

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PIERRE H. JEZEQUEL and RAMESH JAGANNATHAN

Appeal No. 1997-1663
Application No. 08/448,053

ON BRIEF

Before OWENS, WALTZ and KRATZ, 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 through 3 as amended after final rejection. Claims 1-3 are all of the claims pending in this application.

Appellants' invention relates to a method of producing thin silver halide grains. An understanding of the invention

can be derived from a reading of exemplary claim 1¹, which is reproduced below.

1. A method of producing thin silver halide grains comprising:

providing a mixer having including an inlet surface and an outlet surface and at least one flow channel extending from the inlet surface to the outlet surface;

rotating the mixer;

introducing a silver nitrate solution at the inlet surface of the mixer; and

introducing a halide salt solution at the inlet surface of the mixer within 30 mm of the introduction of the silver nitrate solution wherein silver halide grains having a maximum thickness of 0.145 μm are produced.

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

Frame et al. (Frame) 1968	3,415,650	Dec. 10,
Mumaw 1985	4,539,290	Sep. 3,
Saito 1992	5,096,690	Mar. 17,
Saitou 1995	5,424,180	Jun. 13,

¹ We note that "including" (claim 1, line 3) is superfluous.

(filed Dec. 15,
1992)

Claims 1-3 stand rejected under 35 U.S.C. § 102 as anticipated by or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Saito, Mumaw or Frame. Claims 1-3 stand rejected under 35 U.S.C. § 102 as anticipated by or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Saitou.

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 shall not sustain the stated rejections.

It is well settled that the examiner bears the burden of establishing a *prima facie* case of anticipation or obviousness. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Moreover, when relying upon

the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). *See also In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The inquiry as to whether a particular reference anticipates a particular claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. Here, in maintaining the stated § 102 rejections, the examiner makes reference to drawing figures 5(b), 7, 9, 10, and 11(a)-(d) of Saitou, drawing figure 1 and the claims of Saito, drawing figure 2 and the claims of Mumaw and the drawing figures and claims of Frame (answer, page 4).

However, the examiner has not furnished an acceptable explanation as to how each of the above noted portions of the

applied references describes each and every element as set forth in the claims, either expressly or inherently, as required of an anticipating disclosure in a single prior art reference. See *Verdegaal Bros. Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). Claim 1 calls for a method of producing silver halide grains having a maximum thickness of 0.145 microns wherein; (1) a mixer is rotated; (2) the rotated mixer is required to have (a) an inlet surface, (b) an outlet surface and (c) at least one flow channel extending from the inlet surface to the outlet surface; (3) silver nitrate solution is introduced at the inlet surface of the mixer; and (4) a halide salt solution is introduced at the mixer inlet surface within 30 mm of the introduction of the silver nitrate solution.

The examiner, for example, particularly refers to figure 5(b) of Saitou and figure 2 of Mumaw (answer, page 5) as disclosing or inherently possessing reactant introduction points less than 30 mm apart that correspond to the claimed

method limitations² regarding reactant introduction. However, the examiner has not explained how the referenced portions of these applied patents teach and necessarily describe that a halide salt solution is introduced separately and less than 30 mm from a silver nitrate solution introduction, each introduced at a rotating mixer inlet surface that is connected to a rotating mixer outlet surface via at least one flow channel extending therebetween so as to obtain silver halide grains having a thickness of 0.145 microns. We note that an indication that the applied references teach "close together" (answer, page 4), without a more specific analysis, simply does not anticipate 30 mm or less.

Indeed, the particular portions of the figures and/or written disclosures of each of the separately applied references which the examiner would regard as corresponding to each of the above-noted claim limitations, such as the

² We are cognizant that appealed claim 3 does not require a 30 mm or less distance between silver nitrate solution and halide salt solution introductions but rather the mixing of these solutions prior to introduction at the inlet surface of the mixer. However, the examiner similarly does not carry the burden of explaining how any of the applied references anticipate under § 102 or render obvious, within the meaning of § 103, the subject matter of claim 3.

rotating mixer inlet surface, the rotating mixer outlet surface and the connecting flow channel, have not been adequately identified by the examiner.

With respect to the alternative § 103 rejections, the examiner's representations fall significantly short of establishing why one having ordinary skill in the art would have been led to the claimed invention by the teachings or suggestions found in each of the separately applied references, or by a reasonable inference to the artisan contained in such teachings or suggestions. See *In re Sernaker*, 702 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983). Manifestly, the examiner's unsupported and generalized statements (answer, pages 4 and 5) regarding the obviousness of any apparatus distinctions such as the reactant inlet points of appellants' process over the applied prior art are inadequate to establish the *prima facie* obviousness of the claimed process. It is well settled that a legal conclusion of obviousness must be supported by facts, not speculation. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

On this record, the examiner has simply failed to set forth a *prima facie* case of anticipation or obviousness of the claimed invention.

CONCLUSION

The decision of the examiner to reject claims 1-3 under 35 U.S.C. § 102 as anticipated by or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Saito, Mumaw or Frame; and to reject claims 1-3 under 35 U.S.C. § 102 as anticipated by or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Saitou is reversed.

REVERSED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PETER F. KRATZ)
Administrative Patent Judge)

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