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Budzyn IP Law, LLC 120 Eagle Rock Avenue Suite 328 East Hanover, NJ 07936			CLARK, RYAN T	
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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* ROBERT H. OSHER, BRIANA RAWSON, and  
COLLIN ALEXANDER MURRAY

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Appeal 2019-006062  
Application 15/407,673  
Technology Center 3700

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Before JENNIFER D. BAHR, JOHN C. KERINS, and  
MICHAEL L. WOODS, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

On August 4, 2020, Appellant<sup>1</sup> filed a Request for Rehearing (hereinafter “Request” or “Req. Reh’g”) under 37 C.F.R. § 41.52 of the Decision on Appeal (hereinafter “Decision” or “Dec.”) dated June 4, 2020. In the Decision, the Board affirmed a rejection of claims 16–21 under

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Beaver-Visitec International (US), Inc. Appeal Br. 2.

35 U.S.C. § 103 as unpatentable over Pao, Saliaris, and Fedorov.  
Decision 7.

#### REQUIREMENTS FOR REQUEST FOR REHEARING

A Request for Rehearing must comply with the following requirements:

The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised, and Evidence not previously relied upon, pursuant to §§ 41.37, 41.41, or 41.47 are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section.

37 C.F.R. § 41.52(a)(1).

#### OPINION

Appellant first submits that the Board’s statement that “Pao does not disparage or otherwise discourage the use of a resistive heating probe having a tip comprising a resistance element heated by passing electrical current from a direct-current voltage source, such as a battery” on page 6 of the Decision “fails to provide a basis for modifying Pao to use resistive heating, which operates completely different from use of passing alternating-current through tissue.” Req. Reh’g. 2. This does not identify a point misapprehended or overlooked by the Board. The Board made this statement not to articulate a reason for modifying Pao to use resistive heating, but, rather, to address Appellant’s argument that modifying Pao to be battery powered would undermine Pao’s principle of operation and render Pao unsuitable for its intended purpose. *See* Decision 4–5; *id.* at 6 (stating that “Pao does not teach away from modifying Pao as the Examiner proposes, in view of Saliaris, or otherwise indicate that such a modification

would render Pao's device unsuitable for its intended purpose or change Pao's principle of operation"). As the Board pointed out in its Decision, the Examiner's articulated reason for modifying Pao in view of Saliaris is "in order to make the device more compact, which is important when operating in the region of the eye where there is limited space, and to make the device more 'simple and reliable for using disposable cauteries.'" Decision 4 (quoting Final Act. 4).

Appellant next submits that Pao's objective is "to provide controlled area cauterization for high frequency, alternating current applications." Req. Reh'g 3. Appellant also contends that "[t]he Decision hypothetically modified Pao to be provided with a closed, resistive-heating element, rather than two open, coaxial electrodes, configured for electrical flow therebetween," which, according to Appellant, "results in an impermissible change in function in Pao, with no predictable results." *Id.* at 4.

The Board addressed Pao's principle of operation and objectives in the paragraph bridging pages 6–7 of the Decision, which reads as follows:

As for the principle of operation and intended purpose of Pao's device, Pao seeks to provide an electrocautery device that is visible through the sclera, capable of pinpoint accuracy to produce cautery spots of predetermined areas for producing repeatable marks for use in procedures such as scleral marking, and capable of producing spot cauterization without passing current through a patient's body. *See* Pao 3:39–54. Pao teaches that using electrical current to heat a resistance element, which is then applied to the tissue to be cauterized, "precludes the necessity of applying an electrical current through the tissue." *Id.* at 1:25–30. Further, Saliaris likewise seeks to provide a cautery device that ensures "repeatable reliable operation." Saliaris 1:37–41. This suggests that providing a probe tip that is resistively heated by application of current from a battery via

first and second leads, as taught by Saliaris, would be consistent with Pao's objectives.

For the reasons set forth in this passage of the Decision, Appellant fails to persuade us that the modification proposed by the Examiner would defeat Pao's objectives or impermissibly change Pao's principle of operation or function, and the record does not support Appellant's contention that the modification would yield "no predictable results."

Appellant contends that the definition of "direct voltage" that the Board entered into the record from McGraw-Hill Dictionary of Scientific & Technical Terms "failed to take into account the context of the use of 'direct voltage.'" Req. Reh'g 4; *see* Decision 5–6. In particular, Appellant submits that Pao discloses "'bipolar electrode probe devices' . . . as being used in connection with alternating current." Req. Reh'g 5 (citing Pao 1:34–36). Appellant then points out that the first sentence of Pao's Abstract opens by "referring to 'bipolar electrode probe devices'" and "also refers to 'bipolar electrode probe devices' as including 'a central electrode having an outer electrode coaxially disposed therearound.'" *Id.* Appellant then submits that "[t]he mention of 'direct voltage' [in the second sentence of Pao's Abstract] is in the context of the 'central and outer electrodes [which] are electrically insulated from each other.'" *Id.* Appellant thus asks us to conclude:

Based on Pao's own disclosure of "bipolar electrode probe devices," "direct voltage," which is in the context of "bipolar electrode [probe] devices," does not appear to refer to direct current. Rather, as set forth at page 8 of the Appeal Brief, and page 2 of the Reply Brief, the modifier "direct" may be taken as indicating that voltage is applied directly to the "central and outer electrodes," not necessarily as yielding direct current.

*Id.*

First, to the extent that Appellant may intend to represent that Pao has defined “bipolar electrode probe devices” as requiring or being restricted to use with alternating current, this is misleading. More accurately, Pao discloses that, in the prior art, alternating current was typically applied through tissue using a unipolar or bipolar technique. Pao 1:34–36. In other words, Pao discloses that a unipolar or bipolar technique was a known way to apply alternating current through tissue, not that a unipolar or bipolar technique by definition means that alternating current must be applied. Further, Appellant does not persuasively explain why the reference to “central and outer electrodes [which] are electrically insulated from each other” in the second sentence of Pao’s Abstract inherently points to the application of alternating current, as opposed to direct current. Finally, Appellant proffers no evidence to support Appellant’s asserted interpretation of “the modifier ‘direct’” in the phrase “direct voltage” and rebut the evidence relied on by the Board as to the well-established meaning of “direct voltage” in the art.

For the above reasons, Appellant’s Request does not persuade us that the Board misapprehended Pao’s teachings or erred in sustaining the rejection of claims 16–21 as unpatentable over Pao, Saliaris, and Fedorov.

#### CONCLUSION

Appellant’s Request has been granted to the extent that we have reconsidered our Decision in light of the arguments in Appellant’s Request, but is denied with respect to our making any modification to the Decision.

Appeal 2019-006062  
Application 15/407,673

Outcome of Decision on Rehearing:

<b>Claims</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Denied</b>	<b>Granted</b>
16-21	103	Pao, Saliaris, Fedorov	16-21	

Final Outcome of Appeal after Rehearing:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
16-21	103	Pao, Saliaris, Fedorov	16-21	

#### 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).

DENIED