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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES STUART CUMMING

Appeal 2017-010636
Application 15/069,746
Technology Center 3700

Before BRADLEY B. BAYAT, FREDERICK C. LANEY, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

KORNICZKY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner’s decision, as set forth in the Final Office Action mailed May 15, 2017 (“Final Act.”), rejecting claims 1–4, 6–14, 16–19, and 21–23.² We have jurisdiction under 35 U.S.C. § 6(b). A hearing was held on September 12, 2019.

We AFFIRM and ENTER NEW GROUNDS OF REJECTION.

THE CLAIMED SUBJECT MATTER

The claims are directed to a process for liquefying a carbon dioxide-rich gas. Claim 1, the only independent claim on appeal, is reproduced below with emphases to identify disputed limitations:

1. An intraocular lens comprising:
a lens optic; and
at least one longitudinal, *substantially rigid plate haptic* of a fixed length coupled to the lens optic, the at least one plate haptic having a plurality of laterally extending *substantially rigid* appendages each of which has a proximal portion and a lateral portion with said proximal portion being spaced apart from and extending laterally *substantially* beyond the transverse diameter of the optic.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as James Stuart Cumming. Appeal Brief, filed June 22, 2017 (“Appeal Br.”), 2.

² Claims 5, 15, and 20 are withdrawn. Appeal Br. 3–4; Final Act. 2.

REJECTIONS

The Examiner made the following rejections:

1. Claims 1–4, 6–14, and 16–19 stand rejected under pre-AIA 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

2. Claims 1–4, 6–9, 12–14, 18, 21, and 23 stand rejected under pre-AIA 35 U.S.C. § 102(b) as being anticipated by Israel (US 6,524,340 B2, issued February 25, 2003).

3. Claims 10, 16, and 17 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Israel in view of Cumming '084 (US 2007/0198084 A1, published August 23, 2007).

4. Claim 11 stands rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Israel in view of Cumming '514 (US 5,476,514, issued December 19, 1995).

5. Claims 19 and 22 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Israel in view of Klima (US 2007/0135915 A1, published June 14, 2007).

Appellant seeks our review of these rejections.

DISCUSSION

Rejection 1: Claims 1–4, 6–14, 16–19, and 21–23 as Being Indefinite

The Examiner finds that independent claim 1, and claims 2–4, 6–14, 16–19, and 21–23 which depend from claim 1, are indefinite. Final Act. 3–5.

Claim 1

Claim 1 recites an intraocular lens comprising “at least one longitudinal, substantially rigid plate haptic.” Appeal Br. 20, Claims App. The Examiner finds that the term “substantially” in this claim is indefinite. Final Act. 3–4; Answer, dated July 28, 2017 (“Ans.”), 3 (“[T]he lack of guidance by the present specification or in the prior art in general make[s] the use of ‘substantially’ indefinite as it is utilized in the present claims.”). We do not agree.

The Examiner does not explain persuasively why a person of ordinary skill in the art would not understand the term “substantially” in the context of a “substantially rigid plate haptic,” as used in the Specification and claims. The Specification states that “the plate haptic 10 may be substantially or partially constructed of flexible material, such as silicone, acrylic, hydrogel, and/or similar materials known in the art.” Spec. ¶ 21. The Specification also states that the plate haptic is able to “vault” backward when confined to the space in a capsular bag. Spec. ¶ 7. Appellant adds that a person of ordinary skill in the art would understand that the plate haptic must have sufficient rigidity to function for its intended purpose, that is, to attach to an intraocular lens. *See, e.g.*, Transcript of September 12, 2019 Hearing (“Tr.”), 3–6; Appeal Br. 10. In light of the Specification’s description of the plate haptic, we do not agree with the Examiner that use of “substantially” in claim 1 is indefinite.

For the reasons above, the rejection of claim 1 as being indefinite is not sustained. Likewise, the rejection of claims 6–11, 13, 14, 16, 18, 19, and 21–23, which depend from claim 1, is not sustained. The rejection of claims 2–4, 12, and 17 is addressed below.

Claim 2

Claim 2 recites at least one plate haptic comprising “a proximal portion; and wherein each of the plurality of appendages comprises a flange-like portion extending proximally and defined by the intersection of the proximal portion and a lateral portion.” Appeal Br. 20, Claims App. The Examiner finds that claim 2 is indefinite due the usage of three terms: (1) proximal portion, (2) flange-like, and (3) intersection. We address each finding below.

First, the Examiner finds that “proximal portion” in claim 2, line 5 is indefinite because it is unclear what structure is being referenced — the proximal portion of the appendage recited in claim 1 or the proximal portion of the at least one plate haptic recited in claim 2. Final Act. 4; Ans. 4. We do not agree. Claim 2, line 5 states that the “at least one plate haptic,” not the “appendages” in claim 1, comprises “a proximal portion.”

Second, the Examiner finds that “flange-like” is indefinite because it is unclear “how much like a flange that the portion has to be in order to be like a flange.” Final Act. 4 (citing MPEP § 2173.05(d)); Ans. 5. Appellant argues that the Examiner’s rejection is erroneous. According to Appellant,

Flange is defined as “a projecting rim, collar or or rib on an object” (Oxforddictionaries.com) and “like” is defined as “having the same characteristics or qualities as; similar to” (same). Thus, “flange-like[”] means similar to a flange.

Appeal Br. 11. We agree with Appellant that, read in light of the Specification, the term “flange-like” is plainly descriptive of appendages 30 of the intraocular lens of the present invention, and stating that something is similar to a known object does not involve uncertainty.

Third, the Examiner finds the term “intersection” is indefinite because it lacks antecedent basis. Final Act. 5; Ans. 5. In response, Appellant states that the “claim would make no sense, i.e., would be indefinite if it recited ‘an intersection’ because that would indicate that there are many intersections, whereas ‘the intersection’ means that there is one intersection. This keeps the claim consistent with the specification.” Appeal Br. 3.

After considering the claims and the Specification, we determine that Examiner has the better position. The scope of the claims are unclear and amenable to two plausible interpretations. *In re Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential) (“[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.”). Both “the plurality of appendages” and the “at least one plate haptic” recited in claim 2 may have “an intersection” between their respective proximal and lateral portions. Thus, the Examiner reasonably determines that multiple intersections may exist.

We also note that the limitation “defined by the intersection of the proximal portion and a lateral portion” is indefinite because it is unclear whether this limitation refers to the proximal and lateral portions of “the plurality of appendages” or the “at least one plate haptic.” The recitation to “a lateral portion” is further also indefinite because it is unclear whether this refers to the recitation of “a lateral portion” in claim 1 or “a plurality of opposing lateral portions” in claim 2.

Because multiple interpretations of claim 2 are plausible in light of the Specification, we agree with the Examiner that claim 2 is indefinite. Here,

Appellant is in the best position to more precisely define the metes and bounds of his claim. Thus, the rejection of claim 2 is sustained.

Claims 3 and 4

Claim 3 recites that the opposing lateral portions of the appendages “are substantially non-convergent.” Appeal Br. 20, Claims App. Claim 4 recites that the opposing lateral portions of the appendages “are substantially divergent.” The Examiner states that the term “substantially” in these claims is indefinite. Final Act. 3–4; Ans. 3–4. We do not agree.

As to claims 3 and 4, the Specification addresses the orientation of the appendages:

[E]ach appendage 30 is formed of the lateral portion 14 and proximal portion 16. In some embodiments, the lateral portions 14 of opposing appendages 30 may be *substantially non-convergent*. In other words, the lateral portion 14 may be approximated by lines which, if extended roughly in the direction of the lens optic 20, would be *substantially non-convergent*. In at least one preferred embodiment, the lateral portion 14 may be substantially divergent, as shown in FIG. 3. In at least one preferred embodiment, they may be *substantially parallel*, as shown in FIG. 4.

Spec. ¶ 31 (emphases added). One definition of “convergent” is “characterized by convergence; tending to come together; merging.”

Dictionary.com (accessed Sept. 13, 2019),
<https://www.dictionary.com/browse/convergent?s=t>.

One definition of converge is “to tend to meet in a point or line; incline toward each other, as lines that are not parallel.” Dictionary.com (accessed Sept. 13, 2019), <https://www.dictionary.com/browse/converge?s=t>. We understand that “non-convergent” means to move or extend in different

directions. One definition of “diverge” is “to move, lie, or extend in different directions from a common point; branch off.” Dictionary.com (accessed Sept. 13, 2019), <https://www.dictionary.com/browse/diverge?s=t>. The terms “non-convergent” and “divergent” have the same meaning. *See* Tr. 10. A person of ordinary skill in the art would understand that the terms “substantially non-convergent” and “substantially divergent” mean that the appendages extend in different directions from a common point.

CLAIMS 3 AND 4: NEW GROUND OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection. Claims 3 and 4 are rejected under 35 U.S.C. §112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of the claim upon which they depend. Because the terms “substantially non-convergent” recited in claim 3 and “substantially divergent” recited in claim 4 are synonymous, claim 4, which depends from claim 3, does not add any further limiting structure to claim 3.

CLAIM 12: NEW GROUND OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection. Claim 12 is rejected under 35 U.S.C. §112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends. Claim 1 recites a “substantially rigid plate haptic” and “substantially rigid appendages.” Likewise, claim 12 recites that the “at least one plate haptic and the appendages are substantially rigid.” Claim 12, which depends from claim 1, does not add any further limiting structure to claim 1. *See* Tr. 12.

Claim 14

Claim 14 recites a “lens of claim 2, wherein the proximal portion of the at least one haptic comprises a connecting portion connecting the lens optic to the haptic.” Appeal Br. 20, Claims App. The Examiner finds that claim 14 is indefinite because “‘the proximal portion’ lacks antecedent basis because it is not clear which proximal portion is being referenced.” Final Act. 5. Appellant argues that the Examiner’s finding is erroneous because “[t]his recitation in claim 14 is part of the larger recitation ‘the proximal portion of the at least one haptic’.” Appeal Br. 12. We agree with Appellant. Claim 14 references the proximal portion of the at least one plate haptic recited in claim 2. Thus, the rejection of claim 14 is not sustained.

Claim 17

The Examiner finds that the recitation of “the strap” in claim 17 is indefinite because it lacks antecedent basis. Final Act. 5. In response, Appellant states that the “rejection of claim 17 is based on a typographical error which Applicant acknowledges and this rejection is not appealed. [] Claim 17 [] will be amended to depend on claim 16 upon an indication of allowable subject matter.” Appeal Br. 12. Thus, the rejection of claim 17 is sustained.

*Rejection 2: Claims 1–4, 6–9, 12–14, 18, 21, and 23
as Anticipated by Israel*

Claim 1, 3, 4, 6, 8, 9, 12, 18, 21, and 23

Appellant argues claims 1, 3, 4, 6, 8, 9, 12, 18, 21, and 23 as a group. Appeal Br. 14–16. We select claim 1 as the representative claim, and claims

3, 4, 6, 8, 9, 12, 18, 21, and 23 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv). Claims 2, 7, 13, and 14 are addressed below.

The Examiner finds that Israel discloses all of the limitations of claim 1. Final Act. 5–6. In particular, the Examiner finds that Israel’s arm 16 corresponds to the recited plate haptic. *Id.* The Examiner explains that “haptic” “is a broad term and certainly can encompass about any feature that is not the optic itself,” and “[s]ince the arm (16) of Israel is in the form of a flat plate structure, the claim language is fully met in this regard.” Ans. 6. The Examiner further explains that “there is no special definition of ‘plate haptic’ or ‘haptic’ in the present specification,” and “the term ‘haptic’ is denoted as ‘*a science concerned with the sense of touch*’ (Merriam-Webster.com) or ‘*[t]he science of applying tactile sensation to human interaction with computers*’ (mondofacto.com) or ‘*a study of the sense of touch*’ (medical-dictionary.thefreedictionary.com).” *Id.* (alteration in original).

Appellant argues that the Examiner’s rejection is erroneous for several reasons. First, Appellant argues that Israel discloses a “ring haptic,” not a “plate haptic” as recited in claim 1. Appeal Br. 16; Reply Brief, filed August 11, 2017 (“Reply Br.”), 4. According to Appellant, the fundamental error of the rejection “is that leverage arms 16 of Israel are not haptics, but rather are members which connect ring haptic 14 to optic 12. In addition, ring haptic 14 is not a plate haptic as recited in the claims.” Appeal Br. 16. Appellant also states that the Examiner’s dictionary definitions of haptic are inapplicable when read in light of the technology in the Specification, and that “the relevant definition of ‘haptic’ is ‘The flexible, looping extension

attached to an intraocular lens that stabilizes and centers it within the eye’ (Steadman Medical Dictionary 2004-2017).” Reply Br. 5.

We note the Specification provides a broad definition of “haptic” — the “word ‘haptic’ has been used to describe an attachment to intraocular lens.” Spec. ¶ 6. We agree with Appellant that the Examiner’s dictionary definitions are inapplicable. Based on the Specification and Appellant’s proposed definition, the meaning of “haptic” is the “extension attached to an intraocular lens that stabilizes and centers it within the eye.” Reply Br. 5.

The Specification describes different types of haptics. The Specification states that the “first attachments to the optic were called ‘haptics’. They consisted of multiple flexible loops of various designs, J loops, C loops, closed loops and flexible radial arms.” Spec. ¶ 6. The Specification further states that “[l]ater, these loops which became commonly referred to as ‘haptics’ were replaced in some lens designs with flat homogeneous plates, called ‘plate haptics’.” *Id.* ¶ 7. We note that Appellant’s Information Disclosure Statement identifies US Patent 7,553,327 B2, issued June 30, 2009 (“Cumming ’327”), another patent by the listed inventor, Mr. J. Stuart Cumming. According to Cumming ’327, a “plate haptic lens may be defined as an intraocular lens having two or more plate haptics where combined junctions with the optic represent one quarter or more of the circumference of the optic.” Cumming ’327, 1:54–57. Figures 1–18 of Cumming ’327 illustrate plate haptics having flat homogenous plates with circular, rectangular, and other shapes. Based on the usage of the term “plate haptic” in the Specification, a plate haptic broadly means flat homogenous plates attached to an intraocular lens that stabilize and center an intraocular lens within the eye.

According to the broad usage of “plate haptic” in the Specification, Israel’s arm 16 meets the requirements of the “plate haptic” in claim 1. Israel’s arms 16 are flat homogenous plates that stabilize and center intraocular lens 12 within the eye. Israel, 3:66–67 (“Each leverage arm 16 is preferably configured generally as a plate and has a longitudinal axis 18.”). Structural element 14, which Israel calls a haptic, is attached to arms 16 but does not detract from the arms’ flat homogenous plate shape and function. Israel states that element 14 has a ring-shape, but this “is just one example of a suitably shaped haptic and other sizes and shapes of haptics may be used as well.” *Id.* at 3:47–49. We note, for example, that Cumming ’327 discloses plate haptics having flat plates and protruding ring-like structures. *See* Cumming ’327, Figures 3, 13, 14, 16–18. Stated another way, leverage arm 16, which is integrally attached to structure 16, corresponds to the “plate haptic” recited in claim 1.

Second, Appellant argues that Israel does not disclose a haptic “having a plurality of laterally extending substantially rigid appendages” as recited in claim 1. Appeal Br. 14–15. Appellant argues:

Zones 24 of arms 16 of Israel are points of contact between arms 16 and optic 12. Unlike the appendages of the claims in this application, arms 16 are not part of haptic 14 of Israel and thus are not appendages as recited in the claims of this application. Indeed, points of contact cannot conceivably to be considered appendages of any sort. An “appendage” is defined as a “limb or other subsidiary part that diverges from the central or principal structure” (Random house Webster's College Dictionary, 1991).

Appeal Br. 14–15. Appellant’s argument is not persuasive. Israel discloses that the arm 16 has two second-ends 22/attachment zones 24 that diverge and extend laterally from the central part of arm 16. We agree with the

Examiner that this structure meets the requirements of appendage as recited in claim 1.

Third, Appellant argues that Israel's arm 16 does not have a "proximal portion" and a "lateral portion" as recited in claim 1 because Israel does not have the recited appendage, as discussed above. Appeal Br. 15. Appellant's arguments are not persuasive because, for the reasons discussed above, Israel discloses the recited appendage. The Examiner correctly finds that "the proximal portion as claimed is the adjacent connection point of zone (24)" and "the lateral portion as claimed is at the connection point of zone (24) and the transverse diameter as claimed is the diameter oriented vertically on Figure 2 as between the two attachment zones (24) of the arms (16)." Final Act. 5-6.

For the reasons above, the rejection of claim 1 is sustained. Likewise, the rejection of dependent claims 3, 4, 6, 8, 9, 12, 18, 21, and 23 is sustained.

Claim 2

Claim 2 recites that "the at least one plate haptic further comprises: a plurality of opposing lateral portions." Appeal Br. 20, Claims App.

Appellant argues that the Examiner erroneously finds that Israel discloses this limitation because the "'lateral portion' 14 of the haptic referred to in claim 2 of this application cannot be found in Israel because the connection point 24 of leverage arm 16 relied upon by the Examiner is not part of ring haptic 14." Appeal Br. 15. Appellant's argument is not persuasive because, for the reasons discussed above, Israel's arm 16 meets the requirements of the recited "plate haptic," and arm 16 has proximal and lateral portions. Thus, the rejection of claim 2 is sustained.

Claim 7

Claim 7 recites that “the appendages extend laterally and are substantially coextensive with a transverse diameter of the lens optic.” Appeal Br. 20, Claims App. The Examiner finds that Israel discloses the limitations in claim 7. Final Act. 5–6. First, Appellant argues that this “recitation of the extent of [Appellant’s] appendages cannot be found in Israel because Israel has no appendages. Furthermore, the Examiner has taken only a fragment (‘transverse diameter’) out of this recitation in a fundamentally flawed attempt to reject the claim.” Appeal Br. 15. Appellant’s arguments are not persuasive because, for the reasons discussed above, Israel’s arm 16 meets the requirements of the recited “plate haptic,” and arm 16 has extending appendages 22/24 which are substantially coextensive with a transverse diameter of optic lens 12.

Second, Appellant argues that Israel’s leverage arms 16 end at chord 26, which is not a diameter, and Israel expressly states that “arm 16 is preferably not attached to the equator of the lens,” thereby teaching away from this claim. Appeal Br. 15 (citing Israel, 4:23–24). Appellant’s arguments are not persuasive. Claim 7 requires that the appendages are substantially coextensive with the lens diameter, not that the arm 16 is attached to the equator of lens 12. The Examiner correctly explains that Israel’s appendages 22/24 are “substantially coextensive with a transverse diameter of the lens optic” because “substantially coextensive” is a broad limitation that encompasses Israel’s structures. Ans. 7. Referring to Figure 2 of Israel, for example, the outermost edges of Israel’s appendages (e.g., the arrow of reference 22 points to one of the outermost edges) are slightly

wider than the lens diameter and are “substantially coextensive” with the lens diameter.

For the reasons above, the rejection of claim 7 is sustained.

Claim 13

Claim 13 recites that “the at least one plate haptic further comprises a chassis having distal and proximal ends, the chassis operable to substantially permit flexion in a longitudinal direction and to substantially prohibit flexion in a transverse direction.” Appeal Br. 20, Claims App. The Examiner finds that Israel discloses the limitation in this claim — reference 14 meets the requirements of the chassis recited in claim 7. Final Act. 6 (citing Israel, 4:8–18).

Appellant argues that the Examiner’s finding is erroneous because “[h]aptic 14 of Israel cannot be the chassis 18 of the present application. The chassis 18 of the claims is an addition to the haptic, not the haptic itself.” Appeal Br. 15. Because Appellant does not address the rejection as articulated by the Examiner, Appellant’s argument is not persuasive. The Examiner finds that arm 16, not element 14, corresponds to the recited “plate haptic.” As discussed above, arm 16 meets the definition of “plate haptic.” We recognize that Israel calls element 14 a “haptic,” but Appellant does not explain how element 14 meets the definition of a “haptic” as defined in the Specification. Element 14 is not an “extension attached to an intraocular lens that stabilizes and centers it within the eye.” Israel’s terminology for element 14 (i.e., haptic 14) does not apprise us of error in the Examiner’s finding that arm 16, not element 14, is the recited “plate haptic,” which has flat homogenous plates attached to an intraocular lens that stabilize and

center an intraocular lens within the eye. *Ans. 2; In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) (explaining there is no *ipsisimis verbis* test for determining whether a reference discloses a claim element, i.e., identity of terminology is not required). Because Appellant does not address the Examiner’s construction of “haptic” and “plate haptic,” Appellant does not identify Examiner error.

For the reasons above, the rejection of claim 13 is sustained.

Claim 14

Claim 14 recites “the proximal portion of the at least one haptic comprises a connecting portion connecting the lens optic to the haptic.” Appeal Br. 20, Claims App. The Examiner finds that Israel discloses the limitations in claim 14. Final Act. 5–6.

Appellant argues that the Examiner’s finding is erroneous because “the Examiner relies on the proximal portion of arms 16 of Israel for this feature even though as explained at some length above, arms 16 are not a haptic. Ring haptic 14 is the haptic of Israel and it is connected to optic 12 by arms 16.” Appeal Br. 15–16. For the reasons discussed above in connection with claim 1, the Examiner correctly finds that Israel’s arm 16 corresponds to the plate haptic recited in claim 1. Appellant’s argument is not persuasive. The rejection of claim 14 is sustained.

Rejection 3: Claims 10, 16, and 17 as Unpatentable Over Israel and Cumming ’084

The Examiner finds that the combination of Israel and Cumming ’084 discloses the limitation in claims 10, 16, and 17. Final Act. 7–8. As to

claim 10, the Examiner states that Israel does not disclose the recited widths of appendages but Cumming '084 teaches that it was known to make optics about 4.5 mm (citing Cumming '084, ¶ 14), and, thus, it would have been obvious to make the appendages of Israel about 2.0 mm as claimed for the same reasons that Cumming '084 teaches that this is the relative size of optics in the same art and for the reason that it would have been a mere application of a known dimension to yield a predictable result. *Id.* at 7 (citing MPEP § 2143).

As to claims 16 and 17, the Examiner finds that Israel does not disclose the recited “straps,” but Cumming '084 “teaches that it was known to utilize multiple straps between optics and haptics within the art,” and, thus, it would have been obvious to a person of ordinary skill in the art “to utilize multiple straps in the Israel invention for the same reasons that Cumming '084 utilize the same (greater stability as compared to a single attachment point)” or “it would have been a mere modification of a known feature to another known feature structure to yield a predictable result.” Final Act. 7–8 (citing MPEP § 2143).

Appellant argues that the Examiner’s rejection is erroneous because “claim 10 recites dimensions of the appendages which do not exist in Israel and because claims 16 and 17 recite straps 40 connecting [Appellant’s] plate haptic 10 to his optic 20, whereas Israel discloses only a ring haptic 14 connected to his optic 12 by arms 16.” Appeal Br. 16. However, Appellant is attacking the teachings of Israel individually. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, the Examiner finds that

Cumming '084, not Israel, discloses the recited dimensions, and states that it would have been obvious to make the appendages of Israel about 2.0 mm as claimed for the same reasons that Cumming '084 teaches that this is the relative size of optics in the same art and for the reason that it would have been a mere application of a known dimension to yield a predictable result. Final Act. 7. Appellant does not address the rejection as articulated by the Examiner, and, thus, does not identify error by the Examiner.

Appellant also argues that “there would be no motivation to combine Cumming with Israel, because the entire thrust of Israel is to provide leverage arms 16 to connect his ring optic 14 to his optic 12,” and “[i]f straps 40 of Cumming were substituted for Israel’s arms 16, the essence of Israel would be destroyed.” Appeal Br. 16. Appellant, however does not address substantively the Examiner’s reasoning that Cumming '084 “teaches that it was known to utilize multiple straps between optics and haptics within the art,” and, thus, it would have been obvious to a person of ordinary skill in the art “to utilize multiple straps in the Israel invention for the same reasons that Cumming '084 utilize the same (greater stability as compared to a single attachment point)” or “it would have been a mere modification of a known feature to another known feature structure to yield a predictable result.” Final Act. 7–8. Because Appellant does not address the Examiner’s articulated reasoning for combining the two references, Appellant does not identify error by the Examiner.

For the reasons above, the rejections of claims 10, 16, and 17 is sustained.

*Rejection 4: Claim 11
as Unpatentable Over Israel and Cumming '514*

The Examiner finds that the combination of Israel and Cumming '514 discloses the limitation in claims 11. Final Act. 8. The Examiner states that Israel does not disclose the recited thickness of the plate haptic, but Cumming '514 teaches that it was known to make haptics with the claimed thickness. *Id.* (citing Cumming '514, 12:46). The Examiner reasons that it would have been “obvious to make the haptics with the haptic thickness of Cumming '514 to provide the permit accommodation movement without interference with the capsular ring.” *Id.*

Appellant argues that the Examiner’s findings are erroneous because Israel has no plate haptic, but rather has a ring haptic. The two types of haptic are so fundamentally different that looking to one for guidance with regard to the thickness of the other makes absolutely no sense. Thus, the references cannot be rationally combined. Furthermore, even if the ring haptic 14 of Israel had the same thickness as the plate haptic of Cumming, the structure of claim 11 would not result because it would not contain a plate haptic. Hence, there would be no motivation to combine these references.

Appeal Br. 16–17.

Appellant’s argument is not persuasive. As discussed above in connection with claim 1, the Examiner correctly finds that Israel discloses a plate haptic as recited in claim 1. In addition, Appellant is attacking the teachings of Israel individually. *In re Merck*, 800 F.2d at 1097 (Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures.). Here, the Examiner finds that Cumming '514, not Israel, discloses the recited dimensions. Final Act. 8. Appellant does not address

the rejection as articulated by the Examiner, and, thus, does not identify error by the Examiner.

For the reasons above, the rejection of claim 11 is sustained.

*Rejection 5: Claims 19 and 22
as Unpatentable Over Israel and Klima*

The Examiner finds that the combination of Israel and Klima discloses the limitation in claims 19 and 22. Final Act. 8. The Examiner finds that Israel does not disclose a “chassis inside the appendix or embedded in the haptic as claimed,” but Klima teaches that it was known “to make chassis that extend throughout the haptic or be embedded in the same.” *Id.* (citing Klima, ¶¶ 38, 147, 154; Figures 12, 26, and 39). The Examiner reasons that it would have been obvious “to make the chassis within the haptics as taught by Klima to provide better support of the chassis to the haptic and the better control the flexing properties of the haptic and arms.” *Id.*

Appellant argues that the Examiner’s findings and reasoning are erroneous because:

There is no way that the reinforced plate haptics of Klima could be combined with Israel in substitution for ring haptic 14 without destroying the essence of Israel and there is no way that the reinforcements of Klima could be combined with Israel’s ring haptics 14.

Appeal Br. 17.

Appellant also argues that “there would be no motivation to combine the references as suggested by the Examiner because such combination would either be self-defeating or impossible.” *Id.* According to Appellant,

[i]f the Examiner’s suggestion is that the reinforcing elements of Klima be added to arms 16 of Israel, that would rewrite Klima by transferring his reinforcing elements 334 of Fig. 12 from the

haptics 314 to legs 316 and would misconstrue the claims of this application by locating the reinforcing elements in the straps 40 rather than the haptics 10.

Id.

Appellant’s arguments are not persuasive. The Examiner proposes embedding Klima’s chassis in Israel’s plate haptic (i.e., arm 16), not Israel’s ring structure 14. Appellant does not address the Examiner’s proposed rejection and reasoning as articulated by the Examiner, and, thus, does not identify error by the Examiner.

For the reasons above, the rejection of claims 19 and 22 is sustained.

CONCLUSION

In summary:

Claims Rejected	Basis (35 U.S.C.)	Affirmed	Reversed	New Ground
1–4, 6–14, 16–19, 21–23	§ 112, second paragraph	2, 17	1, 3, 4, 6–14, 16, 18, 19, 21–13	3, 4, 12
1–4, 6–9, 12–14, 18, 21, 23	§ 102(b) Israel	1–4, 6–9, 12–14, 18, 21, 23		
10, 16, 17	§ 103(a) Israel, Cumming ’084	10, 16, 17		
11	§ 103(a) Israel, Cumming ’514	11		
19, 22	§ 103(a) Israel, Klima	19, 22		
Overall Outcome		1–4, 6–14, 16–19, 21–23		3, 4, 12

For the above reasons, we AFFIRM the Examiner's rejection of claims 2 and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite.

We REVERSE the Examiner's rejection of claims 1, 3, 4, 6–14, 16, 18, 19, and 21–23 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Under 37 C.F.R. § 41.50(b), we enter a new ground of rejection — claims 3, 4, and 12 are rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of the claim upon which they depend.

We also AFFIRM the Examiner's rejections of claims 1–4, 6–14, 16–19, and 21–23 under 35 U.S.C. §§ 102(b) and 103(a).

FINALITY AND RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to any affirmed rejection, the effective date of the affirmance will be deferred until conclusion of the prosecution before the Examiner unless the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment, or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

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

AFFIRMED; 37 C.F.R. § 41.50(b)