

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DONALD J. DENIS

Appeal No. 2006-0245
Application No. 10/222,467

ON BRIEF

Before HAIRSTON, RUGGIERO, and SAADAT, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-10 and 13-16. Claims 11 and 12 have been allowed by the Examiner. An amendment filed November 29, 2004 after final rejection has been approved for entry by the Examiner.

The claimed invention relates to an optical demultiplexer in which a first light bandpass filter, upon receiving an input light beam at a first angle of incidence, passes a first light wavelength and reflects a reflected beam. A second light bandpass filter receives, via a beam redirection element such as a reflective surface, the reflected beam at a second angle of incidence and passes a second light wavelength. According to Appellant (specification, pages 3 and 4), by recognizing that the bandpass wavelength of a

light bandpass filter is dependent upon the angle of incidence of the light beam upon the light bandpass filter, the number of light bandpass filters for a demultiplexer can be reduced, in some cases to only one light bandpass filter. Claim 1 is illustrative of the invention and reads as follows:

1. An optical demultiplexer comprising:

a first light bandpass filter that receives an input light beam at a first angle of incidence, passes a first light wavelength, and reflects a reflected beam;

a second light bandpass filter that receives the reflected beam at a second angle of incidence and passes a second light wavelength, wherein the second angle of incidence is different from the first angle of incidence; and

a beam redirection element that receives the reflected beam from the first light bandpass filter and redirects the reflected beam toward the second light bandpass filter at the second angle of incidence.

The Examiner relies on the following prior art:

Grann et al. (Grann)	6,563,976	May 13, 2003 (filed May 09, 2000)
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Claims 1-10 and 13-16, all of the appealed claims, stand finally rejected under 35 U.S.C. § 102 as being anticipated by Grann.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

¹The Appeal Brief was filed February 22, 2005. In response to the Examiner's Answer mailed May 19, 2005, a Reply Brief was filed July 5, 2005, which was acknowledged and entered by the Examiner as indicated in the communication dated August 18, 2005.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of anticipation relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the Grann reference fully meets the invention as set forth in claims 1-10 and 16. We reach the opposite conclusion with respect to claims 13-15. Accordingly, we affirm-in-part.

At the outset, we note that it is well settled that anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1 and 16, argued together by Appellant, the Examiner indicates (Answer, pages 5 and 6) how the various limitations in claims 1 and 16 are read on the disclosure of Grann. In particular, the Examiner points to the illustration in

Grann's Figure 17 along with the accompanying description beginning at column 11, line 63. According to the Examiner, Grann discloses the requisite first light bandpass filter 394 which receives a beam at a first angle of incidence, a second light bandpass filter 393 which receives a reflected beam at a second angle of incidence, and a beam redirection element 396 which receives a reflected beam from the first light bandpass filter 394 and redirects it toward the second light bandpass filter 393.

In our view, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of anticipation. The burden is, therefore, upon Appellant to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case. 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 Briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)].

Appellant's arguments in response assert that the Examiner has not shown how each of the claimed features are present in the disclosure of Grann so as to establish a case of anticipation. In particular, Appellant contends (Brief, pages 6 and 7) that, in contrast to the claimed invention, Grann does not disclose an input light beam incident at a first angle of incidence upon a bandpass filter, the light beam having at least two wavelengths, one which is passed through the filter, and at least one which forms a reflected beam. According to Appellant, Grann's beam at a wavelength λ_1 , incident upon

filter 394 at a first angle of incidence, is either passed through the filter or reflected from it, not both passed and reflected as set forth in claims 1 and 16.

After reviewing the arguments of record, however, we find ourselves in agreement with the Examiner's contention (Answer, page 13) that Appellant's arguments are not commensurate with the scope of representative claim 1. In our view, Appellant's arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations which have no basis in the claim. See In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

In particular, Appellant's arguments to the contrary notwithstanding, we agree with the Examiner (Answer, page 5) that the language of claims 1 and 16, which recites "an input light beam at a first angle of incidence," does not preclude other wavelengths from being incident upon filter 394 at different angles of incidence. As asserted by the Examiner, the bandpass filter 394 in Grann receives an input light beam λ_4 at a first angle of incidence which is passed through. The filter 394 also reflects a reflected beam, i.e., any of the other light beams λ_1 , λ_2 , or λ_3 , which is received by the filter at different angles of incidence. The second light bandpass filter 393 in Grann in turn receives and passes at least one of the reflected beams, i.e., λ_3 , from beam redirection element 396 which beam is incident upon filter 393 at an angle of incidence which is different from the first angle of incidence.

Appellant, in the Reply Brief, expands upon the argument alleging distinction of the claim language over Grann by asserting that the reflected beam from the filter 394 in Grann is not “associated with the ‘input light beam at a first angle of incidence’ (id., at 2), and that the reflected beam in Grann is “not part of ‘input light beam at a first angle of incidence.’ (Id., at 4). Again, it is our view that Appellant is relying on disclosed distinctions over Grann, rather than the claimed language which is at issue in this appeal. We find nothing in the language of claims 1 and 16 which requires a reflected beam from the first light bandpass filter to be “associated with” or “part of” the beam that is input at a first incidence angle. To the contrary, the language of claim 1 and 16 requires only that a reflected beam be reflected from the first light bandpass filter, a feature which is met by any one the beams λ_1 , λ_2 , or λ_3 which are reflected from filter 394 in Grann.

In view of the above discussion, since the Examiner’s prima facie case of anticipation has not been overcome by any convincing arguments from Appellant, the Examiner’s 35 U.S.C. § 102(e) rejection of independent claims 1 and 16, as well as dependent claims 2-4 and 6-10 not separately argued by Appellant, is sustained.

We also sustain the Examiner’s 35 U.S.C. § 102 rejection of dependent claim 5, separately argued by Appellant, directed to a “same construction” feature for the first and second light bandpass filters. We find no error in the Examiner’s line of reasoning (Answer, page 6) which asserts that the broad “same construction” of claim 5 can reasonably be interpreted as meaning, inter alia, “same shape,” a filter characteristic which

is disclosed by Grann. We are also of the view that, to whatever extent Appellant is correct in the assertion (Reply Brief, pages 5 and 6) that the discussion in Grann at column 5, lines 45-49, directed to an embodiment illustrated in Grann's Figure 4A, describes filters which are of different construction, we find no indication in Grann's disclosure that such a described filter construction also applied to the embodiment illustrated in Figures 16 and 17 relied upon by the Examiner in making the rejection. To the contrary, our review of the description of the Figures 16 and 17 embodiment in Grann described at column 11, lines 50 through column 17, line 39, suggests that Grann's bandpass filters are of the same construction, at least in the manner broadly set forth by Appellant in appealed claim 5.

We next consider the Examiner's 35 U.S.C. § 102 rejection of claims 13-15, separately argued by Appellant, based on Grann. We note that, while we found Appellant's arguments to be unpersuasive with respect to the Examiner's rejection of claims 1-10 and 16 discussed supra, we reach the opposite conclusion with respect to the rejection of claims 13-15. We agree with Appellant (Brief, pages 10 and 11; Reply Brief, pages 6 and 7) that Grann has no disclosure which corresponds to the claimed feature of a first set of light bandpass filters in which each filter of the set passes a different wavelength of light at a first angle of incidence. As described by Grann, each of the wavelengths λ_1 through λ_4 are incident upon the filters 391-394 in the Figure 17 embodiment, or the filters 231-234 in the Figure 13 embodiment, at different angles of incidence. In other words, a

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filter designed to pass wavelength λ_1 , received at a particular angle of incidence, will pass only that wavelength, and no other wavelengths at that particular angle of incidence.

In summary, with respect to the Examiner's 35 U.S.C. § 102 rejection of appealed claims 1-10 and 13-16, we have sustained the rejection of claims 1-10 and 16, but have not sustained the rejection of claims 13-15. Therefore, the Examiner's decision rejecting claims 1-10 and 13-16 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a)(1)(IV) (effective September 13, 2004).

AFFIRMED IN PART

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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JOSEPH F. RUGGIERO)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
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