

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte FREDDY HENDERICKX,  
ANN VERBEECK,  
PASCAL MEEUS,  
and  
HIERONYMUS ANDRIESSEN

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Appeal No. 1999-0106  
Application No. 08/594,721

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HEARD: OCTOBER 17, 2001

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Before OWENS, LIEBERMAN, and DELMENDO, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 10. Claims 11 through 15 stand withdrawn from consideration pursuant to a requirement for restriction.

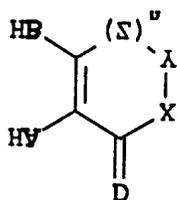
### THE INVENTION

The invention is directed to a photographic developing solution comprising specified components and having a pH between 9.6 and 11.0. Additional features of the claimed subject matter are set forth in the following illustrative claim.

### THE CLAIM

Claim 1 is illustrative of appellants' invention and is reproduced below:

1. Photographic developing solution having a pH value between 9.6 and 11.0, comprising hydroquinone in an amount from 0 to less than 30 g per liter, an auxiliary developing agent, and as silver halide complexing agents alkali metal sulphate salts in an amount from 0 to less than 50 g per liter, thiocyanate salts in amounts from 0.1 to 3 g, and of a compound corresponding to the formula (I), a precursor thereof, and/or a metal salt thereof



(I)

wherein each of A, B and D independently represents an oxygen atom or NR<sup>1</sup>;

X represents an oxygen atom, a sulphur atom, NR<sup>2</sup>; CR<sup>3</sup>R<sup>4</sup>; C=O; C=NR<sup>5</sup> or C=S;

Y represents an oxygen atom, a sulphur atom, NR<sup>2</sup>; CR<sup>3</sup>R<sup>4</sup>; C=O; C=NR<sup>5</sup> or C=S;

Z represents an oxygen atom, a sulphur atom, NR<sup>2</sup>; CR<sup>3</sup>R<sup>4</sup>; C=O; C=NR<sup>5</sup> or C=S;

n equals 0, 1 or 2;

each of  $R^1$  to  $R^5$ ,  $R'^1$  to  $R'^5$  and  $R''^1$  to  $R''^5$ , independently represents hydrogen, alkyl, aralkyl, hydroxyalkyl, carboxyalkyl; alkenyl, alkynyl, cycloalkyl, cycloalkenyl, aryl or heterocyclyl; and wherein  $R^3$  and  $R^4$ ,  $R'^3$  and  $R'^4$ ,  $R''^3$  and  $R''^4$ , may further form together a ring; and wherein in the case that  $X = CR^3R^4$  and  $Y = CR'^3R'^4$ ,  $R^3$  and  $R'^3$  and/or  $R^4$  and  $R'^4$  may form a ring and wherein in the case that  $Y = CR'^3R'^4$  and  $Z = CR''^3R''^4$  with  $n = 1$  or  $2$ ,  $R^3$  and  $R''^3$  and/or  $R^4$  and  $R''^4$  may form a ring.

#### THE REFERENCE OF RECORD

As evidence of obviousness, the examiner relies upon the following reference:

Katz	3,865,591	Feb. 11, 1975
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#### THE REJECTIONS

Claims 1 through 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Katz.

#### OPINION

We have carefully considered all of the arguments advanced by the appellants and the examiner, and agree with the appellants that the rejection of the claims under § 103(a) is not well founded. Accordingly, we reverse this rejection.

#### Rejection under 35 U.S.C. § 103(a)

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability," whether on the grounds of anticipation or obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24

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USPQ2d 1443,

1444 (Fed. Cir. 1992). On the record before us, the examiner relies upon a reference to Katz to reject the claimed subject matter and establish a prima facie case of obviousness. The basic premise of the rejection is that, "[t]he issue of the obviousness is the pH values, 9.5 in Katz (at col.5:19) as compared to 9.6 in the claims, for the reasons that (A) the difference in the pH value is small, 0.1, which is within an obvious extension or variation to one having ordinary skill in the art at the time the invention was made and (B) there is no convincing evidence on the record that the use of the pH 9.6 as claimed would provide an unusual or unexpected result over that of 9.5 in Katz." See Answer, page 4. We agree to the extent that the distinction in pH is the dispositive issue before us. We disagree however, that the extension of pH is an obvious extension.

We find that Katz is directed to a developer composition comprising each of the components required by the claimed subject matter. See Table 1, and Examples 1 and 3. We find that ascorbic acid is a preferred component of both appellants and Katz and corresponds to a preferred compound within the scope of Formula I of the claimed subject matter. Compare Examples 1 and 3 with the specification, page 5. The disclosure in Katz of pH however, is very specific. We find that Katz discloses a developer composition "adjusted to the pH range 8.0 to 9.5." See column 2, lines 11-12. We further find that Katz described the invention, "in its broadest form, provides an alkaline developer composition, pH 8 to 9.5." See column 2, lines 48-49. See also

column 5, lines 18-19, and claims 1 and 22 of Katz. The very specific language utilized by Katz provides no basis for one of ordinary skill in the art to extrapolate or vary the pH. Accordingly, no prima facie case of obviousness has been established with respect to the claimed subject matter.

Furthermore, as we stated at the outset of our opinion, the burden of proof rests with the examiner to establish a prima facie case of obviousness. Contrary to the examiner's position, appellants are not required to provide, "convincing evidence on the record that the use of the pH 9.6 as claimed would provide an unusual or unexpected results over that of 9.5 in Katz," Answer, page 5, until such time as a prima facie case of obviousness has been established.

Based upon the above analysis, we have determined that the examiner's legal conclusion of obviousness is not supported by the facts. "Where the legal conclusion is not supported by [the] facts[,] it cannot stand." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

DECISION

The rejection of claims 1 through 10 under 35 U.S.C. § 103(a) as being unpatentable over Katz is reversed.

The decision of the examiner is reversed.

REVERSED

	TERRY J. OWENS	)	
	Administrative Patent Judge	)	
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		)	
		)	BOARD OF PATENT
		)	PAUL LIEBERMAN
)	APPEALS	)	AND
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	ROMULO H. DELMENDO	)	
	Administrative Patent Judge	)	
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