

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(2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN KURTIN, DANIEL E. FEDELE
and SAUL EPSTEIN

Appeal No. 97-1697
Application No. 08/336,170¹

ON BRIEF

Before McCANDLISH, Senior **Administrative Patent Judges** and
COHEN and PATE III, **Administrative Patent Judges**.

PATE, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow
claims 1 through 3, 8 through 10, 22, 23, 26, and 27 as
amended after the final rejection. Claims 5, 6, 12, 14
through 21, 25, and 28 through 32 have been indicated as

¹ Application for patent filed November 08, 1994.

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directed to allowable subject matter. These are all the claims in the application.

The claimed invention relates to an eyeglass having a variable focus lens system. The lens includes both a rigid glass element and a distensible transparent plastic element with a space therebetween filled with a transparent liquid. A mechanical system is provided in the frame to change the shape of the distensible filled membrane thereby changing the focal length of the lens.

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. In a variable focus lens of the type having a lens assembly comprising a rigid lens, a distensible membrane spaced from said rigid lens, and liquid filling the space between said rigid lens and said distensible membrane, where the focal length of said variable focus lens is varied by changing the spacing between said rigid lens and said distensible membrane, an actuation system which comprises:

a finger operated positioner;

a flexible elongated operating member moveable lengthwise responsive

to movement of said finger operated positioner;

a supporting structure of said flexible elongated operating member

for preventing compressive buckling; and

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actuator means responsive to

movement of said elongated operating member for causing said spacing between said rigid lens and said distensible membrane to change.

The reference of record relied upon by the examiner as evidence of anticipation is:

Kurtin et al. (Kurtin)	5,371,629	Dec. 06,
1994		
		(filed Feb. 4,
1993)		

THE REJECTION

Claims 1 through 3, 8 through 10, 22, 23, 26, and 27 stand rejected under 35 U.S.C. § 102 as anticipated by Kurtin. On page 4 of the examiner's answer, the examiner states that the Kurtin reference shows a variable focus length lens with a distensible membrane and a space between the lens and the membrane filled with a liquid. The actuating system of Kurtin has, according to the examiner, a flexible elongated operating member (**16**), a support structure for the member (frame **10** and/or pivot **17**), a finger-operated positioner (**20**) and a means for changing the space between the rigid lens and the distensible membrane (screw **21**).

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Beginning on page 9 of the Brief, appellants argue that Kurtin does not disclose a flexible elongated operating member, nor does Kurtin disclose a supporting structure for the operating member. Appellants are further of the view that there is no finger operated positioning member in Kurtin for moving the operating member lengthwise. Finally, in the Reply Brief, appellants take issue with the examiner's argument that pin **17** of hinge **16** could be considered part of the support for the elongated flexible member.

OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of the appellants and the examiner. As a result of this review we have reached the determination that the applied prior art does not anticipate independent claims 1 and 22 on appeal. Therefore, the rejection of all claims on appeal is reversed. Our reasons follow.

Turning to the appellants' first argument with respect to the examiner's finding of anticipation, appellants argue that

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the Kurtin reference does not show a flexible elongated operating member movable lengthwise in response to movement of the finger-operated positioner. We find it unnecessary to make a factual finding about whether members **16'** and **16"** of the Kurtin reference are flexible elongated operating member, inasmuch as it is clear that members **16'** and **16"** do not move lengthwise in response to movement of the finger operated positioner knurled nut **20**.

Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). A prior art reference anticipates the subject matter of a claim when that references discloses, either expressly or under the principles of inherency, each and every element set forth in the claim. **See In re Paulsen**, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1673, (Fed. Cir. 1994). The law of anticipation does not require that the reference teach what the appellants are claiming but only the claims on appeal read

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on something disclosed in the reference. **See Kallman v. Kimberly-Clark Corp.** 713 F.2d, 760, 772, 218 USPQ 781, 799, (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984), **overruled-in-part on another issue**, 775 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1990). As noted by us above, we are in agreement with the appellants that the applied prior art to Kurtin does not disclose a flexible elongated operating member movable lengthwise responsive to movement of the finger-operated positioner. For this reason, no finding of anticipation based on the Kurtin reference is proper. The rejection of the claims on appeal is reversed.²

² With respect to the actuator means as the ultimate limitation in claim 1, we note that "actuator means" is stated in means plus function language which triggers the application of 35 USC § 112, paragraph 6. Therefore, one construing the means-plus-function language in the claim must look to the specification and interpret the language of the claim in light of the corresponding structures, material, or acts described in the specification and equivalents thereof. The actuator means disclosed in the specification are the cam **30** and the cam follower **12**. The actuator tab **19** of the reference is not seen to correspond to this structure and its equivalents.

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No period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

HARRISON E. McCANDLISH)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
WILLIAM F. PATE III)	
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APJ PATE

APJ COHEN

APJ McCANDLISH

DECISION: ***REVERSED***
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): 102

Prepared: January 24, 2000

Draft Final

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PALM / ACTS 2 / BOOK
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