey and Komamura '422 disclose methods for producing a photographic transfer image wherein 1) an imagewise-exposed photographic element is treated with an alkaline processing composition in the presence of a silver halide developing agent to develop the exposed area of each of the silver halide emulsion layers, 2) a dye-releasing compound releases a diffusible azo dye imagewise as a function of the development of each of the silver halide emulsion layers, and 3) at least a portion of the imagewise distribution of the azo dye diffuses to a dye image-receiving layer to form a metal-complexed azo dye transfer image (Bailey, col. 13, lines 13-26; Komamura '422, col. 10, lines 3-26). The azo dye can have an alkoxy group at the 2-position of a phenyl ring (Bailey, col. 2, lines 1-52;

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col. 2, line 65 - col. 3, line 9; Komamura '422, col. 2, lines 9-14).

The examiner argues that it would have been obvious to one of ordinary skill in the art to use dyes similar to those of Kovacs which are capable of forming a tridentate complex and which have Kovacs' oxygen atom replaced with the alkoxy substituent of Komamura '092, Bailey and Komamura '422, with a

reasonable expectation of achieving a stable complex in the recording layer as shown by Komamura '092, Bailey and Komamura '422 (answer, page 5).

In order for a *prima facie* case of obviousness of appellants' claimed invention to be established, the prior art must be such that it would have provided one of ordinary skill in the art with both a suggestion to carry out appellants' claimed invention and a reasonable expectation of success in doing so. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529,

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1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.* 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 Fritch*, 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. See *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84.

The examiner argues that one of ordinary skill in the art would have had a reasonable expectation of success if the teachings of the references were combined as proposed by the examiner, but has not explained why the references would have fairly suggested, to such a person, the desirability of the proposed modification. The examiner argues that both an alkoxy group and a hydroxyl group at the 2-position of a

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phenyl nucleus function to form a chelate (answer, pages 15-16), but has not explained why the disclosures in Komamura '092, Bailey and Komamura '422 of using an alkoxy group at the 2-position in imaging systems which, as discussed above, are different from that of Kovacs, would have fairly suggested, to one of ordinary skill in the art, the desirability of substituting an alkoxy group for the oxygen atom at the 2-position of the phenyl nucleus of Kovacs' dye.

The examiner, therefore, has not carried the burden of establishing a *prima facie* case of obviousness. Consequently, we reverse the examiner's rejection.

Since no *prima facie* case of obviousness has been established, we need not address the experimental results.

See

In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

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DECISION

The rejection of claims 1-5 under 35 U.S.C. § 103 over the combined teachings of Kovacs, Komamura '092, Bailey and Komamura '422 is reversed.

REVERSED

	JOHN D. SMITH)	
	Administrative Patent Judge)	
)	
)	
)	
	TERRY J. OWENS)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	HUBERT C. LORIN)	
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