

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID L. COLE

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Appeal No. 1998-1672  
Application No. 08/708,163

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HEARD: May 10, 2001

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Before KRATZ, DELMENDO, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 8-20, 25, 26, and 27.

Appellant states that all of the claims are grouped together for consideration in this appeal. (Brief, page 6). The examiner states that "[s]ince appellants fail to separately provide an argument for each of the claims, the group of the appealed claims stands or falls with the

broadest claim 25 as clearly made of [sic] record in the office action mailed on April 16, 1997 in the [sic] second paragraph".

In the second paragraph on page 2 of the office action mailed April 16, 1997, the examiner states the following:

- II. There are four independent groups of claims. They have been considered as being obvious variants under 35 U.S.C. § 103 to one having ordinary skill in the art there is no evidence of the record that they are patentably distinct. Therefore, no restriction is made at the present time until applicant shows or urges otherwise.

In appellant's response to the office action mailed April 16, 1997 (i.e., in appellant's amendment filed on July 25, 1997), appellant did not comment on the examiner's position summarized above, and the examiner did not later require a restriction in connection with these groups of claims.

In view of the treatment of claims 8-20, 23, 25, 26 and 27, and noted in the prosecution history summarized above and in view of the examiner's position and statement made in the answer that the claims stand or fall with broadest claim 25, we consider claim 25 on appeal. We note that appellant did not object to the examiner's position taken in appellant's reply brief.

The reference relied upon by the examiner is:  
Fujimoto et al. (Fujimoto) 4,985,347 Jan. 15, 1991

The subject matter on appeal is reflected in claim 25, reproduced below:

- 25. A stabilized color developer solution having a pH of from about 9.0 to 9.7, and comprising:
  - a color developing agent present at from about 0.01 to about 0.1 mol/l,

bromide ion at from at least  $5 \times 10^{-5}$  mol/l,  
iodide ion at from at least  $5 \times 10^{-7}$  mol/l, and  
an organic antioxidant present at from about  
0.001 to about 0.5 mol/l, said antioxidant having the  
formula:



wherein R and R' are independently hydrogen or  
substituted or unsubstituted alkyl of 1 to 10 carbon  
atoms or substituted or unsubstituted aryl.

Claims 8-20, 23, 25, 26 and 27 stand rejected as being  
unpatentable for novelty and for obviousness under  
35 U.S.C. § 102(b) and 35 U.S.C. § 103 over Fujimoto.

We have thoroughly reviewed appellant's arguments for  
patentability, and the examiner's position. For the  
reasons discussed below, we will reverse the 35 U.S.C.  
§ 102(b) rejection, but we will affirm the 35 U.S.C. § 103  
rejection.

Appellant argues that Fujimoto teaches a broad pH  
range of from 9 to 12, but fails to teach this in  
combination with the required iodide ion concentration in  
the color developer solution. Appellant argues that the  
only description of iodide ion in the solution is in  
Example 1, but the pH is 10.0, which is above the pH  
recited in appellant's claims.

The examiner rebuts and states that Fujimoto's  
invention is not limited to the examples. We find,  
however, that other disclosure in Fujimoto provides for a  
pH range from 9 to 12, the amount of bromide or iodide ions  
is not specified (other than in the example in column 43).  
The examiner has not addressed this issue. When the prior  
art discloses a range which touches, overlaps, or is within  
the claimed range, but no specific examples falling within

the claimed range are disclosed, a case by case determination must be made as to anticipation. MPEP § 2131.08 Rev. 1, Feb 2000. The examiner must, in this case, provide reasons for anticipation. Ex parte Lee, 31 USPQ2d 1105, 1107 (Bd. Pat. App. & Inter. 1993). Here, the examiner has not explained how Fujimoto anticipates claim 25 in light of the fact that (1) the example at cols. 43-44 does not disclose an pH within the claimed range; (2) the amount of bromide or iodide ions at col. 25 is not specified to fall within the range claimed in claim 25. Accordingly, we reverse the 35 U.S.C. § 102(b) rejection.

With regard to the 35 U.S.C. § 103 rejection, the examiner has made a proper prime facie for the reasons presented by the examiner on pages 4-5 of the Answer.

Appellant argues that the pH of the solution is kept within a very narrow range of from about 9.0 to 9.7, preferably from about 9.3 to 9.7. (Brief, page 10).

The examiner rebuts and states that Fujimoto suggests a pH solution of 9 and above. (Answer, page 6).

Appellant states that the effect of pH on the color developer solution stability is demonstrated in appellant's comparative showings on pages 17-20 of the present application. (Brief, page 10). Appellant states a very modest change of pH from 9.7 to 10 caused a significant loss in stability. (Brief, page 10). Appellant states that improved solution stability is achieved using the very narrow pH range recited in appellant's claims, and that no one would have expected this minor pH difference to have such an impact on dye density at elevated temperatures. (Brief, page 11).

The examiner rebuts and states that the showings on pages 17-20 of the specification are insufficient to overcome the Fujimoto reference. The examiner's reasons for his conclusion are set forth on pages 6 and 7 of the Answer.

Appellant argues on page 3 of his Reply Brief that the examiner, for the first time, argues the inadequacy of the data on pages 17-20 of the specification. Appellant also argues that most of the ingredients (listed on page 17 in Table I of the specification) are common addenda for color developing solution and are not the basis for patentability.

It is well settled that a prima facie case of obviousness is established by showing that some objective teaching of suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings appellant's disclosure. See generally, In re Oetiker, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992)(Nies, J., concurring); In re Laskowski, 871 F.2d 115, 117, 10 USPQ3d 1397, 1389-99 (Fed. Cir. 1989); In re Fine, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

Based upon the objective teachings set forth in Fujimoto, we agree with the examiner's conclusion of obviousness. That is, we find that the Fujimoto reference would have led the skilled artisan to appellant's claimed invention without undue experimentation. Afterall,

although the specific example at column 43 does not include a pH of from about 9.3 to 9.7, column 24, lines 11-12, discloses a more preferred amount of from 9.0 to 11.0. We note that it is not invention to discover optimum or workable ranges by routine experimentation. Where general conditions of the appealed claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation, and appellants have the burden of proving any criticality. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 218-19 (CCPA 1980); In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Once a prima facie case of obviousness is established by the examiner, as in the present case, the burden shifts to appellant to rebut it. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). A prima facie case of obviousness is rebuttable by proof that the claimed invention possesses unexpectedly advantageous or superior properties. In re Papesch, 50 CCPA 1084, 1091-92, 315 F.2d 381, 386-87, 137 USPQ 43, 47-48 (CCPA 1963). As rebuttal evidence, Appellant refers to the data on pages 17-20 of this specification. This data is insufficient to rebut the prima facie case of obviousness for the following reasons.

Rebuttal evidence can be in the form of direct or indirect comparative testing between the claimed invention and the closest prior art. In re Merchant, 575 F.2d 865, 869, 197 USPQ 785, 788 (CCPA 1978); In re Blondel, 499 F.2d 1311, 1317, 182 USPQ 294, 298 (CCPA 1974); In re Swentzel, 42 CCPA 757, 763, 219 F.2d 216, 220, 104 USPQ 343, 346 (1955). In the present case, the data on pages 17-20 is not compared with the closest solution disclosed in Fujimoto.

Assuming, arguendo, that appellants have presented comparative examples that are representative of the closest prior art, in order to establish unexpected results for a claimed invention, objective evidence of non-obviousness must also be commensurate in scope with the claims which the evidence is offered to support. In re clemens, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980); In re Greenfield, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978); In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); In re Tiffin, 448 F.2d 791, 792, 171 USPQ 294, 294 (CCPA 1971). Here, the scope of the evidence has not been shown to be commensurate with the scope of appellant's claims. For example appellant's solution in Table I on page 17 does not fully reflect the ranges of each component in appellant's claim 25. Appellant could have provided representative examples at each end of each range and examples within each range.

Furthermore, the test conducted must be sufficient to permit a conclusion respecting the relative effectiveness of appellant's claimed invention and the invention of the closest prior art. In re of Payne, 606 F.2d 303, 316, 203 USPQ 245, 256 (CCPA 1979); In re Holladay, 584 F.2d 384, 386, 199 USPQ 516, 518 (CCPA 1978); In re Merchant, 575 F.2d at 869, 197 USPQ at 787-88 (CCPA 1978). It is not an unreasonable burden on appellant to require comparative examples relied on for non-obviousness to be truly comparative. The cause and effect sought to be proven is lost here in the jumble of unfixed variables. In re Dunn, 349 F.2d 433, 439, 46 USPQ 479, 483 (CCPA 1965).

In view of the above reconsideration of the totality of the record before us, we have weighed the evidence of

Appeal No. 1998-1672  
Application No. 08/708,163

obviousness found in the applied references with appellant's counterveiling evidence of and argument for nonobviousness, and conclude that the claimed invention encompassed by appealed claims would have been obvious as a matter of law under 35 U.S.C. § 103.

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

AFFIRMED

PETER F. KRATZ	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
ROMULO H. DELMENDO	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
BEVERLY A. PAWLIKOWSKI	)	
Administrative Patent Judge	)	

SLD

Appeal No. 1998-1672  
Application No. 08/708,163

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