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Appeal No. 93-0877

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Drake M. Michno,
Richard P. Szajewski
and
Stephen P. Singer

Application for Patent filed August 6, 1990, Serial No. 563,725. This application is a Continuation-in-Part of Serial No. 209,613, filed June 21, 1988, abandoned. Photographic Materials Having Releasable Compounds.

Charles L. Gholz et al. for Appellants.

Supervisory Primary Examiner - Charles L. Bowers, Jr.
Examiner - J. Baxter.

Before Calvert, Vice Chairman, and Steiner, Meros, Lyddane, and Garris, Examiners-in-Chief.

Steiner, Examiner-in-Chief.

Appellants appeal from the examiner's decision rejecting claims 17 through 29 and 31 through 39 over claims 1 through

14 of Michno¹ on the ground of double patenting of the obviousness type. We reverse.

BACKGROUND

The appealed claims are directed to a photographic element or film comprising a support having at least one photographic silver halide emulsion layer thereon. Two different types of photographic couplers are reactively associated with the silver halide emulsion. The first coupler is known as a development inhibitor releasing coupler (DIR), the second is commonly known in the art as a bleach accelerator releasing compound (BARC). The DIR comprises three moieties -- a color coupler (COUP), timing group (T) and an inhibitor group (INH). Concededly, the individual components of the claimed invention are not novel. Rather, the claimed invention apparently stems from the discovery that a class of compounds previously believed to be useful only as BARCs allows the use of greater amounts of DIRs while maintaining the desired degree of color correction. This subset of BARCs is employed in combination with the defined DIRs to provide low layer inter-image effect, high image sharpness and

¹U.S. Patent No. 4,912,024, March 27, 1990.

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low gamma-normalized granularity. The DIRs of the claimed invention are limited to those which contain timing groups commonly known in the art as "quinone-methide" timing groups, a specific type of timing group which is bonded to the inhibitor group through a substituted or unsubstituted methylene group contained in the timing group. For illustration, a copy of independent claim 17 is appended hereto.

Appellants also discovered that when a specific subset of inhibitor groups was selected for the inhibitor portion of the DIR, the selection of the particular timing group required in the claimed invention was not critical. This invention is encompassed in the now patented claims of Michno. The parent of the present application and the application upon which Michno issued were filed on the same day.

The claimed invention is broader than the invention defined in most of the patented claims as to the inhibitor group, and narrower as to the timing group.² However, appellants acknowledge that as to claims 11 and 12 of Michno, the claimed invention is generic to the patented invention.³ Thus, for

²The BARCs employed in the claimed invention are admittedly the same as the BARCs employed in the patented claims of Michno.

³A copy of claims 1 and 11 of Michno is also appended hereto.

purposes of resolving the double patenting issue presented on appeal, the relationship of the appealed claims to the patented claims is one of genus-species, i.e., the appealed claims dominate the patented claims.

OPINION

The issue generated by the examiner's rejection is whether the claimed generic invention is or is not an obvious variation of the patented more narrowly defined invention. In attempting to establish a prima facie basis⁴ to deny patentability to the claimed invention on the ground of double patenting of the obviousness type, the examiner merely observes that the appealed claims encompass Michno's invention, a fact readily conceded by appellants, refers to In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970), and rests his case. In our opinion, the examiner has fallen far short of establishing a prima facie case of double patenting of the obviousness type.

We are unaware of any judicial precedent which stands for the proposition that an obviousness-type double patenting situation automatically arises when a patent on a narrow

⁴The initial burden of establishing a prima facie basis to deny patentability to a claimed invention is always upon the examiner. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

invention issues during pendency of an application for a claimed invention which encompasses or dominates the narrow invention. The notion that a pending claim to a generic invention is necessarily patentably indistinct, in the sense of double patenting of the obviousness type, from a narrower patented claim encompassed by the pending generic claim was scotched by In re Braat, 937 F.2d 589 at 594, 19 USPQ2d 1289 at 1293 (Fed. Cir. 1991). See, also, In re Kaplan, 789 F.2d 1574 at 1577, 229 USPQ 678 at 681 (Fed. Cir. 1986), wherein the court stated:

This commonplace situation (domination) is not, per se, double patenting as the board seemed to think. In re Sarett, 327 F.2d 1005, 1014, 1015, 140 USPQ 474, 482, 483 (CCPA 1964). (See particularly the quotation from E. Stringham's Double Patenting (1933) about terms such as "covered" and "embraced.")

In re Sarett, supra, involved a factual situation not unlike that in the present appeal, wherein an application with claims to a broad invention was filed on the same day as an application with claims to a narrowly defined invention, but the application with the narrowly claimed invention issued while the application with the broadly claimed invention was pending. After analyzing the inventions claimed in the pending application and in the patented claims, the court acknowledged that certain claims in the application (claims 15-19) were generic to the patented claims and stated:

Certainly a claim to the genus so defined is not directed to the same subject matter as a claim to the species and we hold claims 15-19 to be "patentably distinct" from any Arth et al. claims (140 USPQ at 481).

Thus, it would appear clear that a mere genus-species or broad-narrow relationship between pending and patented claims is not a litmus test for resolving the question of double patenting of the obviousness type.

It is judicially recognized that resolution of the obviousness-type double patenting question is not free from difficulty. In re Braat, 937 F.2d at 592, 19 USPQ2d at 1292. It is clear, however, that the inquiry pivots exclusively about the subject matter defined by the claims in question. General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992). In the present case, the examiner declined to provide appellants with any analysis, e.g., as in In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982), to support the conclusion that the claimed invention is an obvious variation of the patented invention. Rather, the examiner relied exclusively on In re Vogel, supra.⁵ It is not apparent why Vogel

⁵In Vogel, a claimed method for prolonging the storage life of packaged meat products comprising a series of manipulative steps including comminuting, sealing and cooling, was rejected over a patented method more narrowly defined dealing with pork vis-à-vis meat. Under the particular facts in Vogel, the court concluded that the inventions were not patentably distinct for purposes of
(continued...)

stands for the proposition that a genus-species or broad-narrow relationship constitutes a litmus test for obviousness-type double patenting situations. As previously discussed, that proposition was specifically disavowed in In re Braat, supra, and In re Kaplan, supra. We observe that the examiner does not actually confront appellants' representation that the appealed and patented claims involve different inventions, in that the selection of the particular inhibitor group for the DIRs of Michno's patented invention renders it unnecessary to employ the specific timing group required in the here claimed invention to yield the unexpected improvements obtained by the claimed invention. In short, the examiner did not provide a sufficient basis to support the conclusion that the claimed invention is an obvious variation of the patented invention.

⁵(...continued)

double patenting of the obviousness type, i.e., different inventions were not involved. In Van Ornum, pending claims to a sealant composition comprising high and low molecular weight butyl rubbers generically encompassed patented claims to a composition containing the same components, albeit the ratio of butyl rubbers was more narrowly defined, as well as patented claims to a composition containing such butyl rubbers in addition to a tackifier. Under the facts of that case, the court viewed the claimed invention as a mere obvious variation of the patented inventions, and noted

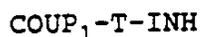
[t]here is a significant difference between justifying the broadening of claims and disclosing additional inventions (686 F.2d at 944, 214 USPQ at 767).

APPENDED CLAIM

17. A photographic element comprising a support having thereon

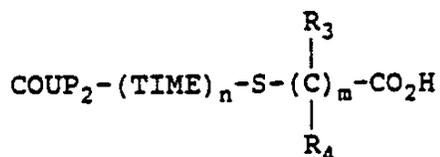
at least one photographic silver halide emulsion layer, in reactive association with the silver halide emulsion:

a) a first coupler represented by the formula:



wherein COUP₁ is a coupler moiety, T is a timing group bonded to INH through a substituted or unsubstituted methylene group contained in T and bonded to COUP₁ through an O, S, or N atom contained in T, and INH is a development inhibitor moiety, and wherein the T-INH group is able to undergo electron transfer along a conjugated system therein to cleave INH after T-INH is cleaved from COUP₁, and

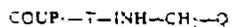
b) a second coupler represented by the formula:



wherein COUP₂ is a coupler moiety, TIME is a timing group, n is 0 or 1, m is 1 to 8, R₃ and R₄ each independently represent hydrogen or alkyl of from 1 to 4 carbon atoms, and the sum of m and the number of carbon atoms represented by both R₃ and R₄ is 1 to 8.

APPENDED CLAIMS OF MICHNO

1. A photographic element comprising a support having thereon at least one layer comprising a photographic silver halide emulsion, in reactive association with the silver halide emulsion:
(a) a first coupler represented by the formula:



wherein

COUP_1 is a coupler moiety,

T is a timing group that is bonded to the coupler moiety at a coupling position and that is cleaved from $-\text{INH}-\text{CH}_2-\text{Q}$ after it is released from the coupler moiety upon exposure and processing of the element, and

$\text{INH}-\text{CH}_2-\text{Q}$ is a development inhibitor moiety

wherein Q is a ballasting group, and

- (b) a second coupler represented by the formula:



wherein COUP_2 is a coupler moiety, TIME is a timing group, n is 0 or 1, R_1 is a divalent linking group that does not include a heterocyclic ring attached directly to S, and R_2 is a water solubilizing group.

11. A photographic element according to any of claims 1-7 wherein T is a timing group bonded to INH through a substituted or unsubstituted methylene group contained in T and bonded to COUP_1 through an O, S, or N atom contained in T, and INH is a development inhibitor moiety, and wherein the T-INH group is able to undergo electron transfer along a conjugated system therein to cleave INH after T-INH is cleaved from COUP_1 .