

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte HUBERT VANDENABEELE

---

Appeal No. 1997-0421  
Application No. 08/304,485

---

HEARD: March 06, 2000

---

Before KIMLIN, PAK, and KRATZ, Administrative Patent Judges.  
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 13, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to a light sensitive silver halide material having a protective layer. According to appellant, a protective antistress gelatin layer containing a synthetic clay is employed with a polyoxyalkylene antistatic agent added as part of that layer or, alternatively, with the

polyoxyalkylene antistatic agent added in a separate outer layer. The protective layer(s) are alleged to preserve the antistatic properties of the photographic material after a long storage period with the avoidance of water spot defects and sticking problems associated with photographic materials (specification, page 3). Claim 1, the only independent claim on appeal, is reproduced below.

1. A photographic silver halide material which comprises a support and on one or both sides thereof at least one silver halide emulsion layer and a protective antistress gelatin layer containing a synthetic clay wherein the said protective antistress layer or a gelatin free antistatic afterlayer, coated over said antistress layer comprises a polyoxyalkylene compound as an antistatic agent.

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

Chen et al. (Chen) 1986	4,610,955	Sep. 09,
Timmerman et al. (Timmerman) 12, 1993	5,252,445	Oct.

Claims 1-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chen in view of Timmerman.

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with

appellant that the aforementioned rejection is not well founded. Accordingly, we will not sustain this rejection.

Chen discloses the use of antistatic layers comprising: (1) a hydrophilic binder such as gelatin; (2) a surface active polymer including polymerized oxyalkylene monomers and (3) a fluorine containing inorganic salt selected from a specified group thereof (column 1, line 55 to column 2, line 40). The photographic element to be coated by such antistatic layer may comprise a silver halide emulsion (column 6, lines 3-32).

Timmerman discloses the use of solvent-resistant polymer beads in a covering layer for a recording material containing a support, a silver halide containing emulsion layer and a colloidal silica containing antistatic layer (column 4, lines 27-39). Timmerman further teaches that microcracking in dry state antistatic layers consisting of colloidal silica may be counteracted by adding a synthetic clay to such an antistatic layer.

The examiner correctly recognizes that: (1) Chen does not disclose the use of a synthetic clay in the protective layer (answer, page 2, last line); and (2) Timmerman's teachings regarding the use of a synthetic clay and the advantages

associated therewith are directed to "... dry state anti-static layers consisting of colloidal silica" (answer, page 3). The examiner assumes, however, that an ordinarily skilled artisan "... might expect..." gelatin, a hydrophilic colloid, to function in "... a similar manner..." to colloidal silica (answer, page 3).

It is the examiner's position that "[b]ased on this assumption, one of ordinary skill in the requisite art would have found it prima facie obvious to utilize a synthetic clay in the anti-static layer of Chen et al. with a reasonable expectation of achieving the same beneficial results as taught by Timmerman et al., those being a reduction in micro-cracking in the anti-static layer to help reduce the amount of lateral conductivity in the anti-static layer ...." (answer, page 4).

The difficulty we have with the examiner's position is that the proposed modification of Chen is premised on the examiner's speculation regarding what one of ordinary skill in the art may contemplate happening when using a synthetic clay in combination with the hydrophilic binder in the antistatic layer of Chen. In this regard, it is well settled that a legal conclusion of obviousness must be supported by facts,

not speculation. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

Timmerman only discusses the usefulness of a synthetic clay in the context of an antistatic layer consisting of colloidal silica, not in the context of a antistatic layer including a specified polymer, a specified fluorine containing salt and a hydrophilic binder (such as gelatin) as used in Chen. The examiner has not pointed to where Chen alone or in combination with Timmerman would have suggested the use of colloidal silica in their anti-static layer rather than the components otherwise taught by Chen, and in amounts such that the addition of a synthetic clay would have been necessary to forestall microcracking as discussed by Timmerman.

Indeed, our reading of Chen indicates that the disclosed invention therein is premised on the use of the combination of a specified polymer, a specified fluorine containing salt and a hydrophilic binder (such as gelatin) as an antistatic composition. References cannot properly be combined if the effect would destroy the invention on which one of the reference patents is based. *Ex parte Hartmann*, 186 USPQ 366, 367 (Bd. App. 1974).

To establish a *prima facie* case of obviousness, an examiner must explain why the teachings of the prior art would have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Based on this record, we are not convinced that the examiner has met the burden of establishing a *prima facie* case of obviousness. Accordingly, we will not sustain the stated rejection.

CONCLUSION

The decision of the examiner to reject claims 1-13 under 35 U.S.C. § 103 as being unpatentable over Chen in view of Timmerman is reversed.

REVERSED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHUNG K. PAK	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
PETER F. KRATZ	)	
Administrative Patent Judge	)	

Appeal No. 1997-0421  
Application No. 08/304,485

Page 8

BREINER & BREINER  
P.O. Box 19290  
Alexandria, VA 22320-0290

APPEAL NO. - JUDGE KRATZ  
APPLICATION NO. 08/304,485

APJ KRATZ

APJ KIMLIN

APJ PAK

DECISION: **REVERSED**

Prepared By: TINA

**DRAFT TYPED:** 07 Dec 00

**FINAL TYPED:**