

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMIE H. LINDSEY,
JAMES M. SCOTT, and STEPHEN J. VAN NOY

Appeal 2007-1199
Application 10/124,648¹
Technology Center 3700

Decided: May 31, 2007

Before JAMESON LEE, RICHARD TORCZON and SALLY C. MEDLEY,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

DECISION ON APPEAL

A. Statement of the Case

This is a decision on appeal by an applicant under 35 U.S.C. § 134(a) from a rejection of claims 1-15 of Application 10/124,648. We have jurisdiction under 35 U.S.C. § 6(b).

Reference Relied on by the Examiner

Nigam 5,928,282 Jul. 27, 1999

¹ The real party in interest is Alcon, Inc.

The Rejections on Appeal

The Examiner rejected claims 1-15 under 35 U.S.C. § 102 as anticipated by Nigam.²

B. Issues

Have the Applicants shown error in the rejection of claims 1-15 as anticipated by Nigam?

C. Summary of the Decision

The Applicants have not shown error in the rejection of claims 1-15 as anticipated by Nigam.

D. Findings of Fact (Referenced as FF. ¶ No.)

1. The invention is directed to an anterior chamber phakic lens made from a foldable, highly biocompatible material that has a very low haptic compression force and low axial displacement, and which is still stable in the anterior chamber. (Specification 4: 2-4).

2. According to the Applicants, they have discovered that the compressive forces of prior art polymethyl methacrylate anterior chamber lenses are far in excess of what is required for stability. (Specification 4: 26-27 and 5: 1).

3. Also according to the Applicants, they have discovered that lenses made from soft material are stable when certain compressive forces and contact areas are used. (Specification 5: 4-6).

4. Further according to the Applicants, they have discovered that an intraocular lens having haptics that contact the anterior chamber angle at

² A previous rejection of claims 7-15 under 35 U.S.C. § 103 as unpatentable over Nigam and U.S. Patent 5,861,031 has been withdrawn by the Examiner.

only four locations, and with a ratio of haptic spread to optic diameter of less than 1.5, and preferably around 1.3 for a 5.5 mm optic provides sufficient stability without excessive angle contact. (Specification 5: 17-21).

5. Further still according to the Applicants, they have recognized that the compressive force of haptics and footplates on haptics need to be sufficient for the stability of the optical lens but not large enough to cause irritation or pupil ovaling. (Specification 6: 4-6).

6. Claims 1 and 10 are the only independent claims on appeal. They read as follows:

1. An intraocular lens, comprising:

- a) an optic having a diameter; and
- b) at least one pair of footplates, the footplates

being separated by a haptic and attached to the optic by a ramp, the ramp being wider in a plane in which the optic lays than it is in a plane perpendicular to the plane of the optic,

wherein the intraocular lens exhibits a force response of approximately less than 0.5 mN when the intraocular lens is compressed 1 mm.

10. An intraocular lens, comprising:

- a) an optic having a diameter; and
- b) a pair of footplates, each of the footplates

being separated by a haptic and attached to the optic by a ramp, the ramp being wider in a plane in which the optic lays than it is in a plane perpendicular to the plane of the optic, the optic, footplates and ramps being made in a single piece entirely from a soft acrylic,

wherein the intraocular lens exhibits a force response of approximately less than 0.5 mN when the intraocular lens is compressed 1 mm.

7. Citing Figures 10-12 of Nigam, the Examiner determined that Nigam discloses an intraocular lens comprising an optic (22) having a

diameter and at least one pair of footplates (32B) separated by a haptic (26B) and attached to the optic (22) by a ramp (44). (Answer 3: 16-18).

8. The Examiner determined that the ramp of Nigam's Figure 10 is wider in the optic plane than it is in a plane perpendicular to the optic plane. (Answer 3-4).

9. The Examiner determined that the ratio of haptic spread to optic diameter for the lens shown in Nigam's Figure 10 is less than 1.5 and 1.3. (Answer 4: 8-9).

10. The Examiner determined that Nigam's lens is made of soft acrylic, silicones, or hydrogels. (Answer 4: 5-6).

11. With regard to the force response claim limitation, the Examiner concluded that Nigam's lens will react in the same manner as does the Applicants' claimed lens because the two have a common structure and use the same material. (Answer 4: 3-6 and 9-10).

E. Principles of law

For determining patentability over prior art, the name of the game is the claim. *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

To establish anticipation under 35 U.S.C. § 102, each and every element in a claim, arranged as is recited in the claim, must be found in a single prior art reference. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). Anticipation can be found when a claim limitation is inherent or otherwise implicit in the relevant reference. *Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). For establishing inherency, that which is missing in the express description must

necessarily be present. *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Once a prima facie case of anticipation by inherency has been established, however, the burden shifts to the Applicants to prove that the subject matter shown in the prior art does not possess the characteristics relied on by the Examiner. *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). The Patent and Trademark Office is not equipped to prove any assertion by way of conducting experiments. *In re King*, 801 F.2d at 1327, 231 USPQ at 139.

F. Analysis

In an appeal such as this, the Applicants have a burden to demonstrate error or errors in the Examiner's findings of which feature or features of each claim is met by an anticipatory reference and how. We are not here to conduct examination anew, based on the Applicants' mere general assertion that Nigam does not disclose all the features of the claimed invention.

With regard to the Applicants' Appeal Brief, none of the Examiner's specific findings and determinations with regard to where each claim limitation is found in and disclosed by Nigam is controverted individually by the Applicants, including (1) the finding that Nigam discloses an intraocular lens comprising an optic having a diameter, (2) the finding that Nigam's lens has at least one pair of footplates which are separated by a haptic and attached to the optic by a ramp, (3) the finding that the ramp in Nigam is wider in a plane in which the optic lays than it is in a plane perpendicular to the plane of the optic, (4) the finding that Nigam's lens is made of soft acrylic, silicones, or hydrogels, (5) the finding that for Nigam's lens the ratio of haptic spread to optic diameter is less than 1.5 and also 1.3, as is preferred by the Applicants, and even (6) the finding that Nigam's lens will inherently

have the same reactive force as is recited in Applicants' claims 1 and 10 because the same structure and material is used.

What the Applicants do argue in the Appeal Brief, is this (Appeal Br.: 5):

Contrary to the Examiner's position, nothing in the Nigam '282 references teaches nor suggests an intraocular lens having at least one pair of footplates, the footplates being separated by a haptic and attached to the optic by a ramp, the ramp being wider in a plane in which the optic lays than it is in a plane perpendicular to the plane of the optic.

It is uncertain whether the conclusory assertion applies to each claim feature individually or all three in combination. More importantly, however, the Applicants do not address and discuss the Examiner's explanation in support of the finding that the named features are disclosed in Nigam's intraocular lens. The question of what is wrong with the Examiner's rationale and analysis remains unanswered.

The Applicants generally argue that Nigam teaches away from the claimed invention by disclosing that its lens is stiffer along the optical axis than in the plane perpendicular to the optical axis. Even assuming that the allegation regarding relative stiffness in Nigam's lens is true, it has not been established or explained which feature of the claimed invention is at odds with and cannot possibly coexist with the alleged stiffness characteristic of Nigam. The Applicants' approach is misplaced. For determining patentability over prior art, the name of the game is the claim. *In re Hiniker Co.*, 150 F.3d at 1369, 47 USPQ2d at 1529, not some other feature the relationship of which to any claim feature has not been sufficiently established. No testimony of any technical witness has been submitted to the effect that a lens which is stiffer along the optical axis than in a plane

Comment [S1]: Should there be a “;” after claim and not a “.”?

perpendicular to the optical axis necessarily cannot comprise of a certain claim feature of the Applicants. Similarly, it has not been demonstrated why a lens generally softer as a whole cannot still be more stiff in one direction than another.

The deficiencies in the Applicants' Appeal Brief are also present in and shared by the Reply brief, except that in the Reply Brief, the Applicants specifically assert that nothing in Nigam says anything about the Applicants' recited force response, i.e., that the lens exhibits a force response of approximately less than 0.5 mN when the intraocular lens is compressed 1 mm. The argument is belated and not entitled to consideration, as it should have been presented for the first time in the Appeal Brief, not the Reply Brief.

In the alternative, even if we do consider the argument, it is without merit. The argument does not address or rebut the Examiner's rationale with regard to the meeting of the claim feature concerning the lens' reactive force, i.e., because all the structural features as claimed as well as the additional disclosed feature of the haptic spread to optic diameter ratio being less than 1.5 and 1.3 are met by Nigam, Nigam's lens inherently possesses the same reactive force property recited by the Applicants. The Examiner has articulated a reasonable basis of inherency based on structural identity. When the issue is inherent disclosure and when a *prima facie* case of inherency has been established, as here, the Applicants' simply saying that the reference does not teach the feature is unpersuasive. The Applicants have submitted no testimony from any technical witness to establish that Nigam's disclosed lens could not have a reactive force that is less than 0.5 mN when the intraocular lens is compressed 1 millimeter. Also, it is not

apparent and it has not been articulated by the Applicants what structural feature disclosed in their Specification as necessary to achieve the lower reactive force is not embodied in Nigam's lens. According to the Specification, although it is not claimed, the ratio of haptic spread to optic diameter should be less than 1.5 and 1.3. The Examiner determined that Nigam's lens exhibits such a ratio and that determination has not been specifically challenged by the Applicants. When a *prima facie* case of anticipation has been established based on inherency, the burden shifts to the Applicants to prove that the subject matter in the prior art does not possess the characteristics relied on. *In re King*, 801 F.2d at 1327, 231 USPQ at 138.

As for the merits of the dependent claims, it is noted that the Applicants represent that the dependent claims are not separately patentable.

Conclusion

The rejection of claims 1-15 under 35 U.S.C. § 102(b) as anticipated by Nigam is affirmed.

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

AFFIRMED

LP

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