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Ascenda Law Group, PC 333 W San Carlos St. Suite 200 San Jose, CA 95110			MENEFFEE, JAMES A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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

CISCO SYSTEMS INC.,
Requester,

v.

CIRREX SYSTEMS, LLC,
Patent Owner.

Appeal 2018-007446
Reexamination Control 95/001,175
Patent 6,415,082 B1
Technology Center 3900

Before KEVIN F. TURNER, JONI Y. CHANG, and
THOMAS L. GIANNETTI, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION

In an earlier Decision on Remand, Appeal No. 2012-006121, mailed February 12, 2018 (“Decision”), we addressed the case on remand from the United States Court of Appeals for the Federal Circuit (“Federal Circuit”). *See Cisco Systems, Inc. v. Cirrex Systems, LLC*, 856 F.3d 997 (Fed. Cir. 2017). The Federal Circuit determined that all claims on appeal were unpatentable for lack of proper written description support, affirming the rejections of claims 38–41, 43–47, 49, 50, 58–61, 75, 84–87, 89–93, 95, 96,

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104–107, and 121, and reversing the patentability findings with respect to claims 56, 57, 76, 102, and 103. *Id.* at 1011. In our Decision on Remand, we determined that claims 56, 57, 76, 102, and 103 are unpatentable as lacking proper written description support under 35 U.S.C. § 112, first paragraph, consistent with the Federal Circuit’s directive, and denominated that rejection as a new ground of rejection under 37 C.F.R. § 41.77(a). Decision 8.

Thereafter, Patent Owner sought to reopen prosecution, filing a Request to Reopen Prosecution (dated March 12, 2018) (“Request”) that proposed amendments of the subject claims. We granted the Request, in part, determining that proposed amendments to claims 56, 57, 76, 102, and 103, “appear to be responsive to the new ground of rejection,” but that Patent Owner failed to present any support of arguments that the newly proposed claims, i.e., claims 125–129, are necessary to overcome the new ground of rejection. “Order Remanding *Inter Partes* Reexamination Under 37 C.F.R. § 41.77(d) to the Examiner,” dated May 25, 2018 (“Order”), 2–3. Thereafter, we remanded to the Examiner to provide a determination whether the new ground of rejection enumerated in the Decision dated February 12, 2018, is maintained or has been overcome under 37 C.F.R. § 41.77(d), and whether any new grounds of rejection apply to the pending claims (i.e., claims 56, 57, 76, 102, and 103). Order 3.

In accordance with 37 C.F.R. § 41.77(e), the Examiner determined “that the rejection will be maintained.” “Examiner’s Determination Under 37 C.F.R. § 41.77(d),” dated June 6, 2018 (“Examiner’s Determination”), 3. The Examiner determined that each amended claim requires “attenuation

material within the optical paths of the PLC equalizing signal strength across a spectral range of channels,” which is supported, generally, by the disclosure of subject patent, but that the same disclosure does not support the amended claim in combination with the features of their associated independent claims. *Id.* at 3–4.

Pursuant to 37 C.F.R. § 41.77(f), the proceeding has been returned to the Board so that we may reconsider the matter and issue a new decision.

Patent Owner argues that “[s]upport for the foregoing amendments . . . is found, in particular, in Figure 13 and in Column 14, line 58 through Column 15, line 28 of the specification.” Request 7. With respect to claim 56, Patent Owner argues, for example, that, as amended, the claim

recites a cross-connect waveguide system operative to equalize signal strength across a spectral range of channels by applying attenuation to each channel utilizing attenuation material within optical paths of the planar lightguide circuit. This language finds direct support in the specification of the ’082 patent, which, as noted above, indicates that appropriate attenuation can be applied to each channel to equalize the signal strength across a spectral range of channels. Furthermore, the specification states the attenuation material can be included within the zigzag-depicted optical path within the planar lightguide circuit (PLC).

Id. at 9.

As the Examiner notes, however, each of independent claims 1, 26, 31, no longer pending, recites a planar lightguide circuit (PLC) having one or more optical paths and *a diverting element* for feeding certain light energies into or away from the PLC. Examiner's Determination 4. As such, each independent claim is drawn to the diverting element embodiment in the ’082 patent, having a diverting element 1000, such as the embodiment illustrated in Figure 10. *Id.* The Examiner contrasts this embodiment with

the embodiment illustrated in Figure 13, which has no diverting element, and upon which Patent Owner ascribes written description support. *Id.* at 5. The Examiner also points out that the claimed diverting element for feeding certain light energies into or away from the PLC is not illustrated or described as being part of the Figure 13 embodiment, and the '082 patent provides for no embodiments “including *both* diverting elements such as 1000 and attenuation elements such as 1300 in a single system as the claims require.” *Id.*

We are persuaded by the Examiner’s analysis that amended claims 56, 57, 76, 102, and 103 do not have written description support in the disclosure of the '082 patent. Although the embodiments of Figures 10 and 13 are recited in the same disclosure and could conceivably be combined, per the amended claim’s recitations, written description support cannot be derived from obvious variants of its disclosure.

The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.

Lockwood v. Am. Airlines, Inc., 107 F.3d 1565, 1572 (Fed. Cir. 1997).

Similarly, in *Hyatt v. Dudas*, the Federal Circuit explained that the examiner had sufficiently established a *prima facie* case of lack of written description by explicitly explaining that “while each element may be individually described in the specification, the deficiency [is] the lack of adequate description of their *combination*.” 492 F.3d 1365, 1371 (Fed. Cir. 2007).

As such, we concur with the Examiner's analysis and determine that claims 56, 57, 76, 102, and 103 as amended do not overcome the new grounds of rejection under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. Pursuant to 37 C.F.R. § 41.77(f), this decision is deemed to incorporate our earlier decisions, except as indicated.

DECISION

Claims 56, 57, 76, 102, and 103 remain rejected under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement.

In accordance with 37 C.F.R. § 41.79(a)(4), the “[p]arties to the appeal may file a request for rehearing of the decision within one month of the date of: . . . [t]he new decision of the Board under § 41.77(f).” A request for rehearing must be in compliance with 37 C.F.R. § 41.79(b). Comments in opposition to the request and additional requests for rehearing must be in accordance with 37 C.F.R. § 41.79(c)–(d), respectively. Under 37 C.F.R. § 41.79(e), the times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (c) of this section, and for submitting comments under paragraph (b) of this section may not be extended.

An appeal to the United States Court of Appeals for the Federal Circuit under 35 U.S.C. §§ 141–144 and 315 and 37 C.F.R. § 1.983 for an *inter partes* reexamination proceeding “commenced” on or after November 2, 2002 may not be taken “until all parties’ rights to request rehearing have been exhausted, at which time the decision of the Board is

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final and appealable by any party to the appeal to the Board.” 37 C.F.R. § 41.81. *See also* MPEP § 2682 (8th ed., Rev. 8, July 2010).

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).

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. §§ 1.304, 1.956, and 41.79(e). *See* 37 C.F.R. § 41.79.

In the event neither party files a request for rehearing within the time provided in 37 C.F.R. § 41.79, and this Decision becomes final and appealable under 37 C.F.R. § 41.81, a party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

AFFIRMED

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