

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 48

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIANE M. FOLEY,
EVERETT W. BENNETT,
SAM C. SLIFKIN, dec'd,
BY CAROLYN J. SLIFKIN

Appeal No. 1999-1005
Application No. 08/739,157

ON BRIEF

Before KIMLIN, GARRIS, and WALTZ, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 87, 88, 90-92, 94-102, 108, 109 and 116 as amended subsequent to the final rejection.¹ These are all of the claims remaining in the application.

¹We observe that the amendment filed March 5, 1998 after the final rejection has not been physically entered despite the examiner's entry-authorization in the advisory action mailed March 19, 1998. This oversight should be rectified upon return of the application to the jurisdiction of the Examining Corps.

Appeal No. 1999-1005
Application No. 08/739,157

The subject matter on appeal relates to an organization and to a system for transferring a contrasting pattern of intelligence from an ablation-transfer imaging medium to a receptor element. The organization consists essentially of an ablation-transfer imaging medium, which includes a support substrate and a laser radiation-ablative topcoat essentially coextensive therewith, and a receptor element in contiguous registration with the imaging medium. The topcoat contains an ablative-transfer effecting amount of at least one non-black body, non-imaging sensitizer that absorbs laser radiation at a rate sufficient to effect the imagewise ablation mass transfer of the topcoat, and the topcoat also contains an imaging amount of a non-black body, non-ablation sensitizing contrast imaging material comprising a yellow dye or pigment, a magenta dye or pigment, or a cyan dye or pigment. This appealed subject matter is adequately illustrated by independent claim 87 which reads as follows:

87. An organization adopted for transferring a contrasting pattern of intelligence from an ablation-transfer imaging medium to a receptor element, consisting essentially of (1) an ablation-transfer imaging medium including a support substrate and a laser radiation-ablative topcoat essentially coextensive therewith, said essentially coextensive topcoat containing an effecting ablative-transfer effecting amount of at least one non-black body,

Appeal No. 1999-1005
Application No. 08/739,157

non-imaging sensitizer that absorbs laser radiation at a rate sufficient to effect the imagewise ablation mass transfer of said topcoat, and said laser radiation-ablative topcoat also containing an imaging amount of a non-black body, non-ablation sensitizing contrast imaging material therein, said non-black body, non-ablation sensitizing contrast imaging material comprising a yellow dye or pigment, a magenta dye or pigment, or a cyan dye or pigment, and (2) a receptor element in contiguous registration therewith.

The references set forth below are relied upon by the examiner in his Section 102 and Section 103 rejections:

Roberts	3,787,210	Jan. 22, 1974
Smith et al. (Smith)	4,496,957	Jan. 29, 1985
Stewart et al. (Stewart)	4,588,674	May 13, 1986
Barlow	4,788,128	Nov. 29, 1988
Kanno et al. (Kanno)	4,908,294	Mar. 13, 1990
DeBoer	4,973,572	Nov. 27, 1990
Ito et al. (Ito) ²	61-206691	Sep. 12, 1986
(published Japanese Kokai Patent Application) (hereinafter referred to as the Japanese reference).		

Claims 87, 88, 90-92, 94-99, 108, 109 and 116 are rejected under 35 U.S.C. § 102(e) as being anticipated by, or alternatively under 35 U.S.C. § 103(a) as being obvious over, DeBoer. In addition, various appealed claims are rejected under 35 U.S.C. § 103(a) as being obvious over DeBoer in various combinations with the above listed references. Finally, claims

²We rely upon a full English translation of this document, previously made of record.

Appeal No. 1999-1005
Application No. 08/739,157

87, 88, 90-92, 94-99, 102, 108, 109 and 116 are rejected under 35 U.S.C. § 103(a) as being obvious over the Japanese reference in view of Stewart.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejections.

OPINION

We cannot sustain any of these rejections.

The Section 102 and Section 103 rejections which include DeBoer as the primary reference are based upon the examiner's position that patentee discloses ingredients for his thermal transfer system which include the ingredients of the appellants' here claimed organization such as a nitrocellulose binder and accordingly that patentee's system would be inherently capable of performing the ablation mass transfer function of the here claimed organization. Although the examiner recognizes that DeBoer's system is designed to effect a laser-induced thermal dye transfer rather than an ablation mass transfer, he nevertheless argues that patentee's system would inherently exhibit ablation mass transfer by "merely turning up the laser power" (answer,

Appeal No. 1999-1005
Application No. 08/739,157

page 5). As phrased on page 11 of the answer, "the examiner . . . holds that at some laser power possibly above that used in the examples of DeBoer . . . ablation will take place."

The record before us contains no evidence in support of the examiner's position that DeBoer's system would exhibit ablation mass transfer if it were exposed to a sufficiently high laser power. In this regard, we emphasize that the appealed claims require "an effecting ablative-transfer effecting amount of at least one non-black body, non-imaging sensitizer that absorbs laser radiation at a rate sufficient to effect the imagewise ablation mass transfer of said topcoat" (appealed independent claim 87). For all we know, patentee's cyanine ingredient (i.e., which corresponds to the here claimed "non-black body, non-imaging sensitizer") of his thermal transfer system is present in an amount which is completely inadequate under any degree of laser power "to effect the imagewise ablation mass transfer" required by the appellants' claims.

It is well settled that the initial burden of establishing a basis to deny patentability rests upon the examiner and that the examiner, if relying upon a theory of inherency, must provide a basis in fact and/or technical reasoning to reasonably support

Appeal No. 1999-1005
Application No. 08/739,157

his or her determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990).

In the appeal before us, for the reasons expressed above, the examiner has failed to provide a basis to reasonably support his determination that ablation mass-transfer necessarily flows from the teachings of DeBoer. With specific reference to the Section 102 rejection based on the examples (i.e., examples 3 and 4 in particular) of DeBoer, we further emphasize that the examiner has failed to rebut with any reasonable specificity the appellants' argument that the presence of patentee's spacer bead overcoat would prevent an imagewise ablation mass-transfer of the type under consideration. Moreover, the Section 103 rejections based on DeBoer are also deficient in that the specific combination of elements defined by the here claimed organization would have been obtained from the broad disclosure of DeBoer only by selectively picking and choosing particular materials and ingredients with the aid of impermissible hindsight derived from

Appeal No. 1999-1005
Application No. 08/739,157

the appellants' own disclosure. 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).

It follows that the examiner has failed to carry his initial burden of establishing a prima facie case of unpatentability with respect to the Section 102 and Section 103 rejections based on DeBoer as the primary reference. As a consequence, we cannot sustain any of these rejections.

Concerning the Section 103 rejection based on the Japanese reference in view of Stewart, the examiner concludes that:

It would have been obvious to one skilled in the art to add other pigments, such as yellow, which absorb in the blue to improve the light absorbing qualities in this region of spectrum of JP 61-206691 [i.e., the Japanese reference], or to use a combination of cyan, magenta, and blue pigments to form a black layer based upon the teaching by Stewart . . . that these coatings are able to provide masking elements, with a reasonable expectation [of] success in changing the absorptivity of the image without affecting the function of the ablative medium. [Answer, page 10.]

It does not appear to us that the examiner has provided an adequate factual basis for supporting his conclusion that one with ordinary skill in the art would have been motivated, based upon a reasonable expectation of success, to modify the Japanese reference teachings in the proposed manner. In addition, it is significant that the examiner has not contested the appellants'

Appeal No. 1999-1005
Application No. 08/739,157

argument that the result of this modification would not correspond to the here claimed organization. More specifically, it is the appellants' contention that the combination of the Japanese reference and Stewart would contain graphite and/or carbon black as an imaging material in contradistinction to the claim 87 "non-black body, non-ablation sensitizing contrast imaging material." This contention has not been rebutted at all in the examiner's answer. Under these circumstances, we are compelled to regard the examiner as having failed to carry his burden of establishing a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Appeal No. 1999-1005
Application No. 08/739,157

Accordingly, we also cannot sustain the examiner's Section
103 rejection based on the Japanese reference in view of Stewart.

The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

BRG:hh

Appeal No. 1999-1005
Application No. 08/739,157

BRIAN L. MICHAELIS, ESQ.
BROWN, RUDNICK, FREED & GESMER, P.C.
ONE FINANCIAL CENTER, 18TH FLOOR
BOSTON, MA 02111