

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAMOTSU AKASHI, TSUYOSHI YAMAMOTO,
SHINJI YAMASHITA, KOHEI SHIBATA
AND HIROFUMI AOTA

Appeal 2007-3800
Application 11/041,435
Technology Center 2800

Decided: March 20, 2008

Before KENNETH W. HAIRSTON, MAHSHID D. SAADAT
and KARL EASTHOM, *Administrative Patent Judges*.
HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134 from the final rejection of claims 1 to 22.

Claim 1 is representative of the claimed invention, and it reads as follows:

1. A collimator array, comprising:
a substrate having first and second faces;

a plurality of lenses formed on the first face of the substrate; and
a plurality of projecting parts corresponding, respectively, to the
plurality of lenses, each projecting part being formed on a portion of the
second face of the substrate corresponding to the respective lens that
corresponds to the projecting part, wherein

the plurality of projecting parts are fusion-connected to a
plurality of optical fibers, respectively, and

an area of a fusion-connected face of each projecting part is
larger than a cross sectional area of the respective optical fiber to
which the projecting part is fusion-connected.

The prior art relied upon by the Examiner in rejecting the claims on
appeal is:

Blarasin US 2003/0219213 A1 Nov. 27, 2003

The Examiner rejected claims 1, 2, 9, 16, 20, and 22 under 35 U.S.C.
§ 102(b) based upon the teachings of Blarasin.

The Examiner rejected claims 3 to 8, 10 to 15¹, 17 to 19, and 21 under
35 U.S.C. § 103(a) based upon the teachings of Blarasin.

Turning first to the anticipation rejection, the Examiner notes that
Blarasin teaches that the diameters of the fiber 116 and the projecting part
114 are “substantially equal”² (paragraph 0007), “close to” one another
(paragraph 0032), “about the same” (paragraph 0034), and “substantially

¹ The Examiner listed claim 16 under both statutory grounds of rejection
(Ans. 3 and 4). We agree with Appellants’ conclusion (Reply Br. 1) that
claim 15, as opposed to claim 16, should have been listed in the obviousness
rejection.

² Claim 40 in Blarasin states that the diameters are “approximately equal.”

match” (paragraph 0038) (Ans. 4). In view of the noted teachings in Blarasin, the Examiner contends that “the terms ‘substantially’, ‘close to’ and ‘about’ all encompasses both slightly larger and slightly smaller diameters, wherein a slightly larger diameter reads on the limitation ‘larger’ thus anticipating the claimed limitation”³ (Ans. 4). Appellants contend that “Blarasin does not disclose or suggest that an area of a fusion-connected face of each projecting part is larger than a cross sectional area of the respective optical fiber to which the projecting part is fusion-connected” (Reply Br. 4), and that the descriptions of the diameters noted by the Examiner demonstrate that “Blarasin intends for the diameters to be the same” (Reply Br. 6).

³ The Examiner’s statement appears to characterize the quoted material in Blarasin as creating a range from “slightly smaller” to “slightly larger” that encompasses the claimed “larger” limitation. “It is well established that the disclosure of a genus in the prior art is not necessarily a disclosure of every species that is a member of that genus.” *In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1994). An earlier genus does not normally anticipate a narrower species. *Titanium Metals Corporation v. Banner*, 778 F.2d 775, 782 (Fed. Cir. 1985). “On the other hand, a very small genus can be a disclosure of each species within the genus.” *In re Petering*, 301 F.2d 676, 682 (CCPA 1962); *see also Bristol-Myers Squibb Co. v. Ben Venue Labs, Inc.*, 246 F.3d 1368, 1380 (Fed. Cir. 2001). The Examiner’s statement in the Answer does not establish that the range from “slightly smaller” to “slightly larger” is a “very small genus” as set forth in the *Bristol-Myers* case. Even if such a case had been made by the Examiner, we are still confronted with the fact that each of the claims on appeal requires that each of the plurality of projecting parts has to be larger than the respective optical fiber. In the absence of Appellants’ disclosed and claimed invention, we fail to see how all of the projecting parts in Blarasin would be larger than the optical fibers fused thereto.

With respect to the Examiner's contention that one diameter can be larger than the other diameter, we will not use impermissible hindsight to select each of a plurality of projecting parts as having the larger diameter/area.

We agree with Appellants that Blarasin teaches the use of projecting parts and optical fibers that are of the same diameter or nearly the same diameter. Thus, the anticipation rejection of claims 1, 2, 9, 16, 20, and 22 is reversed because each and every limitation in the claims is not found either expressly or inherently in the cited reference to Blarasin. *In re Crish*, 393 F.3d 1253, 1256 (Fed. Cir. 2004).

Turning lastly to the obviousness rejection of claims 3 to 8, 10 to 15, 17 to 19, and 21, this rejection is reversed for the same reason that the anticipation rejection was reversed, and because the Examiner's articulated reasons for the rejection do not support a legal conclusion of obviousness. *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007).

The decision of the Examiner is reversed.

REVERSED

KIS

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