

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEON ESTEROWITZ and CHARLES L. MARQUARDT

Appeal No. 2000-0948
Application No. 08/511,341

ON BRIEF

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 to 24, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No. 6, mailed February 26, 1997) and the answer (Paper No. 15, mailed August 14, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 14, filed March 25, 1998) for the appellants' arguments thereagainst.¹

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will

¹ The rejection of claims 1 and 3 to 24 under 35 U.S.C. § 112, first paragraph, made in the final rejection was withdrawn by the examiner (answer, p. 3).

not sustain the examiner's rejection of claims 1 and 3 to 24 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 1, the sole independent claim on appeal, reads as follows:

A dual wavelength surgical laser system for performing laser surgery on living tissue with a minimum amount of collateral tissue damage, said laser system comprising:

a pump laser for emitting pump laser pulses of light at a preselected pump wavelength of about 2 microns;
means coupled to said pump laser being responsive to each pump pulse from said pump laser for producing a first wavelength pulse of light at about 3 microns in a water absorption band of the tissue and a second wavelength pulse of light at about 6 microns in a protein absorption band of the tissue;
first optical means coupled to said producing means for only passing therethrough each first wavelength pulse from said producing means;
means coupled to said first optical means for delaying each first wavelength pulse from said first optical means by a predetermined period of time;
second optical means coupled to said producing means for only passing therethrough each second wavelength pulse from said producing means; and
means coupled to said second optical means and to said delaying means for combining each second wavelength pulse with the following delayed first wavelength pulse to form a stream of consecutive second and delayed first pulse pairs for application to the tissue.

The examiner found (answer, p. 3) that (1) Feld teaches "the desirability of applying pulse sequences of different wavelength to provide tissue ablation using less energy over all;"
(2) Edwards teaches "the desirability of using 3 micron light to remove tissue and the desirability of using 6 micron light to remove tissue;" and (3) Eckardt teaches "the generation for 6 micron light with Ho:YLF or Nd:Yag pumps." After the scope

and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). However, in the rejection before us, the examiner did not ascertain the differences between the prior art and claim 1 on appeal. The examiner did determine (answer, pp. 3-4) that it would have been obvious to the artisan of ordinary skill to use 3 micron and 6 micron light in the method of Feld since both of these work well for removing various types of tissue, as taught by Edwards, and to employ an OPO using AgGaSe₂ since this can produce 6 micron pulses of reasonable power while remaining below the damage threshold of the material as taught by Eckardt, thus producing a device as claimed.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the

combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the prior art contains none. In fact, the advantages of utilizing **both** a first wavelength pulse of light at about 3 microns in a water absorption band of the tissue and a second wavelength pulse of light at about 6 microns in a protein absorption band of the tissue as set forth in claim 1 are not appreciated by the prior art applied by the examiner for the reasons set forth by the appellants (brief, pp. 5-13).

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir.

1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id. Since the subject of claim 1, as a whole, is not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claim 1, and of dependent claims 3 to 24.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 3 to 24 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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