Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKIO IHAMA

Appeal No. 1998-2170
Application No. 08/571,031

ON BRIEF

Before WARREN, LIEBERMAN, and JEFFREY T. SMITH, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 6 through 12, as amended subsequent to the Final Rejection, which are all the claims pending in this application.[1]

THE INVENTION

The invention is directed to a method of preparing a silver halide negative emulsion. The emulsion contains a tabular silver halide ▪ Spectral sensitization is performed on the tabular silver halide by adding a trimethine cyanine dye in an amount of not less than 60% of saturation coverage. During or after sensitization a second silver iodobromide fine grain emulsion is added. 20% or less of the second emulsion is soluble. In addition, the invention requires a surface silver iodide content of 3 to 20 mol% to eliminate agglomeration of the tabular silver halide.

THE CLAIM

Claims 6 is illustrative of appellant's invention and is reproduced below:

6. A method of preparing a tabular silver halide negative emulsion having silver halide grains in which not less than 50% of a total projected area is accounted for by tabular silver halide grains with an aspect ratio of not less than 5, comprising:

forming a first tabular silver halide negative emulsion comprising tabular silver halide grains;

performing spectral sensitization of the first tabular silver halide negative emulsion by adding a trimethinecyanine dye in an amount of not less than 60% of a saturation coverage of said tabular silver halide grains during or before chemical sensitization and

adding, during or after the chemical sensitization, to said first tabular silver halide negative emulsion, a second silver iodobromide fine-grain emulsion having a sensitivity not higher than 1/10 the sensitivity of said first tabular silver halide negative emulsion,

wherein 20% or less of said second silver iodobromide fine-grain emulsion is soluble and wherein said fine grains have an average equivalent-circle diameter of 0.05 to 0.30 µm and a surface silver iodide content of 3 to 20 mol% to eliminate agglomeration of said tabular silver halide grains of said tabular silver halide emulsion.

[1]See the Advisory action, dated August 14, 1997.

THE REFERENCE OF RECORD

As evidence of obviousness, the examiner relies upon the following reference:

Sowinski et al. (Sowinski)	4,656,122	Apr. 7, 1987

THE REJECTION

Claims 6 through 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sowinski.

OPINION

We have carefully considered all of the arguments advanced by the appellant and the examiner, and agree with the appellant that the rejection of claims 6 through 12 under section 103(a) as being unpatentable over Sowinski is not well founded. Accordingly, we reverse this rejection.

The Rejection Over Sowinski

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability," whether on the grounds of anticipation or obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On the record before us, the examiner relies upon a single reference to reject the claimed subject matter and establish a prima facie case of obviousness ■

We find that Sowinski is directed to a reversal silver halide photographic element containing tabular haloiodide grains in at least one emulsion layer. See column 1, lines 10-13. The tabular silver haloiodide grains have a thickness less than 0.5 µm, an aspect ratio of greater than 8:1, and account for at least 50% of the total grain projected area. See column 1, lines 63-67, and column 3, lines 65-67. The tabular grains are blended with relatively fine grain silver salts more soluble than silver iodide. See column 2, lines 9-12 and column 3, lines 41-46. Typically, the fine grained silver halides comprises silver bromide, silver thiocyanate or a combination of both. See column 6, lines 39-42. We find that the fine grain population has an average grain size of less than 0.3 µm and optimally less than 0.1 µm. See column 7, lines 3-6. We further find that the second grain does not form a latent image when the first grain is exposed. See column 7, Indeed the fine grain emulsion may be blended after sensitization. See column 7, line 67 - column 8, line 5, and lines 65-68. The reference, however, is silent both as to sensitization with trimethine cyanine dye and with respect to the dye being present in an amount of not less than 60% saturation coverage.

With respect to each of the above limitations, the examiner argues for the first time that although Sowinski may not specifically disclose the use of trimethine cyanine dye, these dyes are conventionally used to sensitize silver halide emulsions, Answer, page 6, and the amount of cyanine dye, presumal resulting in not less than 60% of saturation coverage, is prima facie obvious. See Answer, page 7.

The appellant however, in the Reply Brief (pages 4-5), has challenged the examiner's statement and responded that, "Sowinski et al. did not appreciate the role of the cyanine due [sic, dye] in contributing to [the] agglomeration of the tabular grains and how that phenomenon could be eliminated by havi relatively insoluble fine grains present, there is no teaching of the type of dye used, the amount thereof or the method of addition thereof in any of the working examples of Sowinski et al ■ "

It is well settled that assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as a standard in the pertinent art and the appellant given, in the Patent and Trademark Office, the opportunity to challenge the correctness of the assertion ■ In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420-21 (CCPA 1970) ■ In re Boon, 439 F.2d 724, 727-28, 169 USPQ 231, 234 (CCPA 1971). Where, the noticed fact as here was challenged by the appellant and the examiner has failed to provide objective evidence in support of the cha examiner's position constitutes reversible error ■ Ex parte Natale, 11 USPQ2d 1222, 1226-27 (Bd. Pat. App. & Int.1989) ■

On the record before us, the examiner has failed to support the statements that the trimethine cyanine dyes are conventionally used to spectrally sensitize the silver halide emulsion to a desired wavelength and that the amount of trimethine dye utilized in spectral sensitization would have been prima fac obvious to the person having ordinary skill in the art ■ These omissions accordingly constitute reversible error and the rejection of the examiner is not sustained.

DECISION

The rejection of claims 6 through 12 under 35 U.S.C. § 103(a) as being unpatentable over Sowinski is reversed.

The decision of the examiner is reversed.

REVERSED

CHARLES F. WARREN Administrative Patent Judge	)	
PAUL LIEBERMAN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY T. SMITH Administrative Patent Judge	)	

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