

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(2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CONTEX INC.

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Appeal No. 98-1949  
Reexamination No. 90/004,323<sup>1</sup>

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HEARD: Aug. 4, 1998

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Before KRASS, FLEMING, and LEE, Administrative Patent Judges.  
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of  
claims 1 through 20 in this reexamination proceeding of U.S.  
Patent No. 5,191,365.

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<sup>1</sup> Reexamination proceeding for U.S. Patent No.  
5,191,365, issued March 2, 1993, to Nick Stoyan, and based on  
application 07/748,845, filed August 23, 1991. Reexamination  
request filed August 2, 1996.



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Hanisch, "Orthokeratology Through the Use of an 'O.K.' Fitting Set," Orthokeratology, vol. 3, pp. 133-136, 1976.

Claims 1 through 20 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Fontana '76 in view of Hanisch with regard to claims 1 through 16, 19 and 20, adding Graham to this combination with regard to claims 17 and 18.

Rather than reiterate the arguments of appellant and the examiner, reference is made to the briefs and answer for the respective details thereof.

#### OPINION

We affirm.

In applying Fontana '76 against the claims, the examiner notes that the reference is also directed to reshaping the cornea through the use of a contact lens which has a central zone of a particular diameter and radius of curvature, a "tear zone," which the examiner identifies as Fontana's paracentral or Fit on "K" zone, with a radius of curvature smaller than the radius of curvature of the central zone, the tear zone having a particular thickness, and a peripheral zone located

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concentrically around the tear zone and integral therewith. The examiner further notes that the peripheral zone has a radius of curvature greater than or equal to the radius of curvature of the central zone and that the reference discloses an intermediate transition-type zone between the tear zone and the peripheral zone. Reference is made to the figure on page 82 of Fontana '76.

Recognizing that Fontana '76 does not specifically disclose a transition zone, having a plurality of transition rings, as claimed, and that Fontana '76 does not specifically disclose a peripheral zone, as claimed, the examiner relies on Hanisch to supply these deficiencies.

Appellant's first argument is that neither Fontana '76 nor Hanisch discloses or suggests the claimed tear zone. More particularly, appellant interprets the term "tear zone" to mean a circular tear channel or duct, providing a reservoir of tear fluid that helps position the lens centrally on the cornea and enhances lens wearing comfort, citing column 3, lines 51-56 of the patent under reexamination. However, the claims do not require so narrow an interpretation of the term

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"tear zone" as there is nothing therein requiring the use of a tear zone to help position the lens centrally on the cornea nor is there any requirement in the claims that such a tear zone enhance lens wearing comfort. In any event, we agree with the examiner that Fontana '76 clearly suggests the "tear zone." Although not labeled as such in Fontana '76, the reference does disclose a fit on "K" zone [see page 82] which is located concentrically around a center zone and has a radius of curvature and a radial thickness. The radius of curvature of the fit on "K," or tear zone, of Fontana '76 is smaller than the central zone radius of curvature.

Appellant vigorously argues that the fit on "K" zone of Fontana '76 is not a tear zone because this portion of Fontana '76 contacts the eye and therefore cannot provide for a reservoir of tear fluid. Appellant relies on a declaration by Dr. Wlodyga, filed in a related reexamination of another Stoyan patent, wherein Dr. Wlodyga explains Figure 1 of another Fontana article, Fontana '74, in order to show how portions of the lens in that article which are in contact with

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the eye differ from the portions of the lens in the instant invention which contact the eye. We find the Wlodyga declaration to be unpersuasive of nonobviousness of the subject matter before us. The instant rejection involves Fontana '76 as the primary reference. Yet, the Wlodyga declaration refers only to Fontana '74. Therefore, the declaration is irrelevant to the issue before us because even assuming, arguendo, that we accept all that declarant would have us accept, this still does not address the issue as to why Fontana '76 does not suggest the instant claimed subject matter even if Fontana '74 does not.

Appellant appears to want to treat the two Fontana references as identical, although there is no indication that they are so identical. Even if Fontana '74 does, somehow, fail to disclose the claimed tear zone, Fontana '76, two years later, may be describing an improvement over the Fontana '74 lens which includes such a tear zone. Although a fit on "K" portion of a lens might, conventionally, be interpreted as a base curve which conforms to, and thus contacts, the cornea, the disclosure of Fontana '76 would appear to suggest

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otherwise. More particularly, at page 83 of the reference, it is stated that the

fluorescein pattern should be one in which there is a slight apical contact at the center of the lens and good drainage throughout the remainder of the lens area.

Accordingly, Fontana '76 appears to suggest contact at the center of the lens, i.e., in the center circle portion, or zone, depicted on page 82 with "good drainage," i.e., a "tear zone," throughout the remainder of the lens depicted at page 82. Thus, the examiner appears to have made out a prima facie case of obviousness at least with regard to the claimed "tear zone" and appellant has not convinced us that the examiner's interpretation of Fontana '76, in this regard, is in error.

Appellant's argument that Hanisch does not disclose the claimed "tear zone" is not persuasive because, as explained supra, it is Fontana '76 which we and the examiner rely on for such a teaching.

Appellant's next argument is directed to the claimed transition rings. Claim 1, for example, requires a "transition zone" that comprises "at least one transition ring having a radius of curvature which is between the radius of

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curvature of said central zone and said tear zone..." While the examiner relies on Hanisch for a teaching of the claimed transition ring, appellant contends that Hanisch's teaching of "blending" between basic curves is not a suggestion of the claimed transition ring. Again, we agree with the examiner.

Clearly, the radius of curvature of the central zone in Fontana '76 is different from the radius of curvature of the tear zone, or fit on "K" zone, of Fontana '76. Accordingly, artisans would have known that there should be some transition between these two curves. Hanisch recognized this and sought to improve lenses by providing for

better blending between the basic curves to allow better drainage and more gradual flattening peripheral curves beyond the paracentral area...for a smooth static tear flow enhancing comfort and rapid corneal changes without arcing from unblended areas bearing on the cornea [page 134].

Accordingly, it would have been obvious to the skilled artisan to provide for such "blending" between the basic curves in Fontana '76. Such a "blending" would obviously have entailed a transition zone between the two zones to be blended, i.e., the central zone and the tear zone. Clearly, to go from one

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curve having a first radius of curvature to a second curve, having a second radius of curvature, the transition zone must have a radius of curvature which is between the first and second radius of curvature. This is all that the "transition ring" of instant claim 1 requires. Thus, contrary to appellant's position, the "better blending" suggested by Hanisch does, indeed, suggest the provision of one or more transition rings as recited in the instant claims.

Appellant also argues [bottom of page 10 of the principal brief] that Hanisch does not disclose or suggest the plurality of peripheral rings with increasing radii of curvature of claims 2, 5, 12, 13 and 20 while the reference also does not disclose or suggest the plurality of transition rings with increasing radii of curvature of claims 3, 4 and 9 through 11. We disagree.

For the reasons supra, in our view, Hanisch does suggest the claimed rings because it suggests a blending between curves of differing radii of curvature. It would have been obvious to artisans, within the meaning of 35 U.S.C. § 103, that, given such a teaching, one may transition between two

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different curves with a single transition ring spanning between the two different radii of curvature or, if desired, a plurality of such transition rings, with as many increments as desired, may be employed to gradually span the two different radii of curvature. Either way would have been equally obvious to the skilled artisan, with a greater plurality of transition rings being employed for a smoother transition.

It is noted that while Hanisch does not explicitly disclose transition "rings" as actual circular elements, the "rings" of the instant claims do not require such circular elements. The claimed transition and peripheral "rings" are defined by their recited functions of providing transitions between different radii of curvature and this function is clearly suggested by the "blending" of Hanisch. Accordingly, we find the instant claimed subject matter to have been obvious within the meaning of 35 U.S.C. § 103.

Appellant's argument that the combination of Fontana '76 and Hanisch would not yield the present invention [page 11 of the principal brief] is not persuasive because appellant bases

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this conclusion on the faulty premise that Hanisch suggests that the "better blending" between curves is accomplished by polishing. We are aware of nothing in Hanisch which discloses polishing as the manner in which Hanisch accomplishes the disclosed "better blending." Taken as a whole, together with the teaching of Fontana '76, we find the applied references to clearly suggest the instant claimed subject matter.

Finally, Appellant argues that neither Fontana '76 nor Hanisch provides for the comfort problem that the instant invention solves. We find this argument to be unpersuasive first, because the instant claims recite nothing about such "comfort" and, second, because there is no evidence in this record relating to the comfort of the instant lenses compared to the comfort achieved by prior art lenses.

In appellant's reply brief, there is an argument regarding the order of cutting the lens in Fontana as compared with the order of cutting the lens of the instant invention. Appellant contends that the declaration of Dr. Wlodyga supports the contention that the manner of cutting the Fontana lens would clearly have not provided for the properties of the

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claimed zones. Appellant also contends that the Blackburn declaration, submitted by the third party requestor in the reexamination proceedings involving the Stoyan patents, and purporting to show that the Fontana lens was actually made and did, indeed, result in the instant claimed invention, is faulty because the paracentral curve was not cut first, as suggested by Dr. Wlodyga and Fontana.

We have considered the declarations and the arguments regarding how the Fontana lens would be cut but we are unpersuaded of the unobviousness of the instant claimed subject matter.

With regard to the Blackburn declaration, we find this declaration faulty as it raises many questions as to how, exactly, the lens was made, what cuts were made in what order, etc. Also, since the declaration was submitted by a party whose interests are adverse to appellant's and the declarant is unavailable for cross-examination, it would appear to be unfair to appellant to accept the Blackburn declaration, without more, at face value.

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With regard to the Wlodyga declaration, as explained supra, as this declaration is not directed to Fontana '76, but only to Fontana '74, and there is no reason to accept that they are one and the same lens being disclosed, it does not seem to have any probative value with regard to what Fontana '76 teaches or suggests.

For the reasons supra, we hold that the examiner has established a prima facie case of obviousness under 35 U.S.C. § 103 with regard to the instant claimed subject matter and that appellant has not overcome that prima facie case either by argument or evidence.

Accordingly, the examiner's decision rejecting claims 1 through 20 under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

	Errol A. Krass	)	
	Administrative Patent Judge	)	
		)	
		)	
	Michael R. Fleming	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	Jameson Lee	)	
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