

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD W. CANAVAN

Appeal 2007-0554
Reexamination Control Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1
Technology Center 2800

Hearing: August 15, 2007

Decided: September 19, 2007

Before TEDDY S. GRON, JAMESON LEE, and RICHARD TORCZON,
Administrative Patent Judges.

GRON, *Administrative Patent Judge.*

DECISION ON APPEAL

Introduction

This is an appeal under 35 U.S.C. § 134 from an Examiner's final rejection of Claims 1-8 in Reexamination Control Nos. 90/006,118, filed

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

September 28, 2001, and 90/006,254, filed March 26, 2002, for reexamination of Canavan, U.S. Patent 6,196,681, which issued March 6, 2001, from Application 09/573,577, filed May 18, 2000. Claims 1-8, all the claims of the patent, stand finally rejected under 35 U.S.C. § 103(a) in view of various combinations of the prior art indicated below:

Fecteau (applied against Claims 1-8);	US 5,825,455	Oct. 20, 1998
Bolle (applied against Claim 5);	US 5,841,505	Nov. 24, 1998
Chiang (applied against Claims 2, 4 and 5);	US 5,867,841	Feb. 9, 1999
Lin (applied against Claim 3); and	US 5,903,331	May 11, 1999
Conway (applied against Claims 1-8).	WO 99/56942	Nov. 11, 1999

Appellant has not argued the separate patentability of the subject matter defined by any one of Claims 6 to 8 from the patentability of Claim 1. However, Appellant has argued that none of the references applied to dependent Claims 2-5 describe the further limitations thereof, and no combination of the prior art applied to Claims 2-5 would have suggested an invention defined by any one of Claims 2-5. Accordingly, we shall consider the patentability of the subject matter defined by each of Claims 2, 3, 4, and 5 separately from the patentability of the subject matter more broadly defined by Claim 1 under 35 U.S.C. § 103(a). On the other hand, we deem Claims 6-8 to stand or fall with Claim 1.

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

We have considered all the evidence relied upon by the Examiner in support of the conclusion that the claimed subject matter is unpatentable under 35 U.S.C. § 103 and all the evidence to the contrary, most particularly the Declaration of Phillip M. Johnson, Vice President of Research and Development and Quality Assurance of Bacou-Dalloz USA, Inc., the alleged owner of the patent, under 37 CFR § 1.132, and the support therefor. We affirm all the appealed rejections. The following factual findings and legal determinations support our conclusions.

Claim interpretation

Claims 1-5 are reproduced below (Appeal Br. (Br.), (vii) *Claims Appendix* (App.)):

1. A unitary structure for an eye covering comprising,
 - a soft inner portion adapted to engage the brow and nose of a wearer and a hard outer portion adapted to support a transparent lens portion and temple pieces and formed by a two-shot process in a single mold that chemically bonds the soft portion to the hard portion.
2. A unitary structure in accordance with claim 1 wherein said unitary structure is formed with a nose piece with the soft portion thereof having a plurality of flexible fingers adapted for engaging the nose of a wearer.
3. A unitary structure in accordance with claim 1 and further comprising, a transparent lens portion detachably secured to the hard portion and depending from the brow portion thereof.
4. A unitary structure in accordance with claim 2 and further comprising, a transparent lens portion detachably secured to the hard portion and depending from the brow portion thereof.

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

5. A unitary structure in accordance with claim 2 constructed and arranged to position the lens portions to provide a series of vertical venting areas between the inside surface of the lens portions and the unitary structure.

Generally, “in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification.” *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ385, 388 (Fed. Cir. 1983). The same is true in reexamination proceedings. *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). “The reason is simply that during . . . prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.” *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). When the supporting specification provides a narrower definition of the claim language, the claims shall be read accordingly. *Id.*:

During . . . examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant’s invention and its relation to the prior art.

However, when the specification lacks a clear term definition, the language of the claims, and accordingly the scope and content of the claimed subject matter, should be interpreted as broadly as the specification will otherwise reasonably allow.

Here, when we refer to Appellant’s Specification, we refer to Canavan, U.S. Patent 6,196,681, issued March 6, 2001 (hereafter

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

Specification). Cited in the body of the Specification (Specification col. 1, l. 19; col. 2, l. 50), but not incorporated by reference, is Canavan et al., U.S. Patent 5,457,505, issued October 10, 1995 (hereafter Canavan '505). The Specification reports: (1) "For background, reference is made to U.S. Pat. No. 5,457,505, which describes eyewear construction. Reference is also made to commercially available sport glasses such as Nike sport glasses that include some structure made by a two-shot process in a single mold" (Specification, col. 1, ll. 18-22); (2) "The temple pieces may be substantially of the form shown in the aforesaid U.S. Pat. No. 5,457,505 (note: two types shown)" (Specification, col. 2, ll. 33-35); and (3) "The structure also readily accommodates temple pieces that may be pivotable and extendable in the manner described in the aforesaid U.S. Pat. No. 5,457,505 to allow adjustment for a variety of wearers" (Specification, col. 2, ll. 48-51).

The problem any person having ordinary skill in the art reading Appellant's claims must face, and the problem we also encounter in trying to interpret the scope and content of the subject matter claimed, is that most of the terms in Appellant's claims are not defined in the eight claims themselves or in the one page, two column supporting Specification. For example, the Specification does not discuss how, where, and to what extent the soft inner portion of the claimed unitary structure is "adapted to engage the brow and nose of the wearer" (Br. App. Claim 1). Nor does the Specification define the "the two-shot process in a single mold that chemically bonds the soft portion to the hard portion" (Br. App. Claim 1). But for the drawings and the function to be performed by various portions of

the claimed “unitary structure for an eye covering” (Br. App. Claim 1), the size, shape, and configuration of the claimed “structure” are undefined.

Accordingly, we interpret the phrase “[a] unitary structure for an eye covering adapted to engage the brow and nose or the wearer” in Claim 1 to include conventional unitary structures comprising a segment to be supported by the nose (nosepiece support segment) and segment or segments to which transparent eye coverings may be attached which extend from the nosepiece support segment across, and adjacent to, some portion of the undefined brow.¹ The soft portions of the segments, extending from the nosepiece support segment across and adjacent to the brow of the wearer, are adapted to softly contact the brow of the wearer in the event of a force applied to the eye covering or claimed unitary structure therefor. The Specification teaches that “the nosepiece comfortably engages the nose of the wearer while maintaining a desired position of the eye covering structure” (Specification, col. 2, ll. 45-47). The claimed unitary structure affords “good protection from shock created by a force applied to the transparent lens structure” (Specification, col. 2, ll. 43-45). Appellant’s drawings depict a unitary structure within the scope of the Appellant’s claims, and the Specification as a whole describes no more.

To enlighten persons skilled in the art as to the meaning of “the two-shot process in a single mold that chemically bonds the soft portion to the hard portion” (Br. App. Claim 1) and “a two-shot process that chemically bonds a first hard material forming said hard outer portion to a second soft

¹ We note the exemplary brow of Frida Kahlo (1907-1954), the iconic Mexican painter.

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

material forming said soft inner portion in the same mold” (Br. App. Claim 7), the Specification points to “commercially available sport glasses . . . that include some structure made by a two-shot process in a single mold” (Specification, col. 1, ll. 20-22) and Canavan ‘505. Itself, the Specification recites the phrase “two-shot process . . . in a single mold” repeatedly (Specification, col. 1, ll. 22, 27, and 66; col. 2, ll. 11, 37-38; and Claims 1 and 7), without amplification. We find that Canavan ‘505 does not mention a “two-shot process . . . in a single mold” for any purpose whatsoever.

On the other hand, at the August 15, 2007, oral hearing of this appeal, Appellant was asked to explain how the supporting Specification in this case could have enabled a person skilled in the art to make and use the full scope of the claimed invention. Appellant appeared to concede that the “two-shot process . . . in a single mold” nominally recited in its claims and Specification was a process well-known in the art of making thermoplastic structures of various sizes, shapes and complex configurations prior to its filing date (Transcript of Proceedings, August 15, 2007, Oral Hearing, pp. 5-10).

Discussion

1. Prima facie obviousness

Appellant and the Examiner appear to agree that Conway describes a unitary structure with an inner soft portion and an outer hard portion which are formed by a two-shot process whereby each shot is separately performed in each of two distinct molds. The frame of Conway’s eyewear is “formed of a rigid plastic across substantially the entire front-facing surface thereof, wherein the rigid (front surface) plastic and soft (rear surface) plastic are

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

sequentially shot in first and second mold cavities. As such, the rigid plastic and soft plastic which comprise the front frame are bonded at the molecular level to provide ultimate assurance against separation of the two materials during use” (Conway, p. 2, first full para.). Conway’s “inventive method may be used . . . to form a single brow bar to which single or paired lenses are mounted” (Conway, p. 7, ll. 6-8). In fact, we find that Conway reasonably appears to describe every physical and chemical limitation of the unitary structure defined by Appellant’s Claim 1 (See Conway, pp. 2-3, Summary of the Invention). *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985):

[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. . . .

The patentability of a product does not depend on its method of production. . . . If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

No limitation of the process of making the claimed “unitary structure” as defined in Appellant’s Claim 1 or Specification undermines our finding that every physical and chemical limitation of the product Appellant claims is described by Conway. Accordingly, we find that the unitary structure defined by Applicant’s Claim 1 is unpatentable under 35 U.S.C. § 102 as anticipated by Conway alone. Therefore, we also conclude that the unitary structure defined by Applicant’s Claim 1 is unpatentable for obviousness under 35 U.S.C. § 103 in view of Conway’s disclosure. *See In re Pearson*,

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974) (“a lack of novelty in the claimed subject matter, e.g., as evidenced by a complete disclosure of the invention in the prior art, is the ‘ultimate or epitome of obviousness’”).

We also find that the nose pieces depicted in Fecteau’s Figures 25A and 25B and the eyewear depicted in Fecteau’s Figures 19-21, as explained in the written description of Fecteau’s Figures 20, 25A and 25B at col. 9, l. 22, to col. 10, l. 6, anticipate the unitary structure defined by Appellant’s Claim 1. Fecteau’s nosepiece is “formed by a two-shot process in a single mold that chemically bonds the soft portion to the hard portion” (Br. App. Claim 1). Fecteau teaches (Fecteau, col. 9, ll. 37-59; emphasis added):

Also in a preferred embodiment, lower section **28** (which contacts the wearer’s nose) is made from a material having . . . a different durometer (e.g., softer or stiffer) relative to the material comprising the remaining portion of the nose piece. For example, the material in the nose pad **28** may be comprised of a softer material such as rubber, silicone, soft thermoplastic materials or soft foam materials and the material in the extended clip-on section **30** may be comprised of hard thermoplastic materials (i.e., polycarbonate, ABS, nylon), hard foams or metals.

In accordance with a novel feature of the present invention, the two sections **28** and **30** of differing materials are made in a single co-injection molding step as opposed to prior art processing whereby the two sections **28**, **30** would be separately molded and thereafter bonded together. By co-injection molding of the nose piece, substantial savings in both processing time and assembly is achieved. The co-molded sections **28**, **30** would remain bonded either through a chemical bond (through proper selection of the two co-molded materials) or through a mechanical bond, or more preferably, through a combination of a chemical and mechanical bond.

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

We reject Appellant's argument at oral hearing that the phrase "unitary structure for an eye cover comprising, . . . a soft inner portion adapted to engage the brow and nose of the wearer" in Appellant's Claim 1 necessarily excludes the unitary structure for an eye cover comprising the soft portion and hard portion of the nose piece depicted in Fecteau's Figures 19-21, 25A and 25B (Transcript of Proceedings, August 15, 2007, Oral Hearing, pp. 11-12). In light of the nominal description of the claimed invention and lack of definition of the words and phrases used in the Specification in support of Appellant's claims, we conclude that a broader reading of the scope of the Claim 1 subject matter, including the phrase "adapted to engage the brow and nose" (Br. App. Claim 1), is both reasonable and warranted. Nevertheless, the Examiner appears to have adopted Appellant's narrower interpretation of the scope of the claimed invention in the final rejection. Accordingly, we turn to the question of obviousness as it relates to the more narrowly claimed invention.

The claims were finally rejected under 35 U.S.C. § 103 in view of the combined teachings of Conway and Fecteau. The Examiner appears to have argued that the unitary structure defined by Appellant's Claim 1 would have been obvious to a person having ordinary skill in the art because it would have been obvious to the ordinary artisan to make the unitary structure for an eye covering which Conway makes by separately molding and chemically bonding together two sections of soft and hard materials "by a two-shot process in a single mold that chemically bonds the soft portion to the hard portion" (Br. App. Claim 1) with reasonable expectation of success. The Examiner's argument stems from Fecteau's teaching to form the soft and

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

hard sections of its unitary nose piece for an eye covering in a single co-injection molding step, as opposed to prior art processing whereby the two sections would be separately molded and chemically bonded together, so to achieve substantial savings in both processing and assembly time. We see no reversible error in the examiner's position.

Appellant cannot credibly deny that persons having ordinary skill in the art would have been able to make and use a more complex unitary structure of the type described by Conway using the single co-injection molding process used by Fecteau to make its nosepiece without undue experimentation or additional instruction. Appellant's Specification provides no more instruction to make and use its complex unitary structure for an eye covering than the combined teachings of Conway and Fecteau would have provided persons having ordinary skill in the art.

We also agree with the Examiner that it would have been prima facie obvious to a person having ordinary skill in the art to use a single co-injection mold to make the eyewear described or suggested by Conway with the soft portion of the nose piece "having a plurality of flexible fingers adapted for engaging the nose of a wearer" (Br. App. Claim 2) in view of Chiang's teaching. Chiang's Figure 4B eyewear includes "base sections **20** extend[ing] a distance from the rim **10** with the contact sections **21** further extending therefrom . . . for more comfortable engagement with the wearer's face" (Chiang, col. 3, ll. 47-51). Chiang describes (Chiang, col. 3, ll. 57-63):

The face contact means **2** comprises a plurality of slits **201** extending from the free ends of the contact sections **21** to the base sections **20**

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

for separating the adjacent ones of the base sections **20** as well as the contact sections **21** so as to provide the face contact means **2** with better compliance with the wearer's face contour.

Lin shows eyewear having "a transparent lens portion detachably secured to the hard portion [of a unit frame] and depending from the brow portion thereof" (Br. App. Claim 3). We conclude that it would have been obvious to a person having ordinary skill in the art reading Conway and Lin to detachably secure a lens to the hard brow bar portion of Conway's eyewear in light of Lin's teaching. Conway explicitly states (Conway, p. 7, last two sentences; emphasis added):

[V]arious modifications may be made to the invention as would be obvious to one skilled in the art. For example, the inventive method may be used to form individual eye rims which are secured together with a separate bridge component, or to form a single brow bar to which single or paired lenses are mounted.

Moreover, we find no reversible in the Examiner's conclusion that it would have been obvious to persons having ordinary skill in the art to use a single co-injection mold to make the eyewear described or suggested by Conway with the lens securing hard portion of the unitary structure including vertically positioned mounting blocks 35 and venting notches 36 of the type depicted in Bolle's Figure 1. Appellant argues that a person having ordinary skill in the art would find it impossible to impart Bolle's design into Conway's unitary structure (Br., pp. 15-16). We disagree. Conway mounts his lenses to the hard outer portion of the single brow bar, unitary structure of its eye covering. Appellant has not explained why Bolle's mounting blocks/notches for detachably mounting lenses to its frame

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

could not be employed to secure the lenses to the hard, single brow bar portion of Conway's eyewear for the benefits Bolle discloses.

Accordingly, we conclude that the Examiner has established that a unitary structure for an eye covering encompassed by all of Appellant's claims would have been *prima facie* obvious to a person having ordinary skill in the art in view of the applied prior art. However, our deliberations are not finished. Appellant has submitted secondary evidence of unobviousness in the form of a Declaration under Rule 132.

2. Declaration of Phillip M. Johnson under 37 CFR § 1.132

The PTO has the initial burden to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The PTO may satisfy its initial burden by showing objective teaching or prior knowledge in the art which would have led one of ordinary skill in the art to the invention claimed. *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1599. Hereinabove, we concluded that the Examiner in this case satisfied his initial burden to establish that the subject matter Appellant claims would have been *prima facie* obvious to a person having ordinary skill in the art. However, the obviousness of the claimed invention under 35 U.S.C. § 103 is not thereby resolved. *See In re Piasecki*, 745 F.2d at 1472, 223 USPQ at 788:

The process is as stated in *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976):

When *prima facie* obviousness is established and evidence is submitted in rebuttal, the decision-maker must start over. . . . *Prima*

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

facie obviousness is a legal conclusion, not a fact. Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself.

Considering the Declaration of Phillip M. Johnson, “Vice President of Research and Development and Quality Assurance of Bacou-Dalloz USA, Inc., the owner of the above patent” (Decl. 132, p. 1), we find a dearth of requisite facts to support Appellant’s argument that the full scope of the claimed subject matter is patentable over the applied prior art. We are overwhelmed by deficiencies found in the declaration and attached Exhibit B in support thereof.

Johnson states that Exhibit B demonstrates commercial success which is said to be “directly attributable to the invention of claims 1-8” (Decl. 132, para. 3). Exhibit B purports to be “based on records kept in the ordinary course of business by Bacou-Dalloz USA, Inc. sales of the Genesis safety eye covering product made and sold by the assignee of the above-identified patent and corresponding substantially to the invention shown, described and claimed in claims 1-6 and made by the method of claims 7 and 8 of above patent” (Decl. 132, para. 2). Exhibit B is submitted to show the commercial success of “Genesis” in the years 2000-2005 by reporting the number of “Genesis” units sold, the dollar amount of sales, and “ASP” (undefined) for each year. While Johnson declares that sales of “Genesis . . . [corresponds] substantially to the invention shown, described and claimed in claims 1-6” (Decl. 132, para. 2) and “is directly attributable to the invention of claims 1-8” (Decl. 132, para. 3), we are unable to determine: (1) how “the Genesis safety eye covering product” relates to the full scope of the invention

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

claimed; (2) what the utility, design, and cost aspects of the “Genesis” units sold are; (3) whether the limitations defined in Appellant’s claims are directly and exclusively responsible for the reported sales; and (4) how Genesis’ sales compare to sales of products on the market related in design and utility features, production costs, and price. In short, Appellant has neither explained its declaration of commercial success, established a nexus between any commercial success of the “Genesis” product sold and the claimed invention, nor compared the sales of the product sold to that of the closest prior art. With the noted deficiencies in mind, we find that Johnson’s Declaration under Rule 132 amounts is little more than unsupported arguments of the owner of an invention said to be encompassed by the claims on appeal and, as such, entitled to little evidentiary weight in support of the patentability of the full scope of the subject matter claimed.

Moreover, Johnson’s opinions that the claimed unitary structure and particular elements thereof made by the two-shot process in a single mold according to Appellant’s claims would not have been obvious over the applied prior art are not commensurate in scope with the full scope of the subject matter claimed. Evidence said to support the patentability for claimed subject matter must be explained and commensurate in scope of the claimed invention to be persuasive. Here, we have opinion relating to a question of law which is supported by unexplained evidence. It carries little, if any, weight.

Finally, given our finding that unitary structures encompassed by Appellant’s broadest product claims are fully described by Conway and/or Fecteau, *i.e.*, subject matter encompassed by Appellant’s Claim 1 is the

Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

epitome of obviousness for anticipation by the prior art, Appellant's showing of commercial success and/or declaration of unobviousness with respect to the Claim 1 subject matter cannot establish the patentability of the Claim 1 subject matter. We find that the unitary structure defined by Appellant's Claim 1 reasonably appears not to be novel.

Conclusion

Having considered all the evidence of record for and against the patentability of Claims 1-8 of Reexamination Control Nos. 90/006,118 and 90/6,254 under 35 U.S.C. § 103, we affirm the appealed final rejections. Accordingly, it is

ORDERED that the examiner's final rejections of Claims 1-8 of Reexamination Control Nos. 90/006,118 and 90006,254 under 35 U.S.C. § 103 are affirmed; and

FURTHER ORDERED that the time for taking further action in this appeal cannot be extended under 37 CFR § 1.136(a) (2006).

AFFIRMED

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Appeal 2007-0554
Reexamination Nos. 90/006,118 & 90/006,254
Patent 6,196,681 B1

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