

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAURENT MAURIN

Appeal No. 2001-0975
Application No. 09/119,448

Before KIMLIN, GARRIS, and OWENS, *Administrative Patent Judges*.
GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-4.

BACKGROUND

The subject matter on appeal relates to a device for drawing an optical fiber from a preform. The device includes a furnace for melting one end of the preform from which the optical fiber is drawn, and an optical sensor disposed at the exit of the furnace to measure the diameter of the optical fiber in order to adjust drawing speed and drawing tension. The optical sensor is surrounded by a mask forming a chamber through which the optical fiber passes such that the mask protects the optical sensor from ambient light sources. The mask protects the optical sensor from ambient light sources so that accuracy in the diameter measurement is increased by eliminating artifacts caused by ambient light sources (see specification, page 5 lines 26-34).

Claim 1 is representative of the subject matter on appeal and is reproduced below:

1. A device for drawing an optical fiber from a preform, comprising a furnace for melting one end of said preform from which said optical fiber is drawn and an optical sensor disposed at the exit from said furnace to measure the diameter of said optical fiber in order to adjust the drawing speed and the drawing tension, wherein said optical sensor is surrounded by a mask forming a chamber through which said optical fiber passes such that said mask protects said optical sensor from radiation from ambient light sources.

Floch et al. (Floch)

5,841,524

Nov. 24, 1998

Claims 1, 2 and 4 are rejected under 35 U.S.C. § 103 as being unpatentable over Inoue or Floch; and claim 3 is correspondingly rejected over Inoue or Floch, further in view of Koenig.

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the Appellant and by the Examiner concerning the above noted rejections.

OPINION

For the reasons set forth below, we cannot sustain the § 103 rejections before us.

The appealed claim 1 calls for an optical sensor which is surrounded by a mask forming a chamber through which an optical fiber, drawn from a furnace, passes, such that the mask protects the optical sensor from radiation from ambient light sources. Each of Inoue and Floch teaches an optical sensor; however, neither reference teaches or suggests a mask as claimed. The

provide a housing to encase and protect the optical sensor because it is well known to encase all sorts of electronic devices, such as TVs, VCRs, etc (see answer, page 3). However, we agree with the Appellant that there would have been no motivation to combine the teachings of Inoue or Floch with the prior art encasement for an electronic device, such as a TV or VCR, to thereby result in the here claimed invention. It has been established that there must be a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the teachings of the references, based on a reasonable expectation of success; *See Smith Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir.1999). It has also been established that one should not fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against him. *See W. L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Furthermore, if there is no evidence that a person of ordinary skill in the art at the time of applicant's invention would have expected a problem to exist, it may be improper to conclude that an invention, which solves that problem and which is claimed as an improvement of the prior art device, would have been obvious. See *In re Nomiya et al*, 509 F.2d 566, 572-73, 184 USPQ 607, 612-13 (CCPA 1975).

specification page 3 lines 17-23 and page 5 lines 28-34). It also appears that the Appellant's discovery of this problem, with its seemingly simple solution of providing a mask as claimed, is being improperly used as glue to hold together the evidence relied upon by the Examiner. This is because the applied art does not teach and would not have suggested the use of a mask surrounding the optical sensor through which the optical fiber passes such that the mask protects the sensor from radiation from ambient light sources. Furthermore, even if the proposed modification of providing a housing were made to Inoue or Floch, it would not necessarily result in a mask that (1) surrounds the sensor such that the fiber passes through a chamber formed by the mask, or (2) functions to protect the optical sensor from radiation from ambient light sources, as recited in claim 1. In our view, the evidence relied upon by the Examiner contains no suggestion, reason, motivation or teaching to add a mask as claimed herein to either Inoue or Floch.

Finally, we note that the other reference applied by the Examiner to dependent claim 3 does not correct the above discussed deficiencies.

In light of the foregoing, we cannot sustain either of the Examiner's Section 103

