The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL T. TRESE
and
GEORGE A. WILLIAMS

Appeal No. 2004-2249
Application No. 09/820,159

ON BRIEF

Before WALTZ, DELMENDO, and JEFFREY T. SMITH, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2004) from the examiner's final rejection of claims 1, 2, 5, and 6 in the above-identified application. Claims 3 and 4, the only other pending claims, stand "objected to as being dependent upon a rejected base claim" but indicated as "allowable if rewritten in independent form including all of the limitations

of the base claim and any intervening claims."[1] (Examiner's answer mailed Oct. 21, 2003, paper 17, page 2.)

The subject matter on appeal relates to a "method for creating a separation of posterior cortical vitreous in an eye from an eye retina." According to the appellants, "[c]ertain diseases and/or conditions of the eye, such as diabetes, cystoid macular edema or trauma, produce a vitreoretinal traction on the surface of the retina," which, if continued, "may lead to breaks in the retinal surface and, in severe cases, to retinal detachment." (Specification, page 1, lines 9-12.) The appellants further explain that "[t]he introduction of plasmin into the vitreous humor creates a separation of the posterior cortical vitreous and the retina thus minimizing or eliminating the vitreoretinal traction." (Id. at page 1, lines 21-23.) The appellants also disclose that "if additional plasmin is necessary to create the desired separation between the vitreous 16 and the retina 14, a portion of the aqueous humor 16 may be removed from the anterior chamber 32 [sic] by paracentesis to eliminate excessive intraocular pressure." (Id. at page 3,

[1] The final rejection under 35 U.S.C. § 112, ¶1 (lack of written description), of claims 3 and 4 has been expressly withdrawn. (Answer at 5.)

lines 19-23; Figure 1.) Further details of this appealed subject matter are recited in representative claims 1 and 6 reproduced below:

> 1. A method for creating a separation of posterior cortical vitreous in an eye from an eye retina consisting of the steps [sic] of introducing plasmin into the vitreous humor so as to create a separation of the cortical vitreous from the retina without removal of the vitreous humor from the eye.
>
> 6. The method as defined in claim 1 wherein said introducing step further [sic] consists of the step of using a sustained release device to introduce plasmin into the vitreous humor of the eye.

The examiner relies on the following prior art references as evidence of unpatentability:

Zaffaroni et al. (Zaffaroni)	4,135,514	Jan. 23, 1979
Trese et al. (Trese)	5,304,118	Apr. 19, 1994

Claims 1 and 5 on appeal stand rejected under 35 U.S.C. § 102(b) as anticipated by Trese. (Answer at 3.) In addition, claim 2 on appeal stands rejected under 35 U.S.C. § 103(a) as unpatentable over Trese. (Id. at 3-4.) Further, claim 6 on appeal stands rejected under 35 U.S.C. § 103(a) as unpatentable over Trese in view of Zaffaroni. (Id. at 3.)

We affirm these rejections. Because we are in complete agreement with the examiner's factual findings and legal

conclusions, we adopt them as our own and add the following comments for emphasis.[2]

As discussed above, appealed claim 1 is directed to a "method for creating a separation of posterior cortical vitreous in an eye from an eye retina" consisting of the recited step. Trese discloses a method for performing a vitrectomy on an eye. (column 1, lines 7-10.) According to Trese, "[o]ne difficulty in performing a vitrectomy is that the vitreous exhibits a relatively strong adhesion to the retina of the eye" and thus "[m]echanical removal of the vitreous from the retina of the eye can result in scarring, tearing and other damage to the retina." (Column 1, lines 24-28.) To overcome this problem, Trese teaches the introduction of human plasmin into the vitreous in order to induce posterior vitreous detachment (i.e., detach the vitreous from the retina) prior to removing the vitreous from the eye. (Column 1, lines 37-52; column 2, lines 3-12.)

[2] The appellants submit that claim 6 stands or falls separately from claim 1 and provides reasonably specific arguments in support thereof. (Appeal brief filed on Sep. 29, 2003, paper 16, pp. 4 and 7.) We note, however, that the appellants rely on the same arguments for the patentability of appealed claim 2 and 5 as they do for appealed claim 1. Accordingly, we confine our discussion to representative claims 1 and 6. 37 CFR § 1.192(c)(7) (2003)(effective Apr. 21, 1995).

Under these circumstances, we share the examiner's view that Trese describes each and every limitation of the invention recited in appealed claim 1.

Relying on the claim language "consisting of," the appellants argue that Trese is not anticipatory because the reference teaches that removal of vitreous from the eye is an essential part of the disclosed procedure. (Appeal brief at 6; see also reply brief filed on Dec. 19, 2003, paper 18, page 2.) We, like the examiner (answer at 4-5), find this argument unpersuasive. While it is true that Trese teaches a method for performing a vitrectomy involving a step of introducing plasmin followed by a step of removing vitreous, the reference undeniably describes a method for separating posterior vitreous from the retina consisting of only one step - a step of introducing plasmin into the vitreous. (Column 2, lines 4-12.) Trese's procedure for separating posterior vitreous from the retina consisting of only one step (i.e., a step of introducing human plasmin into the vitreous) is the very same method for creating a separation of posterior cortical vitreous in an eye from an eye retina as recited in appealed claim 1. Moreover, we note that even the present specification discloses that a portion of the vitreous may be removed after introduction of the

plasmin to eliminate intraocular pressure. (Specification, page 3, lines 16-23.)

With respect to appealed claim 6, the appellants contend that "[t]he Trese et al./Zaffaroni et al. combination is defective and lacking a motivation to combine..." (Appeal brief at 7-8.) Specifically, the appellants urge that a "slow sustained release of plasmin only makes sense in the context of the present invention where the vitreous is left in place following plasmin action to create a separation" and that "Trese...teaches the need for a quick complete surgical procedure." (Id. at 8.) We cannot agree.

While Trese states that separation of the vitreous from the retina occurs "after a relatively short period, for example five to sixty minutes" (column 2, lines 7-12), the reference also teaches that the plasmin may be introduced into the "vitreous...by any conventional means..." (column 2, lines 4-7). Zaffaroni, which the present specification describes as teaching a sustained released intraocular device suitable for use in the claimed invention (page 4, lines 6-10), teaches such a conventional means for delivery. In particular, Zaffaroni discloses an ocular drug delivery device 10 positioned in immediate contact with an eyeball 29 for osmotically

administering a beneficial drug to eye 29 at an osmotically metered dosage rate. (See, e.g., Column 10, lines 45-49; Figure 5.) Given the collective teachings of Trese and Zaffaroni, we agree with the examiner's determination (answer at 3) that one of ordinary skill in the art would have found in the prior art the requisite motivation, suggestion, or teaching to combine Zaffaroni with Trese. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991)(citing In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)).

For these reasons and those set forth in the answer, we affirm the examiner's rejections under: (i) 35 U.S.C. § 102(b) of appealed claims 1 and 5 as anticipated by Trese; (ii) 35 U.S.C. § 103(a) of appealed claim 2 as unpatentable over Trese; and (iii) 35 U.S.C. § 103(a) of appealed claim 6 as unpatentable over Trese in view of Zaffaroni.

The decision of the examiner is affirmed.

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

AFFIRMED

Thomas A. Waltz Administrative Patent Judge	)	
Romulo H. Delmendo Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Jeffrey T. Smith Administrative Patent Judge	)	

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