

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBIN K. ELKINS and  
MARTIN B. GRIER

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Appeal No. 96-0069  
Application 08/110,493<sup>1</sup>

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ON BRIEF

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Before THOMAS, JERRY SMITH and CARMICHAEL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed August 23, 1993. According to appellants, the application is a continuation of Application 07/796,826, filed November 25, 1991, now abandoned.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 13-21, which constitute all the claims remaining in the application.

The claimed invention pertains to a laser apparatus which uses a solid regular pyramid having a square base and four triangular faces which meet at the apex.

Representative claim 13 is reproduced as follows:

13. A laser apparatus comprising a solid regular pyramid made of laser material, having a square base and four triangular faces of equal size and shape meeting at the apex and a laser beam directed perpendicularly to said base and characterized as having substantially 0% reflection.

The examiner relies on the following references:

Almasi et al. (Almasi)	3,631,362	Dec. 28, 1971
Koechner	4,357,704	Nov. 02, 1982

Claims 13-21 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Koechner or Almasi.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into

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consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 13-21. Accordingly, we reverse.

Appellants have nominally indicated that the claims on appeal do not stand or fall together [brief, pages 5-6]. However, appellants have made no separate arguments with respect to any of the claims within each rejection. Since appellants have failed to appropriately argue the separate patentability of the claims, all contested claims stand or fall together. See In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will only consider the rejections against claim 13 as representative of all the claims on appeal.

We consider first the rejection of the claims under 35 U.S.C. § 103 as being unpatentable over Koechner. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner

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to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

As indicated by the cases just cited, the examiner has at least two responsibilities in setting forth a rejection under 35

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U.S.C. § 103. First, the examiner must identify all the differences between the claimed invention and the teachings of the prior art. Second, the examiner must explain why the identified differences would have resulted from an obvious modification of the prior art. In our view, the examiner has not properly addressed his first responsibility so that it is impossible that he has successfully fulfilled his second responsibility.

It is not entirely clear from the examiner's rejection just what the perceived differences are between claim 13 and the teachings of Koechner. The examiner notes that the slab type laser in Koechner can be pyramidal or the like in configuration [answer, page 5]. The examiner concludes that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to use [the] teaching of both references for a laser apparatus, as claimed if so desired" [answer, page 6].

Appellants argue that Koechner does not disclose a solid regular pyramid as recited in claim 13 [brief, page 7]. More specifically, appellants argue that the truncated pyramids of the applied prior art would not have suggested the specific solid pyramid as recited in the claims [reply brief, page 1].

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It should be noted that claim 13 as reproduced above specifically recites an optical article having the shape of a solid regular pyramid in which the sides of the pyramid meet at the apex of the pyramid. The corresponding device in Koechner which may be "pyramidal" is the laser module bounded by faces 8 and 9 and concentrator 7. This device in Koechner is described as a "truncated pyramid" [column 4, line 30]. A truncated pyramid is a pyramid in which the top portion has been cut off. Therefore, the truncated pyramid of Koechner does not have triangular faces which meet at the apex of the pyramid as recited in the claimed invention.

The examiner never recognizes this difference between the "pyramid" of Koechner and the pyramid as specifically recited in claim 13. The examiner's position simply assumes that the pyramid of Koechner meets the pyramid of the claims which is not the case. Consequently, the examiner never addresses why the pyramid as recited in the claims would have been obvious to the artisan in view of the truncated pyramid of Koechner. The failure of the examiner to even acknowledge the difference between Koechner's truncated pyramid and the pyramid of the claims results in a failure by the examiner to establish a prima facie case of obviousness. While we are not able to say whether

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the prior art in general might suggest the optical element of claim 13, we can say that the invention as specifically recited in claim 13 is not rendered obvious on this record.

Since Koechner does not suggest an optical element in the shape of a pyramid as specifically recited in the claims, we do not sustain the rejection of claims 13-21 based on the teachings of Koechner.

We now consider the rejection of the claims under 35 U.S.C. § 103 as being unpatentable over the teachings of Almasi. The examiner relies on the "pyramid" 20 of Almasi as meeting the pyramid as recited in the claims [answer, page 10]. Appellants argue that Almasi does not teach a solid regular pyramid as set forth in the claims [brief, page 8].

Pyramid 20 in Almasi is a truncated pyramid similar to the truncated pyramid of Koechner [note column 4, line 14]. The truncated pyramid of Almasi does not suggest the specific pyramid of the claims for the same reasons discussed above with respect to Koechner. Therefore, the rejection of claims 13-21 based on Almasi fails to make a prima facie case of obviousness for the same reasons discussed above. Therefore, we also do not sustain this rejection of claims 13-21.

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We have not sustained either rejection of claims 13-21 as formulated by the examiner. Therefore, the decision of the examiner rejecting claims 13-21 is reversed.

REVERSED

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JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JERRY SMITH	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES

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