

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAY M. EASTMAN, WILLIAM J. FOX,  
ROGER J. GREENWALD, KEVIN P. ROESSER,  
and JAMES M. ZAVISLAN

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Appeal 2006-3381  
Application 10/162,317<sup>1</sup>  
Technology Center 2800

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Decided: November 30, 2007

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Before KENNETH W. HAIRSTON, HOWARD B. BLANKENSHIP,  
and JAY P. LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have requested a rehearing of our decision dated March 23, 2007 in which the rejections of the Examiner were Affirmed-in-Part. The rejection of claims 42, 43, and 50 was reversed, all others rejections were affirmed.

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<sup>1</sup> Application was filed on June 4, 2002. Appellants claim the benefit under 35 U.S.C. § 120 of application 09/502,252, filed February 17, 2000, now U.S. Patent No. 6,411,434 and the benefit under 35 U.S.C. § 119 of provisional patent application 60/120,534 filed February 17, 1999. The real party in interest is Lucid, Inc. of Rochester, NY.

Appellants argue that the Board's affirmance of the Examiner's rejection of claims 23, 26, 33, 41, 46, 48, 49, 53 to 57 and 60 to 63 under 35 U.S.C. 102(b) for being anticipated by Brackett is based on a misapprehension of Brackett.

Specifically, Appellants argue that although "some level of pressure may have incidentally occurred on the specimen in Brackett by squeezing liquid mounting medium, the specimen would relax to its pre-squeeze shape once pressure of the squeeze were removed as the mounting medium cannot adhere anything until cured". (Req. p. 1, ¶ 2 and restated on p. 2).

We have carefully considered Appellants' argument, but are not convinced to reverse our decision. First, the argument is based on a scenario that is not necessarily true. The extended period for the curing of a mounting medium during which the specimen exerts continuous pressure to return to its pre-squeezed position is based on an example of the Appellants. In giving a broad but reasonable interpretation to the claim, we can easily contrive a flat cut tissue specimen of such a nature that it need not be continuously pressed until a mounting medium cures. Secondly, the claim does not require a curing for a permanent shaping. The steps that are recited in the claims are simply anticipated by the teachings of Brackett: locating the specimen, placing a pliable membrane, retaining the specimen against a window, applying pressure, shaping the tissue specimen, engaging the membrane to the base member. Brackett teaches that the tissue specimen may be oriented (by a bonding process) in a certain orientation, namely "against said window". Arguments that it takes time for Brackett's mounting fluid to cure, and that the specimen would have to be held for that time are

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addressing actions not required by the claimed limitations, nor are such actions precluded by the claims.

Appellants' request for rehearing has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

REHEARING

DENIED

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