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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NEIL GOODENOUGH, DAVID ROBERT MORSLEY, IAN BRUCE, EDYTA S. BIALEK, and LEE DARREN NORRIS

Appeal 2018-001337
Application 15/007,237
Technology Center 1700

Before ADRIENE LEPIANE HANLON, CATHERINE Q. TIMM, and N. WHITNEY WILSON, *Administrative Patent Judges*.

WILSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's March 6, 2017 decision rejecting claims 20, 21, and 23–31² (“Non-Final Act.”). We have jurisdiction over the appeal under 35 U.S.C. § 6(b). An oral hearing was held on August 29, 2019, a transcript of which will be made part of the record.

We reverse.

¹ Appellant is the Applicant, CooperVision International Holding Company, L.P., which is also identified as the real party in interest (Appeal Br. 1).

² Claims 32–36 have been withdrawn from consideration (Non-Final Act. 1).

CLAIMED SUBJECT MATTER

Appellant's disclosure relates to an ophthalmic mold member which includes a molding surface configured to form an entire surface (either anterior or posterior) of a contact lens (Abstract). The molding surface contains two distinct portions formed from different polymers (*id.*). One polymer is water soluble and the other polymer is water insoluble (Spec. ¶¶ 29, 49). Details of the claimed invention are set forth in independent claim 20, which is reproduced below from the Claims Appendix to the Appeal Brief (*emphasis added*):

20. An ophthalmic contact lens mold member including a molding surface configured to form an entire anterior or posterior surface of a contact lens, the molding surface comprising:

(a) a distinct first portion formed of a first polymer, wherein the first polymer is water-soluble, and wherein the distinct first portion is configured to come into direct contact with a polymerizable composition to cast mold a first region of the anterior or posterior surface of the contact lens; and

(b) a distinct second portion formed of a second polymer that is different from the first polymer, wherein the second polymer is essentially insoluble in water, and wherein the distinct second portion is configured to come into direct contact with the polymerizable composition to cast mold a second region of the same anterior or posterior surface of the contact lens, and is configured, in combination with the distinct first portion, to form the entire anterior or posterior molding surface, and wherein the combination of the distinct first portion and the distinct second portion are configured to come into direct contact with the polymerizable composition to cast mold the entire anterior or posterior surface of the contact lens.

REJECTIONS³

1. Claims 20, 23, 24, and 27–31 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tokarski.⁴

2. Claims 21, 28, and 29 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tokarski in view of Plastic Technology.⁵

3. Claims 25 and 26 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tokarski in view of Yamamichi.⁶

DISCUSSION

We decide this appeal based on limitations found in independent claim 20. Accordingly, we limit our analysis to the rejection of claim 20 as obvious over Tokarski.

The Examiner finds that Tokarski teaches an ophthalmic contact lens mold member including a molding surface configured to form an entire surface of a contact lens (Non-Final Act. 8, citing Tokarski ¶¶ 20–79, FIGS. 1–4):

³ In the Non-Final Action, claims 20, 23, 24, and 27–31 were rejected under 35 U.S.C. § 102(b) as anticipated by Tokarski (Non-Final Act. 3). This rejection was withdrawn by the Examiner (Ans. 2) and, therefore, is not considered as part of this appeal.

⁴ Tokarski et al., US 2008/0001317 A1, published January 3, 2008.

⁵ “Vinyl Alcohol Polymers Are Moldable and Extrudable,” *Plastics Technology*, published July 2009.

⁶ Yamamichi, US 2006/0284327 A1, published December 21, 2006.

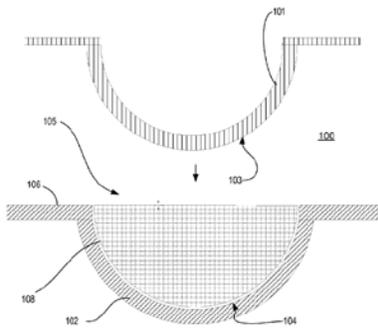


FIG. 1

FIG. 1 illustrates a diagram of an ophthalmic lens mold as taught by Tokarski.

As shown in FIG. 1 above, Tokarski's lens mold has two parts: female concave piece **102** and male convex piece **101**. The Examiner interprets claim 20 as requiring only "a distinct first and second mold (made of different material), one water soluble material, and the other water insoluble material" (Non-Final Act. 9). The Examiner further finds that Tokarski teaches the use of both water soluble and water insoluble polymers to form the mold member (Non-Final Act. 8-9). The Examiner also finds there is sufficient motivation for one of ordinary skill in the art to modify Tokarski's mold parts "in order to have at least one mold made of [a] water soluble material (see [0040]), and the other insoluble ([0040])." (Non-Final Act. 10).

Appellant argues that claim 20 requires that the molding surface of a single mold part (i.e. a part which can form either the anterior or the posterior surface of a contact lens) comprise two distinct portions, a first portion formed of the water-soluble polymer, and a second portion formed of the water insoluble polymer (Appeal Br. 5). The Examiner, in response, contends that "Appellant's argument is not found persuasive since claim 20

as written does not state that ‘both first and second portions form SAME, single, surface (anterior or poster) of the contact lens’ as argued” (Ans. 3).

In view of the claim language and the disclosure of Appellant’s Specification, we agree with Appellant and reverse the rejection. In particular, claim 20 recites that the second distinct portion of the molding surface “is configured to come into direct contact with the polymerizable composition *to cast mold a second region of the same anterior or posterior surface.*” (Emphasis added). Thus, contrary to the Examiner’s argument, the two distinct regions are required to cast mold the same surface of the contact lens. Moreover, the Specification is clear in stating that:

“[F]orming the entire molding surface *does not comprise forming a mixture of the first and second polymers* and using the polymer mixture to form the entire molding surface. Instead, distinct first and second portions are combined to form the entire molding surface, and once the first and second portions have been combined to form the entire molding surface, *distinct first and second portions remain.*”

(Spec. ¶ 24) (emphasis added). Thus, forming the molding surface from a mixture of water-soluble and water-insoluble polymers without having distinct regions of those two materials would not meet the limitations of the claim.

The Examiner has the initial burden of establishing a prima facie case of obviousness based on an inherent or explicit disclosure of the claimed subject matter under 35 U.S.C. § 103. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.”). To establish a prima facie case of obviousness, the Examiner must show that each and every limitation of the claim is described

or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). In this instance, the preponderance of the evidence of record supports Appellant's contention that the cited art does not teach or suggest a single molding surface made up of two distinct regions, one formed of a water soluble polymer, and one formed of a water insoluble polymer. Accordingly, we reverse the rejection of claim 20. We reverse the rejections of the dependent claims for the same reason.

CONCLUSION

We REVERSE the rejection of claims 20, 23, 24, and 27–31 under 35 U.S.C. § 103(a) as unpatentable over Tokarski.

We REVERSE the rejection of claims 21, 28, and 29 under 35 U.S.C. § 103(a) as unpatentable over Tokarski in view of Plastic Technology.

We REVERSE the rejection of claims 25 and 26 under 35 U.S.C. § 103(a) as unpatentable over Tokarski in view of Yamamichi.

REVERSED