

**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(2) is not binding precedent of the Board.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. 48

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** MICHAEL S. BERLIN

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Appeal No. 1997-3676  
Application 08/237,221

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HEARD: June 5, 2000

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Before ABRAMS, FRANKFORT and McQUADE, **Administrative Patent Judges**.

ABRAMS, **Administrative Patent Judge**.

**DECISION ON APPEAL**

Appeal No. 1997-3676  
Application 08/237,221

This is an appeal from the decision of the examiner finally rejecting claims 49-56. Claims 1-48 have been canceled. No claims have been allowed.

The appellant's invention is directed to a method for surgical treatment of tear ducts and passages of the eye. The claims before us on appeal have been reproduced in an appendix to the Brief.

#### **THE REFERENCES**

The references relied upon by the examiner to support the final rejection are:

L'Esperance	3,982,541	Sep. 28, 1976
Hussein	4,470,407	Sep. 11, 1984
Ector	4,658,816	Apr. 21, 1987
Herrick et al. (Herrick)	4,660,546	Apr. 28, 1987

Myron L. Wolbarsht (Wolbarsht), "Laser Surgery: CO<sub>2</sub> or HF," QE-20 *Journal of Quantum Electronics*, no. 12, 1427-1432 (Dec. 1984).

Michael S. Berlin et al. (Berlin), "Eximer Laser Photoablation in Glaucoma Filtering Surgery," 103 *American Journal of Ophthalmology*, no. 5, 713-14 (May, 1987).

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### **THE REJECTIONS**

The following rejections stand under 35 U.S.C. §  
103:

(1) Claims 49, 51, 53, 54 and 56 on the basis of Herrick in  
view of L'Esperance, Wolbarsht, Ector and Hussein.

(2) Claims 50, 52 and 55 on the basis of Herrick in view of  
L'Esperance, Wolbarsht, Ector, Hussein and Berlin.

Rather than attempt to reiterate the examiner's full  
commentary with regard to the above-noted rejections and the  
conflicting viewpoints advanced by the examiner and the  
appellant regarding them, we make reference to the Examiner's  
Answer (Paper No. 34) and to the Appellant's Brief (Paper No.  
32).

### **OPINION**

The test for obviousness is what the combined  
teachings of the prior art would have suggested to one of  
ordinary skill in the art. **See, for example, In re Keller,**  
642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In

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establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. *See Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. *See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1439, 5 USPQ2d 1434, 1439 (Fed. Cir.), **cert. denied**, 488 U.S. 825 (1988).

The method recited by the appellant in independent claim 49 comprises the steps of introducing a fiber optic probe until the penetrating end is adjacent the punctum, surgically entering the tear passages to localize obstruction of tear flow, coupling the exterior end of the fiber optic element to a photo- ablative laser selected from a particular group and emitting laser pulses to cause photodecomposition of

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tissue occluding the duct, and advancing the probe so as to effect cannulization of occlusive tissue and bone adjacent thereto by photoablation thereof to create patency of the ducts and passages by re-establishment of tear flow to the nasopharynx. The examiner's conclusion that this method would have been obvious to one of ordinary skill in the art relies upon the combined teachings of five references, two of which are applied to the basic features of the method and three to the characteristics of the laser.

Our evaluation of the rejection of claim 49 leads us to conclude that the teachings of the applied prior art fail to establish a ***prima facie*** case of obviousness with regard to the subject matter recited therein, and we will not sustain the rejection of claim 49 or, it follows, of claims 51, 53, 54 and 56. Our reasoning follows.

Herrick, the primary reference, is directed to a method for treating a deficiency in tears. Herrick explains that his invention replaces the expensive laser equipment of

the prior art which had been used to first close the tear ducts to determine whether too much drainage of tears from the eye through the tear ducts was the solution to certain eye problems, and later to re-open the ducts, if necessary. As we understand the procedure in the prior art laser method, the punctum (the entrance of the tear duct) was the site of the application of laser energy to close and open the tear duct (see column 1). Ector is combined with Herrick with regard to the basic features of the claimed invention. Ector discloses an intubation device that functions to re-establish the flow of fluids through the tear ducts by removing blockages. In order for the physician to monitor the location of the end of the device as it moves through the tear duct, it is provided with a fiber optic illumination probe. There is no teaching of using laser energy. It is the examiner's position that "[i]t would have been obvious . . . to provide for the insertion of fiber optic elements into the tear ducts as taught by Ector in the method of Herrick . . . since this would enable the removal of occlusions which were more deeply lodged in

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the tear ducts," and to apply a laser through the illuminating fiber to the tissue of interest, the laser being of the type required by the claim pursuant to the teachings of L'Esperance, Wolbarsht and Hussein (Answer, page 4).

It is axiomatic that the mere fact that the prior art structure **could** be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. **See, for example, In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to combine Herrick and Ector in the manner proposed by the examiner. In this regard, Herrick teaches opening and closing only the punctum, that is, the entrance to the tear ducts, by means of laser energy, and does not disclose or teach that the laser be inserted into the tear ducts for any reason, much less for the purpose of operating upon occlusions present therein. Thus, suggestion to proceed through the tear ducts for any reason is absent from Herrick, as is suggestion that

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occlusions in a tear duct can be removed by the use of laser energy. As far as Ector is concerned, while light energy is used, it is not laser energy, and its purpose is not to operate upon occlusions found therein, but only to mark the end

of the instrument upon which the fiber optics is installed. Therefore, this reference also provides no suggestion that a laser be inserted into a tear duct or that laser energy be used to remove occlusions located therein. The lack of suggestion to combine the references is not alleviated by further considering the teachings of the other three references, which are directed to the existence and characteristics of various types of lasers.

For the reasons set forth above, it is our opinion that the only suggestion for combining Herrick and Ector in the manner advanced by the examiner is found in the luxury of the hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a

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rejection. As our reviewing court stated in *In re Fritch*, 972  
F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992):

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" (citations omitted).

We therefore will not sustain the rejection of independent claim 49 or of claims 51, 53, 54 and 56, which depend therefrom.

The same reasoning applies, and we reach the same conclusion, with regard to the rejection of claims 50, 52 and 55, which was on the basis of the references applied in the other rejection, taken further in view of Berlin, for the final reference fails to overcome the problem set out above.

**SUMMARY**

Neither rejection is sustained.

The decision of the examiner is reversed.

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**REVERSED**

	NEAL E. ABRAMS	)	
	Administrative Patent Judge	)	
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		)	
		)	BOARD OF
PATENT		)	
	CHARLES E. FRANKFORT	)	APPEALS AND
	Administrative Patent Judge	)	
INTERFERENCES		)	
		)	
		)	
	JOHN P. McQUADE	)	
	Administrative Patent Judge	)	

NEA:psb

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