

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. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT T. TRICK

Appeal No. 2001-1306
Application No. 08/100,019

HEARD: MARCH 5, 2002

Before FLEMING, LALL, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL AND ORDER

This is a decision on appeal from the Examiner's final rejection of claims 1 through 8 and 10 through 17. Claim 9 has been canceled.

We affirm-in-part and remand.

BACKGROUND

Appellant's invention is directed to a sealed package of film for producing photographs in a plurality of frames upon exposure. Each frame comprises an exposed portion and an unexposed portion, which is later exposed in a conventional

manner to form images in the unexposed portion (specification, page 2). The conventionally exposed portions along with the previously exposed portions on the film are developed simultaneously (specification, page 4). Thus, each frame produces a photograph including a portion with a predetermined content independent of that which is later conventionally exposed.

Representative independent claim 1, and dependent claims 4 and 7 are reproduced as follows:

1. A sealed package of photographic film comprising a plurality of exposable photographic frames to be exposed, each exposable photographic frame comprising a first unexposed portion and a second exposed portion.

4. A package according to Claim 1, wherein the package is of instant developing film.

7. A package according to claim 1, wherein each second exposed portion in the package is developed.

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

Ames	1,933,953	Nov. 7, 1933
Jones	4,304,471	Dec. 8, 1981
Guez	4,827,291	May 2, 1989

Claims 7 and 15 stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of an enabling disclosure.¹

Claims 1 through 3, 6, 8, 10, 11, 14, 16 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ames.

Claims 1 through 3, 6, 8, 10, 11, 14, 16 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Guez.

Claims 4, 5, 12 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ames and alternatively under 35 U.S.C. § 103(a) as being unpatentable over Ames in view of Jones.

Claims 4, 5, 12 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Guez and alternatively under 35 U.S.C. § 103(a) as being unpatentable over Guez in view of Jones.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 36, mailed June 8, 1999) for the Examiner's complete reasoning, the appeal brief (Paper No. 35, filed May 17, 1999) and the reply brief

¹ Appellant filed an amendment on August 12, 1999 simultaneously with the reply brief, canceling claims 7 and 15, which was denied entry by the Examiner.

(Paper No. 39, filed August 12, 1999) for Appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by Appellant and the Examiner. As a consequence of a careful review of the evidence before us, we agree with the Examiner that the specification does not describe the claimed subject matter of claims 7 and 15 in an enabling manner. We are also in agreement with the Examiner that Guez anticipates the invention of claims 1 through 3, 6 and 8, and that, in combination with Jones, renders obvious the invention of claims 4 and 5. We reach the opposite conclusion with respect to the § 102 rejections of claims 4, 5, 10 through 14, 16 and 17 over Guez and claims 1 through 6, 8, 10 through 14, 16 and 17 over Ames. Additionally, it is our view that Ames in combination with Jones would not have suggested the invention of claims 4, 5, 12 and 13 and that Guez in combination with Jones would not have suggested the invention of claims 12 and 13.

Accordingly, we affirm-in-part. We also remand the application to the Examiner for further evaluation and

reconsideration of the declarations under 37 CFR § 1.131 (papers No. 8, filed May 8, and No. 10, 1995 and October 23, 1995).

At the outset, we note that Appellant considers claims 7 and 15, rejected under § 112, separately and indicates that they do stand or fall with the remaining claims (brief, page 14). Appellant further provides arguments for claims 1 through 3, 6, 8, 10, 11, 14, 16 and 17, corresponding to the rejection under § 102, that are separate from those provided for the rejection of claims 4, 5, 12 and 13 under § 103 (brief, pages 14 & 21). Therefore, we will consider the claims as the above-mentioned three groups.

With respect to the rejection of claims 7 and 15 under the first paragraph of 35 U.S.C. § 112, Appellant argues that at least three methods by which a partially developed and sealed film could be made were known at the time of the filing of the application (brief, page 11). Appellant provides a description of three such methods (brief, pages 11-13) as well as a depiction of the related process steps (attachment to the brief, Figures 1-14) and concludes that the known methods are simple enough that would have been known to any person skilled in the art.

The Examiner responds to Appellant's arguments by stating that such methods of partially developing pre-exposed portions

have no support in the art and require supporting evidence (answer, page 3). The Examiner further argues that the claimed selective development of the second exposed portion involves complex development methods that are not readily available or obvious to one of ordinary skill in the art (answer, page 5).

We note that the first paragraph of 35 U.S.C. § 112 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains... to make and use the same....

As pointed out by our reviewing court, the specification, when filed, must enable one skilled in the particular art to use the invention without undue experimentation. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). To be enabling, the specification must teach those of ordinary skill in the art "how to make and how to use the invention as broadly as it is claimed." In re Vaeck, 947 F.2d 488, 496, 20 USPQ2d 1438, 1445 (Fed. Cir. 1991). Also see Spectra-Physics v. Coherent, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987).

After a review of the specification and the claims, we find that the specification does not describe with any specificity, how the second exposed portions may be developed prior to

packaging. We agree with the Examiner that at least one of the specific ways of developing the pre-exposed portions prior to packaging is necessary for the disclosure to be enabling. Particularly significant are methods of pre-developing the partially exposed films without affecting the unexposed portions prior to packaging, which are missing from the disclosure of this application. Furthermore, Appellant has not provided any evidence of the commonly known methods of pre-developing partially exposed film.

As to Appellant's reliance upon the description and the depiction of methods of partially exposing and developing films, as outlined in the brief, we point out that these methods need to be recognized not only by Appellant, but also by those of ordinary skill in the art. We further note that the figures (attachment to the brief, Figures 1 -14) Appellant relies upon for depicting the corresponding process steps, do not show that such information had been known to one of ordinary skill in the art at the time the application was filed. It is not clear from this record that one of ordinary skill in the art of photography would have recognized such methods as conventional and well known. We conclude that those of ordinary skill in the art were not aware of such methods since, other than Appellant's own

knowledge of partial exposure and development, no evidence of other skilled artisans' published work tending to support this assertion has been presented. Thus, we agree with the Examiner that the specification does not describe the subject matter of claims 7 and 15 in an enabling manner and their rejection under the first paragraph of 35 U.S.C. § 112 is sustained.

Turning to the § 102 rejection of claims 1 through 6, 8, 10 through 14, 16 and 17 over Ames, Appellant relies on the claim limitation of "[a] sealed package of photographic film" to distinguish the claimed invention from Ames (brief, page 16). Appellant further points out that Ames uses a photographic paper which is different from the claimed photographic film (brief, page 16 and reply brief, page 3). Additionally, Appellant argues that Ames does not teach "a sealed package of film" and merely provides for different boxes that house the unexposed, partially exposed and fully exposed sensitized paper as the paper moves from one box to another and passes before the camera lens (brief, page 16, reply brief, page 3).

The Examiner responds by arguing that the sensitized photographic paper of Ames functions as instant photographic film and reads on the claimed subject matter (answer, page 6). The Examiner further characterizes light-sealed box B and receptacle

R of Ames as a sealed package through which no light is permitted to enter (answer, page 6).

Before addressing the Examiner's rejection based upon prior art, it is essential that we understand the claimed subject matter and determine its scope. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, as required by our reviewing court, we will initially direct our attention to Appellant's claim 1 in order to determine its scope. "[T]he name of the game is the claim." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

Appellant's claim 1 requires "[a] sealed package of photographic film" comprising a "plurality of exposable photographic frames" wherein each frame further comprises "a first unexposed portion" and "a second exposed portion." Appellant would have us read "a sealed package" as limited to films sealed only in a bag or similar containers. We decline to

attribute such limited meaning to claim 1 since the claim does not preclude a partially exposed photographic film sealed in other enclosures, such as a camera itself.

A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 1566, 1567, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

We observe that Ames discloses a number of enclosures in which a roll of sensitized photographic paper is contained and exposed in different stages (page 1, lines 96-108). Therefore, the sensitized paper, on which the photograph is taken, is contained in a (light) sealed enclosure formed of box B, the section in front of two cameras and receptacle R. Box B supports the roll of paper while two cameras C and C' provide the exposure of the paper to the subject and the background before the fully

exposed section of the paper is received in receptacle R (page 2, lines 123-149). Thus, Ames starts with a completely unexposed frame and successively exposes the frame first with a background and later with the subject. The result is a complete exposure of that frame by the time receptacle R receives the paper while the next completely unexposed frame advances to a position in front of background camera C'. Accordingly, we find that Ames cannot anticipate claim 1 since its double exposed paper is not the same as the claimed film having a plurality of frames with "each exposable photographic frame comprising a first unexposed portion and a second exposed portion." Therefore, the Examiner has failed to meet the burden of providing a prima facie case of anticipation. We therefore, do not sustain the rejection of claims 1 through 6, 8, 10 through 14, 16 and 17 under 35 U.S.C. § 102 over Ames.

Turning now to Guez as anticipating claims 1 through 6, 8, 10 through 14, 16 and 17, Appellant argues that the partial exposure, rewinding and repositioning of the film as disclosed in Guez is not the same as the claimed "sealed package of film" (brief, page 17 and reply brief, page 4). In particular, Appellant points to the failure of Guez to teach or suggest that the film is packaged and sealed between exposures (brief, page

18). Appellant further argues that the partially exposed film of Guez that is rewound back into the canister, must be partially hanging out of the canister for further use and therefore, is not a sealed package (reply brief, page 6).

In response, the Examiner argues that the rewound film must be an inherently (light) sealed package in order to properly function as a photographic film (answer, page 6). The Examiner further argues that the claim does not require that the film be packaged and sealed between exposures (answer, pages 6 & 7).

After our review of Guez, consideration of the arguments of record and our determination of the scope of claim 1, we agree with the Examiner that Guez sufficiently describes a sealed package of photographic film comprising partially exposed frames. The reference teaches a method of making superimposed pictures on a roll of film by first shooting all the backgrounds (or foregrounds) and rewinding the film in the sealed film compartment of a camera. Next, the foregrounds (or backgrounds) corresponding to each pre-exposed frame are shot on the same film (col. 10, lines 36-46). A mask combination, as depicted in Figure 8, masks the foreground when the background is being shot and, similarly, masks the background during the exposure to the foreground subject. We note that the roll of film remains in the

sealed film compartment of the camera as it is advanced and rewound between the film canister and the right-hand spool. Therefore, before the second exposures are shot, the roll of film is in a sealed package and includes a plurality of exposable photographic frames that are partially exposed leaving exposed and unexposed portions on each frame. Hence, Guez meets the broadly recited "sealed package" of film comprising a plurality of frames having exposed and unexposed portions. Therefore, we sustain the rejection of independent claim 1 as well as claims 2, 3, 6 and 8, which stand or fall therewith, under 35 U.S.C. § 102 over Guez.

We note that independent claim 17 recites a process for obtaining developed photographs by removing the film from the sealed film package of claim 1 and placing it into a camera. Claim 17 further requires that the partially exposed film frames be exposed after placement in the camera. We find that Guez, in contrast, teaches that the film is exposed twice while inside the camera. Therefore, the film of Guez is not removed from the sealed package prior to the second exposure and does not anticipate the invention of independent claim 17 and claims 10 through 14 and 16, dependent thereupon. Additionally, Guez fails to teach the limitation of the package being of "instant

developing" kind as recited in claims 4, 5, 12 and 13.

Accordingly, the rejection of claims 4, 5, 10 through 14, 16 and 17 under 35 U.S.C. § 102 over Guez is not sustained.

We next consider the rejection of claims 4, 5, 12 and 13 under 35 U.S.C. § 103 over Guez or Ames in combination with Jones. We take claim 4 as the representative claim of this group and observe that the claim has the same recited elements as claim 1 and further requires that the package be "of instant developing film." The rejection is based on the Examiner's proposed modification of the partially exposed film of Ames or Guez by using the instant camera of Jones to provide a decorative border for each film frame (answer, page 4). In response, Appellant argues that there are no teachings or suggestions in Jones to overcome the deficiencies in Ames and Guez (brief, page 21).

The initial burden of establishing a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Where, as here, a conclusion of obviousness is premised upon a combination of references, the examiner must identify a reason, suggestion, or motivation which would have led one having ordinary skill in the art to combine those references. See Pro-Mold & Tool Co. V. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626,

1629, (Fed. Cir. 1996), In re Sernaker, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

Our review of Jones reveals that the reference teaches producing photographs with borders or writings by using one or more masks that are superimposed on the film for use in a regular or instant camera (col. 2, lines 32-62). Thus, the desired configuration can be produced in the print at the time of making the exposure for the instant developing films. Jones further teaches that the mask member may remain in the camera during several succession exposures since it does not interfere with the forward feeding of the film (col. 2, lines 12-16). However, we find no teachings or suggestions in Jones relating to the limitation of exposed and unexposed portions on each frame of a sealed photographic film, that would overcome the deficiencies noted above in Ames. Therefore, we do not sustain the rejection of claims 4, 5, 12 and 13 under 35 U.S.C. § 103 over Ames in view of Jones.

With respect to the combination of Jones with Guez, it is our view that the Examiner has established a reasonable prima facie case of obviousness with respect to claims 4 and 5. Based on our review of Jones, we agree with the Examiner that it would have been obvious to substitute an instant developing film for

the continuous film of Guez to produce a partially pre-exposed frame of instant developing kind that is later exposed in order to complete the picture. However, we find nothing in Jones that relates to the process steps of claim 17 related to opening and removing a sealed package of film to be placed into a camera, which are also present in claims 12 and 13. Therefore, the subject matter of claims 12 and 13 would not have been obvious over the combination of Guez and Jones since Jones does not cure the above-noted deficiency of Guez with respect to the recited features of base claim 17 from which claims 12 and 13 depend. Accordingly, we sustain the rejection of claims 4 and 5 under 35 U.S.C. § 103 over Guez in view of Jones, but reach the opposite conclusion with respect to claims 12 and 13.

REMAND TO THE EXAMINER

Our further consideration of the record in this application leads us to conclude that the rejection of appealed claims 1 through 8 and 10 through 17 based on the prior art listed below, that was overcome by establishing prior date of the invention, should be revisited by the Examiner. Our conclusion is based on an analysis of the propriety of the declarations under 37 CFR § 1.131 (filed May 8, 1995 and October 23, 1995) to overcome the art rejection based on these references. Accordingly, we remand

the application to the examiner pursuant to 37 CFR § 1.196(a) to consider the following issues and to take appropriate action.

The declarations under 37 CFR § 1.131 were determined by the Examiner to have overcome the following references:

Spector (Spector '832)	4,994,832	Feb. 19, 1991 (filed Jan. 2, 1990)
Spector (Spector '224)	5,111,224	May 5, 1992 (filed Feb. 7, 1991)
Olson	5,142,311	Aug. 25, 1992 (filed Jul. 8, 1991)
Kirkendall	5,187,512	Feb. 16, 1993 (filed Oct. 21, 1990)
Wheeler	5,189,467	Feb. 23, 1993 (filed Jun. 27, 1991)

Upon return of the application, the examiner is expected to review and reevaluate the effectiveness of the § 1.131 declarations in removing the Spector '224, Spector '832, wheeler, Olson and Kirkendall references. In so doing, we suggest that the examiner rely on the information as set forth in 37 CFR §§ 1.131 and 1.601(n) for the details of the requirements under these provisions.

DISCUSSION

The examiner rejected the original claims 1 through 7 under 35 U.S.C. § 102(e) as anticipated by Wheeler and [or] Olson in a

previous Office Action (Paper No. 7, mailed February 6, 1995). In the same office action, the Examiner also rejected the claims under 35 U.S.C. § 103 as being unpatentable over Spector '832, Spector '224 and Kirkendall. Appellant filed a declaration under 37 CFR § 1.131 to establish invention prior to June 27, 1991 (Paper No. 8, filed May 8, 1995). The Examiner found the declaration proper for antedating Wheeler and Olson, but not for the remaining references. Appellant submitted a second declaration under 37 CFR § 1.131 (Paper No. 10, filed October 23, 1995 which was perfected in paper No. 15, filed April 19, 1996) to establish invention prior to January 2, 1990 in order to overcome the rejection based on Spector '832, Spector '224 and Kirkendall. We remand this application with the following discussion and recommend that the examiner revisit the effectiveness of the § 1.131 declarations in overcoming the rejections of claims 1-7 and reconsider the propriety of similar rejections applied to claims 1 through 8 and 10 through 17, which are presently under appeal.

We observe that 37 CFR § 1.131(a) (July 1, 1994) as amended at 53 Fed. Reg. 23734 (June 23, 1988), which was controlling at the time of Appellant's filing the declarations states:

(a) When any claim of an application or a patent under reexamination is rejected on reference to a domestic patent which substantially shows or describes but does not claim the same patentable invention, as defined in § 1.601(n), as the rejected invention, or on reference to a foreign patent or to a printed publication, and the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the person qualified under §§ 1.42, 1.43 or 1.47, shall make oath or declaration as to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the inventor or the confirmation of the patentability of the claims of the patent, unless the date of such patent or printed publication is more than one year prior to the date on which the inventor's or patent owner's application was filed in this country. [Emphasis added.]

We further observe that 37 CFR § 1.601(n) defines "same patentable invention" as follows:

(n) Invention "A" is the "same patentable invention" as an invention "B" when invention "A" is the same as (35 U.S.C. § 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

Initially, the rules indicate that if the date of the reference to be overcome is more than one year prior to the date on which Appellant's application was filed (July 30, 1993), the declaration is ineffective to establish prior invention and overcome the rejection. Secondly, determination of the "same

invention" involves a two-way patentability analysis. The claimed invention of the patent and the claims of the application are compared with each other. The claimed invention of the patent must anticipate or render obvious the claimed invention of the application and the claimed invention of the application must anticipate or render obvious the claimed invention of the patent. When the two-way analysis is applied, then if "same invention" is claimed in both the patent and the application, an interference should be declared instead of removal of the patent as prior art based on a § 1.131 declaration.

At the time of filing of the declarations, claim 1 read as follows:

1. A sealed package of film to be opened, put into a camera and exposed to form a plurality of photographs, comprising a plurality of film items to be exposed, each film item comprising a first unexposed portion and a second exposed portion, whereby upon exposure of the first unexposed portion and development there is formed in said first portion a picture corresponding to the exposure alongside a picture corresponding to the second portion.

Claim 1 was amended to its current form (paper No. 23, filed July 7, 1997) in order to overcome the Examiner's rejection based on the second paragraph of 35 U.S.C. § 112 by conforming the claim language to that of a product. The amendment broadened the scope of the claim by removing the limitations related to placing the

film in the camera and its subsequent exposure and development, which are now recited in the process claim 17.

We recommend that the Examiner take into consideration the fact that Spector '224 and Spector '832 were issued more than one year prior to the July 30, 1993 filing date of Appellant's application. According to the rules, a declaration under 37 CFR § 1.131 would not be effective in establishing prior invention and removing a reference having a date of more than one year prior to the date of filing of the application. Additionally, we recommend that the Examiner evaluate the disclosures of these two patents and determine whether they teach the limitations of current claim 1. For example, Spector '224 teaches in col. 3, lines 4-21 that:

More particularly, an object of this invention is to provide a dual-track film for a camera of the above type in which one track which is advanceable through the exposure section of the camera has successive light-sensitive picture frames that are partially pre-exposed to contain a latent image of a character

A significant advantage of the invention is that ... when a picture is taken the latent, partially-exposed character image is then fully exposed and the resultant picture shows the individual in proper juxtaposition to the character.

Similarly, Spector '832 in col. 2, lines 31-41 states:

To carry out this technique, a camera is loaded with a light-sensitive film whose successive frames are partially

pre-exposed so that each frame contains a latent image of a character.

When the camera is set to place a particular frame behind the lens, the individual is then posed before the camera to occupy a predetermined position relative to the latent frame image. Upon actuation of the camera, a latent image of the individual is formed on the frame in juxtaposition to that of the character and the exposure of the frame is completed. The film is then developed and printed to provide the desired picture.

Turning now to Wheeler, we recommend that the Examiner make the necessary analysis to determine whether "same invention" is claimed, i.e., whether the subject matter of Appellant's claim 1 is anticipated (35 U.S.C. § 102) or rendered obvious (35 U.S.C. § 103) by the subject matter of Wheeler's claim 1 and vice versa. The Examiner should pay specific attention to claim 1 of Wheeler where "a photographic film having thereon a pre-exposed image A which is undeveloped" is provided in which a mask section A' masks image A while the remaining unexposed portion is exposed to receive image B. The claim further requires "developing said film to convert said images A and B thereon into developed visible images." We advise that the Examiner consider whether Wheeler's claim 1 is obvious over Appellant's claim 1 based on the reason that it would have been conventional and obvious to one of ordinary skill in the art to block exposure with a mask

while the unexposed portion is exposed, as is routinely practiced in photography art.

Likewise, the Examiner is recommended to make similar determination with respect to Olson and determine whether "same invention" is claimed, i.e., whether the subject matter of Appellant's claim 1 is anticipated (35 U.S.C. § 102) or rendered obvious (35 U.S.C. § 103) by the subject matter of Olson's claims 1, 18 or 19 and vice versa. We suggest that the Examiner pay specific attention to col. 7, lines 24-29 and 43-51 of Olson in which claim 1 recites:

directing actinic light through the first section of the template and onto the photosensitive layer so as to pre-expose a first portion thereof to form a first latent image while simultaneously leaving a second portion thereof unexposed;

packaging the film unit in an opaque film cassette having an exposure aperture ... while the first portion of the photosensitive layer containing the first latent image is substantially completely covered by portions of the wall defining the exposure aperture;

actuating a shutter of the camera ..., such scene light being adapted to expose only the second portion of the photosensitive layer of the film unit to provide a second latent image while the first portion ... is protected from further exposure by the wall of the film cassette; and

processing the film unit so as to simultaneously develop the first and second latent images. [Emphasis added.]

Similar to the discussion of Wheeler, we also advise that the Examiner consider whether Olson's claim 1 is obvious over Appellant's claim 1 based on the reason that it would have been conventional and obvious to one of ordinary skill in the art to block the pre-exposed portion during the exposure of the second unexposed portion to prevent double exposure of the pre-exposed portion as is well-known in photography art. Similarly, analysis should be made with respect to claims 18 and 19 of Olson, which recite a first pre-exposed section and a second non-exposed section in which only the second section will be exposed to light during photography in a camera.

Lastly, with respect to Kirkendall, the Examiner is recommended to determine whether "same invention" is claimed, i.e., whether the subject matter of Appellant's claim 1 is anticipated (35 U.S.C. § 102) or rendered obvious (35 U.S.C. § 103) by the subject matter of Kirkendall's claims 12 and vice versa. We suggest that the Examiner review the "SUMMARY OF THE INVENTION" section in Kirkendall and specifically consider the way the reference preexposes portions of each photographic frame. Kirkendall in col. 2, lines 48-55 recites:

Each frame of the [film] strip is subsequently masked and exposed to light which passes through nonopaque areas of the

mask in order to expose the underlying film to an image contained on said nonopaque areas of the mask.

Claim 12 of Kirkendall includes similar features in col. 12, lines 7-10 by reciting:

a strip of negative film having opposite ends, ..., said strip of negative film comprising a plurality of frames each of which includes a portion, which has previously been exposed during its manufacture so as to provide a first latent image therein, and an unexposed portion;

and in col. 12, lines 22-29 by reciting:

means for configuring said exposure frame opening so as to prevent the further exposure of said exposed portion of each of said film frames while simultaneously allowing the exposure of said unexposed portion of said film frame to image bearing light rays passing through said exposure frame opening during its exposure within a camera so as to provide a second latent image within said film frame.

Similar to the discussions of Wheeler and Olson, we also advise that the Examiner consider whether Kirkendall's claim 12 is obvious over Appellant's claim 1 based on the reason that it would have been conventional and obvious to one of ordinary skill in the art to block the pre-exposed portion during the exposure of the second unexposed portion as is routinely practiced in photography art.

We emphasize that we have not made any determination with respect to the propriety of the declarations under 37 CFR § 1.131

and their effectiveness in removing the above-discussed references by establishing prior date of completion of the invention. It is our objective that the Examiner reevaluate the references in view of our discussions and determine whether Appellant's declarations under 37 CFR § 1.131 have properly established the date of the invention prior to the effective filing dates of the applied prior art, or an interference between Appellant's application and any of the cited references should be declared.

Upon remand, if the examiner decides to enter new grounds of rejection based on further consideration of the prior art as discussed above in the "DISCUSSION" section, the examiner should ensure that all references relied upon have been evaluated in view of the provisions of 37 CFR § 1.131. On the other hand, if the examiner determines that any of the applicable references claim "same invention" according to the provisions of 37 CFR § 1.601(n), the reference can only be overcome by way of interference according to 37 CFR 1.608. We also caution the Examiner that if any claims drawn to the invention of the reference(s) are presented in the application more than one year after the issue date of the patent(s), a rejection of the claims of the application under 35 U.S.C. 135(b) should be made. See In

re McGrew, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) (The court holding that application of 35 U.S.C. 135(b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.).

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01. After action by the examiner in response to this remand, it is important that the Board of Patent Appeals and Interferences be promptly informed of any such actions affecting the appeal in this application.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 7 and 15 under 35 U.S.C. § 112, rejecting claims 1 through 3, 6 and 8 under 35 U.S.C. § 102 over Guez and rejecting claims 4 and 5 under 35 U.S.C. § 103 over Guez and Jones is affirmed. The decision of the Examiner rejecting claims 1 through 6, 8, 10 through 14, 16 and 17 under 35 U.S.C. § 102 over Ames and rejecting claims 4, 5, 10 through 14, 16 and 17 under 35 U.S.C. § 102 over Guez is reversed. Additionally, the decision of the Examiner rejecting claims 12 and 13 under 35 U.S.C. § 103 over Guez and Jones, and rejecting claims 4, 5, 12 and 13 under 35 U.S.C. § 103 over Ames and Jones is reversed.

We further remand this application to the examiner for action as required by this remand, and for such further action as may be appropriate.

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

AFFIRMED-IN-PART and REMANDED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
PARSHOTAM S. LALL)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

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