

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LESLIE J. BUTTON,
MARK A. NEWHOUSE and
Z. GEORGE PAN

Appeal No. 97-0398
Application 08/281,732¹

ON BRIEF

Before THOMAS, MARTIN and BARRETT, Administrative Patent
Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed July 29, 1994.

Appeal No. 97-0398
Application 08/281,732

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 3, 5, 6, 10 and 18.

Representative independent claim 1 is reproduced below:

1. A multistage fiber amplifier comprising
an input stage having a given passive loss and a flattened gain spectrum, and
an output stage coupled to said input stage, said output stage having a passive loss that is lower than said given passive loss and gain spectrum that is less flat than [said] input stage.

The following reference is relied on by the examiner:

DiGiovanni et al. (DiGiovanni) 5,050,949 Sept. 24,
1991

Claims 1 through 3, 5, 6, 10 and 18 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon DiGiovanni alone.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and the answer for the respective details thereof.

OPINION

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We reverse the outstanding rejection of claims 1 through 3, 5, 6, 10 and 18 under 35 U.S.C. § 103.

From our consideration of the examiner's statement of the rejection in the final rejection and the examiner's remarks in the answer, we conclude that the examiner has not set forth a prima facie case of obviousness of the threshold question of the subject matter presented in independent claim 1 on appeal. The focus of the dispute between the appellants and the examiner is the claimed output stage set forth at the end of independent claim 1 on appeal. In the brief and the declaration from one of the inventors, it is asserted that the specific embodiment discussed in DiGiovanni does not teach the second stage of claim 1 on appeal. The examiner apparently agrees with the brief and the declaration that the teachings in DiGiovanni as to the second stage in that reference indicate a structure opposite in characteristics to that which are set forth in the claimed second stage of claim 1 on appeal.

The top of page 3 of the examiner's answer states:

[T]he Boards' attention is drawn to the Abstract and column 3, line 49 through column 4, line 3 of

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DiGiovanni et al to show that experimentation with the composition of the second stage is clearly suggested. Note that there is no teaching that requires a particular passive loss or gain flatness for the first stage with respect to the second stage.

Overall, the examiner's rationale of the statement of the rejection in the final rejection and as amplified in this portion of the answer is considered to be presumptive and essentially begging the question by relying essentially upon an obvious to experiment type of rationale, at the same time the examiner recognizes that "there is no teaching [in DiGiovanni] that requires a particular passive loss or gain flatness for the first stage with respect to the second stage." Although there may be some merit from an artisan's perspective that the reference suggests some degree of experimentation or variability of the composition of the optical fibers discussed in the reference, the examiner has provided no rationale and/or additional evidence in the form of other patents or publications to persuade us to conclude that the artisan would have found it obvious to have constructed an output stage having a passive loss that is lower than the given passive loss of the first stage at the

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same time as having a gain spectrum that is less flat than the input stage as recited in the claimed output stage of claim 1 on appeal. Therefore, based upon the weight of the evidence and arguments of record, we must reverse the outstanding rejection of independent claim 1 on appeal and, therefore, the stated rejection of its respective dependent claims 3, 5, 6, 10 and 18.

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The decision of the examiner is reversed.

REVERSED

	JAMES D. THOMAS)	
	Administrative Patent Judge)	
)	
)	
)	
	JOHN C. MARTIN)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	LEE E. BARRETT)	
	Administrative Patent Judge)	

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