

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOMOYUKI KOIDE

Appeal No. 2003-0500
Application No. 09/794,362

HEARD: November 18, 2003

Before WALTZ¹, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-5 and 7-15, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a color photographic light-sensitive material comprising a silver halide emulsion including

¹ Paul Lieberman, Administrative Patent Judge, who participated in the oral hearing for this appeal, is now retired. Therefore, Thomas A. Waltz, Administrative Patent Judge, has been added to the panel for participation in the subject decision. Reargument is not required. See In re Bose Corp., 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985).

specified tabular silver halide grains and a tellurium sensitizer as claimed. Appellant states that "[t]he claims all stand together for the purposes of this appeal" (brief, page 6). Accordingly, we select claim 1 as the representative claim on which we shall decide this appeal. Claim 1 is reproduced below.

1. A silver halide color photographic light-sensitive material comprising, coated on a support, a photographic structural layer that comprises at least one photographic light-sensitive layer containing a light-sensitive silver halide, a compound that forms a dye by a coupling reaction with a oxidized product of a developing agent, and a binder, wherein at least one photographic light-sensitive layer of the light-sensitive material contains a silver halide emulsion that comprises tabular silver halide grains having principal faces composed of (111) planes, an average equivalent circle diameter of a least 0.70 μm , and an average thickness of less that 0.20 μm , and the silver halide of the emulsion is chemically sensitized by a tellurium sensitizer,

wherein the tellurium sensitizer is a compound of formula (III)



wherein, R_{31} and R_{32} each represent $-(\text{C}=\text{Y}')-\text{R}_{33}$; R_{33} represents $\text{NR}_{34}(\text{R}_{35})$; Y' represents an oxygen atom; R_{34} and R_{35} each represent a hydrogen atom, an aliphatic group, an aromatic group, or a heterocyclic group and may bond together to form a ring; and n denotes 1 or 2.

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

Kashi et al. (Kashi)	5,561,033	Oct. 01, 1996
Ito et al. (Ito)	5,985,508	Nov. 16, 1999

Claims 1-5 and 7-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kashi in view of Ito.

We refer to the brief and reply brief and to the final rejection and the answer for a complete exposition of the opposing viewpoints expressed by appellant and the examiner concerning the issues before us on this appeal.

OPINION

Having carefully considered each of appellant's arguments set forth in the brief and reply brief, appellant has not persuaded us of reversible error on the part of the examiner. Accordingly, we will affirm the examiner's rejection for substantially the reasons set forth by the examiner in the final rejection and the answer.

The examiner has found that Kashi discloses a photographic material that corresponds to the material called for by appellant's representative claim 1 but for a difference in the particular tellurium sensitizer employed. See page 2 of the final rejection and the portions of Kashi referred to therein by

the examiner. Moreover, the examiner has determined that Ito discloses the interchangeableness of tellurium compounds that correspond to those required by appellant's representative claim with tellurium compounds that correspond to those employed by Kashi for the purpose of sensitizing silver halide grains. See page 2 of the final rejection and the portions of Ito referred to by the examiner therein. Appellant does not contest those determinations of the examiner in the briefs.

Based on those unchallenged factual findings of the examiner, we agree with the examiner's determination that the combined teachings of Kashi and Ito would have rendered the use of tellurium compounds corresponding to Formula X of Ito as a replacement for or addition to the tellurium compounds of Formula I or II of Kashi prima facie obvious to one of ordinary skill in the art with a reasonable expectation of success in sensitizing the silver halide grains of Kashi in so doing.²

Appellant notes that Ito discloses no additional preference for the compounds of their formula X over the compounds of their

² As pointed out by the examiner in the final rejection, the formula VIII and IX tellurium compounds of Ito correspond to Kashi's formula I and II tellurium compounds and the formula X tellurium compounds of Ito correspond to appellant's claimed tellurium compounds of formula III.

formula VIII or IX. Appellant argues against the examiner's obviousness conclusion based on an expected rough functional equivalency of the formula VIII, IX and X compounds of Ito principally by maintaining that their specification and a declaration of the named inventor, Mr. Tomoyuki Koide, that is of record, provide evidence of unexpected results for their formula III compounds that correspond to Ito's formula X compounds. A copy of the declaration accompanies the briefs. Appellant asserts that the furnished evidence overcomes any prima facie case of obviousness (brief, pages 7-9 and reply brief) that is made out by the examiner based on the applied references' teaching of the interchangeableness of the formula VIII, IX and X compounds of Ito as sensitizers in Kashi.

We do not find appellant's evidence sufficient to outweigh the evidence of obviousness relied upon by the examiner. In this regard, we note that a review of representative appealed claim 1 reveals that a variety of tellurium compounds are included in the scope of representative claim 1, including tellurium compounds as shown at page 15, line 18 of appellant's specification, as amended in the amendment filed April 05, 2002. Yet, the specification and declaration only furnish test results for three tellurium compounds (Koide declaration, page 3) within the

scope of the broad class of tellurium compounds that representative claim 1 is inclusive of.

Appellant has not furnished any test results for tellurium compounds within the claimed formula wherein $n = 2$. Nor do the furnished test results establish the effect of varying other additives and parameters that may be used in photographic materials that are within the scope of the representative appealed claim. For example, representative claim 1 is open to any iodide content, grains that may or may not have dislocation lines and using any percentage of the total projected area of all grains that is occupied by tabular grains. Yet, the tested examples employed methods of preparation that resulted in particular amounts of iodide content (about 3 mole percent) and relatively high tabular grain area percentage ratios and a number of dislocation lines in the tabular grains. See, e.g., pages 21-27 and Example 1 of appellant's specification. We note that applicant/declarant has not offered a convincing line of reasoning explaining why one of ordinary skill in the art would expect substantially the same results with the multitude of alternative compositions that are embraced by the claims as with the tested compounds.

The question as to whether unexpected advantages have been demonstrated for the claimed subject matter is a factual question. See In re Johnson, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984). Thus, it is incumbent upon appellant to supply the factual basis to rebut the prima facie case of obviousness established by the examiner. See, e.g., In re Klosak, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972). Appellant, however, does not provide an adequate explanation regarding the factual showing in the specification and declaration of record referred to in the briefs to support a conclusion of unexpected advantages for the reasons outlined above.

Indeed, appellant has not fairly established that the results reported represent truly unexpected results for any of the tested compounds rather than expected normal variations for different tellurium compounds within the genus taught by the applied prior art, much less unexpected results reasonably co-extensive with the scope of the claimed process of representative claim 1. We note, for example, that the declaration table B shows an improved sensitivity of 120 for appellant's example 112 for the 11th layer and an improved sensitivity of 117 for compound 13 of Kashi for the 11th layer. Appellant has not

explained how that slightly different sensitivity represents an unexpected result given the variation in improved sensitivities displayed in the tables for the limited examples presented. In this regard, appellant's position that the tests establish unexpectedly improved results is not persuasively explained or substantiated on this record by the conclusory statements in the declaration.

Also, appellant has not shown that the samples prepared for comparison using compounds 7, 12, 13, 23 and 30 of Kashi in the declaration represent the closest prior art described in Kashi. Indeed, it is not clear how a fair comparison can be made considering the numerous variables involved in the specification and declaration tests and the breadth of the representative claim.

Hence, we are not satisfied that the evidence of record that is offered for comparison, as discussed in the briefs, demonstrates results that are truly unexpected and commensurate in scope with the claims. Nor has appellant satisfied their burden of explaining how the results reported in those limited samples presented can be extrapolated therefrom so as to be reasonably guaranteed as attainable through practicing the invention as broadly claimed. It is well established that the

evidence relied on to establish unobviousness must be commensurate in scope with the claimed subject matter. See In re Kerkhoven, 626 F.2d 846, 851, 205 USPQ 1069, 1072-73 (CCPA 1980) and In re Clemens, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980).

Under the circumstances recounted above, it is our determination that the evidence of record for and against a conclusion of obviousness, reconsidered in light of the respective arguments and evidence advanced by appellant and the examiner, on balance, weighs most heavily in favor of an obviousness conclusion with respect to the rejection under consideration. Accordingly, we shall sustain the examiner's § 103 rejection.

CONCLUSION

The decision of the examiner to reject the appealed claims under 35 U.S.C. § 103 as being unpatentable over Kashi in view of Ito is affirmed.

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

AFFIRMED

Thomas A. Waltz)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Appeal No. 2003-0500
Application No. 09/794,362

Page 11

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