

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE H. BARBEE, JOHN D. LANG,
GIFFORD J. LEWIS and WILLIAM A. TORPEY

Appeal No. 95-2382
Application 07/955,671¹

ON BRIEF

Before STONER, ***Chief Administrative Patent Judge***, and JOHN D. SMITH and WALTZ, ***Administrative Patent Judges***.

WALTZ, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 6, 8 through 15 and 27 through 32, which are all of the claims remaining in this application.

¹ Application for patent filed June 29, 1992. According to appellants, the application is a continuation of Application 07/703,542, filed May 21, 1991, now abandoned.

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According to appellants, the invention is directed to a method of manufacturing coated photographic materials wherein the chilling and gelling of the photographic liquid materials occur while the web is horizontal and the materials are on the underside of the web (brief, page 3).

As stated by appellants on page 4 of the brief, the claims stand or fall together. Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A method of manufacturing coated photographic materials, comprising

feeding a support web through a curtain coating position;

applying liquid photographic materials to the support web while at said curtain coating position whereby a layer of uniform thickness is formed on the web, said liquid photographic layer including material which is gelable by chilling;

moving the web with the layer of material thereon in a substantially horizontal direction with the photographic materials facing downwards; and

chilling said liquid materials while said web is substantially horizontal with the materials on the underside thereof whereby the liquid materials gel.

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The examiner has applied the following references:

Di Mino	3,265,034	Aug. 9, 1966
Finnicum et al. (Finnicum) (filed Jul. 12, 1991) ²	5,114,759	May 19, 1992
Zhongjun (EP '493) (European Patent Application)	0 197 493	Oct. 15, 1986

Claims 1, 5, 6, and (1, 5, 6)/11-13 stand rejected under 35 U.S.C. § 102(b) as anticipated by EP '493. Claims 8, 10, 27, 31 and (8, 10, 27, 31)/11-13 stand rejected under 35 U.S.C. § 103 as unpatentable over EP '493. Claims 2-4, 9, 28-30 and (2-4, 9, 28-30)/11-13 stand rejected under 35 U.S.C. § 103 as unpatentable over EP '493 in view of Di Mino. Claims 15 and 32 stand rejected under 35 U.S.C. § 103 as unpatentable over EP '493 in view of Finnicum. Claim 14 stands rejected under 35 U.S.C. § 103 as unpatentable over EP '493 in view of Di Mino and Finnicum.

We reverse the rejection of claims 8, 10, 27, 31 and (8, 10, 27, 31)/11-13 under § 103 in view of EP '493. Accordingly, the rejection of claims 9, 28-30 and 32, which depend upon claims 8 and 27, are also reversed. We affirm all other stated rejections

² Finnicum is a continuation-in-part of Application No. 07/559,806, filed on Jul. 30, 1990. Appellants state that this application is a continuation of Application No. 07/703,542, filed May 21, 1991. The availability of Finnicum as prior art against appellants' claims has not been raised by the examiner or appellants.

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involving claims 1-6, 11-14 (as they depend upon claims 1-6), and 15. Our reasons are set forth below.

OPINION

A. The Rejection Under § 102(b)

Under 35 U.S.C. § 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. See *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

The method of appealed claim 1 requires four steps. Appellants do not contest that the first three steps are disclosed by EP '493 (brief, pages 5-7). Appellants argue that EP '493 fails to discuss the chilling of liquid coating materials on a support with the materials facing downwards and horizontal until the materials gel (brief, sentence bridging pages 6-7). Appellants recognize that Figures 5, 7 and 8 of EP '493 show chilling chambers wherein the web enters the chamber with the coated photographic materials facing downward but argues that these drawings are "truncated", i.e., the web is not shown leaving the chilling chamber (brief, pages 5 and 6). Appellants submit that Figure 9 of EP '493 shows the only complete chilling chamber and this figure shows the support at an angle with the

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photographic materials facing upwards (brief, page 6).

Appellants conclude that, since the only complete chilling chamber is shown with the photographic materials facing upwards, it is likely that this is the true construction of the apparatus (brief, page 7).

Appellants' arguments are not well taken for several reasons. As noted by the examiner on page 11 of the answer, Figure 9 of EP '493 is specifically disclosed as "an embodiment" of the invention, not as further description of the embodiment in Figures 5, 7 and 8 (see page 15, lines 13-16). The embodiment of Figure 9 is completely different than the embodiment of Figures 5, 7 and 8, with Figure 9 directed to "an embodiment of a new coating machine" with an angled chilling chamber (page 18, lines 16-25) while Figures 5, 7 and 8 have a horizontal chilling chamber. In fact, Figure 9 specifically requires a turning roller 24 to reverse the web so that the photographic material faces upwards **before** the web enters the angled chilling chamber (see page 18, lines 21-22, and Figure 9). No such turning roller is depicted or taught for the embodiments of Figures 5, 7 and 8. There is no evidence that any such turning roller was contemplated in EP '493 for the embodiment of Figures 5, 7 and 8. The photographic material clearly faces downward from the web in

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Figures 5, 7 and 8 as it moves through the chilling chamber 17 (page 16, line 23-page 18, line 15). EP '493 teaches that the liquid material adheres to the surface of the web before "then slowly gelling in a chilling chamber" (page 12, lines 3-7).

Therefore EP '493, in the embodiment shown in Figures 5, 7 and 8, discloses every limitation set forth in appealed claim 1. As noted above, the claims stand or fall together. Accordingly, the rejection of claims 1, 5, 6 and (1, 5, 6)/11-13 under 35 U.S.C. § 102(b) in view of EP '493 is affirmed.

B. The § 103 Rejection in view of EP '493

The examiner states that, in addition to the features discussed in the rejection under § 102(b), EP '493 further teaches the conventional use of a bead coater and curtain coater to apply photographic coatings, referring to Figures 2 and 3 and pages 1 and 15. The examiner concludes that it would have been obvious to use the chilling of coated layers while facing downwards from EP '493 with conventional bead coating "because '493 teaches that photographic layers can be chill set in a downwards facing manner in order to help provide a smooth and defect free coating and that it is conventional to apply photographic layers by bead coating or curtain coating methods."

(answer, page 5). Appellants admit that the substitution of bead coating for curtain coating is well known in the photographic industry but submit that EP '493 does not teach or suggest chilling the liquid material in a downward horizontal facing direction until the liquid materials gel (brief, page 7).

The examiner's reasoning is deficient for several reasons. Although bead coating is conventional in the art, as admitted by appellants and shown in Figure 2 of EP '493, the reference only discloses chilling coated photographic liquid materials in a downward facing position for curtain coating (see Figures 5, 7 and 8). The conventional bead coating as shown in Figure 2 does not result in the liquid material being in a downward facing manner.³ The coating layer 3 is on top of the moving web 1 (see Figure 2). There is no motivation or suggestion to use the coating and chilling method of the curtain coating embodiment of Figures 5, 7 and 8 in the conventional bead coating depicted in Figure 2. See *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997) ("It is insufficient to establish obviousness that the separate elements

³ The examiner has referred to Figure 3 on page 5 of the answer presumably for its depiction of conventional curtain coating. See EP '493, page 14, lines 21-23.

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of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."). The examiner's finding that EP '493 "teaches that photographic layers can be chill set in a downwards facing manner in order to help provide a smooth and defect free coating" is not supported by the record before us. EP '493 does not teach any benefits of chilling in a downwards facing manner. Where the legal conclusion of obviousness is not supported by facts, it cannot stand. See *In re Warner*, 379 F.2d 1011, 1016-17, 154 USPQ 173, 177-78 (CCPA 1967). Accordingly, the rejection of claims 8, 10, 27, 31 and (8, 10, 27, 31)/11-13 under 35 U.S.C. § 103 as unpatentable over EP '493 is reversed.

C. The Remaining Rejections Under § 103

Appellants have not contested the applicability of the references in the remaining three rejections of dependent claims under § 103 except for the arguments discussed above regarding the primary reference EP '493 and the argument that Di Mino is nonanalogous art (brief, pages 7-9). Thus we will only address appellants' argument regarding Di Mino. We find Di Mino to be analogous art and properly combinable with EP '493 substantially for the reasons set forth by the examiner on pages 15 and 16 of

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the answer. We add the following comments primarily for emphasis.

Di Mino is not limited to coating paper webs but teaches that "it will be clear to those skilled in the art that [the] invention may also be used for applying many different types of coating materials to many different types of webs" (column 2, lines 60-64). As discussed by the examiner, Di Mino meets both tests for analogous art. See *In re GPAC, Inc.*, 57 F.3d 1573, 1577, 35 USPQ2d 1116, 1120 (Fed. Cir. 1995). Di Mino is related to the field of endeavor of the inventors, i.e., coating of liquid materials onto a web with subsequent chilling. Di Mino is also concerned with the particular problem confronting appellants, i.e., to immobilize the liquid material on the web as soon as possible after coating to achieve thickness uniformity before the final set by the chilling rolls or chamber (see column 4, lines 17-24 and 50-54, and appellants' specification, page 4, lines 1-8, and page 8, lines 28-29). Accordingly, Di Mino is analogous prior art and properly combinable with EP '493.

For the foregoing reasons, the rejection of claims 2-4 and (2-4)/11-13 under 35 U.S.C. § 103 as unpatentable over EP '493 in view of Di Mino is affirmed. The rejection of claim 15 under 35 U.S.C. § 103 as unpatentable over EP '493 in view of Finnicum is

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affirmed. The rejection of claim 14 as it depends upon claims 1-6 under 35 U.S.C. § 103 as unpatentable over EP '493 in view of Di Mino and Finnicum is affirmed.

D. Summary

The rejection of claims 8, 10, 27, 31 and (8, 10, 27, 31)/11-13 under § 103 is reversed, as are the rejections involving claims 9, 28-30, and 32, since these claims depend upon claims 8 and 27. The rejections of claims 1, 5, 6 and (1, 5, 6)/11-13 under § 102(b), claims 2-4 and (2-4)/11-13 under § 103, claim 15 under § 103, and claim 14 as it depends upon claims 1-6 under § 103 are affirmed. Accordingly, the decision of the examiner is affirmed-in-part.

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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

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BRUCE H. STONER, Jr., Chief)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN D. SMITH)	
Administrative Patent Judge)	APPEALS AND
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