

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 FERENC M. BOZSO
AND PHILIP G. EMMA

Appeal No. 2006-1150
Application No. 10/317,585

ON BRIEF

Before KRASS, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-5, and 21-33.

The invention is directed to a method of continuity checking an optical connection, best illustrated by reference to representative independent claim 1, reproduced as follows:

1. A method of continuity checking an optical connection, said method comprising the steps of:
 - a. transmitting an optical signal from a first optical source;
 - b. checking a first optical receiver for said optical signal;

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- c. transmitting an optical signal from a second optical source; and,
- d. checking a second optical receiver for said optical signal.

The examiner relies on the following references:

Dummermuth	4,510,565	Apr. 09, 1985
Kim	6,661,940	Dec. 09, 2003 (filed Jul. 18, 2001)

Claims 1-5, 21, 23-26, and 28-32 stand rejected under 35 U.S.C. § 102 (e) as anticipated by Kim.

Claims 22, 27, and 33 stand rejected under 35 U.S.C. § 103 as unpatentable over Kim in view of Dummermuth.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

_____A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

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In applying Kim against independent claim 1, the examiner points to Figures 1 and 2 of Kim, identifying 104b as the "first optical source," element 102c as the first optical receiver checked, 111 as the claimed optical signal, 104c as the second optical source from which the optical signal is transmitted, and 102b as the second optical receiver which is checked for the optical signal. The examiner also asserts that Kim's disclosure relates to "continuity checking" since all of the elements are in a "common optical grating (110) structure (20) wherein the elements form an optical transceiver (column 6, lines 36-45 of Kim).

Appellants do not dispute the examiner's characterization of Kim's elements 104b, 102c, 11, 104c, and 102b as constituting the claimed elements. But appellants do dispute the examiner's characterization of Kim as disclosing "continuity checking an optical connection" as set forth in the instant claims. In making their argument, appellants cite authority, at page 8 of the principal brief, for defining "continuity check" as "checking whether a good contact/connection exists" and, specific to the optical field, checking "whether the optical component is connected to the optical medium."

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We have reviewed the evidence before us and we conclude that the examiner has, indeed, established a prima facie case of anticipation which has not been successfully rebutted by appellants.

The "continuity checking" aspect of the claimed invention appears only in the preamble of the claim, with no clear indication, within the body of the claim, as to how, exactly, such "continuity checking" is accomplished. Claim limitations, even in the preamble, are essential if "necessary to give life and meaning" to the claims and properly define the invention. In re Fritch, 972 F.2d 1260, 1262, 23 USPQ2d 1780 (Fed. Cir. 1992).

In the instant case, the recitation of "continuity checking" in the preamble does not give "life and meaning" to the claims because there is nothing in the body of the claims describing how such "continuity checking" is achieved. Accordingly, we find "continuity checking" to be merely an intended use of the claimed subject matter. Statements of intended use in a preamble do not distinguish claimed structural apparatus from reference disclosing the structure but not the intended use. In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962).

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Since the examiner has shown how elements of Kim meet the four method steps claimed, and such is not disputed by appellants, to whatever extent these method steps achieve a "continuity checking" in appellants' invention, they must also achieve that result in Kim.

Accordingly, we will sustain the rejection of independent claim 1 under 35 U.S.C. § 102 (e).

With regard to claims 2 and 3, appellants merely state that:

Kim does not teach a continuity check for the optical transceiver with both optical sources and both optical receivers that may be at a common optical grating and that may be located adjacent to an optical channel in an optical backplane, as recited in claims... 2 and 3 and further in claims 24, 25, 30 and 31 (principal brief-page 7).

It is not clear exactly what part of this statement is being emphasized by appellants. The examiner has pointed out that the elements are "in a common optical grating (110) structure (20)" and that the "common optical grating structure is located adjacent a backplane optical channel..." (answer-page 4), and specifically points to column 6, lines 36-45, and column 8, lines 17-25, of Kim. Appellants have not shown any error in this portion of the examiner's rationale and appellants have not shown

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why Kim's backplane and common optical grating, as identified by the examiner, are any different from those set forth in the instant claims. Thus, appellants must be arguing the "continuity check" portion of the statement. As far as this is concerned, we have treated it supra, as indicative of merely an intended use recited in the claim preamble, without any indication within the claim body how this objective is achieved.

Accordingly, we will also sustain the rejection of claims 2, 3, 24, 25, 30, and 31 under 35 U.S.C. § 102 (e).

With regard to claim 4, this claim calls for each of the optical sources and receivers to "form an optical transceiver." The examiner has pointed out that elements 100a, 100b... constitute such transceivers, since they both transmit and receive. Again, appellants show no error in the examiner's rationale and, so, we will sustain the rejection of claim 4 under 35 U.S.C. § 102 (e).

Since the rejection of claims 5 and 22 are not argued separately by appellants, we will also sustain the rejection of claims 5 and 22 under 35 U.S.C. § 102 (e).

Claim 21 recites that the first optical source transmits the optical signal in a first direction and the second optical source

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transmits the optical signal in a second direction. Appellants contend that Kim fails to suggest this limitation while the examiner points to column 5, line 40, of Kim.

We agree with the examiner. The identified portion of Kim states that a function of the backplane assembly includes "providing bidirectional signal paths for communicating or broadcasting and rebroadcasting optical signals between components 84." Since bidirectional communication is clearly provided in Kim, allowing different optical sources to transmit in first and second directions, and appellants have not convinced us of any reason that this cited portion of Kim should not be read in this manner, we will sustain the rejection of claims 21 and 26 under 35 U.S.C. § 102 (e).

Independent claim 23, unlike independent claim 1, requires the transmission of an optical signal "into an optical channel from a first optical source" and then transmitting an optical signal from a second optical source "into *said* optical channel," i.e., into the *same* optical channel into which the first optical source transmitted.

Similarly, independent claim 29 requires the same as independent claim 23, with the additional requirement that the

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first optical signal is transmitted *in a first direction*, while the second optical signal is transmitted *in a second direction* and into the same optical channel into which the first optical source transmitted.

In Kim, the first optical signal channel is represented by arrows 111 in Figure 1. A second optical channel is represented by arrows 112 in that same Figure (see column 7, lines 33-34, and 39-40). While column 9, lines 33-36, of Kim recites that:

Optical signals 120a and 120b may be communicated in both directions from distributor 84c through the second optical signal channel provided by optical waveguiding plate 32. See arrows 112 of FIG. 1,

making it sound like we have two optical signals in two different directions in a single optical channel, the instant claim language is not met. Claims 23 and 29 require that the first optical signal must come from a first optical source while the second optical signal must come from a second optical source. It does not appear reasonable to assume that the first and second optical sources may be one and the same. If so, the claims would not label them "first" and "second." Therefore, the first and second optical sources are to be different. The situation described at column 9 of Kim describes a single optical source, optical signal 120 generated from optical transmitter 102c being

split into the two bidirectional signals 102a and 102b in Figure 2b. Accordingly, the first and second optical signals in this embodiment of Kim are not transmitted from two different optical sources.

The examiner points to column 5, line 40, of Kim for a teaching of bidirectional signal paths, but as far as claims 23 and 29 are concerned, this portion of Kim does not teach or suggest two different optical sources transmitting first and second optical signals in two different directions (claim 29) in the *same optical channel* (claims 23 and 29).

However, at page 4, four lines up from the bottom, of the answer, the examiner describes the optical channel as being met by element 32 of Kim. While element 32 is described as a "waveguiding plate" (see column 9, lines 22-23, of Kim, for example), it is fair for the examiner to equate element 32 to a "channel" since Kim describes a "channel provided by optical waveguiding plate 32" (column 9, lines 21-22). Since this channel 32 provides for both paths 111 and 112, as described with regard to claim 1 supra, it appears reasonable to interpret waveguiding plate 32 as the claimed single channel over which the

first and second optical sources transmit first and second optical signals in different directions.

Accordingly, we will sustain the rejection of claims 23 and 29 under 35 U.S.C. § 102 (e). We will also sustain the rejection of claim 28 under 35 U.S.C. § 102 (e) as this claim is not argued separately from the others by appellants.

The only mention appellants make of claims 5, 27, and 32, is that these claims "teach a continuity check for the optical transceiver where each optical signal may be two different data values" not taught by Kim (principal brief-page 7). But the examiner points out that column 7, line 55, of Kim anticipates this limitation because the term "optical signals" is plural, indicating that there are two signals and thus two values, i.e., a first data value followed by a second data value.

Appellants argue that the propagated signals recited at that portion of Kim refer to whatever is transmitted by the transmitters and not the content of what is being transmitted (reply brief-page 3). We disagree. If signals are propagated, as disclosed by Kim, then those signals contain data, and that "data," i.e., content, is transmitted, as claimed.

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Thus, we will sustain the rejection of claims 5, 27, and 32 under 35 U.S.C. § 102 (e).

Turning to the rejection of claims 22, 27, and 33 under 35 U.S.C. § 103, appellants argue only that Dummermuth does not provide for the deficiencies alleged as to the independent claims. However, since we find no such deficiencies, as noted supra, we will sustain the rejection of claims 22, 27, and 33 under 35 U.S.C. § 103.

The examiner's decision rejecting claims 1-5, 21, 23-26, and 28-32 under 35 U.S.C. § 102 (e) and claims 22, 27, and 33 under 35 U.S.C. § 103 is affirmed.

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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) .

AFFIRMED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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