

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte N. THORTON LIPSCOMB  
And OMAR M. BUAZZA

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Appeal No. 1999-1071  
Application No. 08/453,770

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ON BRIEF

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Before GARRIS, WALTZ and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal from the final rejection of claims 41-47, 49-58, 60-76, 81-85, 87-94, 97, 98, 100-103, 105, 106, 108-110, 112-120, 122-129, 131-140, 142-158, 163-167, 169-176, 179, 180, 182-185, 187, 188, 190-192, 194-202, and 204-229. With respect to the status of the other claims of the present application, we refer to pages 2 and 3 of appellants' brief, and note that these other claims are not under consideration in the appeal.

The subject matter on appeal is represented by process claim 94, and product claims 176 and 207, set forth below:

**94.** A process for making a plastic eyeglass lens using a composition comprising a photoinitiator, an aromatic containing bis(allyl carbonate)-functional monomer, and at least one polyethylenic-functional monomer containing at least two ethylenically unsaturated groups selected from acrylyl and methacrylyl, the process comprising:

placing a lens forming composition into a mold cavity formed at least in part by a first mold member with a casting face and a noncasting face, and a second mold member with a casting face and noncasting face, the composition comprising a photoinitiator, an aromatic containing bis(allyl carbonate)-functional monomer, and at least one polyethylenic-functional monomer containing at least two ethylenically unsaturated groups selected from acrylyl and methacrylyl, and wherein the composition is curable by exposure to ultraviolet light to form a substantially clear eyeglass lens in a time period of less than one hour;

curing the lens forming composition to form a substantially clear eyeglass lens by exposing the composition to ultraviolet light for a time period of less than one hour; and

cooling at least a portion of the mold cavity, the cooling being conducted while the lens forming composition is curing.

**176.** An eyeglass lens prepared using the process of claim 94.

**207.** An eyeglass lens prepared using the process of claim 94 wherein the eyeglass lens is substantially free of distortions, cracks, patterns, and striations.

The references relied upon by the examiner as evidence of unpatentability are:

Kaetsu et al. (Kaetsu)	4,138,538	Feb. 6, 1979
Rips	4,252,753	Feb. 24, 1981
Misura et al. (Misura)	4,622,376	Nov. 11, 1986
Matsuo et al. (Matsuo)	4,983,335	Jan. 8, 1991

I. Claims 41, 44-47, 49-58, 60-76, 81-85, 89, 94, 98, 100-103, 105, 117, 118, 120, 123, 126-129, 131-140, 142-158, 163-165, 167, 171, 176, 180, 182-185, 187, 199, 200, 202, 205, 206, 207, 209-211, 213-215, 217-219, 221-224 and 226-229 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kaetsu in view of Misura.

II. Claims 41-43, 54, 84, 85, 87, 92, 93, 119, 124, 125, 136, 166, 167, 169, 174, 175, 179, and 201 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kaetsu and Misura as applied to claims 94, 41 and 117 above, and further in view of Rips.

III. Claims 65, 66, 67, 68, 88, 90, 91, 103, 106, 108, 110, 112-116, 122, 147-150, 170, 172, 173, 185, 188, 190, 192, 194-198, 204, 206-226, and 229 stand rejected under 35 U.S.C. §103 as

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being unpatentable over Kaetsu and Misura, as applied to claims 94, 41 above, and further in view of Matsuo.

IV. Claims 109 and 191 stand rejected under 35 U.S.C. being unpatentable over Kaetsu, Misura, Matsuo, and further in view of Rips.

We note that appellants' presentation of the above-mentioned rejections is set forth on page 7 of the brief. We observe that the identification of which claims are rejected under each rejection differs from that set forth by the examiner on pages 2, 6, 7, 8, and 9 of the answer. The examiner states that claims were added in Amendment D, which was entered upon filing of the appeal brief. (answer, page 2). Possibly, this may be the reason for some of the conflicting identification of rejected claims. Because appellants have not raised any issue in connection with the examiner's presentation of each rejection, we are using the examiner's presentation of each rejection in this appeal.

We further note that the examiner included paragraph 14 on page 26 of the answer stating that a new ground of rejection has been set forth. We believe this is an inadvertent error because (1) this paragraph is in direct conflict with paragraph 12 on page 10 of the answer which states that the answer does not contain any new grounds of rejection, and (2) appellants have not acknowledged any new ground of rejection.

The examiner has withdrawn the 35 U.S.C. § 112 rejection. The examiner has also withdrawn the 35 U.S.C. § 102(b) or 103(a) rejection over Kaetsu alone. (answer, page 2).

Lastly, we have reviewed the supplemental examiner's answer in response to appellants' request for reconsideration filed on March 3, 2000. We are in agreement with the examiner's comments regarding parent case S.N. 07/425,371. As pointed out by the examiner, the rejections in this appeal rely upon the reference of Kaetsu (among others), which was not applied in connection with parent case S.N. 07/425,371.

#### **OPINION**

For the reasons set forth in the brief and below, we reverse each of the above-mentioned rejections.

#### I. The Rejections

The critical issue before us is whether the combination of Kaetsu in view of Masura sets forth a prima facie case of obviousness. In making this determination, we focus on the crucial aspect of appellants' invention wherein the composition is curable by exposure to ultraviolet light to form a substantially clear eyeglass lens in a time period of less than one hour.

The examiner's basic position is that it would have been obvious to modify the compositions in the method of Kaetsu to include the aromatic bis(allyl carbonate) monomer and the tri(meth)acrylate monomer as taught by Misura. (answer, page 6). The examiner states that substitution of an aromatic bis(allylcarbonate) monomer of Misura in place of an aliphatic bis(ally)carbonate monomer of Kaetsu "would have been expected to be light polymerizable in less than one hour because the polymerizable allylcarbonate functionality is the same and in

analogous (meth)acrylate functional compositions". (answer, page 5).

Appellants argue that Misura relates to a thermal curing process rather a curing process by UV light. Appellants argue that Misura's composition does not include a photoinitiator, and is not curable to form a substantially clear eyeglass lens by exposure to UV light. Appellants argue that one having ordinary skill in the art would not look to a thermally curable composition to prepare a composition to be cured by exposure to UV light to form a substantially clear eyeglass lens in less than one hour. (brief, page 14).

The examiner rebuts and states that substitution of an aromatic bis(allylcarbonate), as taught by Misura, for the aliphatic bis(allylcarbonate) monomer disclosed in Kaetsu "would not be expected to affect the photopolymerizability of the compositions disclosed by Kaetsu". The examiner further states that the compositions disclosed by Misura, as thermally curable, and by Kaetsu, as being photocurable, are analogous because the components of the disclosed compositions are analogous (bis(allylcarbonate monomers, poly(meth)acrylate monomers, peroxy initiators, such as benzoyl peroxide), and are disclosed by patentees as being useful for forming lenses. The examiner states that "[f]or these reasons, the disclosures of the two references are considered to be analogous". (answer, page 11).

We note that beyond looking to the prior art to determine if it suggests doing what the inventor has done, one must also consider if the art provides the required expectation of succeeding in that endeavor. In re Dow Chem., 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988) ("Both the suggestion and the expectation of success must be founded in the prior art, and

not in applicant's disclosure."). "Obviousness does not require absolute predictability but a reasonable expectation of success is necessary." In re Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). See also In re O'Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

Here, the examiner does not rely upon any specific teachings in the combination of references to support both the suggestion and the expectation of success that the substitution as stated by the examiner would provide for a lens forming composition that forms into a substantially clear eyeglass lens by exposing the composition to ultraviolet light for a time period of less than one hour. Rather, the examiner concludes that substitution of the aromatic bis(allylcarbonate) monomer of Misura in place of the aliphatic bis(allyl)carbonate monomer of Kaetsu "would have been expected to be light polymerizable in less than one hour **because the polymerizable allylcarbonate functionality is the same and in analogous (meth)acrylate functional compositions**". [emphasis added] (answer, page 5). The examiner's conclusion of obviousness, therefore, is not based upon the suggestion and the expectation of success founded in the prior art, but rather is based upon the examiner's determination that the references are "analogous". This is not a correct application of the law.

We therefore determine that the examiner has not set forth a prima facie case of obviousness.

We need not discuss appellants' rebuttal evidence in connection with the Declaration by Dr. Buazza (Exhibit A in appellant's brief) in view of the determination that a prima facie case has not be made.

Because the other rejections each involve the combination of Kaetsu in view of Misura, and because the additional references

in these rejections do not cure the deficiencies discussed in connection with the combination of Kaetsu in view of Misura, we need not discuss the additional references, and also reverse these rejections.

## II. Other Issues

We importantly note that the claims on appeal include product-by-process claims.

We observe that the examiner states on page 5 of the answer that the end product would be expected to exhibit the same properties. We have also reviewed the prosecution history.

Upon this review, we are uncertain as to whether patentability of the product-by-process claims has been carefully considered in view of the following law, and strongly recommend that upon return of this application to the jurisdiction of the examiner, such an evaluation should be undertaken.

When evaluating patentability at the patent office level, if the claimed composition reads on a prior art composition, then it will properly draw a rejection of unpatentability, even if produced by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 965-66 (Fed. Cir. 1985); In re Hirao, 535 F.2d 67, 69, 190 USPQ 15, 17, (CCPA 1976). In this regard, the examiner should consider whether to reject the product-by-process claims under 35 USC § 103 over an art reference such as Misura. So, for example, if Misura suggests a composition having the same compounds as claimed by appellants, then Misura would suggest the product, absent evidence from appellants that the claimed composition materially differs from the prior art composition. In re Marosi, 710 F.2d 799, 802, 218 USPQ 289, 292-93 (Fed. Cir. 1983).

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We therefore recommend that this issue be considered in light of the above-mentioned case law.

III. Conclusion

Each rejection of record is reversed.

**REVERSED**

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
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THOMAS A. WALTZ	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
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Beverly A. Pawlikowski	)	
Administrative Patent Judge	)	

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