

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FU-PAO TSAO and ROSALIND DANRIDGE

Appeal No. 1996-2766
Application No. 08/258,909

HEARD: February 22, 2000

Before GARRIS, PAK, and WALTZ, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 15 through 17, 19 through 22 and 24. Claims 18 and 23, the only other claims remaining in this application, stand objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form. Therefore, claims 18 and 23 are not included in this appeal (Brief, page 2, and Answer, page 1).

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According to appellants, the invention is directed to compositions and dosage forms for cleaning protein and lipid deposits from the lens surface of contact lens by providing a cleaning composition which increases the pH to a basic level using substantially no protein-digesting enzyme or protein-dissolving surfactant (Brief, pages 2-3). Claim 15 is illustrative of the subject matter on appeal and a copy of this claim is reproduced below:

15. A solid pH-controlled cleaner dosage form, comprising:

a) a tonicity builder comprising a water-soluble salt compatible with ocular tissue; and

b) a pH regulator selected from the group consisting of basic acetates, phosphates, borates, nitrates, sulfates, tartrates, lactates, carbonates, bicarbonates, and mixtures thereof, whereby dissolution of said pH regulator in an aqueous environment results in a protein cleaning composition having a pH of 7.5 to 11.5,

wherein said composition includes substantially no protein-digesting enzyme and wherein a protein-dissolving effective amount of surfactant is absent from said composition.

The examiner has relied upon the following references as evidence of obviousness:

Fu	4,323,467	Apr. 6, 1982
Davies et al. (Davies)	4,863,627	Sep. 5, 1989

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The claims on appeal stand rejected under 35 U.S.C. § 103 as unpatentable over Fu in view of Davies (Answer, page 3).¹ We reverse this rejection for reasons which follow.

OPINION

The examiner finds that Fu discloses a solution for cleaning a contact lens comprising a tonicity agent, a viscosity builder, a sequestering agent and water (Answer, page 3). The examiner further finds that Fu does not disclose or suggest the inclusion of an enzyme but discloses the addition of an ethylenediamine surfactant in amounts as little as 0.01% (*Id.*). The examiner submits that appellants have not shown that the range of surfactant taught by Fu (as low as 0.01%) "is not encompassed by the instant negative limitation 'substantial absence of a surfactantly effective amount of surfactant.'" (Answer, page 5).² The examiner further notes

¹The final rejection of claims 18 and 23 under the first paragraph of 35 U.S.C. § 112 has been withdrawn by the examiner in view of appellants' response dated Sep. 27, 1995, Paper No. 27 (see the Advisory Action dated Nov. 14, 1995, Paper No. 28).

²The "instant negative limitation" quoted by the examiner is incorrect. The claimed provision reads "wherein a protein-dissolving effective amount of surfactant is absent from said composition." (see claim 15 on appeal).

that the claims are drafted using the term "comprising" which opens the claimed composition to additional adjuvants, even in major amounts (*Id.*).

Appellants argue that the Fu compositions require the presence of a "protein-dissolving effective amount of surfactant." (Brief, page 5). Appellants further argue that even if Fu and Davies were combined as proposed by the examiner, the combination would require more than a protein-dissolving effective amount of surfactant, otherwise the Fu composition would not effectively perform its cleaning function (Brief, page 6).

Fu teaches that the "cleaning and wetting functions of these solutions can be achieved when the surfactant is present in a non-irritating amount and which is 0.01% to 40% by weight of the solutions." (column 4, lines 37-40). Fu also contains the following disclosure:

agents contact capable (column 7,	Tetronic® polyols disclosed herein as wetting also have utility for removing soilants from lenses. All the solutions described above are of effectively removing proteins, fats, mucopolysaccharides and other soilants that may accumulate on lenses during normal wear. lines 46-51).
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Accordingly, the above quoted disclosure from Fu teaches that the compositions of this reference contain a protein-removing effective amount of surfactant. The claims on appeal require that "a protein-dissolving effective amount of surfactant is absent" from the claimed composition (see claim 15 on appeal).³ The examiner, not the appellants, bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The examiner has not shown or established, by evidence or convincing reasoning, why one of ordinary skill in the art would have excluded the effective protein-removing amount of surfactant used in the compositions of Fu.

The examiner notes that the claims are drafted with the term "comprising" which opens the claim to additional adjuvants (Answer, page 5). This claim interpretation is not well taken since the plain meaning of the claims cannot be altered by the common interpretation of "comprising", i.e.,

³On this record, there is no allegation or evidence that the effective protein-removing by the surfactant of Fu differs from the "protein-dissolving" by the surfactant as recited in the claims on appeal.

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the claims require the absence of a protein-dissolving effective amount of surfactant.

The examiner's combination of Davies with the primary reference to Fu does not remedy the deficiency discussed above as Davies is applied by the examiner for the teaching that contact lens cleaners are formulated in a solid form for superior cleaning performance (Answer, pages 4-5). In addition to the deficiency in Fu discussed above, the examiner has not provided any reason or suggestion for the proposed combination of Fu and Davies. Davies discloses a disinfecting/cleaning composition which contains a hydrogen peroxide source which would be inactivated by water. Thus the disinfecting unit form must be a solid (see Davies, column 1, lines 5-13; column 2, lines 14-18; column 3, lines 9-18; column 6, lines 10-17). The examiner has not presented evidence or convincing reasoning of any teaching, suggestion or motivation to support the proposed combination of Fu and Davies, considering that the cleaning composition of Fu does not contain hydrogen peroxide and is in aqueous form. See *In*

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re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

For the foregoing reasons, we determine that the examiner has failed to establish a *prima facie* case of obviousness in view of the reference evidence. Accordingly, the rejection of the claims on appeal under 35 U.S.C. § 103 over Fu in view of Davies is reversed.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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THOMAS A. WALTZ)	

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APJ PAK

APJ GARRIS

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):
Prepared: October 16, 2000

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT