

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DANIEL G. BRADY, CHRISTOPHER DOYLE
and BERNARD F. GRISONI

Appeal No. 2003-0260
Application No. 09/507,601

ON BRIEF

Before COHEN, ABRAMS, 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 21 and 34 to 37, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to an intraocular lens (IOL) with a deformable optic which enables the IOL to be passed through an incision into the eye (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellants' brief. Claims 21 and 34, the independent claims under appeal, read as follows:

21. An intraocular lens for implantation in an eye comprising:
 - a resilient, deformable silicone based optic having at least about 20 diopter power, said optic having a periphery and being configured so that the optic can be resiliently deformed from a normal optical condition into a deformed insertion condition to permit the intraocular lens to be passed through a scleral tunnel incision of no longer than about 3.2 millimeters into the eye;
 - fixation means coupled to the optic for retaining the optic in the eye, the fixation means including first and second generally C-shaped resilient fixation members coupled to the optic at generally diametrically opposed locations; and
 - said optic when implanted in the eye being in a normal optical condition and having sufficient rigidity to be substantially free of optical distortion resulting from force from the eye acting on the intraocular lens and said optic when implanted in the eye being of sufficient size to substantially prevent glare resulting from interaction of light and the periphery of the optic.

34. An intraocular lens for implantation in an eye comprising:
 - a resilient, deformable silicone based optic having at least about 20 diopter power, said optic having a periphery and being configured so that the optic can be resiliently deformed from a normal optical condition into a deformed insertion condition to permit the intraocular lens to be passed through an incision of no longer than about 3.2 millimeters into the eye;
 - fixation means coupled to the optic for retaining the optic in the eye, the fixation means including elongated, resilient fixation members extending curvedly radially from the optic; and
 - said optic when implanted in the eye being in a normal optical condition and having sufficient rigidity to be substantially free of optical distortion resulting from force from the eye acting on the intraocular lens and said optic when

implanted in the eye being of sufficient size to substantially prevent glare resulting from interaction of light and the periphery of the optic.

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

Kelman	4,608,049	Aug. 26, 1986
Stoy	4,731,079	Mar. 15, 1988
Blumenthal	4,840,627	June 20, 1989

Claims 21 and 34 to 37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kelman in view of Stoy or Blumenthal.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 16, mailed June 4, 2002) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 15, filed March 4, 2002) and reply brief (Paper No. 17, filed August 12, 2002) for the appellants' arguments thereagainst.¹

¹ The rejection of claims 21 and 34 to 37 under 35 U.S.C. § 102(b) was withdrawn by the examiner in the answer (p. 2).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants 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 21 and 34 to 37 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).

In the obviousness rejection before us in this appeal (answer, pp. 3-4), the examiner (1) ascertained² that Kelman meets the claim language except for the dioptic power; and (2) concluded that it would have been obvious, in view of either Stoy or Blumenthal, to make the Kelman lens into a 20 diopter power lens or greater so that greater correction could be made to a patient's eye who is in need of such.

The appellants argue (brief, pp. 6-12; reply brief, pp. 1-4) that Kelman does not meet all the claim language except for the dioptic power. Specifically, the appellants argue that the fixation means coupled to a resilient, deformable silicone based optic as recited in independent claims 21 and 34 is not taught by Kelman. We agree.

Kelman teaches two embodiments of an intraocular lens for implantation in an eye having a resilient, deformable silicone based optic.³ The first embodiment (Figures 4-6) has a deformable lens body 71 with a diameter of 6 mm. made of silicone rubber. The lens body 71 may be molded, glued or otherwise attached to a position-fixation member 72, preferably along a chord of the lens body 71. The second embodiment

² After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). In this rejection, the examiner did not set forth the pertinent teachings of the applied prior art.

³ The other embodiments of Kelman (i.e., the embodiment of Figures 1-3 and the embodiment of Figures 9-10) of an intraocular lens for implantation in an eye do not have a resilient, deformable silicone based optic.

(Figures 7-8) has a deformable lens body 80 made of silicone rubber fixed in position by a position-fixation member 75 similar to the position-fixation member 72 but with a flexible loop 76.

The position-fixation members 72 and 75 of Kelman do not include first and second generally C-shaped resilient fixation members coupled to the optic at generally diametrically opposed locations as recited in claim 21. Likewise, the position-fixation members 72 and 75 of Kelman do not include elongated, resilient fixation members extending curvedly radially from the optic as recited in claim 34.

Thus, even if it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have made the Kelman resilient, deformable silicone based optic to have at least about 20 diopter power, the claimed subject matter would not have resulted since the Kelman resilient, deformable silicone based optic does not include the claimed fixation means coupled thereto.⁴

⁴ On page 5 of the answer, the examiner posits that C-shaped resilient fixation members on the deformable lens of Kelman would have been obvious to an artisan. We note that this obviousness determination is not part of the rejection before us in this appeal and therefore we need not further comment on this issue other than to say there is no evidence presented by the examiner to support it.

For the reasons set forth above, the examiner has not established the obviousness of the claimed subject matter. Accordingly, the decision of the examiner to reject claims 21 and 34 to 37 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 21 and 34 to 37 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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