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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DOUGLAS M. BANEY and WAYNE V. SORIN

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Appeal No. 2000-2041
Application 09/014,148

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ON BRIEF

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Before BARRETT, FLEMING, and RUGGIERO, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 7.

The invention relates to an apparatus having one or more narrow band, selectable output wavelengths. On page 3 of the specification, Appellants disclose that figure 1 is a block diagram of a filter according to the present invention. On page

4 of the specification, Appellants disclose that figure 1 shows filter 100 which takes the output 111 of a broad-spectrum light source 101 and converts it to a signal 113 having one or more discrete spectral lines at selected wavelengths. The output of the light source 101 is applied to a channel filter 103. The output of channel filter 103 is a signal having a spectrum comprising a series of discrete spectral lines shown at 112. The output of channel filter 103 is applied to a channel selector 105. The channel selector 105 separates the desired spectral lines from the output of channel filter 103 to generate output signal 113. The channel filter 103 is constructed from a fiber Bragg reflector.

Independent claim 1 is reproduced as follows:

1. A filter for generating an output light signal having one or more output spectral lines selected from a plurality of potential spectral lines included in an input light signal, said filter comprising:

a channel filter for filtering said input light signal to create a notched light signal having a spectrum devoid of light at a first wavelength; and

a variable wavelength reflector connected to said channel filter for reflecting a portion of the light leaving said channel filter, said reflected light having a wavelength equal to a

reflection wavelength, said reflection wavelength being selectable from said first wavelength and a second wavelength equal to the wavelength of one of said spectral lines.[1]

The reference relied on by the Examiner is as follows:

Li 5,841,918 Nov. 24, 1998

Claims 1 through 7 stand rejected under 35 U.S.C. § 102 as being anticipated by Li.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the briefs[2] and the answer for the details thereof.

OPINION

After a careful review of the evidence before us, we do not agree with the Examiner that claims 1 through 7 are anticipated by Li.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136,

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[1] We note that the brief provides a copy of claim 1. This claim includes the phrase "said potential spectral lines." However the claim above which is present in the application only recites "said spectral lines".

[2] Appellants filed an appeal brief on December 14, 1999. Appellants filed a reply brief on March 20, 2000. The Examiner mailed an office communication on May 8, 2000, stating that the reply brief has been entered and considered.

138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.,*** 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Appellants argue on page 3 of the brief that Li does not teach a variable link reflector connected to said channel filter for reflecting a portion of the light leaving said channel filter, said reflected light having a wavelength equal to a reflection wavelength, said reflection wavelength being selectable from said first wavelength and a second wavelength equal to the wavelength of one of said potential spectral lines as recited in Appellants' claim 1. Appellants point out that Li teaches a system in which the desired spectral lines pass through reflector 16. Appellants direct our attention to figure 3 of Li showing output 1.

The Examiner responds to Appellants' argument on page 4 of the Examiner's answer. The Examiner argues that the Li reflector is tunable, thus it can be tuned to reflect any wavelength including the desired wavelength which outputs to port 4 of circulator 112 in figure 6.

In the reply brief, Appellants argue that the Examiner has not overcome the Appellants' argument by arguing that Li's reflector is tunable. Appellants point out the issue is not whether the reflector can be tuned but rather whether Li teaches making the required tuning. Appellants argue that the Examiner has the burden of showing that Li expressly teaches the claim limitation or that the limitation is inherenty taught under the rejection of 35 U.S.C. § 102 which is maintained by the Examiner.

"[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion," ***In re Lee***, 277 F.3d 994, 1342-43, 61 USPQ 1430, 1434 (Fed. Cir. 1999).

Upon our review of Li, we fail to find that Li teaches the Appellants' claimed limitation "a variable wavelength reflector connected to said channel filter for reflecting a portion of the light leaving said channel filter, said reflected light having a wavelength equal to a reflection wavelength, said reflection wavelength being selectable from said first wavelength and a second wavelength equal to the wavelength of one of said potential spectral lines" as recited in Appellants' claim 1. We note under 35 U.S.C. § 102, the question is not whether the Li

system can be modified but instead the question is whether Li teaches these limitations or is inherent in the reference. We find that these limitation are not taught by or inherent in Li.

In view of the foregoing, we will not sustain the Examiner's rejection of claims 1 through 7 under 35 U.S.C. § 102.

Therefore, the Examiner's decision is reversed.

REVERSED

LEE E. BARRETT Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH F. RUGGIERO Administrative Patent Judge	)	

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