

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUSAN D. HILL, VICKY SINN,
and JEAN-FABIEN DUPONT

Appeal No. 2003-0407
Application No. 09/550,503

ON BRIEF

Before KIMLIN, GARRIS and LIEBERMAN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-23. Claims 24-27 have been withdrawn from consideration. Claim 1 is illustrative:

1. A black and white silver halide motion picture sound recording film comprising a transparent support bearing at least one silver halide emulsion layer and an antihalation layer comprising filter dye which is incorporated in the form of a solid particle dispersion which is readily solubilized and removed or decolorized upon standard processing in the D-97

Appeal No. 2003-0407
Application No. 09/550,503

process as specified in Kodak publication H-24, so as to result in a minimum density of 0.07 or less.

The examiner relies upon the following references as evidence of obviousness:

Brick et al. (Brick)	5,709,983	Jan. 20, 1998
Gerlach et al. (Gerlach)	5,955,255	Sep. 21, 1999
Anderson et al. (Anderson)	5,962,207	Oct. 05, 1999

Appellants' claimed invention is directed to a black and white silver halide motion picture sound recording film comprising a transparent support and an antihalation layer. The antihalation layer comprises a solid particle dispersion of filter dye that is readily solubilized and removed or decolorized upon standard processing. According to the present specification, "[h]alation protection is conventionally accomplished in current sound recording films by using a gray-tinted support, or by including an anti-halation layer containing permanently colored dyes, to yield a neutral density," which neutral density "increases the minimum density (Dmin) of current sound films by 0.2 density units" (page 2 of specification, lines 30-34). Standard processing of the claimed recording film results in a minimum density of 0.07 or less. According to appellants, the advantage of the present invention "is obtained by substantially eliminating the traditional permanent density incorporated in prior art sound recording films, which permanent

Appeal No. 2003-0407
Application No. 09/550,503

density increases the requirements for exposure time or intensity needed to achieve a print density that enables optimal sound performance when printing the sound negative information to a color print film" (page 3 of Brief, first paragraph).

Appealed claims 1-7 and 14-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gerlach in view of Anderson. Claims 1-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gerlach in view of Brick.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we concur with appellants that the examiner has failed to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejections for essentially those reasons espoused by appellants.

Gerlach, the primary reference, discloses a black and white motion picture sound recording film but fails to teach the general use of an antihalation layer, let alone the specifics of one. According to appellants, the Examples of Gerlach "are clearly consistent with the conventional prior art sound recording film practice of using a gray-tinted support, or including permanently colored dyes, to provide such permanent

Appeal No. 2003-0407
Application No. 09/550,503

neutral density, as Table 3 of Gerlach et al reports a D_{min} value of 0.24" (page 6 of Brief, first paragraph).

The examiner appreciates that Gerlach does not disclose an antihalation layer, but it is the examiner's position that Gerlach's disclosure of the use of conventional interlayers would have suggested the inclusion of an antihalation layer. Based on the disclosures in Anderson and Brick of antihalation layers for motion picture films comprising the presently claimed filter dye which is readily solubilized and removed or decolorized upon standard processing, the examiner concludes that it would have been prima facie obvious for one of ordinary skill in the art to employ the antihalation layers of Anderson and Brick in the sound recording film of Gerlach.

The flaw in the examiner's reasoning is that Anderson and Brick do not refute appellants' statement in the specification that antihalation in sound recording films is effected by using a gray-tinted support or by using an anti-halation layer containing permanently colored dyes. Neither Anderson nor Brick discloses that the antihalation layers described therein are for use in black and white silver halide motion picture sound recording film. Hence, the examiner has not established the requisite motivation for one of ordinary skill in the art to use the

Appeal No. 2003-0407
Application No. 09/550,503

antihalation layers of Anderson and Brick in sound recording film. In addition, the examiner has not established that using the antihalation layers of Anderson or Brick in the sound recording film of Gerlach would necessarily, or inherently, result in a minimum density of 0.07 or less. We find that the examiner has not adequately refuted appellants' argument that:

To obtain a sound recording film in accordance with the invention, rather than simply add materials taught by Anderson et al or Brick et al to the film material taught by Gerlach et al as proposed by the examiner, all film materials employed must be specifically chosen so as to result in the claimed minimum density requirements (e.g., the conventional prior art sound recording film practice of using a gray-tinted support or including permanently colored dyes which yield a substantial minimum density after processing cannot be done.

Sentence bridging pages 6 and 7 of Brief. Furthermore, the examiner has also not refuted appellants' contention that:

The addition of further antihalation, antistatic and overcoat layer materials found in the layers of Anderson et al or Brick et al to the material as taught by Gerlach et al as proposed by the examiner would if anything be expected to increase densities above that demonstrated in the Examples of Gerlach et al due to light absorption of any of such added materials which may be retained after processing.

Page 6 of Brief, first paragraph. As emphasized by appellants, Table 3 of Gerlach reports a Dmin value of 0.24.

Appeal No. 2003-0407
Application No. 09/550,503

In our view, the examiner's position emanates from the impermissible obvious to try approach.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	
BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
)	
PAUL LIEBERMAN)	
Administrative Patent Judge)	

ECK:clm

Appeal No. 2003-0407
Application No. 09/550,503

Patent Legal Staff
Eastman Kodak Co.
343 State St.
Rochester, NY 14650-2201