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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JAMES D. RIALL, FREDERICK A. FLITSCH,  
RANDALL B. PUGH, and  
SHARIKA SNOOK

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Appeal 2019-001427  
Application 15/144,513  
Technology Center 2800

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Before DONNA M. PRAISS, MICHELLE N. ANKENBRAND, and  
JEFFREY R. SNAY, *Administrative Patent Judges*.

SNAY, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

Appellant<sup>2</sup> filed an appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–9, 11–23, and 25–30. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Our Decision refers to the Specification filed May 2, 2016 (“Spec.”), the Final Office Action dated Mar. 29, 2018 (“Final Act.”), the Appeal Brief dated Sept. 25, 2018 (“Appeal Br.”), the Examiner’s Answer dated Nov. 5, 2018 (“Ans.”), and the Reply Brief dated Dec. 5, 2018 (“Reply Br.”).

<sup>2</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Johnson & Johnson Vision Care, Inc., as the real party in interest. Appeal Br. 1.

## BACKGROUND

The subject matter on appeal relates to a multi-piece insert device for an ophthalmic lens (*see, e.g.*, claims 1 and 15). According to the Specification, it has been theorized that active components, such as semiconductor devices, may be incorporated into a contact lens. Spec. 1:20–22. The Specification states that ophthalmic lenses containing inserts and components may produce a device having an appearance different from a standard look of a user’s eye. *Id.* at 1:27–2:1. Therefore, it may be desirable for the ophthalmic product to have printed features that render an appearance similar to a standard look of a user’s eye. *Id.* at 2:1–3. For instance, the Specification discloses an embodiment of an ophthalmic lens device having a pattern representing an iris type pattern. *Id.* at 16:3–5. The pattern may cover or obscure underlying components and the region may include features such as integrated circuits and electrical interconnects. *Id.* at 16:13–16. The pattern may further have a window that allows light to pass through the patterned region, such as to an underlying detector that can detect a blink, which may signal a desire to change a state in the ophthalmic lens. *Id.* at 16:20–27.

Independent claim 1 is illustrative and is reproduced below from the Claims Appendix of the Appeal Brief. Limitations at issue are italicized.

1. A multi-piece insert device for an ophthalmic lens comprising:
  - a back curve piece;
  - a front curve piece combined with the back curve piece to form a cavity therebetween;
  - a pattern of conductive material placed onto one or both of the front curve piece and the back curve piece;
  - at least one electronic component placed onto at least a portion of the pattern of conductive material; and

a colorant pattern placed onto a surface of the front curve piece such that it overlies the electronic component but has a region located within the colorant pattern which comprises *a transparent window located such that light may pass* through the transparent window to the electronic component.

Appeal Br. 11 (Claims App'x).

#### REJECTIONS ON APPEAL

- I. Claims 1, 4–9, 11, 12, 15, 18–23, 25, 26, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Pugh<sup>3</sup> in view of Otis;<sup>4</sup>
- II. Claims 2 and 3 as being unpatentable under 35 U.S.C. § 103(a) over Pugh in view of Otis and further in view of Ocampo;<sup>5</sup>
- III. Claims 13 and 14 as being unpatentable under 35 U.S.C. § 103(a) over Pugh in view of Otis and further in view of Blum;<sup>6</sup>
- IV. Claims 16 and 17 as being unpatentable under 35 U.S.C. § 103(a) over Pugh in view of Otis and further in view of Ocampo; and
- V. Claims 27 and 28 as being unpatentable under 35 U.S.C. § 103(a) over Pugh in view of Otis and further in view of Blum.

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<sup>3</sup> Pugh et al., US 2010/0072643 A1, published Mar. 25, 2010 (“Pugh”).

<sup>4</sup> Otis et al., US 2012/0245444 A1, published Sept. 27, 2012 (“Otis”).

<sup>5</sup> Ocampo, US 2005/0001978 A1, published Jan. 6, 2005 (“Ocampo”).

<sup>6</sup> Blum et al., US 2009/0033863 A1, published Feb. 5, 2009 (“Blum”).

## DISCUSSION

### *Rejection I*

Claims 1, 4–9, 11, 12, 15, 18–23, 25, 26, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over by Pugh in view of Otis.

The Examiner finds Pugh discloses an insert device for an ophthalmic lens comprising a back curve piece, a front curve piece, a pattern of conductive material, at least one electronic component, and a colorant pattern. Final Act. 4. The Examiner finds Pugh does not teach that the colorant pattern includes a region comprising a transparent window located to pass through the window to the electronic component, as claim 1 recites. *Id.*

The Examiner finds Otis discloses an ophthalmic device including an insert, conductive material, a sensor, and a mask overlying an electronic component that has a window. *Id.* The Examiner concludes it would have been obvious to one of ordinary skill in the art to modify Pugh’s device to include a window in its colorant pattern, as Otis teaches, to permit energy to reach a sensor for its operability. *Id.*

Appellant contends that Otis’s opening or void is not a “transparent window,” as claim 1 recites. Appeal Br. 8. Specifically, Appellant argues that Otis discloses a photoresist, SU-8, that is ultimately removed to create a void or opening above Otis’s sensor. *Id.* The Examiner responds that the broadest reasonable interpretation of “transparent window” is synonymous with an opening. Ans. 3–4 (citing Merriam-Webster dictionary; Spec. 16:27–29).

Appellant disputes the Examiner’s interpretation. Appellant presents an alternative definition, which defines “window” as “an opening especially

in the wall of a building for admission of light and air that is usually closed by casements or sashes containing transparent material.” Reply Br. 2 n.1. Appellant argues that the Examiner’s interpretation gives no meaning, weight, or consideration to the term “transparent.” *Id.* at 1–2. Appellant further asserts that the passage in the Specification the Examiner cites sets forth two alternatives for a window: one that is a lack of pattern-forming material and another that is made by a material transparent to light. *Id.* at 2–3. Appellant argues the latter is an explicit definition for “transparent window” that excludes an opening. *Id.* at 3.

Appellant’s arguments are unpersuasive. During prosecution before the Examiner, the claim language should be given its broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account any definitions or enlightenment contained in the written description of Appellant’s Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

The Specification identifies the transparent window as follows:

[I]t may be desirable for any patterns on the lens to have a window 625 that allows light to pass through the patterned region . . . . The window 625 may be made by the lack of pattern-forming material, or by an alternative material, which is transparent to light.

Spec. 16:25–28.

The above-quoted passage is reasonably interpreted to describe a light-passing window (i.e., a transparent window) formed either as a lack of pattern-forming material (an opening) *or* a provided material that is transparent to light. Appellant’s proposed definition stating that a window is an opening that *usually* is closed by transparent material is not inconsistent with the above-noted reading of the Specification. Accordingly, we find

reasonable the Examiner's determination that the recited "transparent window" encompasses an opening formed by a lack of pattern-forming material.

Appellant further argues the Examiner's statement "it is the examiner's belief that such a transparent window is necessary for the contact lens to be operable" in the Response to Arguments section of the Office Action (Final Act. 3) is conclusory. Appeal Br. 7–8. This argument is unpersuasive because the Examiner has set forth a sufficient rationale in the rejection for modifying Pugh in view of Otis (i.e., modifying Pugh to use Otis's opening as a way for energy to reach Pugh's photo detector for operability). Final Act. 4.

Appellant also asserts the Examiner's discussion of Otis's opening as functionally equivalent in the Response to Arguments section of the Office Action (*id.* at 3) applies to a claim term analyzed under 35 U.S.C. § 112, sixth paragraph, but the Examiner has not applied § 112, sixth paragraph here. Appeal Br. 9. As the Examiner notes, functional equivalence was not used as a basis for the rejection of claim 1. Ans. 5; Final Act. 4.

For the foregoing reasons, Appellant's arguments do not identify reversible error in the rejection of claim 1. Appellant does not separately argue any of claims 4–9, 11, 12, 15, 18–23, 25, 26, 29, and 30 separately from claim 1.

Accordingly, we sustain the Examiner's § 103(a) rejection of claims 1, 4–9, 11, 12, 15, 18–23, 25, 26, 29, and 30 over by Pugh in view of Otis.

*Rejections II–V*

Appellant does not present arguments against any of Rejections II–V apart from the arguments presented in connection with Rejection I.

Therefore, we also sustain the Examiner’s § 103(a) rejections of claims 2, 3, 13, 14, 16, 17, 27, and 28 for the same reasons discussed above.

CONCLUSION

The Examiner’s decision rejecting claims 1–9, 11–23, and 25–30 is affirmed.

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>References/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 4–9, 11, 12, 15, 18–23, 25, 26, 29, 30	103(a)	Pugh, Otis	1, 4–9, 11, 12, 15, 18–23, 25, 26, 29, 30	
2, 3	103(a)	Pugh, Otis, Ocampo	2, 3	
13, 14	103(a)	Pugh, Otis, Blum	13, 14	
16, 17	103(a)	Pugh, Otis, Ocampo	16, 17	
27, 28	103(a)	Pugh, Otis, Blum	27, 28	
<b>Overall Outcome</b>	103(a)		1–9, 11–23, 25–30	

TIME PERIOD FOR RESPONSE

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