

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte RONALD A. SCHACHER

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Appeal No. 2005-1315  
Application No. 09/972,533

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ON BRIEF

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Before FRANKFORT, McQUADE, and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is a decision on the appellant's request for rehearing (filed November 4, 2005) under 37 CFR § 41.52 of our decision mailed August 31, 2005 (hereinafter "earlier decision"). In our earlier decision, we affirmed the examiner's rejection of claims 39, 40, 49 and 50 under 35 U.S.C. § 112, second paragraph, as being indefinite, and the examiner's rejections of claims 1, 36-41 and 45-51 under 35 U.S.C. § 102(b) as being anticipated by Fisher and by Smith. The appellant's request is directed solely to the affirmance of the anticipation rejections and does not request reconsideration of the affirmance of the indefiniteness rejection.

The basis of the appellant's request is that the statement of this panel, on page 7 of our earlier decision, that "the placement of the Fisher and Smith implants in a scleral pocket will necessarily displace scleral tissue, thereby causing scleral expansion" assumes that the scleral pocket or tunnel receiving the Fisher or Smith implant is smaller than the implant, rather than formed to have a size corresponding to the implant, and neither Fisher nor Smith supports such a conclusion. Even assuming, *arguendo*, the appellant is correct that the Fisher and Smith implants surgically implanted according to the particular methods disclosed by Fisher and Smith would not necessarily displace scleral tissue and cause scleral expansion, the appellant's argument overlooks the fact that the claims at issue (claims 1, 36-41 and 45-51) are directed not to a method of implantation but rather to a prosthesis. As pointed out in our earlier decision, the Fisher and Smith implants both appear reasonably capable, without

structural modification, of causing scleral expansion and the appellant has not provided any cogent reasoning why this is not the case. In particular, while the appellant argues in the request that the Fisher and Smith implants will not displace scleral tissue and cause scleral expansion if implanted into a pocket which is of a size corresponding to the implant, the appellant has not explained why the Fisher or Smith implant would not displace scleral tissue and cause scleral expansion if implanted into a pocket or slit which is smaller than the implant. In this case, the appellant's argument as to the differences between the appellant's claims and the implants of Fisher and Smith appears to be directed not to the structure of the implants themselves but rather to the method in which they are used (e.g., the size of the slit or pocket into which they are implanted). It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Accordingly, the appellant's request fails to persuade us that either the Fisher or Smith implant falls short of meeting the language in the appellant's claims.

In light of the above, the appellant's request for rehearing is granted to the extent of our reconsidering our earlier decision but is denied with respect to making any modification thereto.

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

DENIED

CHARLES E. FRANKFORT )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
JOHN P. MCQUADE ) APPEALS  
Administrative Patent Judge ) AND  
 ) INTERFERENCES  
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JENNIFER D. BAHR )  
Administrative Patent Judge )

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**Comment [jvn1]:** Type address

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