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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RONALD A. SCHACHAR

Appeal 2010-003533
Application 11/323,752
Technology Center 3700

Before JENNIFER D. BAHR, JOHN C. KERINS and WILLIAM V. SAINDON, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Ronald A. Schachar (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 31-50. Claims 1-30 are canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

THE INVENTION

Appellant's invention is directed to a method of operating a laser to treat presbyopia or other ocular conditions. Claim 31, reproduced below, is representative of the claimed subject matter:

> 31. A method of operating a laser to treat one of presbyopia, hyperopia, primary open angle glaucoma, and ocular hypertension, the method comprising:
>
> irradiating at least a portion of an eye to increase an ability of a ciliary muscle in the eye to exert tension, wherein irradiating at least the portion of the eye increases an effective working distance of the ciliary muscle;
>
> wherein irradiating at least the portion of an eye comprises reducing a thickness of a sclera of the eye in a region of a ciliary body of the eye without forming an opening completely through the sclera.

THE REJECTION

The Examiner has rejected claims 31-50 under 35 U.S.C. § 102(b) as being anticipated by Wayne F. March, et al., *Safety of High-Energy Neodymium:YAG Laser Pulses in YAG Sclerostomy*, 6 Lasers in Surgery and Medicine, 584-87 (1987) (hereafter, "March").

ISSUE

Has the Examiner established that March discloses a method in which the sclera of an eye is irradiated in a region of the ciliary body, to reduce the thickness of the sclera in that region without forming an opening completely through the sclera, and to increase an ability of a ciliary muscle to exert tension and the effective working distance of the ciliary muscle?

ANALYSIS

The March publication discloses a sclerostomy process using a pulsed YAG laser for opening a channel through the sclera to form a permanent drainage fistula for drainage of aqueous humor from the interior of the eye. (March 584, Introduction). In addition, March discloses that "a number of previous laser treatments for glaucoma have been advocated and used clinically", and that "none of these previous treatments created a complete scleral perforation or sclerostomy". (March 586, Discussion).

The Examiner maintains that, "'[a]s March irradiates and removes tissue in the sclera, the resultant expansion of the globe, to some degree will increase the working distance of the ciliary muscle at a point remote from the fistula . . .." Ans. 4. The Examiner further explains that "the claims at bar would be met by any intermediate state of the procedure of March et al, for example at the seventh pulse thereof." Ans. 5. Supporting this finding, the Examiner maintains that "removal of material from the eye, regardless of the precise location of the removal, will, to some degree, weaken the eye, . . . , and would, as a result, produce expansion, to some degree, of the eye." *Id.*

While we agree that the Examiner's general finding that removal of material from a structure is logically expected to weaken the structure[1], we agree with Appellant that the Examiner has not established that "any removal of scleral tissue from the eye, regard[less] of where or how much, results in . . . an increase in the ciliary muscle's working distance." Reply Br. 4. The claims call for the irradiating of the sclera "in a region of a ciliary body", but more significantly, that the irradiation produces the desired effect of increasing an ability of a ciliary muscle to exert tension and increase an effective working distance of the ciliary muscle. The Examiner's rejection lacks sufficient findings as to the where the channel or fistula is produced in March.

The Examiner also appears to maintain, based upon the position that any removal of material will weaken the eye and produce some degree of expansion of the eye, that the previous treatments referred to in March, in which a complete scleral perforation or sclerostomy was not achieved, inherently weaken the sclera and increase an effective working distance of the ciliary muscle of the eye. Ans. 5. Appellant counters that "*March* is silent regarding practically all details" of the previous treatments receiving passing mention in March, and that the Examiner has not established that "an increase in the ciliary muscle's effective working distance occur[s]" as a result of those prior treatments. Reply Br. 6.

While the Examiner maintains that Appellant's originally filed disclosure provides "[n]o particulars of the degree or amount of tissue

[1] To the extent that Appellant challenges the rejection on the basis that the Examiner has failed to establish this general principle, we do not find Appellant's arguments to be persuasive.

removal or amount of expansion of the eye," (Ans. 5), the claims consistently recite that the irradiation will "increase an ability of a ciliary muscle in the eye to exert tension", and in independent claims 31 and 41, will increase an effective working distance of the ciliary muscle. If there is some question as to whether these limitations are adequately described in the Specification as filed, or as to whether the Specification provides sufficient detail so as to enable persons of ordinary skill in the art to make and use the invention, those issues are not before us. As to the alleged anticipation of the claims by the previous treatments mentioned in March, Appellant is correct that March does not identify where the irradiation was performed (other than generally in the sclera), and thus those treatment processes did not necessarily produce the result recited in the claims that the ability of the ciliary muscle to exert tension is increased, and that an effective working distance of a ciliary muscle of the eye is increased.

The rejection of claims 31-50 as being anticipated by March is not sustained.

CONCLUSION

The Examiner has not established that Marsh discloses a method in which the sclera of an eye is irradiated in a region of the ciliary body, to reduce the thickness of the sclera in that region without forming an opening completely through the sclera, with the irradiation increasing an ability of a ciliary muscle to exert tension and increasing the effective working distance of the ciliary muscle.

DECISION

The decision of the Examiner to reject claims 31-50 is reversed.

REVERSED

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