

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte RONALD A. SCHACHAR

Appeal No. 2005-1315
Application No. 09/972,533

ON BRIEF

Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 36-41 and 45-51. Claims 42-44 and 52-54 stand objected to as being dependent on a rejected base claim but are otherwise indicated as allowable. No other claims are pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a scleral prosthesis for treating presbyopia by applying an outward force on the anterior edge of the scleral pocket in which the prosthesis is implanted which elevates the portion of the sclera attached thereto and the ciliary body immediately beneath the sclera to increase the working distance of the ciliary muscle (specification, page 6). Claims 1 and 45 are representative of the invention and read as follows:

1. A scleral prosthesis comprising:

a base member having a surface adapted to contact ocular tissue within a pocket surgically formed within scleral tissue of an eye in the region of the ciliary body, and

a ridge member associated with said base member that applies force to said pocket to thereby cause scleral expansion.

45. A prosthesis adapted for contact with the sclera of an eye in the region of the ciliary body, said prosthesis comprising a body having an elongated base with a first end and a second end, said body having a shape prescribed to expand said sclera.

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

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| Smith | 4,946,436 | Aug. 7, 1990 |
| Fisher | 5,558,630 | Sep. 24, 1996 |

The following rejections are before us for review.¹

Claims 39, 40, 49 and 50 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1, 36-41 and 45-51 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fisher.

Claims 1, 36-41 and 45-51 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Smith.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed September 2, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (filed June 24, 2003) and reply brief (filed November 7, 2003) for the appellant's arguments thereagainst.

¹ The obviousness-type double patenting rejection of claim 1 has been withdrawn in view of the

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

The basis of the examiner's rejection is that it is unclear whether "said expanding means" in claims 39, 40, 49 and 50, which lacks antecedent basis in the claims, refers to the "ridge member" or "ridge member in association with the base member" (answer, page 4). The appellant contends, on page 7 of the brief, that the words "expanding means" in claims 39 and 40 refer to the text in the last line of claim 1 that reads "a ridge member associated with said base member that applies force to said pocket to thereby cause scleral expansion" and that the words "expanding means" in claims 49 and 50 refer to the text in claim 45 that reads "a body having an elongated base with a first end and a second end, said body having a shape prescribed to expand said sclera."

filings and acceptance of a terminal disclaimer and power of attorney (see page 3 of the answer).

The claim language “expanding means” in claims 39, 40, 49 and 50 is problematic for two reasons. First, the appellant’s simple recitation in the brief of language in claims 1 and 45 to which “said expanding means” purportedly refers does not answer the question as to what recited structure (i.e., the base member, the ridge member or the combination of the ridge member and base member) in claim 1 corresponds to the “expanding means.” Furthermore, in this case, the lack of antecedent basis for “said expanding means” is more than just an inconsequential inconsistency in claim language. The terminology “expanding means” referred to in claims 39, 40, 49 and 50 certainly appears on its face to be a means-plus-function recitation under 35 U.S.C. § 112, sixth paragraph; however, neither claim 1 nor claim 45 recites a means-plus-function limitation. Accordingly, it is not clear to what “said expanding means” in claims 39, 40, 49 and 50 refers, leaving the scope of these claims indefinite.

The anticipation rejections

We recognize the inconsistency implicit in our holding that claims 39, 40, 49 and 50 are rejectable under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention with a holding that these claims are anticipated by Fisher or Smith. Normally, when substantial confusion exists as to the interpretation of a claim and no reasonably definite meaning can be ascribed to the terms in a claim, a determination as to patentability under 35 U.S.C. § 102 or 103 is not

made. See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). However, in this instance, we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. See Ex parte Ionescu, 222 USPQ 537, 540 (Bd. App. 1984). For the reasons outlined below, we interpret “said expanding means” in claims 39 and 40 as referring to the combination of the ridge member and base member recited in claim 1 and “said expanding means” in claims 49 and 50 as referring to the body recited in claim 45. Therefore, we have made a determination below as to the rejections under 35 U.S.C. § 102(b) of the appealed claims in the interest of judicial economy based upon our conclusion that the subject matter of these claims is anticipated by Fisher and by Smith.

Inasmuch as claim 1 recites the ridge member associated with the base member as the structure which causes scleral expansion and claim 45 recites the body as the structure which is “prescribed to expand” the sclera, we have interpreted the language “said expanding means” in claims 39 and 40 as referring to the combination of the ridge member and base member and in claims 49 and 50 as referring to the body. Further, in light of the recitation of positive structure for performing the expanding function in claims

1 and 45, we do not interpret “expanding means” as a recitation under 35 U.S.C. § 112, sixth paragraph.²

Fisher and Smith each disclose an implant of material which is biocompatible with the tissue of the eye and which is surgically implanted into a pocket created in the sclera of the eye. Further, the Fisher and Smith implants both comprise wedge shapes, thus forming a ridge member associated with a base member. While the Fisher and Smith implants are both disclosed for use in facilitating drainage of fluid from the anterior region of the eye through the sclera and are not specifically disclosed for scleral expansion, both of these inserts appear reasonably capable, without structural modification, of causing scleral expansion. In fact, the placement of the Fisher and Smith implants in a scleral pocket will necessarily displace scleral tissue, thereby causing scleral expansion. Accordingly, the functional language of claims 1 and 45 does not in this instance serve to patentably distinguish over the implants of Fisher and Smith. See, e.g., In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 230-31

² The sixth paragraph of 35 U.S.C. § 112, by its very own terms, deals only with elements expressed as a means or step for performing a specified function **without the recital of structure, material, or acts in support thereof.**

(CCPA 1971) and Ex parte Cordova, 10 USPQ2d 1949, 1950-51 (Bd. Pat. App. & Int. 1987).

The appellant argues, on pages 8-10 of the brief, that, in essence, the Fisher and Smith implants are intended to conduct fluid to or from the anterior chamber of the eye in order to regulate intraocular pressure and not to apply force against the scleral pocket to expand the sclera, as recited in claim 1, and further do not possess a shape prescribed to expand the sclera, as recited in claim 45. It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As explained above, the Fisher and Smith implants both appear reasonably capable of functioning in the manner called for in claims 1 and 45 and the appellant has not provided any cogent reasoning why this is not the case.

For the foregoing reasons, we shall sustain the rejections of independent claims 1 and 45 as being anticipated by Fisher and by Smith. The appellant has elected not to separately argue dependent claims 36-41 apart from claim 1 or claims 46-51 apart from claim 45, thus allowing them to stand or fall with claims 1 and 45 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)). Accordingly, the rejections of these claims as being anticipated by Fisher and by Smith are also sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 39, 40, 49 and 50 under 35 U.S.C. § 112, second paragraph, and claims 1, 36-41 and 45-51 under 35 U.S.C. § 102(b) is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

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| CHARLES E. FRANKFORT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOHN P. MCQUADE |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| JENNIFER D. BAHR |) | |
| Administrative Patent Judge |) | |

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