



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCIENTIFIC-ATLANTA, INC.

Appeal 2008-6176
Reexamination Control 90/007,524
Patent 5,225,925
Technology Center 3900

Decided: January 26, 2009

Before CAROL A. SPIEGEL, ROMULO H. DELMENDO, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

Scientific-Atlanta, Inc. (hereinafter Appellant) appeals under 35 U.S.C. §§ 134(b) and 306 from a final rejection of claims 1-7, 9-21, 23-26, 30-40, 46-48, 58-62, 68, and 69 (Appeal Brief filed February 5, 2008, hereinafter “App. Br.,” 1; Final Office Action mailed September 5, 2007; Examiner’s Answer mailed March 28, 2008, hereinafter “Ans.,” 4). We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

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We REVERSE.

STATEMENT OF THE CASE

This reexamination proceeding arose from a request for *ex parte* reexamination filed by Scientific-Atlanta, Inc. (Scientific-Atlanta) of Lawrenceville, Georgia, on April 27, 2005, of United States Patent 5,225,925 (hereinafter the “‘925 Patent”), entitled “SENSITIZED ERBIUM FIBER OPTICAL AMPLIFIER AND SOURCE” and issued to Stephen G. Grubbs, Douglas W. Anthon, William I. Barnes, and Janet E. Townsend on July 6, 1993.¹ The ‘925 Patent was involved in a patent infringement action captioned *Scientific-Atlanta, Inc. v. IPG Photonics Corp.*, Case No. 1:05cv10850 (D. Mass., filed April 26, 2005) (Litigation Status Report entered April 4, 2006). This action was stayed on July 27, 2005 pending this reexamination, but the parties filed a Stipulation of Dismissal with Prejudice on October 12, 2007 (*id.*; App. Br. 14). Oral arguments concerning the present appeal were heard on January 7, 2008.

The invention of the '925 patent relates to a silicic optical fiber for use in optical amplifiers and sources (independent claims 1, 30, 35, 39, 68, and 69; Specification, hereinafter “Spec.,” col. 3, l. 17 to col. 4, l. 61).

Claim 1, which is illustrative of the claims on appeal, reads as follows:

¹ Scientific-Atlanta is the owner of the entire right, title, and interest in and to the ‘925 Patent as recorded in Reel 015991, Frame 00215 and Reel 016004, Frame 0887 on April 1, 2005 and April 4, 2005 (Request for Ex Parte Reexamination filed on April 27, 2005; Patent Assignment Abstract of Title entered May 16, 2005). We are also told that Scientific-Atlanta is a subsidiary of Cisco Systems (Letter entered December 30, 2008).

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Martin Emanuel Fermann, Characterisation Techniques for Special Optical Fibres (September 1988) (Ph.D. thesis, University of Southampton, United Kingdom) (on file with The British Library, West Yorkshire, United Kingdom) (hereinafter "Fermann Thesis").

Stephen Grubb and Doug Anthon, Co-doped Erbium Fibers for Optical Amplifiers (with attached Figures 1-3 dated "DISCLOSURE REC'D" May 21, 1990 and undated Figure 4) (unpublished internal company document, Amoco Corporation) (hereinafter "Grubb").

The Examiner rejected the claims under 35 U.S.C. § 103(a) as follows: (i) claims 68 and 69 as unpatentable over Fermann in view of Barnes, Poole, Fermann Thesis, and Grubb; (ii) claims 1-3, 5, 6, 9-11, 14-21, 23-26, 30-34, 46-48, 58, and 59 as unpatentable over Fermann in view of Grubb; (iii) claims 12 and 13 as unpatentable over Fermann in view of Grubb and, in the alternative, further in view of Barnes; (iv) claims 4, 7, and 35-40 as unpatentable over Fermann in view of Grubb and further in view of Barnes or Snitzer; and (v) claims 60-62 as unpatentable over Fermann in view of Grubb and further in view of Barnes, Poole, and Fermann Thesis (Examiner's Answer mailed March 28, 2008, hereinafter "Ans.," 5-20).

The Examiner found that Fermann describes "a phosphate- and aluminum-doped silica based optical fiber for use in a laser, comprising a concentration of erbium and ytterbium ions which provide and absorb radiation and decay in the manner set forth in the instant claims to reduce back transfer of energy from the erbium ions to the ytterbium ions" (Ans. 6). The Examiner acknowledged, however, that Fermann's disclosure is limited to an exemplary phosphate concentration of 5 mole percent whereas appealed claim 1 recites a phosphate concentration "in the range of approximately 10 mole percent to 25 mole percent" (Ans. 11-12). To

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account for this difference, the Examiner relied on Grubb, which is said to teach a phosphate concentration of 14 mole percent for phosphate-doped silica-based fibers, thus rendering the claimed subject matter obvious (Ans. 12). According to the Examiner, “Patent Owner acquiesced [to the determination of the Examiner and the Board] that Grubb was prior art to them [sic]” during the prosecution of Application 07/644,460 (of which the application that matured into the ‘925 Patent is a continuation-in-part) and that “[s]ince Grubb was prior art in the parent (07/644,460), it is also prior art as to the ‘925 [P]atent” (Ans. 21). Specifically, it is the Examiner’s position that collateral estoppel (as distinguished from *res judicata*) bars Patent Owner from now asserting that Grubb is not prior art against the appealed claims (Ans. 28-29). The Examiner further argues that even if collateral estoppel does not apply, Patent Owner did not “provide what mechanisms/safeguards were in place to keep Grubb an ‘internal document’” (Ans. 24).

Appellant, on the other hand, asserts that without the teachings of Grubb as prior art, the Examiner’s rejections fail because “there is no basis for concluding that the invention as claimed would have been obvious” to a person having ordinary skill in the art (App. Br. 11). According to Appellant, the Examiner failed to carry the burden of proving unpatentability because, among other reasons, “there is no basis for asserting that the Patent Owner is now estopped from challenging the use of the Grubb [r]eference as prior art based on the earlier Board decision [in Application 07/644,460]” (App. Br. 5 and 11). In particular, Appellant urges that collateral estoppel is inapplicable here because: (1) no prior court decision or an inter partes

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adjudication of the prior art status of Grubb has taken place; (2) the prosecution of 07/644,460 was not litigation; (3) “the status of the Grubb [r]eference as prior art was not necessary for the resulting decision”; and (4) the applicants in 07/644,460 had a “statutory right to file continuing applications and present new evidence of patentability” (Reply Brief filed on May 22, 2008, hereinafter “Reply Br.,” 10-13).

ISSUES

Thus, the issues arising from the contentions of the Examiner and Appellant are:

Has Appellant shown that the Examiner reversibly erred by failing to establish in the first instance that collateral estoppel applies and bars Appellant from asserting that Grubb is not prior art?

Has Appellant shown that the Examiner reversibly erred in concluding that Grubb is prior art because Appellant did not identify the mechanisms and safeguards to maintain Grubb as an internal company document?

FINDINGS OF FACT

1. Fermann describes a silica-based fiber doped with 5 mole percent Al_2O_3 and 5 mole percent P_2O_5 and having Yb and Er concentrations of approximately 1.7% and 0.080%, respectively (1135, 2nd col., “Experimental details”).
2. Fermann does not disclose any other amounts for the phosphate (P_2O_5).

3. Grubb is the only document that has been cited to show that a person having ordinary skill in the art would have been led to modify Fermann by increasing the amount of phosphate to the levels recited in the appealed claims (Ans. 5-20).
4. United States Patent and Trademark Office records reveal that the inventors named in Application 07/644,460 are Stephen G. Grubb and Douglas W. Anthon.
5. Grubb and Anthon are the named authors of the Grubb reference.
6. Grubb and Anthon both declare that the Grubb reference was never published and was used only as an internal document within Amoco Corporation, the assignee of Application 07/644,460 at the time of its prosecution (DECLARATION UNDER 37 C.F.R. § 1.132 of Stephen G. Grubb dated April 18, 2007, ¶2; DECLARATION UNDER 37 C.F.R. § 1.132 of Douglas W. Anthon dated April 18, 2007, ¶2).
7. In Application 07/644,460, the claims were finally rejected under 35 U.S.C. § 103 as unpatentable over “any one of Grubb, Hanna and Maker in combination with either the Barnes paper or the Barnes article and any one of Digonnet, Woodcock 757 and Woodcock 004 as to claims 1 through 6, 9 and 18 through 20 and . . . Snitzer as to all the claims” (*Ex parte Grubb*, Appeal No. 93-2951, slip op. 2 (B.P.A.I. August 12, 1993)).
8. Appealed claim 1 in Application 07/644,460 differs significantly from appealed claim 1 of the present appeal in

terms of subject matter (*Ex parte Grubb*, Appeal No. 93-2951, slip op. 2).

9. With respect to whether the Grubb reference was available as prior art against the claims of Application 07/644,460, the Board in *Ex parte Grubb* included a footnote as follows: “Since the paper was presented to the PTO as part of the appellants’ information disclosure statement (Paper No. 3), we will assume that it is prior art as to them” (*Ex parte Grubb*, Appeal No. 93-2951, slip op. 3, n. 1).
10. The Board in *Ex parte Grubb* affirmed the rejection of all the claims of Application 07/644,460 (*Ex parte Grubb*, Appeal No. 93-2951, slip op. 2-7).
11. The Grubb reference was not applied in the same way in Application 07/644,460 as applied in the present reexamination *Ex parte Grubb*, Appeal No. 93-2951, slip op. 2-7).
12. Application 07/644,460 was abandoned in favor of continuation-in-part Application 07/735,387 filed on July 24, 1991, which matured into the ‘925 Patent.
13. The inventors named in the ‘925 Patent are Stephen G. Grubbs, Douglas W. Anthon, William I. Barnes, and Janet E. Townsend (‘925 Patent).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007).

Where no facts are in dispute, the question of whether a document is a printed publication (*i.e.*, prior art) is a legal question that is reviewed *de novo*. *In re Klopfenstein*, 380 F.3d 1345, 1347 (Fed. Cir. 2004).

Collateral estoppel (also called issue preclusion) “precludes relitigation in a second suit of issues actually litigated and determined in the first suit.” *In re Freeman*, 30 F.3d 1459, 1465 (Fed. Cir. 1994). This doctrine applies *only if*: (1) the issue is identical to one decided in the first action; (2) the issue was actually litigated in the first action; (3) resolution of the issue was essential to a final judgment in the first action; and (4) plaintiff had a full and fair opportunity to litigate the issue in the first action. *Id.*

ANALYSIS

We agree with Appellant that Examiner’s rejection is not well founded. Other than reasoning based on the teachings of Grubb, the Examiner has not offered a different rationale for modifying the phosphate content in Fermann to arrive at the claimed invention (Facts 1-3). Thus, unless the Examiner can establish that Grubb is available as prior art, the rejections fail.

The Examiner’s sole basis for holding that Grubb is prior art is that a different examiner and the Board assumed that it was prior art in Application 07/644,460 and Patent Owner did not dispute this assumption in that application (Ans. 21-22; Facts 9 and 10). Then, in a most conclusory fashion, the Examiner alleged that all four requirements necessary to trigger

collateral estoppel were satisfied in the facts of the present appeal (Ans. 22). Conspicuously absent, however, is any detailed analysis or discussion on how and why each of the four requirements is met.

With respect to the first requirement (identity of issues), the Examiner failed to explain how the issue in the present case is identical to that in Application 07/644,460 when Grubb was applied against a claim that was directed to a completely different invention of a different inventive entity for a different teaching (Facts 4, 5, 7, 8, 11, and 13). The Examiner also glossed over the second requirement (“actually litigated” requirement) by failing to provide a meaningful discussion on how an *ex parte* administrative proceeding (in which applicants can continue prosecution in a continuing application following an adverse decision in a parent application) can and should be considered litigation in the context of collateral estoppel.² Turning to the third requirement (“essential to a final judgment”), the Examiner again did not explain how and why Grubb was necessary to the judgment of the Board in 07/644,460 when it was only one of several alternative references (Fact 7). With respect to the fourth requirement (“full and fair opportunity to litigate”), the Examiner did not explain in any meaningful way why the Patent Owner could not choose to “to litigate,” if necessary, the issue of whether Grubb is available as prior art in continuation-in-part Application 07/735,387 (*i.e.*, the application that matured into the ‘925 Patent) (Fact 12).³

² *Cf. Pound v. United States*, 63 Fed.Appx. 499, 501-502 (Fed. Cir. 2003) (unpublished).

³ The Examiner’s position appears to be at odds with policy. If, as the Examiner asserts, collateral estoppel were to apply in a situation such as this,

Finally, the Examiner argues that even if collateral estoppel does not apply, Grubb is assumed to be prior art because no evidence established “what mechanisms/safeguards were in place to keep Grubb an ‘internal document’” (Ans. 23-24). The Examiner’s concern is misplaced. Here, both Grubb and Anthon have declared that the Grubb reference was never published and was an internal company document (Facts 5 and 6). The Examiner, on the other hand, has offered no factual basis upon which to doubt the confidential nature of the Grubb reference. Hence, the Examiner has failed to present any evidence sufficient to prove that Grubb was a printed publication that was publicly accessible.

For these reasons, the Examiner has failed to establish a prima facie case of obviousness. Accordingly, we cannot uphold any of the Examiner’s rejections.

CONCLUSION

On this record, we determine that Appellant has shown that the Examiner reversibly erred by failing to establish in the first instance that collateral estoppel applies and by concluding that Grubb is prior art because Appellant did not identify the mechanisms and safeguards to maintain Grubb as an internal company document.

an applicant would be forced to make *every* conceivable argument in a given application for fear of collateral estoppel. Under the Examiner’s theory, an applicant could never raise an argument in a continuing application if it was not raised in the parent application. Such a position appears to be contrary to current patent practice and procedure and will surely place an immense burden on the examiners to ensure timeliness and quality of examination despite the increased number of arguments to consider.

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DECISION

The Examiner's decision to reject appealed claims 1-7, 9-21, 23-26, 30-40, 46-48, 58-62, 68, and 69 is reversed.

REVERSED

ack

cc:

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