

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES M. ZAVISLAN and JAY M. EASTMAN

Appeal No. 96-1963
Application 08/094,296 ¹

HEARD: May 5, 1998

Before CALVERT, PATE and NASE, **Administrative Patent Judges.**

CALVERT, **Administrative Patent Judge.**

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 5, 10, 13 to 16, 18, 21, 28 and 30 to 35. Of the other claims in the application, claims 6 to 9, 11, 12, 17 and 19, 20, 26 and 27 are indicated as allowed and claims 22 to 25 and 29 stand with-

¹Application for patent filed July 21, 1993.

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drawn from consideration as being directed to a nonelected invention. 37 CFR 1.142(b).²

The subject at issue is defined by claim 1 as follows³
(numbers in brackets added for convenience):

1. A system for thermolysis of dermatological tissue in an area under the surface thereof with visualization of said area which is sufficiently small to be hand held, which comprises [i] a housing, [ii] a window in said housing providing a port for illumination emanating from within said housing and disposed and [sic: in] proximity to the tissue surface above said area, [iii] means for projecting a laser beam from said housing through said window, [iv] means in said projecting means for focusing said beam at selected locations in said area at spots sufficiently small in cross-section and of power and duration of said beam to cause localized thermolysis of the tissue at each of said spots, [v] said projecting means also including means in said housing for deflecting said beam to locate each of said spots at each of said selected locations one at a time and stop said beam, and [vi] means in said housing for visualizing said area while said beam is deflected thereby verifying that each of said spots is at each of said selected locations.

The references applied in the final rejection are:

Sutton	4,617,926	Oct. 21, 1986
Taboada et al. (Taboada)	5,112,328	May 12, 1992

²A rejection of claims 6 to 9, 11, 12, 26 and 27 under 35 USC § 112, made in the final rejection, was, according to the advisory action mailed January 27, 1995 (Paper No. 7), overcome by the amendment filed January 12, 1995.

³We note that in line 3 of claim 1, the expression "which is sufficiently small to be hand held" is so positioned as to appear to modify "area" rather than "housing". The claim should be amended so that this expression is positioned as it is in claim 30, i.e., following "housing", and we will interpret claim 1 as if it had been so amended.

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Buys et al. (Buys) 5,336,217 Aug. 09, 1994
(Filed Jun. 05, 1992)

Keeler Ophthalmic, Inc. Brochure of Ophthalmoscopes, pp 1-11, (no date). (Keeler)

Metalaser Technologies, Inc. "CVL Network News" Bulletin, Spring 1992, pp 1-8. (Metalaser)

The claims on appeal stand finally rejected under 35 USC § 103 as unpatentable over the following combinations of references:

(1) Claims 1, 3, 4, 10, 13 to 16, 18, 28, 30 and 32 to 35, Buys in view of Taboada and Keeler;

(2) Claims 2 and 31, Buys in view of Taboada, Keeler and Sutton;

(3) Claim 5, Buys in view of Taboada, Keeler and Metalaser.

We will first consider the rejection of claim 1, particularly in relation to parts [iv] and [v] thereof. Each of these parts calls for a means plus function, and therefore must be interpreted as covering "the corresponding structure described in the specification and equivalents thereof." 35 USC § 112, sixth paragraph; In re Donaldson Co., Inc., 16 F.3d 1189, 1193, 29 USPQ 2d 1845, 1850 (Fed. Cir. 1994).

Part [iv] of claim 1 recites a "means in said projecting means for focusing said [laser] beam at selected locations in said area". In appellants' specification, the means for

focusing the laser is described thus (page 11, lines 11 to 17):

The laser energy is delivered by the optical fiber cable 22 to a fiber ferrule or coupler 66 from which the incoming beam projects and is focused by a lens 68. Lens 68 nominally collimates the beam. A focus mechanism 69, which may be either manual or electro-mechanical, sets the depth below the surface that the laser light is focused. The focus mechanism 69 moves lens 68 in the z direction relative to ferrule 66.

The examiner does not identify any structure in the primary reference (Buys) which would be the equivalent of the movable-lens focusing mechanism described by appellants, nor do we find any such structure therein. In fact, as appellants assert in the paragraph bridging pages 7 and 8 of their brief, the Buys apparatus is fixed focus; as Buys states in column 12, lines 3 to 8, the two-lens doublet 12, 13 which constitutes the imaging lens system 10 is "axially immobilized and integral with frame 3 via mounting 14". Thus, Buys does not disclose a means for focusing as recited in claim 1.

Part [v] of claim 1 recites a "means in said housing for deflecting said beam to locate each of said spots" In appellants' device, the structure which performs this function is the two-mirror deflection system (specification, pages 10 to 11), together with the shutter 72, which has a position so that the

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laser beam can be used "as a spotter or tracking beam to locate the sites to be treated" (page 13, lines 11 to 13). Buys does

not disclose any such equivalent structure. While the Buys device contains a deflection system and a shutter, the Buys deflection system does not deflect the laser beam per se, but rather deflects the end of the optical fiber from which the laser beam emerges (column 14, lines 28 to 61). Also, Buys' shutter is not constructed to allow deflection of the beam to locate each of the spots, but rather only opens after the end of the fiber is in position for the next "shot" (column 18, lines 6 to 11). In other words, appellants' disclosed structure deflects the laser beam across the area of the tissue to the next spot to be "shot", while the Buys apparatus, instead of deflecting the beam, deflects the end of the fiber optic cable to a position where by opening the shutter, it can then deliver the next "shot". The apparatus disclosed by Buys therefore does not perform the same function as appellants' claimed deflecting means, and is not equivalent to the structure disclosed by appellants for performing the recited function of the deflecting

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means.

Claim 30, the other independent claim on appeal, recites similar means which likewise find no response in Buys.

The secondary references, Taboada, Keeler, Sutton and Metalaser, were cited by the examiner as evidence of the obviousness of various claimed limitations other than those

which we find above to be lacking in Buys. We find no disclosure in any of these references which would supply the above-noted deficiencies of Buys.

Accordingly, we will not sustain the rejection of independent claims 1 and 30 or, it follows, of dependent claims 2 to 5, 10, 13 to 16, 18, 21, 28 and 31 to 35.

The examiner's decision to reject claims 1 to 5, 10, 13 to 16, 18, 21, 28 and 30 to 35 is reversed.

REVERSED

IAN A. CALVERT)
Administrative Patent Judge)
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) BOARD OF PATENT

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WILLIAM F. PATE, III)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JEFFREY V. NASE)	
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