

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.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 YAOPING TAN
and
MAURICE W. LEWIS

Appeal No. 2002-1551
Application No. 09/286,386

ON BRIEF

Before KIMLIN, WALTZ and JEFFREY T. SMITH, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 4-12, 14, 18-21, 24 and 25. Claim 4 is illustrative:

4. A water-based security printing ink which is water proof once dried, and which comprises:

(a) a water soluble, dispersible or emulsifiable pigment or dye

Appeal No. 2002-1551
Application No. 09/286,386

(b) a carrier for said pigment or dye selected from the group consisting of aqueous solutions and water soluble, dispersible or emulsifiable binders; and

(c) a water repelling agent dispersed in the carrier (b) in an amount sufficient to render the ink water proof once dried, wherein the water soluble, dispersible or emulsifiable pigment or dye is selected from thermochromic, photochromic and fluorescent pigments and dyes.

In the rejection of the appealed claims, the examiner relies upon the following references:

Hwang	4,269,627	May 26, 1981
Amon et al. (Amon)	5,630,869	May 20, 1997
Halbrook, Jr. et al. (Halbrook)	5,883,043	Mar. 16, 1999 (filed Aug. 27, 1997)

Appellants' claimed invention is directed to a security printing ink that is water proof when dried. The ink comprises a pigment or dye, a carrier for the pigment or dye, and a water repelling agent which renders the ink water proof when dried. The pigment or dye is thermochromic, photochromic or fluorescent. According to appellants, the ink provides a security feature which "permits the printing of latent images that are revealed with a change in ambient conditions such as light and temperature" (page 2 of principal brief, fourth paragraph).

All the appealed claims stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-23 of U.S. Patent No. 5,883,043. Also, all the appealed

Appeal No. 2002-1551
Application No. 09/286,386

claims stand rejected under 35 U.S.C. § 103 as being unpatentable over Hwang in view of Amon.

We consider first the examiner's double patenting rejection. Although appellants contested this rejection in the principal brief, appellants informed the Board that "a Terminal Disclaimer will be filed to disclaim any patent term which extends beyond the full term of U.S. Patent No. 5,883,043, such that Issue 1 set forth in the Brief of Appeal will be moot" (page 1 of Reply Brief). Accordingly, appellants now do not contest the examiner's double patenting rejection and we, per force, sustain the examiner's rejection.

We now turn to the examiner's rejection of the appealed claims under § 103. Having thoroughly reviewed the opposing positions advanced by appellants and the examiner, we find ourselves in agreement with appellants that the examiner has not established a prima facie case of obviousness for the claimed subject matter. Hwang, the primary reference, is directed to a particular ink composition that comprises a mixture of infrared absorptive dyestuffs and an alkaline agent. As appreciated by the examiner, Hwang does not teach the inclusion of the presently claimed thermochromic, photochromic and fluorescent pigments and dyes. To remedy this deficiency, the examiner relies upon Amon

for disclosing photochromic printing inks, and concludes that it would have been obvious for one of ordinary skill in the art "to substitute the photochromic materials of Amon for the dyes and pigments of Hwang motivated by the expectation that additional feature [sic, features] would be obtained and to expand the utilities of the Hwang inks" (sentence bridging pages 5 and 6 of Answer).

The flaw in the examiner's rationale is that there is no teaching or suggestion in the combined references that the photochromic materials of Amon would be compatible in the ink compositions of Hwang. As urged by appellants, "Amon does not disclose using a water-repelling agent with these photochromic materials,"¹ and "[o]ne skilled in the art would not have a reasonable expectation that the ink components of Amon would be compatible with those of Hwang in that Hwang requires the use of an alkaline agent such as sodium hydroxide in the inks disclosed."² As emphasized by appellants, Amon encapsulizes the photochromic material for protection from the activation by oxygen and detrimental chemical influences, particularly ionic ones. Significantly, the examiner has not explained why one of

¹ Page 4 of principal brief, second paragraph.

² Page 5 of principal brief, second paragraph.

Appeal No. 2002-1551
Application No. 09/286,386

ordinary skill in the art would have reasonably expected photochromic materials of Amon to be compatible with the ink composition of Hwang which comprises an alkaline agent. While the examiner states that there is no "evidence or expectation" that the photochromic agents of Amon cannot be combined with the composition of Hwang,³ the examiner has placed the cart before the horse in not demonstrating why it would have been prima facie obvious for one of ordinary skill in the art to reasonably expect the photochromic agents of Amon to be a suitable addition to the composition of Hwang. Accordingly, we are constrained to reverse the examiner's § 103 rejection.

In conclusion, based on the foregoing, the examiner's double patenting rejection is sustained whereas the § 103 rejection is reversed. The examiner's decision rejecting the appealed claims is affirmed.

³ Page 9 of Answer, penultimate sentence.

Appeal No. 2002-1551
Application No. 09/286,386

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

AFFIRMED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	
THOMAS A. WALTZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
)	
JEFFREY T. SMITH)	
Administrative Patent Judge)	

ECK:clm

Appeal No. 2002-1551
Application No. 09/286,386

Charlene Stukenborg
NCR Corporation Law Dept.
Intellectual Property Section ECD 2
101 West Schantz Ave.
Dayton, CA 45479-0001