

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERTO VALSECCHI and RENZO TORTEROLO

Appeal No. 1996-1864
Application No. 08/330,349¹

ON BRIEF

Before PAK, WALTZ, and KRATZ, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 1 through 18, 21 through 27 and 29 through 35 which are all of the claims pending in the application. Claim 27 was amended subsequent to the final Office action dated July 14, 1995, Paper No. 8.

¹ Application for patent filed October 27, 1994.

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Claim 1 is representative of the subject matter on appeal and reads as follows:

1. A silver halide radiographic element comprising a polymeric film base, at least one gelatin silver halide emulsion layer, and at least one antistatic layer adhered to at least one side of said polymeric film base, wherein (1) said silver halide emulsion layer comprises tabular silver halide grains having an average diameter to thickness ratio of at least 3:1, and (2) said antistatic layer comprises a colloidal vanadium oxide and a sulfopolyester and an adhesion-promoting amount of an epoxy-silane compound.

The prior art references of record relied upon by the examiner are:

Guestaux 1980	4,203,769	May 20,
Valsecchi 15, 1986	4,582,782	Apr.
Anderson et al. (Anderson) 1991	5,006,451	Apr. 9,
Buchanan et al. (Buchanan) 1993	5,203,884	Apr. 20,
Chang et al. (Chang) 1994	5,372,985	Dec. 13,

(Filed Feb. 9,
1993)

Claims 1 through 18, 21 through 27 and 29 through 35 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Anderson, Chang, Guestaux, Buchanan and Valsecchi.

We reverse.

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The examiner has the initial burden of establishing a **prima facie** case of obviousness regarding the claimed subject matter within the meaning of 35 U.S.C. § 103. **In re Oetiker**, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992); **In re Piasecki**, 747 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). A **prima facie** case of obviousness is established only when "[b]oth the suggestion and the reasonable expectation of success [are] found in the prior art and not in applicant's disclosure." **In re Vaeck**, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

The examiner relies on Anderson to show a photographic support material, such as polyester film or cellulose acetate film, having thereon an anti-static layer comprising colloidal vanadium pentoxide, a barrier layer and a silver halide emulsion layer. See Answer, page 3, together with Anderson, columns 7 and 8 and abstract. The barrier layer is used to provide "excellent adhesion between the anti-static layer and [the silver halide emulsion layer]" and to prevent "unwanted diffusion of the vanadium pentoxide..." See Anderson, abstract, and column 7, line 50 to column 8, line 2. The

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examiner recognizes that Anderson does not describe or suggest including a "sulfopolyester compound and [sic, an] adhesion-promoting amount of an epoxy-silane compound in the anti-static layer comprising the colloidal vanadium oxide." See Answer, page 3.

To remedy these deficiencies of Anderson, the examiner initially relies on Chang and Buchanan to show that it would have been "**prima facie** obvious to incorporate a sulfonated polyester in the anti-static layer of Anderson....." See Answer, page 4. Both Anderson and Chang are said to use the same vanadium source taught in Guestaux in their anti-static layers. **Id.** The examiner then relies on Valsecchi to show that it would have been **prima facie** obvious to add an adhesive-promoting amount of an epoxy compound in the anti-static layer that utilizes a sulfonated polymer. See Answer, page 5.

We determine that the examiner's reasoning is flawed. As found by the examiner, Chang, Buchanan and Guestaux may suggest incorporating a sulfopolyester to the anti-static layer of Anderson (an anti-static layer containing vanadium

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oxide) to improve adhesion or other properties. However, they neither teach nor suggest employing a combination of a sulfopolyester and an epoxy compound in the anti-static layer of Anderson. Although the Valsecchi reference relied upon by the examiner employs an epoxy compound, Valsecchi uses the epoxy compound for rendering a sulfonated polymer in the anti-static layer insoluble through some unknown reaction between the epoxy compound and the sulfonated polymer. See column 7, line 59 to column 8, line 10. The examiner has supplied no evidence to support a conclusion that the desired unknown reaction described in Valsecchi is not adversely affected in the presence of the vanadium oxide described in either Anderson, Chang, Buchanan or Guestaux. Nor has the examiner provided sufficient evidence to conclude that one of ordinary skill in the art would have had a reasonable expectation that the modified sulfopolyester taught in Valsecchi (sulfopolyester modified by an epoxy compound) would necessarily have the desirable properties of a sulfopolyester, such as the improved adhesion suggested by Chang. In addition, the examiner has not provided any explanation as to why it would have been obvious to employ the claimed adhesive-

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promoting amount of an epoxy compound in view of Valsecchi. We find no guidance in Valsecchi to optimize the amount of an epoxy compound employed for the purpose of improving or promoting adhesion.

On this record, we determine that the applied prior art references as a whole would not have rendered the claimed subject matter *prima facie* obvious within the meaning of 35 U.S.C. § 103. Accordingly, we reverse the examiner's decision rejecting the appealed claims under 35 U.S.C. § 103.

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

REVERSED

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CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

CKP:lp

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MARK A. LITMAN
3M COMPANY
OFFICE OF INTELLECTUAL PROPERTY COUNSEL
P.O. BOX 33427, 3M CENTER
ST. PAUL, MN 55133

Leticia

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APJ PAK

APJ WALTZ

APJ KRATZ

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):
Prepared: June 19, 2000

Draft Final

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OB/HD GAU

PALM /ACTS 2/BOOK
DISK (FOIA)/REPORT