

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES R. LARGENT

Appeal No. 2000-1844
Application No. 08/506,794

ON BRIEF

Before CALVERT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4 to 11 and 21, which are all of the claims pending in this application.¹

We REVERSE.

¹ Claims 1 and 4 were amended subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to a method of vision correction. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

| | | |
|-----------------------------------|-----------|---------------|
| L'Esperance, Jr. (L'Esperance) | 4,729,372 | March 8, 1988 |
| Ruiz 1996 | 5,533,997 | July 9, |

Claims 1, 2, 4 to 11 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over L'Esperance in view of Ruiz.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 20, mailed October 4, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 19,

filed June 7, 1999) and reply brief (Paper No. 21, filed December 13, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 2, 4 to 11 and 21 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would

have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree for the reasons that follow.

Independent claim 1 reads as follows:

A method of vision correction comprising shaping first, second and third regions of a cornea having an anterior surface to provide the first region located on the anterior surface with a first vision correction power and the second region located on the anterior surface with a second vision correction power which is different from the first vision correction power to enhance vision at first and second different distances, respectively, and the third region located between the first and second regions with progressive vision correction powers which include progressive vision correction powers which are between the first and second vision correction powers.

After reviewing the teachings of the applied prior art, it is our conclusion the subject matter of claim 1 would not have been obvious at the time the invention was made to a person

having ordinary skill in the art.² In that regard, it is our opinion that the applied prior art does not teach or suggest the "third region" as recited in claim 1.

Independent claim 7 reads as follows:

A method of vision correction comprising: shaping first and second annular regions of the anterior surface of a cornea to provide a first anterior surface annular region with a first vision correction power and a second anterior surface annular region with a second vision correction power which is different from the first vision correction power to enhance vision at first and second different distances, respectively; and shaping a third annular region of the anterior surface of the cornea between said first and second anterior surface annular regions to provide a third anterior surface annular region with progressive vision correction powers which include progressive vision correction powers which are between the first and second vision correction powers, said second anterior surface annular region circumscribing the first anterior surface annular region.

Once again, after reviewing the teachings of L'Esperance and Ruiz, it is our conclusion the subject matter of claim 7 would

² In the rejection before us in this appeal (see page 3 of the answer), the examiner did not ascertain the differences between the prior art and any of the claims at issue. Additionally, the examiner never determined if the ascertained differences between the subject matter sought to be patented and the prior art (i.e., L'Esperance) are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

not have been obvious at the time the invention was made to a person having ordinary skill in the art. In that regard, it is our opinion that the combined teachings of L'Esperance and Ruiz are not suggestive of the "third anterior surface annular region" as recited in claim 7.

Independent claim 10 reads as follows:

A method of vision correction comprising: directing laser energy to a mask to provide a modulated laser beam having different energy levels at different locations across the modulated laser beam; and directing the modulated laser beam to a cornea of a patient to ablate a region of the cornea to different degrees to provide the cornea with progressive vision correction powers.

It is our conclusion the subject matter of claim 10 would not have been obvious at the time the invention was made to a person having ordinary skill in the art from the combined teachings of L'Esperance and Ruiz. In that regard, it is our opinion that the combined teachings of L'Esperance and Ruiz are not suggestive of directing a modulated laser beam to a cornea of a patient in which the modulated laser beam has different energy levels at different locations across the modulated laser beam as recited in claim 10.

In our view, the only suggestion for modifying L'Esperance to meet the above-noted limitations of claims 1, 7 and 10 would stem from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L.

Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553,
220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S.
851 (1984).

For the reasons set forth above, the decision of the
examiner to reject independent claims 1, 7 and 10, and claims
2, 4 to 6, 8, 9, 11 and 21 dependent thereon, under 35 U.S.C.
§ 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 1, 2, 4 to 11 and 21 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)
Administrative Patent Judge)
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) BOARD OF PATENT
JOHN P. McQUADE) APPEALS
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