

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TAKATOSHI ISHIKAWA,  
TETSURO KOJIMA, and  
MASARU YOSHIKAWA

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Appeal No. 1997-3361  
Application No. 08/554,939

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HEARD: January 24, 2001

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Before JOHN D. SMITH, WARREN, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

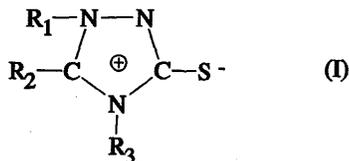
This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1, 7 through 10, 16 through 18, 20, 21, and 23, which are all the claims pending in the subject application. Subsequent to the final Office action, the appellants filed two separate amendments on January 9, 1997 and April 9, 1997 amending claims 1 and 16 and canceling claims 6, 19, and 22. (Papers 12 and 16.) The examiner indicated that

Appeal No. 1997-3361  
Application No. 08/554,939

these amendments have been entered.<sup>1</sup> (Paper 13; examiner's answer, page 3, paper 23; examiner's communication of September 25, 2000, paper 27.)

Claims 1 and 10 are illustrative of the claims on appeal and are reproduced below:

1. A method of processing a silver halide color photographic material which comprises the steps of color-developing an image-wise exposed silver halide color photographic material and subjecting the developed material to desilvering in a processing bath having a fixing function and containing a thiosulfate compound and a compound of the following general formula (I) in a molar ratio of 1/0.05 to 1/0.30:



wherein  $R_1$ ,  $R_2$  and  $R_3$  each represent a hydrogen atom or an alkyl group having 1 to 5 carbon atoms, with the proviso that at least one of  $R_1$ ,  $R_2$  and  $R_3$  is an alkyl group substituted with a water-soluble group selected from the group consisting of sulfonic acid group and carboxylic acid group, and that both  $R_1$  and  $R_3$  cannot be hydrogen atom at the same time, wherein an amount of the compound of the formula (I) is about 0.001 to 0.5 mol/l and an amount of thiosulfate is 0.3 to 3 mol/l in an aqueous solution of the bath.

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<sup>1</sup> The examiner, however, has denied entry of the amendments after final Office action filed June 30, 1997 and March 11, 1998 (Papers 19 and 25). (Examiner's communications of August 28, 1997 and March 24, 1998, papers 20 and 27, respectively.)

Appeal No. 1997-3361  
Application No. 08/554,939

10. The method of claim 1 wherein the silver halide color photographic material has a magnetic recording layer.

The subject matter on appeal relates to a method of processing a silver halide color photosensitive photographic material comprising the recited steps. (Appeal brief, pages 2-3.) According to the appellants, the processing composition "has an excellent fixing function" and "provides a product having an excellent resistance to fading by light." (Appeal brief, page 5.) The appellants further allege that "[t]he inventive method allows for an extremely high speed fixing step even when the rate of addition of a replenisher is low" and that "fixing speed could be increased by use of a combination of a thiosulfate radical and the specified meso-ionic compound... in a specified ratio."

(Id.)

The examiner relies upon the following prior art references as evidence of unpatentability:

Sasaki et al. (Sasaki)	5,120,635	Jun. 9, 1992
Kojima et al. (Kojima '370)	5,298,370	Mar. 29, 1994
Kojima et al. (Kojima '272)	5,543,272	Aug. 6, 1996 (filed Feb. 10, 1994)

Appeal No. 1997-3361  
Application No. 08/554,939

Claims 1, 7, 8, and 9 stand rejected under 35 U.S.C. § 102 as anticipated by Kojima '370.<sup>2</sup> (Examiner's answer, pages 4-7.) Alternatively, claims 1, 7, 8, and 9 stand rejected under 35 U.S.C. § 103 as unpatentable over Kojima '370. (Id.) Further, claims 1, 7 through 9, 16 through 18, 20, 21, and 23 stand rejected under 35 U.S.C. § 103 as unpatentable over Kojima '370 in view of Sasaki. (Examiner's answer, pages 7-10.) Additionally, claims 1, 7 through 10, and 21 stand rejected under 35 U.S.C. § 103 as unpatentable over Kojima '370 in view of Kojima '272. (Examiner's answer, pages 10-13.)<sup>3</sup>

Upon review of the entire record, including all of the appellants' arguments and evidence, it is our judgment that the examiner's rejection under 35 U.S.C. § 102 is not well founded. However, we agree with the examiner as to the rejections under 35

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<sup>2</sup> The examiner indicates that Kojima '370 is available as prior art under either 35 U.S.C. § 102(a) or 35 U.S.C. § 102(e). (Examiner's answer, pp. 4-5.) Kojima '370, however, issued on March 29, 1994, which is more than one year before the U.S. filing date (November 9, 1995) of the present application. Accordingly, under 35 U.S.C. §§ 102(b) and 119(a), Kojima '370 is available as prior art under 35 U.S.C. § 102(b). Because the appellants have not contested the availability of Kojima '370 as prior art under 35 U.S.C. § 102/103, we consider the examiner's error to be inconsequential.

<sup>3</sup> The examiner, however, has apparently withdrawn all rejections based on U.S. Patent 5,401,621 as a prior art reference. (Examiner's answer, p. 4.)

Appeal No. 1997-3361  
Application No. 08/554,939

U.S.C. § 103. Accordingly, we affirm. The reasons for our determination follow.

As a preliminary matter, we note that the appellants urge separate consideration for (1) claims 1, 7 through 9, and 21, (2) claim 10, and (3) claims 16 through 18, 20, and 23. (Appeal brief, pages 6-7.) Regarding group (3), however, the appellants do not explain why these claims are separately patentable over the claims of groups (1) and (2). Merely pointing out differences in what the claims recite is not an argument as to why they are separately patentable. See 37 CFR § 1.192(c)(7) (1995). We therefore select claims 1 and 10 from the three groups of rejected claims and decide this appeal as to the examiner's grounds of rejection on the basis of these claims only.

We consider first the examiner's rejection of claims 1, 7, 8, and 9 under 35 U.S.C. § 102 as anticipated by Kojima '370. "To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); accord Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). In addition, the prior art reference must disclose the limitations of the claimed invention "without any need for picking, choosing,

Appeal No. 1997-3361  
Application No. 08/554,939

and combining various disclosures not directly related to each other by the teachings of the cited reference." In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972); cf. In re Schaumann, 572 F.2d 312, 315, 316, 197 USPQ 5, 8, 9 (CCPA 1978) (holding that "the disclosure of a chemical genus...constitute[s] a description of a specific compound" within the meaning of §102(b) where the specific compound falls within a genus of a "very limited number of compounds.").

Applying these legal principles to the facts of this case, we determine that the examiner's rejection under 35 U.S.C. § 102 relies heavily on "picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." Specifically, Kojima '370 describes a method of processing an imagewise exposed silver halide color photographic material, said photographic material comprising a support having thereon at least one light-sensitive silver halide emulsion layer, comprising the steps of developing in a developing bath, bleaching in a bath having a bleaching ability, and fixing in a bath having a fixing ability.<sup>4</sup> (Column 2, line

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<sup>4</sup> Kojima '370 discloses that the bleaching and fixing steps are known collectively as a "desilvering step." (Col. 1, ll. 20-33.) This is consistent with the appellants' definition of "desilvering." (Specification, p. 16, ll. 11-25.) In any event, Kojima '370 also teaches a bleach-fixing composition containing, inter alia, at least one compound of formulae (A), (B), and (C).

Appeal No. 1997-3361  
Application No. 08/554,939

66 to column 6, line 2.) According to Kojima '370, the bath having a fixing ability contains at least one compound selected from the group consisting of compounds represented by formulae (A), (B), and (C), including compound B-8 which is the appellants' elected species, in an amount from  $1 \times 10^{-5}$  to 10 mol/liter. (Column 3, lines 8-11; column 30, line 65; column 36, lines 1-5; specification, page 5.) Kojima '370 further teaches that the bath having a fixing ability may also contain "known fixing agents" including "thiosulfates, thiocyanates, thioureas and iodide" in an amount of from  $1 \times 10^{-3}$  to 3 mol/liter. (Column 45, lines 40-47.)

Considering Kojima '370 as a whole, we share the appellants' view (appeal brief, pages 9-10) that the disclosure of the prior art reference does not constitute an "anticipation" of the claimed invention. To meet the appellants' claimed limitations concerning compound (I), the thiosulfate, and their relative amounts, the examiner has resorted to "picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference" in order to support a

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(Col. 5, l. 64 to col. 6, l. 2.)

Appeal No. 1997-3361  
Application No. 08/554,939

conclusion of "anticipation."<sup>5</sup> This, of course, is impermissible. Arkley, 455 F.2d at 587, 172 USPQ at 526.

We therefore reverse the examiner's rejection under 35 U.S.C. § 102 of claims 1, 7, 8, and 9 as anticipated by Kojima '370.

However, the examiner's rejections under 35 U.S.C. § 103 stand on different footing. With respect to appealed claim 1, we note that "picking and choosing may be entirely proper" in the context of a §103 obviousness rejection. Id.

As discussed above, Kojima '370 describes a method of processing an imagewise exposed silver halide color photographic material, said photographic material comprising a support having

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<sup>5</sup> The examiner points out that the "molar ratio of 1/0.05 to 1/0.30" as recited in appealed claim 1 "is not matched with any of the proportions in the claims." (Examiner's answer, p. 6.) Although the examiner has not rejected the appealed claims under 35 U.S.C. § 112, ¶2, the examiner's concern appears to be based on an inconsistency between the claimed molar ratio and the recited ranges of amounts for the compound of formula (I) and the thiosulfate. We observe, for example, that certain amounts for the compound of formula (I) (e.g. "about 0.001" mol/liter as recited in appealed claim 1) can not be reconciled with the recited amounts for the thiosulfate and the recited molar ratio, because the minimum amount for the thiosulfate is 0.3 mol/liter and the maximum molar ratio is 1/0.05 (i.e., 20). Thus, it is unclear which limitation (i.e., the molar ratio or the recited range of amounts) should control the metes and bounds of the claim. In the event of further prosecution, we trust that the appellants and the examiner will take appropriate actions to ensure definiteness of claim language in compliance with 35 U.S.C. § 112, ¶2.

Appeal No. 1997-3361  
Application No. 08/554,939

thereon at least one light-sensitive silver halide emulsion layer, comprising the steps of developing in a developing bath, bleaching in a bath having a bleaching ability, and fixing in a bath having a fixing ability. Also, as discussed above, Kojima '370 teaches that the fixing bath can contain compound B-8, which is the appellants' elected species I-5, as well as a known fixing agent such as a thiosulfate in relative amounts encompassed by appealed claim 1. Moreover, Kojima '370 describes working examples (e.g., Table 1, Nos. 11 and 12) showing a method comprising developing an image-wise exposed silver halide color emulsion photographic material and bleach-fixing the photographic material in a solution containing 0.5 mol of compound B-3, which falls within the scope of appealed claim 1. (Example 1.) Thus, we determine that it would have been prima facie obvious for one of ordinary skill in the art to carry out the process as described in Kojima '370 using a fixing bath (or bleach-fixing bath) containing, e.g. 0.5 mol/liter of compound B-8 (or B-3) and 2 mol/liter of a thiosulfate, as expressly described in the reference, so as to arrive at a method encompassed by appealed claim 1, with the reasonable expectation of achieving all of the objects as described in Kojima '370. (Column 2, lines 41-65.)

Appeal No. 1997-3361  
Application No. 08/554,939

That the prior art reference describes a multitude of compounds of formula (A), (B), and (C) and four enumerated "known fixing agents" does not preclude our determination that the subject matter of appealed claim 1 would have been prima facie obvious to one of ordinary skill in the art over Kojima '370. Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); In re Susi, 440 F.2d 442, 445, 169 USPQ 423, 425 (CCPA 1971).

Appealed claim 10 further recites that the silver halide color photographic material has a magnetic recording layer. Kojima '370 does not appear to teach or suggest this feature. However, Kojima '272 teaches that a color negative film should preferably contain a magnetic recording layer as described in WO 90/04205 published on April 1990, copy attached.<sup>6</sup> (Column 30, lines 7-17.) Accordingly, it would have been prima facie obvious for one of ordinary skill in the art to include a magnetic recording layer as described in Kojima '272 in the color photographic material of Kojima '370, with the reasonable expectation of obtaining the well known advantages of a magnetic

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<sup>6</sup> WO 90/04205 teaches that a magnetic layer can be included as an additional layer for the purpose of facilitating information exchange between various users of the film. (Abstract.)

Appeal No. 1997-3361  
Application No. 08/554,939

recording layer (i.e., to facilitate information exchange between various users of the photographic material). Although the processing bath used in Kojima '272 is not the same as that used in Kojima '370, one of ordinary skill in the art would have had a reasonable expectation of success in applying the magnetic recording layer of Kojima '272 to the color photographic material of Kojima '370. In re O'Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) ("Obviousness does not require absolute predictability of success.").

Where, as here, the examiner has established a prima facie case of obviousness, the burden of proof shifts to the appellants to rebut the prima facie case by convincing argument or evidence (e.g., unexpected results). In re Mayne, 104 F.3d 1339, 1343, 41 USPQ2d 1451, 1455 (Fed. Cir. 1997) ("With a factual foundation for its prima facie case of obviousness shown, the burden shifts to applicants to demonstrate that their claimed fusion proteins possess an unexpected property over the prior art."). The question as to whether unexpected advantages have been demonstrated is a factual question. Id. (citing In re Johnson, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984)). Thus, it is incumbent upon the appellants to supply the factual basis to rebut the prima facie case of obviousness established

Appeal No. 1997-3361  
Application No. 08/554,939

by the examiner. See, e.g., In re Klosak, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972).

Relying on the disclosure at column 2, lines 16 and 17 of Kojima '370, the appellants argue that "the selection of thiosulfates become [sic, becomes] even less likely." (Appeal brief, page 12.) However, Kojima '370 teaches that the use of an appropriate amount of sulfites, which is not excluded by the appealed claims, overcomes the problems of thiosulfates. (Column 2, lines 3-17.) The problems regarding the use of thiosulfates as described on column 2, lines 16 and 17 relate to the use of a thiosulfate by itself or the use of an "elevated amount" of sulfites to reduce the amount of replenisher. In any event, the teachings of Kojima '370 as a whole, including the teaching at column 45, lines 40-47, provide the requisite teaching, motivation or suggestion to arrive at a method encompassed by appealed claim 1, as we have discussed above.

The appellants also urge that "the claimed concentrations and molar ratios must be selected from the much broader ranges" described in Kojima '370. (Appeal brief, page 12.) Notwithstanding the appellants' argument, there is no dispute between the appellants and the examiner that the molar ratios and the ranges of amounts recited in the appealed claims overlap

Appeal No. 1997-3361  
Application No. 08/554,939

those in the applied prior art. In this regard, it is well settled that a claimed invention is rendered prima facie obvious when a range recited in the claim overlaps or touches the range disclosed in the prior art. In re Geisler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990); In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

The appellants argue that Kojima '370 "fails to recognize the unexpected effects on fixing speed and resistance to fading caused by light which are provided by a thiosulfate radical in combination with a meso-ionic compound of formula (I)." (Appeal brief, pages 12-13.) To support this allegation, the appellants refer to tests 01-05 as described on pages 70-75 of the present specification. However, we share the examiner's view that the appellants' experimental data are insufficient to rebut the prima facie case of obviousness. In particular, the showing is limited to methods using (i) only one set of specific processing conditions (specification, page 70), (ii) one type of a specific photographic material made of specific coatings and layers, and (iii) a fixing bath containing 1.20 to 1.40 mol/l of ammonium sulfate. By contrast, appealed claims 1 and 16 are not so limited. Appealed claim 1 encompasses any photographic

Appeal No. 1997-3361  
Application No. 08/554,939

substrate, any silver halide emulsion, any processing condition, any thiosulfate, a large number of possible compounds of formula (I), and wide ranges of amounts for the thiosulfate and the compound of formula (I). For example, as pointed out by the examiner (examiner's answer, page 17), the appellants have not presented sufficient evidence that would establish unobvious results for the entire claimed ranges of amounts for the thiosulfate and the compound of formula (I), e.g. about 0.001 mol/liter of a thiosulfate. Under these circumstances, we determine that appellants' showing of unexpected results is far from being commensurate in scope with the degree of patent protection sought. In re Kulling, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990)("[O]bjective evidence of nonobviousness must be commensurate in scope with the claims.") (quoting In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979) ("The evidence presented to rebut a prima facie case of obviousness must be commensurate in scope with the claims to which it pertains.").

For these reasons, we affirm each of the examiner's rejections under 35 U.S.C. § 103.

In summary, we reverse the examiner's rejection under 35 U.S.C. § 102 of claims 1, 7, 8, and 9 as anticipated by Kojima

Appeal No. 1997-3361  
Application No. 08/554,939

'370. However, we affirm (i) the rejection under 35 U.S.C. § 103 of claims 1, 7, 8, and 9 as unpatentable over Kojima '370, (ii) the rejection under 35 U.S.C. § 103 of claims 1, 7 through 9, 16 through 18, 20, 21, and 23 as unpatentable over Kojima '370 in view of Sasaki, and (iii) the rejection under 35 U.S.C. § 103 of claims 1, 7 through 10, and 21 as unpatentable over Kojima '370 in view of Kojima '272.

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

AFFIRMED

JOHN D. SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
CHARLES F. WARREN	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

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Appeal No. 1997-3361  
Application No. 08/554,939

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