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Datasheet for the decision of 13 May 2009

Case Number: T 0553/07 - 3.3.06

Application Number: 96420312.9

Publication Number: 0779542

IPC: G03C 5/14

Language of the proceedings: EN

Title of invention:
Sound recording film

Patentee:
Eastman Kodak Company

Opponent:
Agfa-Gevaert

Headword:
Sound recording film/KODAK

Relevant legal provisions:
EPC Art. 83, 54, 56
RPBA Art. 12(4)

Relevant legal provisions (EPC 1973):
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Keyword:
"Sufficiency of disclosure - all requests (yes)"
"Novelty - all requests (yes)"
"Inventive step - all requests (no)"
"Allowability of late filed documents (no)"

Decisions cited:
-

Catchword:
-

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Case Number: T 0553/07 **-** 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 13 May 2009

Appellant: (Patent Proprietor)	Eastman Kodak Company 343 State Street Rochester NY 14650-2201 (US)
Representative:	Weber, Etienne Nicolas Kodak Etablissement de Chalon Campus Industriel - Département Brevets Route de Demigny - Z.I. Nord - B.P. 21 F-71102 Chalon sur Saône Cedex (FR)
Respondent: (Opponent)	Agfa-Gevaert Septestraat 27 B-2640 Mortsel (BE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted 26 January 2007 revoking European patent No. 0779542 pursuant to Article 102(1) EPC 1973.**

Composition of the Board:

Chairman: L. Li Voti
Members: E. Bendl
J. Geschwind

Summary of Facts and Submissions

I. This appeal is against the decision of the Opposition Division to revoke the European patent 0 779 542.

II. In its notice of opposition the Opponent, referring to documents D1 to D6, sought revocation of the patent on the grounds of Articles 100(a) (lack of novelty and inventive step) and 100(b) EPC.

III. The independent claims of the requests which formed the basis for the decision of the Opposition Division, i.e. those submitted with letter of 13 November 2006, were as follows:

Main request

"1. A black and white silver halide motion picture sound recording film comprising a support bearing at least one silver halide emulsion layer comprising monodispersed silver halide grains having an average grain size of less than 0.35 microns and a coefficient of variation of grain size of less than 55%, and wherein said film is spectrally sensitized with a first sensitizing dye providing a peak sensitivity at less than or equal to 600 nm and a second sensitizing dye providing a peak sensitivity above 600 nm."

"9. A method for recording multiple optical soundtracks in a black and white silver halide motion picture sound recording film according to any one of claims 1-8, comprising recording a first digital soundtrack by exposing said film with a first source of radiation having a peak wavelength of less than or equal to 600 nm, recording a second digital soundtrack by

exposing said film with a second source of radiation having a peak wavelength of greater than 600 nm, and processing said exposed film to form first and second digital soundtrack silver images."

First auxiliary request

The first auxiliary request differed from the main request by the replacement of the term "motion picture sound recording film" with "motion picture sound **negative** recording film" (emphasis added) in Claims 1 and 9.

Second auxiliary request

The second auxiliary request contained only one independent claim, which read as follows:

"1. A method for recording multiple optical soundtracks in a black and white silver halide motion picture sound recording film comprising a support bearing at least one silver halide emulsion layer comprising monodispersed silver halide grains having an average grain size of less than 0.35 microns and a coefficient of variation of grain size of less than 55%, wherein said film is spectrally sensitized with a first sensitizing dye providing a peak sensitivity at less than or equal to 600 nm and a second sensitizing dye providing a peak sensitivity above 600 nm, comprising recording a first digital soundtrack by exposing said film with a first source of radiation having a peak wavelength of less than or equal to 600 nm, recording a second digital soundtrack by exposing said film with a second source of radiation having a peak wavelength of greater than 600 nm, and processing said exposed film

to form first and second digital soundtrack silver images."

Third auxiliary request
The wording of the third auxiliary request was identical to the one of the corresponding claims of the second auxiliary request, but the term "motion picture sound recording film" was replaced by "motion picture sound **negative** recording film" (emphasis added) in Claim 1.

Fourth auxiliary request
The wording of Claims 1 and 9 of this request was identical to that of the corresponding claims according to the main request, but in Claim 1 the passage "and a coefficient of variation of grain size of less than 55%, and wherein said film" was replaced by "and a coefficient of variation of grain size of less than 55%, wherein said emulsion layer comprises a single silver halide emulsion that".

Fifth auxiliary request
The wording of Claims 1 and 9 was identical to that of the corresponding claims according to the fourth auxiliary request, but the term "motion picture sound recording film" was replaced by "motion picture sound **negative** recording film" (emphasis added) in Claims 1 and 9.

IV. In its decision the Opposition Division found that

- the invention was sufficiently disclosed;

- the late filed documents D8-D27 were less relevant than documents D1-D7 and were not admitted into the proceedings;

- the claimed subject-matter was novel over the cited prior art;

- however, the claims according to the then pending main request and first to fifth auxiliary requests did not meet the requirement of Article 56 EPC, because the combination of the closest state of the art described in paragraph 8 of the patent-in-suit with the general knowledge in the field of colour photography, would lead a person skilled in the art to the claimed invention.

V. The Proprietor (Appellant) filed an appeal against this decision.

The requests on which the Opposition Division had decided (i.e. main request and five auxiliary requests) were maintained by the Appellant in the appeal proceedings and re-submitted with the grounds for the appeal.

The Appellant informed the Board with letter of 31 March 2009 that he would not attend the scheduled oral proceedings. Thus, oral proceedings before the Board were held on 13 May 2009 in the absence of the Appellant.

VI. The Appellant maintained in writing that the invention was sufficiently disclosed and novel over the cited

prior art. As to inventive step he submitted inter alia that:

- Paragraph 8 of the patent-in-suit represented the closest prior art; the films disclosed in this paragraph would meet individually the requirements concerning average grain size and variation of grain size of Claim 1, but there was no incentive for the skilled person following the teaching of the prior art to combine these two films.

- In fact, the person skilled in the art would not have considered the technique of colour photography for solving the problem underlying the invention.

- The Respondent's assertion that negative soundtrack recording films were known which contained an analogue, and **two** digital soundtracks, i.e. a Dolby digital soundtrack (SRD) and a DTS Digital soundtrack, was not correct, because the DTS Digital sound system only recorded a timing track on the sound recording film.

VII. The Respondent's main arguments were inter alia as follows:

Introduction of documents D8-D27
The Opposition Division should have entered documents D8-D27 on its own motion under Article 114(1) EPC. In fact, most of these documents had been proposed in order to show that the requirements concerning particle properties were already met by prior art films and D17-D19 had been cited against the novelty of the claimed subject-matter.

Sufficiency of disclosure

Claim 1 embraced all possible uses of the black and white silver halide motion picture sound recording films like analogue and digital sound recording. Claim 9 was restricted to digital soundtrack images, which meant that the films used were different from the ones of Claim 1. No means were provided to distinguish films for digital soundtracks from films suitable for analogue soundtracks.

The skilled person would consequently have been unable to perform the process of Claim 9.

Lack of novelty

Documents D17 to D19 were novelty-destroying.

Lack of inventive step

The EASTMAN Sound Recording Film 2378 already contained three tracks: an analogue soundtrack, a DTS soundtrack and a Dolby SRD soundtrack; starting from the closest prior art, i.e. paragraph 8 of the patent-in-suit, the combination of the two films described therein would have been obvious for a person skilled in the art.

VIII. The Appellant requested in writing that the decision of the Opposition Division be set aside and that the patent be maintained on the basis of the main request or of one of the auxiliary requests 1-5 submitted with the statement of the grounds of appeal, which are identical to those filed with letter of 13 November 2006 during the opposition proceedings. In case of any

new or unresolved issues he requested to remit the case back to the first instance.

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. *Article 123(2),(3) EPC*

The Board is satisfied that the claims of all requests comply with the requirements of Articles 123(2),(3) EPC. Since no objection has been raised by the Respondent in this respect, further details are unnecessary.

2. *Admissibility of documents D8-D27*

2.1 In the present case the introduction of documents D8-D27 into the opposition proceedings was refused by the Opposition Division, because the documents were late filed and were not regarded prima facie as being more relevant than documents D1-D7 already on file.

2.2 Since the Board agrees with the Opposition Division's considerations concerning documents D8-D27, the Board decided not to admit these documents into the appeal proceedings in accordance with RPBA Art. 12(4) (see OJ EPO 11/2007 p. 536).

3. *Sufficiency of disclosure*

3.1 Respondent's reasoning that the patent-in-suit teaches to use different films for digital and analogue sound

tracks, or that the method disclosed cannot be put into practice, cannot be followed by the Board.

Paragraph 10 of the patent-in-suit teaches to record "multiple optical soundtracks" by using one film. Paragraph 30 discloses that multiple digital soundtracks as well as analogue soundtracks may be recorded and that conventional digital and analogue recording equipment may be used for this purpose. For the digital soundtracks the use of lasers or light emitting diodes is recommended, for analogue soundtracks white light or monochromatic light sources are mentioned.

No proof or evidence has been submitted by the Respondent, that the film **of the invention** for recording multiple digital tracks has to be different from films suitable for analogue/digital recording or that the claimed method cannot be carried out.

Thus, the invention is considered by the Board to be sufficiently disclosed.

3.2 This finding applies to all requests.

4. *Novelty*

4.1 The Respondent did not comment on this issue in the oral proceedings. In the written appeal procedure, none of documents D1-D7 was cited by the Respondent as being novelty-destroying.

4.2 The Board also does not see any reason to doubt that the requirements for novelty are met.

4.3 Thus, the requirements of Article 54 EPC are considered to be met for all requests.

5. *Inventive step*

Main request

5.1 Both parties agreed in their submissions that the closest state of the art is described in paragraph 8 of the patent-in-suit.

This passage refers to sound recording films, each being sensitized at **one** specific wavelength: Eastman Sound Recording Film EXR 2378, sensitized with a green dye to provide optimal sensitivity at 580 nm and Eastman Digital Sound Recording Film 2374, sensitized with a red dye to provide optimal sensitivity at 670 nm. As confirmed by the Appellant, both films show particle properties (average grain size of less than 0.35 microns and a coefficient of variation of grain size of less than 55%) as defined in the claims.

The Board shares the parties' point of view that paragraph 8 of the patent-in-suit represents the closest prior art disclosure.

5.2 As submitted by the Appellant in the statement of the grounds of appeal and indicated in the said paragraph 8, the simplification of recording multiple digital soundtracks on one film and the facilitation of synchronisation are to be seen as the technical problems to be solved by the present patent.

More precisely this means that by using a film being sensitized at **two** different wavelengths, two digital tracks can be written on one sound recording film, which simplifies the way in which multiple digital sound tracks are formed on a motion picture film and further facilitates the synchronisation of soundtrack negatives and motion pictures.

5.3 The Board has no doubt that the subject-matter of Claims 1 and 9 solves effectively the above-mentioned technical problem.

5.4 The subject-matter of Claim 1 of the main request differs from the closest prior art insofar, as in the patent-in-suit **one** film is spectrally sensitized to provide a first peak sensitivity at less than or equal to 600 nm and a second peak sensitivity above 600 nm. In the closest prior art two separate films were needed to provide the different peak sensitivities.

In fact, as explained by both parties, these different peak sensitivities were necessary when working with different kinds of soundtrack systems: EASTMAN Sound Recording Film 2378 was green-sensitized at 580 nm and therefore suitable for recording DTS and Dolby SRD soundtracks, EASTMAN Digital Sound Recording Film 2374 was red-sensitized at 670 nm and therefore suitable for recording a Sony SDDS soundtrack.

5.5 The Respondent submitted in writing that the Eastman Sound Recording Film 2378 had three tracks: an analogue soundtrack, a DTS digital soundtrack and a Dolby SRD digital soundtrack. In the letter of reply the Appellant disputed that DTS digital sound system would

be a digital sound track itself, but stated that the DTS data written on the sound recording film consisted only of a timing track.

The Board thus finds that both parties agree that at the priority date of the patent it was known that on **one sound recording film**, in addition to the analogue track, tracks referring to **two different digital sound systems** (i.e. Dolby digital sound system (SRD) and DTS digital sound system) could be found, which, at least indirectly, each related to digital sound.

In turn it can be concluded that the need to equip sound recording films with tracks of two different digital sound systems, in addition to an analogue soundtrack, was already known in the prior art.

In the Board's view, given the fact that one combination containing tracks of two different sound systems in addition to the analogue soundtrack was already on the market (EASTMAN Sound Recording Film 2378), the person skilled in the art **could** not only have tried, but he **would** have tried to use another combination, e.g. with the known Sony SDDS soundtrack, the latter being one of the most frequently used sound systems besides Dolby SRD and DTS, to facilitate the processes with regard to the motion picture film.

The optimization of the necessary film is considered by the Board to be routine and the consequence of a one-way-street situation: Since the SRD and the DTS system are each optimized for green light and SDDS is optimized for red light, a film suitable for such an alternative combination has to show the required

sensitization to green light and to red light. The optimization of a black and white sound recording film in this respect or the use of a panchromatic film are regarded to be trivial for the person skilled in the art, as already found in the decision under appeal. On the one hand panchromatic films have already been known in the art for decades, on the other hand the technique of providing a peak sensitivity for the use of modulated lasers or light emitting diodes to prepare digital soundtracks was well established - see paragraph 7 of the patent-in-suit - and did not present any technical problem to the skilled person.

Therefore it would have been obvious for the skilled person to combine the dyes used in EASTMAN Sound Recording Film 2378 and EASTMAN Digital Sound Recording Film 2374 in one film in order to solve the technical problem underlying the invention.

Thus, the subject-matter of Claims 1 and 9 of the main request is not considered to meet the requirement of Article 56 EPC.

5.6 *Auxiliary requests*

First auxiliary request
Claims 1 and 9 of the first auxiliary request differ from Claims 1 and 9 of the main request in the use of a black and white silver halide motion picture sound **negative** recording film.

However, since the use of negative recording films is part of the process for printing the sound tracks on a positive motion picture film, as disclosed in

paragraph 8 of the patent-in-suit, no inventive step can be seen in this feature either.

Second auxiliary request

The second auxiliary request combines the features of Claims 1 and 9 of the main request. Therefore, considerations as stated for the main request apply and no inventive step can be seen either.

Third auxiliary request

The considerations of the first auxiliary request apply mutatis mutandis also to the third auxiliary request.

Fourth auxiliary request

The fourth auxiliary request differs from the main request in the requirement that it is a single silver halide emulsion layer, which is sensitized with the two dyes.

No effects have been described with respect to the incorporation of the two dyes in one layer instead of two. Since the incorporation of two dyes into one emulsion is common knowledge (e.g. see paragraph 6 of the patent-in-suit) this is again considered a trivial, non-inventive juxtaposition of features.

Fifth auxiliary request

Finally, with regard to the fifth auxiliary request, the fact that the sound recording film is a negative film containing two dyes in one layer, is once more considered to be routine in the art of providing sound recording films. Again, no unexpected or surprising effects have been disclosed.

Also this embodiment does not meet the requirement concerning the inventive step.

Thus, **none** of the sets of claims is considered to meet the requirement of Article 56 EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: C. Vodz

The Chairman: L. Li Voti