

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application 500,734 having been rejected under Rule 47(2) of the Patent Regulations, the Applicant asked that the Final Action of the Examiner be reviewed. The rejection has consequently been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board and the ruling of the Commissioner are as follows:

Agent for Applicant

Marks & Clerk  
P.O. Box 957, Station B  
Ottawa, Ontario  
K1P 5S7

COMMISSIONER'S DECISION SUMMARY

C.D. 1164...App'n 500734

(J40)

Section 2, Non-Statutory Subject Matter:

Amended claims that are directed to the processing of film under abnormal conditions are directed to a useful art, albeit that some of the steps may involve the exercise of human judgement. Rejection modified.

This decision deals with the Applicant's request that the Commissioner of Patents review the Examiner's Final Action on application 500,734 filed January 30, 1986, (Class 95-25). Assigned to Color Processing System SDN. BHD., it is entitled PRODUCTION OF BUSINESS CARDS AND THE LIKE. The inventors are K.S. Liat, K.S. Khoon and K.S. Hean. The Examiner in charge issued a Final Action on December 8, 1989 refusing to allow the application to proceed to patent.

The invention provides a method for producing business cards in color, free of boundary or artist make up lines. The steps include, assembling a composite artwork, exposing it to color film, developing the film under abnormal conditions of either, (a) a given temperature for a time exceeding the manufacturer's specified time, or, (b) a given time at a temperature exceeding the manufacturer's specified temperature, to obtain a color negative having high contrast. The developing process disclosed is Kodak Flexicolour Process C41 (Trade Mark) or compatible process, hereinafter C41 process. After printing the negative, the result is a print free of artwork make-up lines.

In his Final Action the Examiner said, in part, as follows:

...

Claims 1 and 2 are refused as being directed to non-statutory subject matter outside the definition of invention as set forth in Section 2 of the Patent Act. Method steps such as exposing, developing for a given time, immersing in a chemical bath at a given temperature for developing times exceeding the times specified by the manufacturer in order to produce a very high contrast negative are nothing but the use of photographic sensitometry variables known and used by experienced photographers. These expected skills all require human intervention as well as exercising judgemental reasoning. M.O.P.O.P. Section 12.03.01 (c) and (d) specifically identify such procedures and processes as used in this application as non statutory subject matter.

...

The Applicant responded to the Final Action by submitting a new claims 1 and 2 on July 31, 1990 and January 21, 1992 and argued against the rejection in the following terms, in part:

... It is respectfully submitted that all processes be they chemical, photographic or otherwise, require human intervention, as well as exercising judgemental reasoning. In particular, any chemical process requires the intervention by humans in order to make it go, and judgemental reasoning to see that it goes correctly and in the manner required. It cannot be seen that this renders the process unpatentable if it is novel and inventive.

It is pointed out to the Commissioner that the process of the present invention is directed to the production of a vendible product, namely business cards. It is also directed to the production of these business cards by a novel and inventive process, and it is to be noted that the Examiner has not attempted to assert that the process is not novel and inventive. This is a classical case for patentability. Thus, referring to M.O.P.O.P. Section 12.03.01 and the prerequisites of a patentable invention, the first requisite is that it has industrial value. The process of the present invention certainly satisfies this requirement. It must relate to a useful art, as distinct from a fine art, where the result produced is solely the exercise of personal skills, mental reasoning or judgement, and has only intellectual meaning or aesthetic appeal. It is respectfully submitted that clearly the process of the present invention is directed to a useful art. Further, the subject matter is operable, controllable and producible by the means described by the inventor, so that the desired result inevitably follows whenever it is worked. This is certainly the case here. The subject matter has practical application in industry, trade and commerce. It is not illicit, and it is not a mere scientific principle or abstract theorem, and it is certainly beneficial to the public. It is respectfully submitted that Section 12.03.01 (c) and (d) which are exemplifications of what is not patentable relates to whether the process of the present invention is a useful art, as opposed to a fine art, and it is respectfully clearly submitted that it is a useful art. It is a process which is reproducible, can be operated by people skilled in the art of photography, as clearly admitted by the Examiner in his ... statement with regard to experienced photographers, and is not produced solely by the exercise of personal skills, mental reasoning or judgement. The present invention is directed to a method of producing full colour business cards by photographing a subject consisting of artwork pasted up on to a background, using only a single exposure, wherein the single exposure exposes

a single colour negative, after which the negative is processed and printed onto colour photographic paper, such that there is a high contrast between the light and dark colours, in order that the subject of the business is card is bold and stands out, and such that contrast between similar shades of similar colours is suppressed so that the boundary lines present between the areas of the pasted up art work, and the similar shaded areas of the background mounting board disappear, thereby leaving a clear and tidy business card. It has been found that the problem with producing business cards by the conventional developing technique is that the subject of the cards tends not to stand out clearly from the background, and a more significant problem arises from the fact that unwanted boundary lines, which are present between areas of the pasted up art work, and similar shaded areas of the mounting board from which the single negative is obtained in a single exposure step show up in the final print. ...

...

The issue before the Board is whether or not the application and the amended claims are directed to the exercise of judgemental reasoning and are or are not outside the definition of invention set forth in Section 2 of the Patent Act. Amended claim 1 reads:

A method for producing business cards, name cards and the like in color, the steps comprising: (a) assembling artwork comprising images and characters on a substrate to form a composite artwork for a business card, name card or the like, said images and characters comprising a multiplicity of colors; (b) exposing, in a single step, a unit of color film to said artwork to form a latent image of said artwork thereon; deliberately over-developing said exposed unit of color film by employing abnormal processing conditions with respect to the normal processing conditions specified by the manufacturer of the color film to produce a normal contrast color negative, which

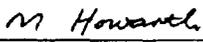
abnormal processing conditions involve one of: (i) immersing said exposed unit of color film in a first chemical at a given temperature  $T$ , for a developing time  $t_1$ , which exceeds the maximum time  $t_0$  specified by the manufacturer for said given temperature by an amount  $\Delta t$ ; and (ii) developing for a given time period  $t$ , the exposed unit of color film in the first chemical at a temperature  $T_1$ , which exceeds the maximum  $T_0$  specified by the manufacturer for said given time period by an amount  $T$ ; said amounts  $\Delta t$  or  $\Delta T$  being selected to provide a single developed color negative containing all of said artwork and having a very high-contrast in relation to a color negative developed under said normal processing conditions so as to permit suppression of the boundary lines resulting from variations in shade of the backgrounds of said substrate and said artwork; (d) printing only said single developed color negative onto color photographic paper in the desired size to reproduce the artwork thereon in a multiplicity of colors substantially corresponding to those of said artwork; and (e) cutting said printed color photographic paper to the desired card size and thereby to provide a desired card in color.

Considering first the method steps of amended claim 1, it is noted they include, the assembly of the artwork, exposing it to film, developing under abnormal conditions, printing the negative obtained, and cutting. These are described in the application with respect to how they have been used with a particular type of process, namely a C41 process, to produce business cards. It may be that some of the steps involve the exercise of human judgement, such as cutting. Other steps such as developing the film fall into the area of a useful art, particularly in view of the disclosure. On pages 5 and 6 of the application, information is given to achieve a result that is different from that produced by following the normal C41 process. As claim 1 calls for

processing film under abnormal conditions, the Board is satisfied that claim 1 is directed to a useful art that is acceptable under Section 2 of the Patent Act.

The Board, therefore recommends that the application containing amended claims 1 and 2 be accepted.

  
\_\_\_\_\_  
F.H. Adams  
Chairman  
Patent Appeal Board

  
\_\_\_\_\_  
M. Howarth  
Member  
Patent Appeal Board

  
\_\_\_\_\_  
P. Ebsen  
Member  
Patent Appeal Board

I concur with the findings and the recommendations of the Patent Appeal Board. Accordingly, I withdraw the rejection of the application and the claims made under Section 2 of the Patent Act. I remand the application to the examiner for prosecution consistent with the recommendations.



J.H.A. Gariépy  
Commissioner of Patents

Dated at Hull, Quebec  
this 30<sup>th</sup> day of January 1992

Marks & Clerk  
P.O. Box 957, Station B  
Ottawa, Ontario  
K1P 5S7