

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(2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUFUMI YOKOGAWA, TAKAHIKO FUJISAKI,
MIYAO TAKAHASHI, SHIGERU KAWABATA, NAOKI HARADA,
KINGO AKAHORI, YUTAKA KAYANE, and TAKASHI OMURA

Appeal No. 95-2830
Application 07/967,617¹

HEARD: Feb. 11, 1999

Before WARREN, WALTZ, and LIEBERMAN, Administrative Patent
Judges.

LIEBERMAN, Administrative Patent Judge.

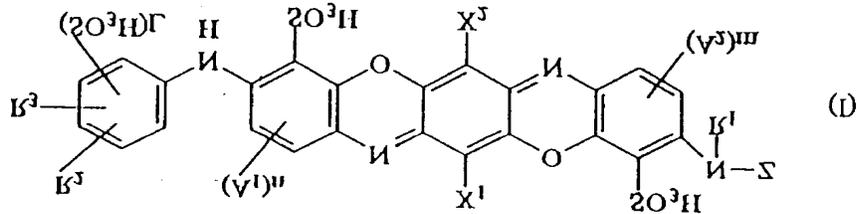
DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the
examiner's final rejection of claims 1, 2, 5 through 9, 11 and
12, all of the claims remaining in this application.

¹ Application for patent filed October 29, 1992.

THE INVENTION

According to appellants, the invention is directed to an asymmetric dioxazine compound having the formula (I) in the free



acid form

wherein A_1 and A_2 independently of one another are each sulfo, halo, alkyl or alkoxy, X_1 and X_2 independently of one another are each hydrogen, halo, alkyl, alkoxy, or phenoxy, R_1 is hydrogen, or unsubstituted or substituted alkyl, R_2 and R_3 independently of one another are each hydrogen, alkyl, alkoxy, halo or amino which is unsubstituted or substituted once or twice by $C_1 - C_4$ alkyl, Z is a fiber reactive group, m and n independent of one another are each 0 or 1, it being provided that m is not equal to n and L is 1 or 2. Claims 1 and 11 are

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illustrative and a copy of which taken from the appellants' Brief is appended to this decision.

The examiner has relied upon the following references to support the rejections:

Pedrazzi	5,122,605	Jun. 16, 1992
Yokogawa et al. (Yokogawa)	5,478,936	Dec. 26, 1995 (filed Aug. 7, 1991)
Sumimoto Chem Co. (EP '975)	0 472 975	Mar. 4, 1992

THE REJECTIONS

The examiner's Final Rejection dated February 25, 1994 is directed to five separate and distinct rejections of record. The first two are directed to the rejection of claims 11 and 12 under 35 U.S.C. § 103 as unpatentable over Yokogawa(CA 118:8311C)² in view of EP '975, Pedrazzi or Smith and the rejection of claims 1, 5 through 9, 11 and 12 under 35 U.S.C. § 103 as unpatentable over Ridyard in view of EP '975, Pedrazzi or Smith. Neither of these rejections has been maintained by the examiner in the Examiner's Answer.

² This Yokogawa reference as opposed to the Yokogawa patent (5,478,936) is a Chemical Abstracts citation, 118:8311C 04/08/92. The Chemical Abstracts reference is no longer relied upon by the examiner in the Examiner's Answer.

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The third rejection directed to the rejection of claims 11 and 12 under 35 U.S.C. § 103 as unpatentable over EP '975 in view of Pedrazzi is maintained by the examiner. The fourth rejection is a provisional rejection of claims 1, 2, 5 through 9, 11 and 12 under 35 U.S.C. § 103 as unpatentable over USSN 08/215,396 in view of Pedrazzi. Since the Brief was submitted, USSN 08/215,396 has matured into U.S. Patent 5,478,936. Accordingly, the rejection supra is no longer provisional. Furthermore at the hearing, February 11, 1999, appellants' counsel confirmed that U.S. Patent 5,478,936 is for all intents and purposes identical to EP '975, both having identical foreign priority applications, Japan 2-220470, dated August 21, 1990 and Japan 3-149813 dated May 24, 1991. Accordingly, we consider the third rejection to be the same as the fourth rejection.

The fifth rejection as stated in the final rejection is the provisional rejection of claims 1, 2, 5 through 9, 11 and 12 under the judicially created doctrine of double patenting over claims 1 through 10 of USSN 08/215,396 in view of Pedrazzi. As stated above, the rejection would now be a rejection of claims 1, 2, 5 through 9, 11, and 12 under the

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judicially created doctrine of double patenting over claims 1 through 10 of U.S. Patent 5,478,936 in view of Pedrazzi. Our analysis of the examiner's rejection of claims 1, 2, 5 through 9, 11, and 12 under the doctrine of judicially created double patenting parallels that for a § 103 rejection. While the double patenting rejection is analogous to a failure to meet the non-obviousness requirement of 35 U.S.C. § 103, that section is not itself involved in double patenting rejections because the patent principally underlying the rejection is not usually prior art. See In re Longi, 759 F.2d 887, 892-93, 225 USPQ 645, 648 (Fed. Cir. 1985); In re Braithwaite, 379 F.2d 594, 600, n. 4, 154 USPQ 29, 34, n. 4 (CCPA 1967). However, in the case before us, the underlying U.S. Patent 5,478,936 constitutes prior art, since it is a continuation of application USSN 07/741,595 having a filing date of August 7, 1991, which is prior to appellants' foreign priority date of November 5, 1991. Accordingly, we will consider the obvious-type double patenting rejection of claims 1, 2, 5 through 9, 11 and 12 as having been subsumed by the rejection of the claims under 35 U.S.C. § 103 over the same reference. See In re Ornitz, 376 F.2d 330, 334, 153 USPQ 453, 457 (CCPA 1967),

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citing In re Bowers, 359 F.2d 886, 891 n.7, 149 USPQ 570, 575
n.7 (CCPA 1966). Based upon the above considerations, the
following rejection is before us for decision.

Claims 1, 2, 5 through 9, 11 and 12 are rejected under 35
U.S.C. § 103 as unpatentable over U.S. Patent 5,478,936
(Yokogawa) in view of Pedrazzi.

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OPINION

Having carefully considered the evidence of record before us, we conclude that the examiner has not established a prima facie case of obviousness within the meaning of 35 U.S.C. § 103. Accordingly, we reverse the examiners decision rejecting claims 1, 2, 5 through 9, 11, and 12.

We recognize that the Yokogawa patent and the instant application parallel each other in the preparation of asymmetric dioxazine compounds. They express the same preferences for fiber forming groups and rely upon the same components in the preparation of their dyes. Compare page 4, line 9 of the Specification through Example 1 with Yokogawa Column 2, line 13 through Example 1. Example 1 of each evidences the preparation of asymmetric dioxazine intermediates alike in every respect including each optional substituent on the dioxazine and the fiber forming group attached thereto. The only distinction between them is the bridging group present in Example 1 of the Yokogawa patent and absent in Example 1 of the instant application.

In this respect, the examiner, in attempting to establish the rejection under 35 U.S.C. § 103, relies upon the alleged

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teaching of equivalency by Pedrazzi of dioxazine compounds optionally having bridging groups present, of the formula $(Y_1-NR)_n$ wherein $n = 0$ or 1 . This bridging group corresponds to the teachings of the primary reference, Yokogawa, having the corresponding bridging group $W-NR_2$, when $n = 1$, and corresponds to the claimed invention when $n = 0$.

However, Pedrazzi fails to establish the equivalency of the bridging group being either present or absent for the purposes and compounds of the instant invention. There is no motivation found in either Yokogawa or Pedrazzi why one having ordinary skill in the art would choose to exclude an internal group, i.e. the $W-NR_2-$ of Yokogawa, based upon the teachings of Pedrazzi.

The examiner states in his Answer, pages 3 and 4, that the secondary reference to Pedrazzi teaches that, "in this art of triphendioxazine fiber dyes, the diamine and amine type bridge between the TPD core and a fiber reactive group are considered functionally equivalent." A careful reading of Pedrazzi does not support the examiner's position. The Z group in Pedrazzi serves the function of being an internal triazinyl bridge between two chromophore containing groups.

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In contrast the non-equivalent Z function of Yokogawa is an external fiber reactive group free of chromophoric groups. Moreover, Pedrazzi does not suggest that the internal triazine bridge performs a fiber reactive function. Nor does Pedrazzi suggest what function, if any, is performed by either the presence or absence of the Y₁NR- bridge.

In determining the propriety of the examiner's case for *prima facie* obviousness, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the proposed substitution or other modification. See In re Lalu 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) and In re Mayne 104 F.3d 1339, 1342 41 USPQ2d 1451, 1454 (Fed. Cir. 1997). Based on our analysis **supra**, we do not find sufficient reason why the person having ordinary skill in the art would have been motivated to remove the W-NR₂- bridge from the dioxazine compound taught by Yokogawa. Accordingly, the examiner's rejection of claims 1, 2, 5 through 9, 11 and 12 under 35 U.S.C. § 103 as unpatentable over Yokogawa in view of Pedrazzi is reversed.

REMAND TO THE EXAMINER

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This application is remanded to the examiner to consider the rejection of the claimed invention as unpatentable over Yokogawa alone. As we discussed above, there is a close parallel relationship between the teachings of Yokogawa and the claimed invention. The distinction between them lies in the presence of a bridging group $W-NR_2-$ being present in Yokogawa patent and absent in the claimed invention. It appears to the Board that appellants definition of Z, the fiber reactive group, may include the bridging group required by Yokogawa. The examiner is referred to the teaching of appellants' specification at page 4, in the last paragraph. Appellants therein define the fiber reactive group as including, "those formed by combination thereof through a suitable bridging group." Based upon this definition of the fiber forming group, the examiner should determine whether the fiber reactive group Z as defined by appellant would be inclusive of the bridging group required by Yokogawa.

DECISION

The rejection of claims 1, 2, 5 through 9, 11 and 12 as unpatentable over Yokogawa (5,478,936) in view of Pedrazzi under 35 U.S.C. § 103 is reversed.

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The examiner is required to take appropriate action consistent with current examining practice and procedure in order to notify appellants of the examiner's position with regard to any rejection over Yokogawa which we have identified above, or take other appropriate action consistent with this decision and the issues presented herein.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application by virtue of its "special" status, requires immediate action. See MPEP §708.01(D) (7th ed., July 1998).

REVERSED AND REMANDED

)	
)	BOARD OF PATENT
THOMAS A. WALTZ)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
PAUL LIEBERMAN)	

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Administrative Patent Judge)

WARREN, *Administrative Patent Judge*, Concurring:

I concur with the panel's decision to reverse the decision of the examiner based on the record before us. I particularly note that the bridging moiety taught by Pedrazzi *contains* the triazinyl group and links *two* chromophoric moieties. Thus, there is no similarity in structure or function between the triazinyl containing bridging moiety of the compounds of Pedrazzi and the bridging moiety used to link a fiber reactive moiety to a single chromophoric moiety in the compounds of Yokogawa. *See In re Payne*, 606 F.2d 303, 315, 203 USPQ 245, 254-55 (CCPA 1979), and cases cited therein. I also concur that this decision carries with it the reversal of the ground of rejection based on the judicially created doctrine of obviousness-type double patenting.

I further concur in the panel's decision to remand this case to the examiner for the examiner's consideration of Yokogawa alone with respect to the appealed claims. It is my view that appealed claims 1, 2 and 5 through 9, which contain the formula member definition "Z is a fiber reactive group," are *prima facie* anticipated by the compounds disclosed by Yokogawa within the meaning of 35 U.S.C. § 102(e) and *prima facie* obvious under 35 U.S.C. § 103 over other teachings of this reference. It is well settled that a reasonable interpretation must be given to the terms of an appealed claim consistent with appellant's specification as it would be interpreted by one of ordinary skill in this art. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). In doing so, the terms in the appealed claim must be given their ordinary meaning unless another meaning is intended by appellants. *See, e.g., Morris*, 127 F.3d at 1055-56, 44 USPQ2d at 1029 ("It is the applicants' burden to precisely define the invention, not the PTO's. See 35 U.S.C. § 112 ¶ 2 [statute omitted]."); *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572-73, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996), and cases cited therein (a claim term will be given its ordinary meaning unless appellant discloses a novel use of that term); *Zletz, supra* ("During patent prosecution the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the

meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art.”).

When the term “fiber reactive group” is given its broadest reasonable interpretation in light of the disclosure at page 4 of appellants’ specification as it would be interpreted by one of ordinary skill in this art, this term includes those fiber-reactive groups “intended” by appellants and thus includes “aromatic ones” which are “formed by combination thereof through a suitable bridging group.”³ Accordingly, since it is clear from the teachings of Yokogawa that the “bridging group” “-W-N(R₂)-Z” is indeed “suitable” to link the “fiber reactive group” “Z” to the chromophoric moiety of the compounds disclosed therein, appealed claims 1, 2 and 5 through 9 are clearly *prima facie* anticipated by and *prima facie* obvious over this reference under §§ 102(e) and 103.

CHARLES F. WARREN) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES

Thomas P. Pavelko, Esq.

³ The pertinent full text at page 4 of appellants’ specification reads as follows:

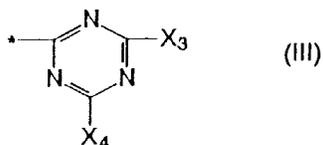
In the present invention, the fiber-reactive group represented by Z is intended to mean those which can react under dyeing or printing conditions with [an] -OH, -NH- or -NH₂ group in the fibers to form a covalent bond.

More specifically, the fiber reactive group includes aromatic ones having at least one fiber reactive substituent on a 5- or 6-membered aromatic heterocyclic ring or a polycondensed aromatic system, aliphatic ones and *those formed by combination thereof through a suitable bridging group*. The heterocyclic ring includes, for example, monoazines, diazines and triazines [Emphasis supplied.]

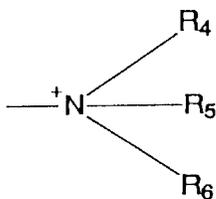
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11. A compound according to Claim 1, wherein the fiber-reactive group represented by Z is either one group represented by the following formulas (III), (IV) or (V):

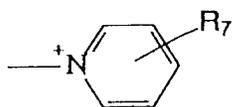


wherein X₃ and X₄ are each independently chloro, fluoro,



wherein R₄, R₅ and R₆ are each independently

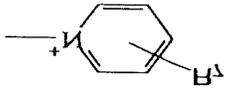
unsubstituted or substituted alkyl or



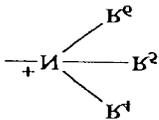
wherein R₇ is hydrogen, cyano, carbamoyl, halo, carboxy,

sulfo, hydroxy, vinyl, or unsubstituted or substituted alkyl

and the mark * is a bond linking to

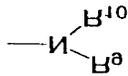


in which B^1 is as defined above, or



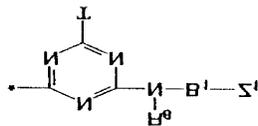
in which B^1 , B^2 and B^e are as defined above,

from the group consisting of porphyrins, bipyridines and phthalocyanines,
 provided that B^9 and B^{10} can be taken together with each other to form a ring selected
 cycloalkyl or an unsaturated or saturated alkyl, vinyl, aryl or benzyl group,

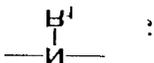


wherein B^9 and B^{10} are each independently methyl, C^2-C^3

ring, ethyl or the group or an alkyl, L is methyl, ethyl,
 saturated alkyl, Σ^1 is $-O^3CH=CH^3$ or $-O^3CH^3CH^3\Lambda^1$, Λ^1 being a group having or
 or $-NB-$ in which B is methyl or C^1-C^4 alkyl, B^8 is methyl or unsaturated or
 or $-(CH^3)^b-O-(CH^3)^d$ wherein b and d are each independently 2, 3 or 4, and O is a $-O-$
 wherein B^1 is an unsaturated or saturated vinylene, alkylene or aryl group,

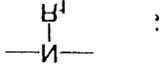
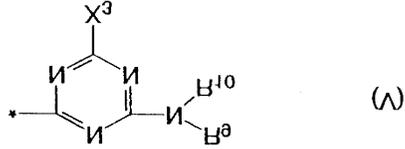


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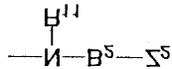
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ωριείν X^3 , B^9 , B^{10} και (ήε) $*$ ατε αε οείμεε αρολε·



και (ήε) $*$ ιε α ρουε ίνκίμεε ιο

οι $-2O^3CH^3CH^3X^3$, X^3 ρείμεε α είονε ααααίε οί ρείμεε εβίηι ρλ (ήε) αείου οί αη αίκαηι
 C^4 αίκαηι, B^{11} ιε μλολοεου οί ηυααααίμεε οί ααααίμεε αίκαηι και Σ^5 ιε $-2O^3CH=CH^3$
 και d ατε ίνθεεουεουίλ Σ^5 ε οί ν^4 και δ ιε $-O-$ οί $-NB-$ ιη ωρίεη B ιε μλολοεου οί C^1-
 αίκαηεου οί ααηίμλίεου είονε, οί $-(CH^3)^b-O-(CH^3)^d-$ ωριείν b



ιη ωρίεη B^5 ιε αη ηυααααίμεε οί ααααίμεε ηίεουίεου,