



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/620,164	09/14/2012	John H. Shaddock	EDGE.004C4	6427
20995	7590	02/13/2018	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			BUI, VY Q	
			ART UNIT	PAPER NUMBER
			3731	
			NOTIFICATION DATE	DELIVERY MODE
			02/13/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jayna.cartee@knobbe.com
efiling@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN H. SHADDUCK

Appeal 2016-003650¹
Application 13/620,164²
Technology Center 3700

Before KENNETH G. SCHOPFER, BRADLEY B. BAYAT, and
AMEE A. SHAH, *Administrative Patent Judges*.

SCHOPFER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the rejection of claims
5–27. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references the Appeal Brief (“Appeal Br.,” filed Aug. 13, 2015) and Reply Brief (“Reply Br.,” filed Feb. 29, 2016), and the Examiner’s Answer (“Ans.,” mailed Dec. 31, 2015) and Final Office Action (“Final Act.,” mailed Aug. 15, 2014). Appellant’s request for an oral hearing has been waived. *See* Waiver of Hearing by Appellant, filed Jan. 16, 2018.

² According to Appellant, “[t]he real parties in interest are Axia Medsciences, LLC the assignee of record of the present application and Edge Systems LLC the exclusive licensee of the present application.” Appeal Br. 3.

BACKGROUND

According to Appellant:

The present invention relates to devices for dermatology and more particularly to a hand-held instrument with a working end that carries (i) a negative pressure aspiration system, (ii) a source for delivery of a sterile fluids to the skin; and (iii) a skin interface surface in the working end that has specially shape structure for abrading surface layers of the patient's epidermis as the working end is moved over the patient's skin while at the same time causing rapid penetration of the fluids into the skin for therapeutic purposes.

Spec. ¶ 2.

ILLUSTRATIVE CLAIM

Claim 5 is illustrative of the appealed claims and recites:

5. A handheld device for resurfacing a skin surface, comprising:

a body comprising a housing;

a working end portion removably attached to a first end of the body, the working end portion comprising a distal end configured to contact a skin surface being treated by the device, wherein the working end portion comprises a perimeter along the distal end, an entirety of the perimeter extending along a single plane;

an abrasive surface entirely surrounded by the perimeter of the working end portion, the abrasive surface configured to abrade skin when the abrasive surface is moved relative to the skin surface; and

at least one opening positioned between the perimeter of the working end portion and the abrasive surface, wherein the at least one opening is configured to be in fluid communication with a vacuum source via at least one passageway to aspirate skin debris away from the working end portion when the vacuum source is activated.

Appeal Br. 11.

REJECTIONS

1. The Examiner rejects claims 5–27 on the ground of nonstatutory double patenting.
2. The Examiner rejects claims 5–7, 10–22,³ and 25–27 under 35 U.S.C. § 102(e) as anticipated by Ramey.⁴
3. The Examiner rejections claims 8–10 and 23–25 under 35 U.S.C. § 103(a) as unpatentable over Ramey in view of Parkin.⁵

DISCUSSION

Double Patenting

Appellant does not present arguments regarding the double patenting rejection and requests only that they “be held in abeyance until claims in this case are indicated as being in condition for allowance.” Appeal Br. 6.

Accordingly, we summarily sustain this rejection.

Anticipation

We are persuaded of reversible error with respect to the anticipation rejection because we agree with Appellant that the Examiner has not shown that Ramey discloses an abrasive surface or structure that is configured to abrade skin, as required by independent claims 5, 13, and 18. *See* Appeal Br. 6–8.

With respect to claims 5, 13, and 18, the Examiner finds, *inter alia*, that Ramey discloses an “abrading member/structure 32” with an “abrasive surface 34 [that] is configured to abrade skin when the abrasive surface is

³ Although the heading for this rejection does not include claim 22, the body of the rejection makes clear that claim 22 is included in this rejection. *See* Final Act. 3.

⁴ Ramey et al., US 2002/0151826 A1, pub. Oct. 17, 2002.

⁵ Parkin et al., US 6,432,113 B1, iss. Aug. 13, 2002.

moved relative to the skin surface.” Final Act. 4. Further, in response to Appellant’s arguments, the Examiner finds that the portions of Ramey cited by Appellant do “not necessarily exclude ‘the broad, substantially flat contact surface 34’ to be ‘an abrasive surface’ capable of abrading skin as recited in [the independent claims].” Ans. 4 (emphasis omitted). Further, the Examiner finds that abrasive may be interpreted to mean “causing irritation,” and under this interpretation the surface 34 “is qualified” as an abrasive surface. *Id.* at 5. Finally, the Examiner asserts:

Further, Ramey (F 4, section [0058]) discloses barrier 50 between skin 80 and flat surface 34 to “reduce or prevent possible irritation from direct contact between skin 80 and the device 10” (see section [0058]). It is recognizable to a person of ordinary skill in the art that at least substantially flat surface 34 of Ramey device will irritate, or wear skin 80 when Ramey device 10 is rubbing directly on skin 80.

Id. at 6 (emphasis omitted).

Regarding the Examiner’s findings, we first note that the claims require an abrasive surface that is “configured to abrade skin” rather than merely a surface that is capable of abrading skin. Thus, the claims require an abrasive surface that is designed to accomplish the function claimed, i.e. it is designed to abrade skin. *See Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d. 1335, 1349 (Fed. Cir. 2012) (noting that claim language “configured to” is construed more narrowly than “capable of” and holding that in cases where claim language including the phrase “adapted to” is to be construed consistent with “configured to” language, it requires that the structure must be “designed or configured to accomplish the specified objective, not simply that [it] can be made to serve that purpose.”) Thus, to the extent the Examiner simply relies on Ramey’s surface 34 as being

“capable of abrading skin,” the Examiner has not set forth a sufficient showing of anticipation.

Further, we also find that Ramey’s contact surface 34 is not configured to abrade skin even if we were to agree with the Examiner that the term abrasive may be construed broadly to mean “causing irritation.” In particular, we find that Ramey’s device, including surface 34, is designed or configured to avoid irritation rather than being designed or configured to cause irritation, as the claims require. Most significantly, Ramey discloses a massaging device and that an object of the invention is to “reduce the potential for skin irritation or abrasion.” Ramey ¶ 26. Further, Ramey describes other objects of the invention as providing a device that avoids pinching the skin and avoids uncomfortable contact with sharp edges. *Id.* at ¶¶ 15, 27. Ramey also discloses that an object of the device is to provide a device that avoids inhibiting or restricting movement of the device along the skin of the patient. *Id.* at ¶ 25. Further, Ramey describes contact surface 34 of post 32 as a “substantially flat contact surface.” *Id.* at ¶¶ 44, 53. Ramey also discloses that “post 32 is designed to be substantially circular with rounded edges adjoining the broad, substantially flat contact surface. A relatively long radius of curvature used in rounding edges increases the comfort to both patient and user and prevents uncomfortable contact with the device.” *Id.* at ¶ 48. As indicated, we find that this evidence shows that Ramey’s device, including Ramey’s post 32 and contact surface 34, is designed to avoid irritating skin during use.

Based on the foregoing, we are persuaded of reversible error with respect to the rejection of independent claims 5, 13, and 18. Accordingly, we do not sustain the rejection of those claims. We also do not sustain the

Appeal 2016-003650
Application 13/620,164

rejection of claims 6, 7, 10–12, 14–17, 19–22, and 25–27, each of which depend from one of claims 5, 13, or 18.

Obviousness

With respect to the obviousness rejection, it is not readily apparent on the record before us that Parkin cures the deficiency found above with respect to the rejection of the independent claims. Accordingly, we do not sustain the rejection of claims 8–10 and 23–25 over Ramey in view of Parkin for the reasons discussed above.

CONCLUSION

We summarily AFFIRM the double patenting rejection of claims 5–27. We REVERSE the anticipation rejection of claims 5–7, 10–22, and 25–27. We REVERSE the obviousness rejection of claims 8–10 and 23–25.

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

AFFIRMED