

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID CLARKE AND PAUL L. R. STANLEY

Appeal No. 1997-3781
Application No. 08/275,204

ON BRIEF

Before GARRIS, PAK, and TIMM, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 2-9 and 11. Claim 10, the only other pending claim, was withdrawn pursuant to a restriction requirement.

BACKGROUND

Appellants' invention relates to a color photographic material. Claim 11 is illustrative:

11. A color photographic material comprising at least two color-forming units sensitive to different regions of the spectrum each comprising a silver halide emulsion layer wherein the material contains in at least one said silver halide emulsion layer, a ballasted sulphonhydrazide color developing agent and a 3-pyridinol photographic color coupler capable of forming a magenta dye upon coupling with the oxidized form of said developing agent, both incorporated therein in droplets of a high boiling solvent.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Aoki et al. (Aoki)	5,260,177	Nov. 9, 1993
Clarke et al. (Clarke)	5,284,739	Feb. 8, 1994

Claims 2-9 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Clarke in view of Aoki. We reverse substantially for the reasons articulated in the Brief and add the following for emphasis.

OPINION

Clarke, as correctly pointed out by the Examiner, describes the color photographic material of claim 11 except for the specified 3-pyridinol photographic coupler (Answer, pages 3 and 4). The Examiner also correctly points out that Aoki describes a photographic material including a 3-pyridinol photographic coupler and that Aoki even exemplifies one of the couplers used in Appellants' invention

(Answer, page 4). What is missing is a suggestion, somewhere in the prior art, to use the 3-pyridinol coupler with the ballasted sulphonhydrazide developing agent of Clarke and a reasonable expectation that such a combination would result in a useful dye.

Appellants point out that oxidized developing agent and coupler reactively interact to form a dye (Brief, page 3). The color obtained is dependent on the end product of the chemical reaction. Therefore, if the composition of either the developing agent or coupler is changed, the reaction products that result are likely to change as well. Appellants argue that those skilled in the photographic art cannot predict whether a visible dye will be formed, or if one is formed, what color it will be, if either the developing agent or coupler are altered (Brief, page 4). The Examiner has presented no persuasive argument or evidence that the use of 3-pyridinol couplers with any developing agents other than the aromatic primary amines mentioned in Aoki was known in the prior art or that one of ordinary skill in the art would have had a reasonable expectation that a useful dye of any desired color would result from the use of that coupler with a sulphonhydrazide developing agent.

The general disclosure must do more than lead one of ordinary skill in the art down the path of investigation, it must contain a sufficient teaching of how to obtain the desired result or must indicate that the claimed result would be obtained if certain directions were pursued. *The Gillette Co. v. S.C. Johnson & Son Inc.*, 919 F.2d 720, 725, 16 USPQ2d 1923, 1928 (Fed. Cir. 1990)(quoting *In re Eli Lilly & Co.*, 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990)). Here, one of ordinary skill in the art might have experimented with various different couplers until they possibly arrived at a

successful result. However, neither Clarke nor Aoki gives any indication of which parameters are critical for the selection of other coupler/developing agent combinations nor any direction as to which of many possible choices is likely to be successful. Under such circumstances, it may be obvious to try the coupler/developing agent combination of the claims, but there is no reasonable expectation of success that any one particular combination different from the combinations disclosed in Clarke, will result in a useful cyan, magenta or yellow dye. We particularly note that Aoki describes the 3-pyridinol coupler as a cyan dye-forming coupler. Yet, according to Appellants specification, the 3-pyridinol coupler and sulphonhydrazide developing agent combination yields a magenta dye (specification, page 2, line 5). This is evidence of the unpredictability of the dye forming reaction.

We conclude that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the subject matter of claims 2-9 and 11.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 2-9 and 11 under 35 U.S.C. § 103 is reversed.

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

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CATHERINE TIMM)	
Administrative Patent Judge)	

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APPEAL NO. 1997-3781 - JUDGE TIMM
APPLICATION NO. 08/275,204

APJ TIMM

APJ GARRIS

APJ PAK

DECISION: REVERSED

DRAFT TYPED: 16 Jul 02

FINAL TYPED:

3 MEM. CONF. Y N

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GAU: 1700

PALM

ACTS 2

BOOK

DISK (FOIA)

REPORT