

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENSUKE IKEDA
And MAKOTO ONO

Appeal No. 1999-1004
Application 08/764,397

HEARD: DECEMBER 11, 2001

Before OWENS, PAWLIKOWSKI and POTEATE, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-3 and 5-13. Claims 4 and 14 have been canceled. Claim 1 is reproduced below:

1. A photoimaging material comprising a support having thereon a photoimaging layer comprising microcapsules and a reducing agent present outside the microcapsules,

wherein the microcapsules contain a leuco dye capable of oxidative color formation, a photooxidizing agent and an organosulfur antioxidant, and

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wherein the reducing agent is 2,2'-methylenebis(4-methyl-6-t-butylphenol) or 2,2'-methylenebis(4-ethyl-6-t-butylphenol).

The examiner relies upon the following references as evidence of obviousness:

Kohmura et al.(Kohmura)	3,937,864	Feb. 10, 1976
Shibahashi et al.(Shibahashi)	4,425,161	Jan. 10, 1984
Washizu et al.(Washizu)	4,962,009	Oct. 9, 1990
Saeki et al.(Saeki)	4,981,769	Jan. 1, 1991

Claims 1-3 and 5-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over either Saeki or Washizu in view of Kohmura and Shibahashi.

OPINION

We have carefully considered all 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.

It is not disputed that the primary references of Saeki and Washizu are directed to image forming systems utilizing optical exposure and that the secondary references of Kohmura and Shibahashi are each directed to recording materials that require heating for an initial image formation. See pages 9-10 of appellants' brief and see page 6 of the examiner's answer.

Appellants point out that the secondary references of Kohmura and Shibahashi do not utilize their claimed leuco dye capable of oxidative color formation. (brief, page 11). The examiner responds and asserts that all of the applied references use the same family of leuco dyes

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and that one of ordinary skill in the art would naturally look to both areas for any advances or teachings.
(answer, page 6).

We find that in fact the primary references of Saeki and Washizu refer to leuco crystal violet, whereas the secondary references of Shibahashi and Kohmura refer to crystal violet lactone. In their reply brief, appellants also recognize this difference. (reply brief, page 2-3). The examiner fails to address this issue. That is, the examiner does not explain why one of ordinary skill in the art would have been led to utilize the antioxidant set forth in Shibahashi and the developing agent/reducing agent set forth in Kohmura, whereby each of these systems in these secondary references utilize a crystal violet lactone, in the system of Washizu or Saeki which utilize a leuco crystal violet. We note that the examiner bears the initial burden of factually supporting a prima facie conclusion of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Here, the examiner does not explain why one of ordinary skill in the art would have been motivated to utilize the organosulfur antioxidant of Shibahashi in the system of Saeki or Washizu. Also the examiner has not explained why one of ordinary skill in the art would have been motivated to use the developing agent of Kohmura in

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the system of Saeki or Washizu. Finally, the examiner has not explained one of ordinary skill in the art would have been motivated to utilize both the developing agent of Kohmura and the antioxidant of Shibahashi in the system of Saeki or Washizu. Here, absent hindsight, the skilled artisan would not have found it obvious to utilize the antioxidant of Shibahashi and the developing agent of Kohmura for the reason discussed above. These desperate processes provide no desirability for the combination as set forth by the examiner, and we find that the examiner's asserted motivation to combine these references is based on improper hindsight reasoning. These circumstances lead us to conclude that the examiner, in making his Section 103 rejection, has fallen victim to the insidious effect of hindsight syndrome wherein that which only the inventor has taught is used against its teacher. W. L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Hence, we reverse the rejection of record.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-3 and 5-13 under 35 U.S.C. § 103 is reversed.

REVERSED

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PATENT

	Terry J. Owens)	
	Administrative Patent Judge)	
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)	BOARD OF
	Beverly A. Pawlikowski)	
	Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
	Linda R. Poteate)	
	Administrative Patent Judge)	

Sughrue, Mion, MacPeak & Seas
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

BAP/cam