

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC J. PAULUS

Appeal No. 1997-3974
Application 08/541,254

ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

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Application No. 08/541,254

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 12-14 and 16-21, which constitute all the claims remaining in the application. This appeal relates only to claims 12-14 and 16-18. Claims 19-21 are not appealed [brief, page 2].

The invention pertains to an optoelectric coupling device for coupling optoelectric transducers to each other.

Representative claim 12 is reproduced as follows:

12. An optoelectric coupling apparatus which includes a connector shell that has an axis and that has an inside, first and second circuit boards mounted at axially spaced positions within said shell and having dielectric boards with inner board faces facing each other and outer board faces facing away from each other, and a plurality of pairs of transducers mounted on said circuit boards, with each pair including first and second transducers that are each mounted on a different one of said circuit boards, with each transducer of a pair having a transducer face facing toward a corresponding other transducer of the pair to transmit and receive light between them, including:

a one-piece integral opaque separator lying at a location within said shell between said circuit boards and occupying substantially the entire cross-sectional area of said shell at said location, said separator having a plurality of through holes that each loosely receives at least part of

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each transducer of a pair.

The examiner relies on the following references:

Chaimowicz 1971	3,562,527	Feb. 09,
Streckmann et al. (Streckmann) 1983	4,401,360	Aug. 30,
Kusuda et al. (Kusuda) 1994	5,285,076	Feb. 08,

Claims 12-14 and 16-18 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on an inadequate disclosure. Claims 12-14 and 16 also stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Chaimowicz in view of Streckmann. Finally, claims 12-14 and 16-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Chaimowicz in view of Streckmann and Kusuda.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner, the arguments in support of the rejections and the evidence of obviousness

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relied upon by the examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure in this application describes the claimed invention in a manner which complies with the requirements of 35 U.S.C. § 112. We are also of the view that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 12-14 and 16-18. Accordingly, we reverse.

We consider first the rejection of claims 12-14 and 16-18 based on the first paragraph of 35 U.S.C. § 112. The examiner's rejection is based on the position that the originally filed specification does not support the invention

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now being claimed. Amendments were made to page 7 of the specification which the examiner finds to be new matter. The claims on appeal recite this "new matter" and the examiner finds no basis in the original specification for this material. Appellant argues that the matter added by amendment to the specification is fully supported by the original specification.

The following passages from independent claims 12 and 17 are asserted by the examiner to be unsupported by the original specification:

1. Claim 12 - "said separator having a plurality of through holes that each loosely receives at least part of each transducer of a pair"; and

2. Claim 17 - "a plurality of said transducers lying loosely in said holes" [answer, page 4].

We note that there are two embodiments of the invention disclosed by appellant. The first embodiment is shown in appellant's Figures 1-3. In this embodiment it is described that the hole "very closely receives" parts of the bodies 94 and 96 [specification, page 5]. The second

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embodiment is shown in Figures 4 and 5. In this embodiment it is described that "the transducers are not closely received in the holes 192" [*id.*, page 7]. It is appellant's position that this passage from page 7 of the specification and the gap shown in the through hole 192 of Figure 4 support appellants recitation that the transducers are received loosely in the through holes. The examiner's position is that a disclosure of "not closely received" does not support a claim recitation of loosely received.

A rejection on new matter goes to the written description requirement of 35 U.S.C. § 112. The purpose of the written description requirement is to ensure that the applicant conveys with reasonable clarity to those skilled in the art that he was in possession of the invention as of the filing date of the application. For the purposes of the written description requirement, the invention is "whatever is now claimed." Vas-cath, Inc. v. Mahurkar, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). In this case the question is whether the phrase "not closely received" reasonably conveys to the artisan that the transducers are loosely received in the through holes. We agree with

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appellant that it does.

We find appellant's use of "closely receives" [page 5] and "not closely received" [page 7] to be compelling. We can see no reason why the specification would emphasize the fact that transducers are not closely received in the hole 192 unless it was intended to convey the fact that a loose fit was desired rather than a tight or close fit. The word "loose" simply means not tight fitting, and we find that the disclosure of not closely received means not tight fitted which implies that the fit is loose.

For all the reasons discussed above, we do not sustain the examiner's rejection of claims 12-14 and 16-18 as being based upon an inadequate written description of the invention under
35 U.S.C. § 112.

We now consider the rejections of the claims under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir.

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1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then

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determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

Although appellant makes several arguments against the references individually for teachings that they are not relied on, appellant does argue that none of the references taken singly or in combination teaches or suggests the feature of the claimed invention of the transducers lying loosely in the separator holes [brief, pages 5-9]. The examiner never addresses this particular limitation of the claimed invention. In fact, the examiner states that "[t]he following rejections are based on the claims without the above stated new matter" [answer, page 6]. Thus, the examiner has admittedly ignored the loose connection of the

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claimed invention because the examiner believed that this claim limitation was not adequately disclosed.

It was error for the examiner to ignore limitations in the claims. Regardless of whether the specification was sufficient to support the subject matter of the claims, claims must be considered in their entirety when making rejections based on the prior art. It is never appropriate to simply ignore limitations of a claim when making a prior art rejection.

Since the examiner never considered the invention as set forth in the claims, the examiner has failed to establish a prima facie case of obviousness. Accordingly, we are compelled to reverse the rejection of the claims under 35 U.S.C. § 103 based on the fact that the examiner has failed to meet his burden of establishing a prima facie case of obviousness.

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In summary, we have not sustained the examiner's rejection of the claims under either 35 U.S.C. § 112 or § 103. Therefore, the decision of the examiner rejecting claims 12-14 and 16-18 is reversed.

REVERSED

Errol A. Krass)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
Jerry Smith)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Michael R. Fleming)	
Administrative Patent Judge)	

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JS/dm

LEON D. ROSEN ESQ.
FREILICH, HORNBAKER AND ROSEN
10960 WILSHIRE BLVD. SUITE 840
LOS ANGELES CA 90024