

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER D. MARSDEN and JOHN R. FYSON

Appeal No. 95-4513
Application 08/261,667¹

ON BRIEF

Before WINTERS, KIMLIN and OWENS, *Administrative Patent Judges*.²

OWENS, *Administrative Patent Judge*.

¹ Application for patent filed June 17, 1994. According to appellants, the application is a continuation of Application 07/971,843, filed January 22, 1993.

²Weimar, Administrative Patent Judge, who participated in the September 25, 1998 decision, has left the board; therefore, Winters, Administrative Patent Judge, has been added to the panel for consideration of the subject request. Compare, *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

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ON REQUEST FOR REHEARING

Appellants request that we reconsider our decision mailed on

September 25, 1998 wherein we affirmed the rejection of claims 1-6 under 35 U.S.C. § 103 over Koboshi.

Appellants argue (request, page 1) that they find in the record no concession that "[t]here is no dispute as to whether Koboshi discloses developing step (a) in appellants' claim 1" as stated on page 4 of our decision. Appellants did not argue in their briefs that Koboshi does not disclose step (a) of their claim 1 and do not make that argument in their request for rehearing.

Appellants argue that Koboshi teaches that image amplification should not be used with a bleaching step (request, page 1). In support of this argument, appellants rely upon the portion of Koboshi which states: "To wit, the inventors have found that the bleaching of silver with hydrogen peroxide can not take place within the region in which the image is amplified, and that it can only take place

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by using the above-mentioned bath which is so adjusted in a region which is different than the above-mentioned region in which the image is amplified" (col. 3, lines 62-68). The compounds which Koboshi adds to the bath to carry out this adjustment, appellants argue, would materially affect the basic and novel characteristics of appellants' method

and therefore are excluded by the term "consisting essentially of" in step (b) of appellants' claim 1 (request, pages 1-2).

Appellants have not stated on the record what they consider to be the basic and novel characteristics of their method. Our decision (page 5) includes a finding as to what the basic and novel characteristics of appellants' claimed method are, and in appellants' request for rehearing, they do not contest this finding. We remain of the view that for the reasons given in our decision (pages 5-6), the compounds which Koboshi adds to his bath would not materially affect the basic and novel characteristics of appellants' claimed method.

Appellants argue that their method has the advantage of permitting the use of a common storage facility for hydrogen peroxide used in the amplification solution and the bleaching

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solution (request, page 2). As stated in our decision (page 5), the hydrogen peroxide used in Koboshi's bleaching solution could be stored in the same container as hydrogen peroxide used in an amplification solution.

Appellants argue that in our decision, we focused only on step (b) of their method (request, page 2). As discussed above, appellants have not argued that Koboshi does not disclose step (a) of their method.

We have considered appellants' request for rehearing but, for the reasons given above, decline to make any change to our decision.

DENIED

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SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
EDWARD C. KIMLIN)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
TERRY J. OWENS))
Administrative Patent Judge)	

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