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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASATO TANIGUCHI,
KIYOSHI MORIMOTO,
HIROSHI FUJIMOTO,
and
AKIMITSU HAIJIMA

Appeal No. 1997-3787
Application No. 08/275,241

HEARD: FEBRUARY 6, 2001

Before PAK, LIEBERMAN, and TIMM, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

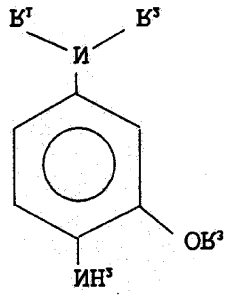
This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 9, which are all of the claims pending in the above-identified application. See the resubmitted Brief dated April 15, 1996 (Paper No. 18, hereinafter referred to as "Brief"), page 2.

Claims 10 through

17 were canceled prior to the final Office action dated June 30, 1995. See the Amendment entered on May 26, 1995.

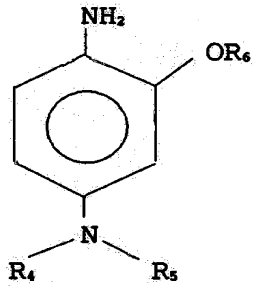
Claims 1 and 7 are representative of the subject matter on appeal and read as follows:

1. A p-phenylenediamine color developing agent represented by the following formula (D1) or (D2):



(D1)

wherein R_1 and R_2 each represent a hydroxyalkyl group having 2 or more carbon atoms, and R_3 represents an alkyl group, with the proviso that the sum of the carbon atoms in R_1, R_2 and R_3 is 9 or below, and

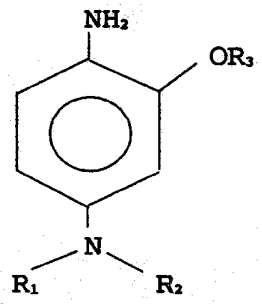


(D2)

wherein R_4 represents an alkyl group having 1 to 3 carbon atoms, R_5 represents an alkyl group having at least two

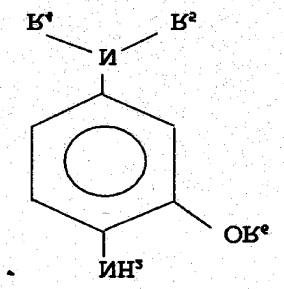
hydroxyl groups, and R_6 represents an alkyl group having
1 to 4 carbon atoms.

7. A processing composition for silver halide color photographic materials, which comprises a p-phenylenediamine color developing agent represented by the following formula (D1) or (D2):



(D1)

wherein R_1 and R_2 each represent a hydroxyalkyl group having 2 or more carbon atoms, and R_3 represents an alkyl group, with the proviso that the sum of the carbon atoms in R_1, R_2 and R_3 is 9 or below, and



(D2)

wherein R_4 represents an alkyl group having 1 to 3 carbon atoms, R_5 represents an alkyl group having at least two hydroxyl groups, and R_6 represents an alkyl group having 1 to 4 carbon atoms, and balance of water, the pH of the composition being 9 to 12.5.

The sole prior art reference[1] relied upon by the examiner is:

Haijima et al. (Haijima) 5,328,812 Jul. 12, 1994

Claims 1 through 9 stand rejected under 35 U.S.C. § 102(a) or (e) as anticipated by the disclosure of Haijima. Claims 1 through 9 also stand rejected under 35 U.S.C. § 103 as unpatentable over the disclosure of Haijima.

We have carefully reviewed the claims, specification and the applied prior art, including all of the arguments advanced by both the examiner and appellants in support of their respective positions. This review leads us to conclude that the examiner's §§ 102 and 103 rejections are not well founded. Accordingly, we will not sustain the examiner's §§ 102 and 103 rejections for essentially those reasons set forth

[1] The §§ 102 and 103 rejections based on U.S. Patent 3,723,117 issued to Willems on March 27, 1973, or on Japanese Patent Application 62-180362 published on August 7, 1987, which were set forth in the final Office action dated June 30, 1995, have been withdrawn. See Answer, page 4.

in the Brief. We add the following primarily for emphasis and completeness.

Initially, we note from a review of the first Office action dated October, 17, 1994, Paper No. 4, page 2, that the examiner here required appellants to “elect a single disclosed species” from those color developing agents disclosed at pages 8 through 12 of the specification. Appellants in turn elected “compound D-1 as [set forth] on page 8 of the [instant] specification” for prosecution on the merits. See the appellants’ response dated November 8, 1994, Paper No. 5, together with the second Office action dated November 28, 1994. Elected compound D-1 has the same general chemical structure defined in the claimed formula above, except that R_1, R_2, and R_3 are limited to $-(CH_2)_3-OH$, $-(CH_2)_3-OH$ and $-CH_3$, respectively. According to the examiner (Answer, page 4), the remaining, non-elected disclosed species (compounds D-2 through D-44) included in the appealed claims “have not been considered, searched or examined.”

Thus, the specific issue presented for review is whether Haijima anticipates or would have rendered obvious claimed compound D-1 and a photographic processing composition

containing the same. We limit our review to this issue only and we take no position respecting the patentability of compounds D-2 through D-44 and photographic processing compositions containing these compounds.

As indicated by the examiner, Haijima discloses a color developing agent defined as Formula (D), which includes the claimed color developing agent, compound D-1. See column 2, line 50 to column 3, line 2, together with column 18, lines 5-46. To arrive at claimed compound D-1, we find that some picking and choosing of the substituents described in Haijima are necessary. Accordingly, we determine that Haijima does not provide a disclosure with sufficient specificity to constitute a description of the claimed compound and composition within the purview of 35 U.S.C. § 102(a) or (e). *In re Schaumann*, 572 F.2d 312, 315, 197 USPQ 5, 8 (CCPA 1978).

Although the above-mentioned picking and choosing has no place in making a rejection under 35 U.S.C. § 102(a) or (e) for anticipation, it may be entirely proper in the making of an obviousness rejection under 35 U.S.C. § 103. *Merck & Co.*

v. Biocraft Labs., Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989); *In re Arkley*,
455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

Here, Haijima specifically names a limited number of substituents useful for Formula (D). The inclusion of some of these specific substituents in Formula D results in the claimed compound and composition. In addition, Haijima discloses specific color developing agents designated as D-30, D-31, and D-34, which are structurally similar to the claimed color developing compound D-1. Given Haijima's disclosure of a limited genus inclusive of the claimed compound, with its specific preference for compounds structurally similar to that claimed, we agree with the examiner that Haijima would have rendered the claimed subject matter *prima facie* obvious to one of ordinary skill in the art.

However, we also agree with appellants that the *prima facie* case of obviousness established by the examiner is rebutted by the specification examples relied upon by appellants. As argued by appellants, a showing of unexpected

results is imparted by using the claimed color developing agent (compound D-1) in a photographic processing composition. Table 4 at page 79 of the specification shows a comparison between the color developing agents designated as COM-9 and D-1. While COM-9 represents compound D-31 described in Haijima, which is closest to the claimed color developing agent, D-1 represents the elected and claimed color developing agent. The comparison demonstrates that the claimed color developing agent (D-1) is superior to that described in Haijima in improving yellow density and color

photograph development time. The above-mentioned improvements have resulted from a showing which is reasonably commensurate in scope with the appealed claims (elected species). *See In re Chupp*, 816 F.2d 643, 646-47, 2 USPQ2d 1437, 1440 (Fed. Cir. 1987). These improvements are not taught, nor shown to be reasonably expected, by the applied prior art, Haijima.

In view of the foregoing, the decision of the examiner is reversed.

REVERSED

CHUNG K. PAK Administrative Patent Judge	)	
PAUL LIEBERMAN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CATHERINE TIMM Administrative Patent Judge	)	

CKP:hh

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