

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANDRA J. DAGAN, PETER T. AYLWARD and
THOMAS H. MOUREY

Appeal 2008-1465
Application 10/462,531
Technology Center 1700

Decided: March 25, 2008

Before THOMAS A. WALTZ , CATHERINE Q. TIMM, and ROMULO H.
DELMENDO, *Administrative Patent Judges*.
WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Primary Examiner's final rejection of claims 1, 6, 7, 11, 15-19, 22-29, 31, 33, and 35 (an amendment subsequent to the final rejection was entered by

the Examiner but no claims were allowed; Br. 1).¹ The remaining claims pending in this application are claims 2-5, 8-10, 12-14, 20, 21, 30, 32, 34, and 36, which stand withdrawn from consideration as directed to a non-elected invention (Br. 1). We have jurisdiction pursuant to 35 U.S.C. § 6(b).

According to Appellants, the invention is directed to an imaging element having long term stability comprising at least one imaging layer and a support, where the support comprises at least one layer containing polylactic acid (Br. 1-2). Independent claim 1 is illustrative of the invention and a copy of this claim is reproduced below:

1. An imaging element having long term stability comprising at least one imaging layer and a support, wherein said support comprises at least one layer comprising polylactic acid.

The Examiner has relied on Kong, US Patent Application Publication No. 2003/0039775 A1, published Feb. 27, 2003, as the sole evidence of obviousness (Ans. 4).

ISSUES ON APPEAL

The claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kong (Ans. 5).

Appellants contend that Kong fails to teach or suggest an imaging layer as claimed, and the printed film labels taught by Kong differ greatly from an imaging element with at least one layer capable of forming an image

¹ We refer to and cite from the amended Appeal Brief dated Nov. 13, 2006.

based on various imaging techniques (Br. 6). Appellants further contend that a label to be printed on does not within itself contain a layer for forming an image (*id.*).

Appellants contend that Kong “teaches away” from the invention by teaching that his film is better for the environment due to its biodegradability while the present invention resists photodegradation and has long term stability (Br. 6-7, citing claim 35 on appeal).

Appellants contend that Kong is non-analogous art since this reference is neither in the field of imaging elements nor does it deal with Appellants’ particular problem of long term stability (Br. 7-8).

Appellants contend that their Specification indicates that an “imaging layer” is the layer that forms the image, and giving this term its plain meaning, as used in the Specification and prior art, one of ordinary skill in the art would understand that it is a layer capable of forming an image within the layer or by the layer alone (Br. 10-11).

The Examiner contends that Kong is analogous prior art since this reference is in the field of imaging (printing) supports, which is the same field of endeavor as Appellants (Ans. 14).

The Examiner contends that an “imaging layer” as defined and illustrated by Appellants’ own Specification includes ink-receiving layers such as those disclosed by Kong (Ans. 9-10 and 15-17).

The Examiner contends that Kong does not “teach away” from the claimed invention since the fact that the Kong films are recyclable and/or biodegradable does not inherently mean that the film is unstable or not durable (Ans. 11-14 and 18).

Accordingly, we determine the following issues presented from the record in this appeal: (1) Have Appellants established that the Examiner reversibly erred in determining that Kong is analogous prior art; (2) if Kong is analogous prior art, have Appellants established that the Examiner reversibly erred in construing the claimed “imaging layer” to include the ink- or inkjet-receiving layers disclosed by Kong; and (3) Have Appellants shown that Kong “teaches away” from the claimed invention?

We determine that the Examiner has correctly determined that Kong is analogous prior art, and properly established a prima facie case of obviousness, which prima facie case has not been adequately rebutted by Appellants’ arguments. Therefore, we AFFIRM the sole ground of rejection presented for review in this appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

We determine the following Factual Findings (FF) from the record presented in this appeal:

- (1) Kong discloses a thermoplastic film comprising a core layer with about 60-95 wt.% of polylactic acid, where the core layer comprises the interior of the film, and at least one ink-receptive and/or print-receptive outer or skin layer (Ans. 5; Kong, Abstract; Fig. 2; ¶¶ [0002], [0019]-[0022], [0071]-[0075]);
- (2) Kong teaches that the films of his invention are useful as labels or sleeves, provided with printing, and having properties of “good

printability,” with advantages of “[h]igh surface energy for printing” as well as enhanced environmental appeal with respect to polyolefin labels (due to recycling), (Kong, ¶¶ [0005]-[0006], [0025]-[0033], [0060], [0062], and [0076]).

Determination that a reference is from non-analogous art includes consideration of the two separate tests that define the scope of analogous art, and this determination is often stated as follows; first, we must decide if the reference is within the field of endeavor of the inventor; if it is not, then we must proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *See In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979). Implicit in our review of the Examiner’s obviousness analysis is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation. *See Gechter v. Davidson*, 116 F.3d 1454, 1457, 1460 n.3 (Fed. Cir. 1997). During examination proceedings, we apply to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account any definitions or other enlightenment contained in the specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). “[T]he specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005), quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Under the proper legal standard, a reference will “teach away” when it suggests that the developments flowing from its disclosures are unlikely to produce the objective of the applicant’s invention. *See In re*

Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). A predecessor of our reviewing court has sanctioned the practice of nominally basing rejections on § 103 when, in fact, the actual ground of rejection is that the claims are anticipated by the prior art. Justification for this sanction is that the lack of novelty is the ultimate or epitome of obviousness. *See In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982).

Applying the preceding legal principles to the Factual Findings (FF) in the record of this appeal, we first determine that Kong is analogous prior art, and secondly determine that Kong reads on the subject matter as recited in claim 1 on appeal, in view of our claim construction discussed below.²

As discussed below, we determine that Appellants' field of endeavor includes ink/inkjet receiving layers as the "imaging layer," and for this reason we determine that subject matter of Kong is within the field of Appellants' endeavor, and thus is analogous prior art (FF (1) and (2) listed above; Ans. 14-15). *See In re Wood, supra.*

Once we have determined that Kong is analogous prior art, we must correctly construe the claim to define the scope and meaning of each contested limitation. *See Gechter v. Davidson, supra.* The only contested limitation from the record presented in this appeal is "[a]n imaging element ... comprising at least one imaging layer" (see claim 1 on appeal). Giving this limitation its broadest reasonable interpretation consistent with the

² We determine that Appellants do not present any argument directed to a specific claim, other than claim 35 (Br. 7). Therefore, we select independent claim 1 on appeal as representative of the grouping of rejected claims, and decide this appeal on the basis of this claim and claim 35. *See 37 C.F.R. § 41.37(c)(1)(vii)(2004).*

Specification, we must agree with the Examiner that this limitation includes layers which receive and retain ink to form images, i.e., ink-receiving layers (Ans. 9 and 15-17). Although specific embodiments described by Appellants include layers capable of forming an image within the layer or by the layer alone (Br. 10-11), the Specification discloses generally that an “imaging layer” includes an inkjet imaging layer or ink/inkjet-receiving layer:

Preferably, the imaging layer comprises photosensitive silver halide imaging layer, an inkjet imaging layer, a thermal imaging layer, or an electrophotographic imaging layer.

As used herein the phrase “imaging element” is a material that may be used as an imaging support for the transfer of images to the support by techniques such as ink jet printing.... (Spec. 21:12-17. *See also* Spec. 22:3-7).

Although the patent literature may contain specific embodiments where an “imaging layer” is capable of forming an image by itself (Br. 10-11), we determine that on this record the Specification is the single best source for determining the meaning of the contested limitation since Appellants specifically define and give examples of the imaging layer, and the patent literature is not directed to the same subject matter as claimed nor is it limited to its specific embodiments. *See Phillips v. AWH Corp., supra.*

As shown by FF (1) and (2) listed above, we determine that Kong discloses an imaging element comprising at least one imaging layer, as construed above, and a support comprising at least one layer of polylactic acid. We agree with the Examiner (Ans. 11-14) that the disclosure of Kong that his film is recyclable and better for the environment than polyolefins (*see* FF (2) listed above) does not lead one of ordinary skill in the art away

from Appellants' objective, namely stability and lack of photodegradation. Furthermore, we determine that every limitation of claim 1 on appeal is anticipated by Kong, as we have construed this claim above. The question of whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. *See Celeritas Techs., Ltd. V. Rockwell Int'l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998). Since anticipation is the epitome of obviousness, we therefore sustain the Examiner's rejection of claim 1 under § 103(a).

With regard to claim 35 on appeal, we note that the degree of resistance to photodegradation is not specified. As stated by the Examiner, the labels disclosed by Kong are applied as sleeves onto packaging containers and the like and would have been expected to have some degree of resistance to photodegradation (Ans. 11-12).

For the foregoing reasons and those stated in the Answer, we affirm the decision of the Examiner.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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