

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUGH G. MCGUCKIN, JOHN S. BADGER and MARY E. CRAVER

Appeal No. 1997-0486
Application 08/417,290

ON BRIEF

Before PAK, OWENS, and DELMENDO, Administrative Patent Judges.
OWENS, Administrative Patent Judge.

DECISION ON APPEAL

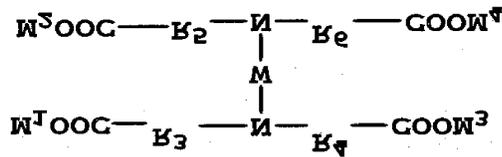
This is an appeal from the examiner's final rejection of claims 1-5, 7-15 and 17-22, which are all of the claims remaining in the application.

THE INVENTION

Appellants' claimed invention is directed toward a conditioning solution which contains, as an antimicrobial agent, a polyaminocarboxylic acid or salt thereof which has a recited general formula and is present in a specified concentration. Appellants state that the conditioning solution is useful in the processing of color photographic materials (specification, page 1, lines 6-10). Claim 1 is illustrative and reads as follows:

1. A conditioning solution having a pH of from about 4.5 to about 8, and comprising a bleach accelerating agent, a formaldehyde precursor, and an antimicrobial composition consisting essentially of a polyaminocarboxylic acid or salt thereof as the sole antimicrobial agent, said antimicrobial agent being present in said conditioning solution in an amount of from about 0.25 to about 3 g/l,

polyamin
 salt
 represen



said
 ocarboxylic acid or
 thereof being
 ted by formula II:

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wherein

R³, R⁴, R⁵ and R⁶ are independently an alkylene group of 1 to 8 carbon atoms,

W is a covalent bond or methylene, ethylene or a cycloalkylene having 5 to 7 carbon atoms in the ring, provided that when W is cycloalkylene, the two nitrogen atoms are attached to the ring at adjacent carbon atoms, and

M₁, M₂, M₃ and M₄ are independently hydrogen or a monovalent cation.

THE REFERENCES

Yamada et al. (Yamada) 1989	4,839,273	Jun. 13,
Cullinan et al. (Cullinan) 1990	4,921,779	May 1,
Fujita et al. (Fujita) 1994	5,334,493	Aug. 2,

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-5, 7, 8, 10-15 and 17-22 over Cullinan in view of Yamada, and claim 9 over Cullinan in view of Yamada and Fujita.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejections are not well

founded. Accordingly, we reverse these rejections.

Cullinan teaches that a commercial process for use with color reversal photographic elements which contain couplers in silver halide emulsion layers or layers contiguous thereto uses, in order, the following processing baths: first developer, wash, reversal, color developer, bleach, fix, wash and stabilizer (col. 1, line 65 - col. 2, line 2). Cullinan includes a bleach-accelerating bath between the color developing bath and the bleaching bath, and states that a bleach-accelerating bath is also referred to in the art as a conditioning bath (col. 2, lines 15-17), which is the type of bath recited in appellants' claims.

Cullinan discloses that the conditioning solution has a pH of about 4.5 to about 6.5 and contains a bleach accelerating agent and a formaldehyde precursor (col. 2, lines 12-17; col. 5, lines 56-66). The conditioning solution typically contains ethylenediaminetetraacetic acid (EDTA) as a sequestering agent which prevents the formation of iron stain in the emulsion layers (col. 5, lines 49-53). EDTA falls within the scope of the polyaminocarboxylic acid formula

recited in appellants' claim 1 (specification, page 16, lines 29-32).

Cullinan does not disclose an EDTA concentration of about 0.25 to about 3 g/l as required by appellants' independent claim 1, or less than about 3 g/l as required by appellants' independent claims 12 and 21.¹ The only concentration of the EDTA disclosed by Cullinan is 8 g/l (col. 8, lines 27, 37 and 47).

Yamada discloses adding water, which has been treated to render it antifungal, as a diluent for at least one of a developing solution and a fixing solution, and also discloses incorporating this water into washing water or a stabilizing solution (col. 2, line 55 - col. 3, line 2; col. 7, lines 8-11; col. 11, lines 12-15 and 17-21). One of the disclosed ways for rendering the water antifungal is to add to it an

¹When we interpret appellants' claims 12 and 21 as a whole, we conclude that the claims require that the conditioning solution includes three components, i.e., a bleach accelerating agent, a formaldehyde precursor and an antimicrobial agent. Thus, we interpret "said antimicrobial agent being present in said conditioning solution in an amount of less than about 3 g/l" as meaning that some antimicrobial agent is present, but in an amount less than about 3 g/l.

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aminopoly-carboxylic acid, one of the preferred aminopolycarboxylic acids being EDTA (col. 2, line 64 - col. 3, line 1; col. 4, lines 27-29; col 6, lines 49-50). The preferred concentration of EDTA in the diluting water is 0.02 to 20 g/l, most preferably 0.05 to 5 g/l (col. 6, lines 62-64).

The examiner argues that Yamada's stabilizing solution has a pH within the range recited in appellants' claims and that a disclosure of such a pH, considered with appellants' discussion of the effects of appellants' conditioning solution, would have led one of ordinary skill in the art to consider the two solutions to have similar effects and thus be analogous (answer, pages 5-6). This argument is not well taken because any

discussion in appellants' specification of the effects of their claimed conditioning solution is not prior art. Moreover, the argument is mere speculation.

The examiner argues that it would have been obvious to one of ordinary skill in the art to use Yamada's EDTA

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concentration in Cullinan's conditioning solution because such a person would have had "a reasonable expectation of obtaining a highly-useful silver halide photographic processing composition and method of using it with the advantage of less stain in the finished photographic material caused by microbiological sources" (answer, page 4). The examiner, however, does not explain how the references would have led such a person to combine their teachings as proposed by the examiner. Cullinan uses an EDTA concentration of 8 g/l in order to obtain a sequestering effect (col. 5, lines 49-55). The examiner has not explained why one of ordinary skill in the art would have expected this sequestering effect to be obtained at the lower EDTA concentrations used by appellants, or why such a person would have been led by the references to eliminate or reduce Cullinan's desired sequestering effect in order to obtain Yamada's antifungal effect which, it appears, is provided by Cullinan's 8 g/l of EDTA.

For the above reasons, we conclude that the examiner has not carried the burden of establishing a *prima facie* case of

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obviousness of the invention recited in any of appellants' claims.² Accordingly, we reverse the examiner's rejections. Since no *prima facie* case of obviousness has been established, we need not address the experimental results. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

²The examiner does not rely upon Fujita for a teaching which remedies the above-discussed deficiency in Cullinan and Yamada.

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DECISION

The rejections under 35 U.S.C. § 103 of claims 1-5, 7, 8, 10-15 and 17-22 over Cullinan in view of Yamada, and claim 9 over Cullinan in view of Yamada and Fujita, are reversed.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
TERRY J. OWENS))
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
ROMULO H. DELMENDO)	
Administrative Patent Judge)	

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