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The time period for reply, if any, is set in the attached communication.
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte IGOR MILICEVIC,
MATTHEUS JACOBUS NICOLAAS VAN STRALEN, and
JOHANNES ANTOON HARTSUIKER

Appeal 2018-004453
Application 14/101,705
Technology Center 1700


REN, Administrative Patent Judge.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellants\(^1\) appeal under 35 U.S.C. § 134 from a rejection\(^2\) of claims 17–31.\(^3\) We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the rejection of claims 17–31 as unpatentable. Because the basis for rejection differs from that relied upon by the Examiner, we designate our affirmance as constituting a new ground of rejection pursuant to 37 CFR § 41.50(b).

CLAIMED SUBJECT MATTER

The claims are directed to a method of manufacturing an optical fiber preform. Claim 17, reproduced below, is illustrative of the claimed subject matter:

17. A method of manufacturing a preform for optical fibers comprising the steps of:
   (i) providing a hollow substrate tube having an inner surface;
   (ii) depositing a plurality of activation glass layers on the inner surface of the hollow substrate tube with PCVD thereby forming a pretreated hollow glass substrate tube, wherein a total thickness of the plurality of activation glass layers deposited in the pretreated hollow substrate tube is at least 10 microns and up to 250 microns;
   (iii) after step (ii), etching the pretreated hollow substrate tube thereby removing at least 30% of and up to 100% of the plurality of activation glass layers thereby forming an etched

\(^1\) The real party in interest is identified as “DRAKA COMTEQ B.V.” Appeal Brief of December 1, 2017 (“Appeal Br.”), 3.
\(^2\) Non-Final Office Action of May 23, 2017 (“Non-Final Act.”). In this opinion, we also refer to the Examiner’s Answer of January 26, 2018 (“Ans.”) and the Reply Brief of March 23, 2018 (“Reply Br.”).
\(^3\) The record shows at least a Non-Final Action of June 22, 2015 and Final Actions of October 13, 2015 and December 13, 2016.
hollow substrate tube having a smooth inner surface without irregularities;

(iv) after step (iii), supplying doped glass forming gases, undoped glass-forming gases, or a combination thereof into the etched hollow substrate tube and depositing glass layers from the doped glass forming gases, undoped glass-forming gases, or the combination thereof on the inside of the etched hollow substrate tube; and

(v) collapsing the etched hollow substrate tube of step (iv) having deposited glass layers from the doped glass forming gases, undoped glass-forming gases, or the combination thereof on the inside of the etched hollow substrate tube into an optical fiber preform, wherein:

the plurality of activation layers do not contribute to a refractive index profile of the optical fiber preform, and the doped glass forming gases, undoped glass-forming gases, or a combination thereof of step (iv) provide the refractive index profile of the optical fiber preform.

Claims Appendix (Appeal Br. 25–26).

REFERENCES

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

<table>
<thead>
<tr>
<th>Reference</th>
<th>Patent Number</th>
<th>Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>Campion</td>
<td>US 6,201,917 B1</td>
<td>Mar. 13, 2001</td>
</tr>
<tr>
<td>Hartsuiker (&quot;Hartsuiker 107&quot;)</td>
<td>US 2009/0173107 A1</td>
<td>July 9, 2009</td>
</tr>
</tbody>
</table>
REJECTIONS

Claims 17–31 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Hartsuiker 404 in view of Hartsuiker 787 and Campion. Non-Final Act. 3.  

OPINION

Rejection of Claim 17

Appellants argue that the Examiner reversibly erred in rejecting claim 17 because the combined prior art would not have resulted in “an etched hollow substrate tube having a smooth inner surface without irregularities” as recited. Appeal Br. 16. More specifically, Appellants argue that the recited “smooth inner surface without irregularities” “refers to the geometrical characteristics of the hollow substrate tube” whereas the disclosure in Campion refers to the “chemical purity of Campion’s silica used to make its tubes/perform.” Id. at 17 (emphasis removed); see also Reply Br. 3–4 (arguing the same).

The Examiner, on the other hand, states that neither claim 17 nor the specification mentions that the “smooth inner surface without irregularities” is based on certain geometrical characteristics. Ans. 9; see also Non-Final Act. 5 (finding that Campion teaches an “ultra-pure silica” tube in the

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4 The Examiner notes that the Non-Final Action should not have mentioned Hartsuiker 107 which is not relied upon for the rejection. Ans. 3. Appellants’ argument is likewise not based on Hartsuiker 107. Appeal Br. 14.

5 Appellants do not present separate arguments for claims 18–31 and they stand or fall with claim 17. Appeal Br. 14–24; see also 37 C.F.R. § 41.37(c)(1)(iv)(2013).
relevant process and citing Campion 4:55–65). We note that the record shows that a previously issued indefiniteness rejection was withdrawn. Non-Final Act. 7 (finding that the “arguments regarding the previous rejection under 35 USC 112 were persuasive; thus the rejection is withdrawn”); see Final Action of December 13, 2016, 2–3 (rejecting claims 17–31 as indefinite finding that the claim term “a smooth inner surface without irregularities” is vague). In withdrawing the indefiniteness rejection, the Examiner nonetheless finds that “not all of the statements within [Appellants’ definiteness] arguments are supported by the record.” Non-Final Act. 7 (finding that the extrinsic evidence proffered for the definition of the claim term is in the medical arts); Response of January 31, 2017 (in response to Final Act of December 13, 2016), 4 (submitting the extrinsic evidence entitled “Three-dimensional surface analysis of young adult human articular cartilage” in support of the definiteness argument).

Based on the record before us, even if we were to agree with Appellants that a skilled artisan would understand the recited “smooth inner surface without irregularities” to be limited to the geometrical characteristics of the hollow substrate tube (Appeal Br. 17), we find that all the steps required by method claim 17 are taught or suggested in the prior art. Given the claim language that the recited steps “thereby form[]” the tube with the smooth surface, it is reasonable to conclude that the prior tube obtained from these identical method steps necessarily must also be identical. See In re Best, 562 F.2d 1252, 1255 (CCPA 1977).

“It is a general rule that merely discovering and claiming a new benefit of an old process cannot render the process again patentable.” In re Woodruff, 919 F.2d 1575, 1578 (Fed. Cir. 1990). The mere recitation of a
property or characteristic not disclosed by the prior art does not necessarily confer patentability to a composition or a method of using that composition. See *In re Skoner*, 517 F.2d 947, 950 (CCPA 1975). The patentability of claim 17 is analyzed based on the process steps recited.

Here, the Examiner establishes a reasonable belief that all the process steps are performed in the prior art (detailed analysis *infra*) and Appellants have not shown it is unreasonable to conclude that the prior art process would form the same “etched hollow substrate tube having a smooth inner surface without irregularities.” See *In re Best*, 562 F.2d at 1255.

With regard to the particular process steps, Appellants first argue that neither Hartsuiker 404 nor Hartsuiker 787 teaches or suggests “a plurality of activation glass layers” as recited in claim 17. Appeal Br. 19, 22 (asserting, without sufficient explanation, that the transition deposition layers in Hartsuiker 787 are not activation layers). Appellants, however, do not address the Examiner’s analysis that the specification provides a specific definition of the term “activation glass layer” as well as the term “activating” which is met by the prior art. Compare id., with Non-Final Act. 3 (citing Spec. ¶¶ 39, 46); compare Ans. 12, with Reply Br. 2–4. We are therefore not persuaded that reversible error has been identified with regard to the Examiner’s analysis of the “activation glass layer.”

Appellants’ argument that Hartsuiker 404 does not teach or suggest using the soot ring “to activate the inner surface of its hollow substrate tube” (Appeal Br. 22) is not persuasive of reversible error. To the extent that there is a “new employment of some ‘machine, manufacture or composition of matter’ already known” (if any in this case), “it makes not the slightest difference how beneficial to the public the new function may be, how long a
search it may end, how many may have shared that search, or how high a reach of imaginative ingenuity the solution may have demanded.” *Old Town Ribbon and Carbon Co. v. Columbia Ribbon and Carbon Mfg. Co.*, 159 F.3d 379, 382 (2d Cir. 1947). “It is a general rule that merely discovering and claiming a new benefit of an *old* process cannot render the process again patentable.” *In re Woodruff*, 919 F.2d at 1578. Appellants’ argument that Hartsuiker 404 is not “analogous with” the activation layers because the soot ring in Hartsuiker 404 is undesirable (Appeal Br. 21) is likewise unpersuasive as it does not patentably distinguish the process steps from the prior art and does not show any teaching away.

We are not persuaded that the Examiner reversibly erred in finding that the limitation “a total thickness of the plurality of activation glass layers . . . at least 10 microns and up to 250 microns” is taught or suggested by the prior art. Appellants’ argument – solely directed to some but not all of the teachings of Hartsuiker 404 – does not address the Examiner’s findings with regard to paragraph 27 of Hartsuiker 404, the cited portions of Hartsuiker 778, as well as the Examiner’s rationale as to why a skilled artisan would have found the recited total thickness obvious. *Compare* Appeal Br. 19, *with* Final Act. 3–4 (citing, among others, Hartsuiker 404 ¶ 27, Hartsuiker 778 ¶¶ 12, 36, 37, 41); *compare* Ans. 12, *with* Reply Br. 2–4. No reversible error has been identified in the Examiner’s findings here.

We are likewise not persuaded that the Examiner reversibly erred in finding that the limitation “removing at least 30% of and up to 100% of the plurality of activation glass layers” is taught or suggested by the prior art. Appellants’ argument does not address the Examiner’s findings that paragraph 38 of Hartsuiker 404 describes that “hardly any soot was left”
after the prior art processing steps (including etching). Compare Appeal Br. 20 (discussing only Hartsuiker 404 ¶¶ 27, 30), with Final Act. 4 (citing, among others, Hartsuiker 404 ¶¶ 28, 30–34, 38); compare Ans. 12 (“The rejection points out that one reading '404 would understand that nearly 100% is etched away. Appellant does not dispute this.”), with Reply Br. 2–4. No reversible error has been identified in the Examiner’s findings here.

Appellants’ argument that Hartsuiker 787 is nonanalogous art because Hartsuiker 787 includes a transition deposition step (Appeal Br. 21) is not persuasive of reversible error. Claim 17, reciting a method “comprising the steps of,” is an open-ended claim and does not preclude additional process steps. In any case, Appellants do not argue that Hartsuiker 787 – describing “a method for manufacturing a preform for optical fibres” (Hartsuiker 787 ¶ 14) – is not from the same field of endeavor as method claim 17. See In re Clay, 966 F.2d 656, 658–59 (Fed. Cir. 1992). Appellants’ argument that Hartsuiker 787 describes an additional process step does not persuade us that it is not analogous art.

Appellants do not explain why the argument regarding the transition deposition step in Hartsuiker 787 “contributes to its refractive index” patently distinguishes the prior art process. We note that method claim 17 does not recite any refractive index. This argument therefore does not identify reversible error.

As to Appellants’ argument that the method of Hartsuiker 787 would be rendered inoperable by including the etching step taught in Hartsuiker 404 (Appeal Br. 21), Appellants do not provide sufficient evidence as to why a skilled artisan would consider the Examiner’s proposed combination inoperable. “Attorneys’ argument is no substitute for evidence.” Johnston
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v. IVAC Corp., 885 F.2d 1574, 1581 (Fed. Cir. 1989). No evidence therefore supports Appellants’ argument. We further note that instead of addressing the Examiner’s rationale to combine, Appellants’ argument is directed to incorporating all of the prior art features. It is established that all of the features of the secondary reference need not be bodily incorporated into the primary reference and the skilled artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment. See Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 889 (Fed. Cir. 1984).

NEW GROUND OF REJECTION

We affirm the rejection of claims 17–31 and designate the rejection claims 17–31 based on Hartsuiker 404 and Hartsuiker 787 as a new ground.

DECISION

The rejection of claims 17–31 is affirmed and we designate our affirmance as constituting a new ground of rejection pursuant to 37 CFR § 41.50(b).

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellants, within two months from the date of the decision, must exercise one of the
following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellants may again appeal to the Board pursuant to this subpart.

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

**AFFIRMED: NEW GROUND OF REJECTION PURSUANT TO 37 C.F.R. § 41.50(b)**