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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES T. PERKINS

Appeal 2010-006276
Application 11/017,581
Technology Center 3700

Before EDWARD A. BROWN, MICHAEL L. HOELTER and
CARL M. DEFRANCO, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal, under 35 U.S.C. § 134(a), from a final rejection of claims 1-10. App. Br. 1, 2. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

THE CLAIMED SUBJECT MATTER

The disclosed subject matter “is related to irrigation and aspiration tubing for use in ophthalmic surgery and more specifically, is directed to tubing that assists in dampening post occlusion surge.” Spec. para. [0001]. Independent claim 1 is illustrative of the claims on appeal and is reproduced below:

1. An irrigation and aspiration tubing length for use in ophthalmic surgery comprising:
a length of tubing including an irrigation lumen for carrying irrigation fluid from a source to an ophthalmic surgical site and an aspiration lumen for carrying aspirant from the surgical site to a collection reservoir; and
wherein the irrigation and aspiration lumens include a compliant common wall, such that any surge occurring after an occlusion break is dampened because of the compliant common wall.

REFERENCES RELIED ON BY THE EXAMINER

Moutafis	US 6375,635 B1	Apr. 23, 2002
Kadziauskas	US 2005/0080375 A1	Apr. 14, 2005

THE REJECTIONS ON APPEAL

1. Claims 1-3, 5-8 and 10 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kadziauskas. Ans. 3.

2. Claims 4 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kadziauskas and Moutafis. Ans. 6.

ANALYSIS

*The rejection of claims 1-3, 5-8 and 10
as being anticipated by Kadziauskas*

Appellant argues claims 1-3, 5-8 and 10 as a group. App. Br. 3-5. We select claim 1 for review with claims 2, 3, 5-8 and 10 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2011).

Claim 1 includes the limitation of “an aspiration lumen for carrying aspirant from the surgical site.” The Examiner finds that Kadziauskas discloses all the limitations of claim 1. Ans. 3. More specifically, the Examiner finds that Kadziauskas’ tubing 46 includes an aspiration lumen and “that the aspiration lumen is capable of carrying aspirant if aspirant is placed in the lumen.” Ans. 3.

Appellant contends that the aspiration lumens identified by the Examiner in Kadziauskas’ Fig. 3 as annotated by the Examiner (*see* Ans. 5) are not aspiration lumens because they “are not connected to the surgical site in any way, and they do not carry aspirant fluid and tissue, as claimed.” App. Br. 4. Appellant further contends that if these identified lumens were connected to Kadziauskas’ aspiration lumen 24, “the function and intent of the accumulator 46 would be completely undermined and accumulator 46 would not function as taught.” App. Br. 4, *see also* Reply Br. 2. In essence, Appellant contends that the lumens identified by the Examiner function differently from the claimed lumens and further that Kadziauskas does not hint, teach or suggest Appellant’s claimed use. App. Br. 4, *see also* Reply Br. 3, 4. In summary, Appellant contends that the Examiner relied on “the

benefit of hindsight to say that the voids of accumulator 46 are capable of being aspiration lumens” and that such voids “are not capable of being aspiration lumens.” App. Br. 5.

Our reviewing court has provided guidance that to “anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently” and further that “the absence of a disclosure relating to function does not defeat [a] finding of anticipation.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Here, Appellant does not dispute Kadziauskas’ disclosed structure of multiple lumens each sharing a compliant common wall with central irrigation line 32. *See* Kadziauskas Fig. 3. Instead, Appellant contends that Kadziauskas functions differently, but as indicated above, the absence of a disclosure relating to function does not defeat a finding of anticipation when the structural limitations are found in the prior art. *Id.*

Further, Applicant references *Swinehart* as support for the contention that claim limitations may be recited in terms of their function (i.e. by what something does rather than by what it is). Reply Br. 3 *citing In re Swinehart*, 439 F.2d 210, 212 (C.C.P.A. 1971). This is not disputed by the Examiner; however, this same court provided further instruction that:

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *Swinehart*, 439 F.2d at 213.

Here, the Examiner identifies the claim limitation “for carrying aspirant from the surgical site to a collection reservoir” as “a functional

limitation.” Ans. 7. The Examiner has also determined that “if aspirant from the surgical site is placed within the identified aspiration lumens, the device is capable of meeting the recited functional limitations.” Ans. 7, *see also* 3. In accordance with *Swinehart*, Appellant has a need to show that the lumens identified by the Examiner do not possess this characteristic, i.e., that these identified lumens are themselves incapable “of carrying aspirant if aspirant is placed in the lumen.” App. Br. 3, 7. Appellant’s discussions regarding how Kadziauskas’ device functions differently are not persuasive.

Appellant also notes that the vacuum source secured to Kadziauskas’ tubing/accumulator 46 is different from Kadziauskas’ aspiration vacuum source 36. App. Br. 3, *see also* Reply Br. 2. Even should this be the case, Appellant does not identify where claim 1 requires securement to any particular vacuum source.

Appellant further addresses the lack of a common wall between Kadziauskas’ aspiration line 38 and irrigation line 32 (App. Br. 4, Reply Br. 2), but the Examiner “did not identify elements (38) and (32) as sharing a common wall” (Ans. 7). Accordingly, we agree with the Examiner that Appellant’s argument is moot. Ans. 7. We further note Appellant’s reference to Kadziauskas’ corrected Fig. 1 (App. Br. 5) but the corrections made to that figure did not alter the structure of the lumens or the common wall disclosed in Fig. 3 which was relied on by the Examiner. Ans. 3, 5. Appellant also addresses Kadziauskas’ Specification paragraph [0042] which discusses the stretched common walls forcing irrigation fluid to the handpiece and ultimately the surgical site (as contrasted with the use of negative pressure). Reply Br. 4. We note that claim 1 is silent regarding whether the fluid is pushed or pulled; instead the claim limitation in question

requires the surge be “dampened because of the compliant common wall.” Appellant does not explain how Kadziauskas’ compliant common wall fails to meet this limitation.

Based on the record presented, Appellant’s contentions are not persuasive and accordingly, we sustain the rejection of claims 1-3, 5-8 and 10.

*The rejection of claims 4 and 9
as being unpatentable over Kadziauskas and Moutafis*

Appellant contends that claims 4¹ and 9 should be allowable due to their being dependent from allowable claims. App. Br. 6. Appellant does not dispute the reason Moutafis was relied on by the Examiner in rejecting these claims. Accordingly, we sustain the Examiner’s rejection of claims 4 and 9.

DECISION

The Examiner’s rejections of claims 1-10 are affirmed.

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

AFFIRMED

MP

¹ Appellant mistakenly references claim 6 as being rejected under § 103, not claim 4. App. Br. 6, *see also* 3.