

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUTAKA URINO and
TOMOKI SAITO

Appeal No. 96-0346
Application 08/007,511¹

ON BRIEF

Before THOMAS, JERRY SMITH and TORCZON, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed January 22, 1993.

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placing two of them in series as individually taught by this reference because the examiner views this case as holding that the mere duplication of parts for a multiplied effect would have been obvious to the artisan within 35 U.S.C. § 103.

Rather than repeat the positions of the appellants and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

We reverse the outstanding rejection.

We understand St. Regis as being heavily fact dependent and conclude that the examiner within 35 U.S.C. § 103 has over-relied upon the thinking processes the court set forth in that case. The first embodiment shown in Figs. 1A and 1B appears to be structurally similar to the subject matter of any one of the two optical isolators set forth in independent claim 1 on appeal. The other embodiments set forth in Figs. 4A, 5A, 6A and 7A in Chang appear to teach different numbers of elements of a singular rather than a serial duplicated arrangement of optical isolators.

The summary paragraph at the bottom of col. 8 of Chang appears to come the closest to suggesting to the artisan the reasoning advanced by the examiner, where it says at lines 62 through 67 that "[o]bviously more than 5 anisotropic crystal

members and more than four Faraday rotators arranged with at least one rotator between any two anisotropic crystal members may be constructed in accordance with the principles of this invention." Even if we assume that this teaching would have indicated to the artisan to have constructed a single optical isolator employing 6 anisotropic elements, each with a Faraday rotator therebetween, we would still not end up with the claimed total number of elements comprising both optical isolators arranged as recited in independent claim 1 on appeal.

In light of this latter teaching in Chang as well as the examiner's reasoning, we find that there would have been no reason within the examiner's reasoning or that which would have been derived from the teachings and suggestions of Chang for the artisan within 35 U.S.C. § 103 to have forward rotated the claimed first birefringent element of the second optical isolator in the manner set forth in the above quoted language at the end of claim 1 on appeal. The mere duplication in series of Chang's Fig. 1A embodiment would not necessarily have led to this rotation. It appears that by the rotation set forth in the above quoted language at the end of claim 1 on appeal, a change in function essentially results in the first and second recited optical isolator combination as expressed functionally in this

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noted language. Therefore, this second optical isolator, even though it is structurally identical to the first optical isolator, does not alone clearly duplicate the function of the first, contrary to the position set forth by the examiner in the answer and is, therefore, as well factually distinguishing over the situation in St. Regis.

We also find no teaching or suggestion or line of reasoning advanced by the examiner, other than that expressed on the basis of St. Regis, for the artisan to have placed two of any one of the optical isolators of Chang's five embodiments in series.

Thus, we find the record deficient of any reasoning or motivation in the art provided to have two optical isolators in series, with the first birefringent element of the second optical isolator having an optical axis rotated by 90 degrees in a normal direction of rotation, which effectively causes the ordinary and extraordinary rays to have equal optical path lengths. Simply stated, additional evidence or references are necessary for us to agree with the examiner's conclusion of obviousness within 35

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U.S.C. § 103 of the subject matter of independent claim 1 on
appeal.

As such, we must reverse the rejection of claims 1 and 2
under 35 U.S.C. § 103.

Therefore, the decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
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)	BOARD OF PATENT
JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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RICHARD TORCZON)	
Administrative Patent Judge)	

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