

UNITED STATES OF AMERICA
BEFORE FEDERAL TRADE COMMISSION

In the Matter of)

Summit Technology, Inc.,)
a Corporation, and)

VISX, Incorporated,)
a Corporation.)

DOCKET No. 9286

ORDER SPECIFYING UNDISPUTED FACTS REGARDING
RESPONDENT VISX, INCORPORATED'S MOTION NO. 2 –
FOR SUMMARY DECISION REGARDING U.S. PATENT
NO. 5,711,762 AND U.S. PATENT NO. 5,735,843

Respondents motion for Partial Summary Decision having been denied, I enter this order, in accordance with Rule 3.24(a)(5), specifying facts that appear without substantial controversy:

1 U.S. Patent No. 7,511,762 (“762 Patent”) is directed to a “system for use in a laser source surgical method of removing corneal tissue.” The system of claim 1 requires a laser that produces a beam of radiation at a wavelength of about 193 nm in a series of pulses. The system also requires a laser delivery system means for receiving the 193 nm radiation from the laser and delivering a fraction of that radiation to the cornea wherein the radiation produces a depth of ablation of approximately 1 micron for each accumulation of one joule per square centimeter of energy applied.

2 U.S. Patent No. 5,735,843 (“843 Patent”) is directed to “a system for use in a laser source surgical method of removing corneal tissue.”

a. The systems of claims 1 and 14 comprise “a mask having an aperture for providing a graded intensity to the cornea.” The systems of claim 1 further requires that the graded intensity to the cornea be from center to edge with more intensity at the center than at the edge. The system of claim 14 requires the graded intensity to the cornea be from edge to center with more intensity at the edge than at the center.

b. The system of claim 16 comprises all of the requirements of claim 14, and in addition requires a laser that produces radiation at a wavelength of 193 nanometers in a series of pulses; however, Respondent does not agree that this paragraph 2(b) is relevant to Motion No. 2.

3. The independent claims in the '388 Patent are all directed to *methods* for performing certain types of corneal surgery.

4. The independent claim in the '762 Patent is directed to *apparatus* useful in performing laser surgery.

5. The independent claims of the '843 Patent are all directed to *apparatus* useful in performing laser surgery.

6. The '762 Patent issued from Patent App. Ser. No. 474,243, which was a division of Patent App. Ser. No. 341,207, which was a division of Patent App. Ser. No. 893,841, which was a continuation of Patent App. Ser. 673,541, which was a continuation of Patent App. Ser. No. 109,812, which was the patent application that issued as U.S. Patent No. 5,108,388 ("'388 Patent").

7. The '843 Patent issued from Patent App. Ser. No. 480,243, which was a division of Patent App. Ser. No. 341,207, which was a division of Patent App. Ser. No. 893,841, which was a continuation of Patent App. Ser. No. 673,541, which was a continuation of Patent App. Ser. No. 109,812, which was the patent application that issued as the '388 Patent.

8. A restriction requirement was issued in Patent App. Ser. No. 893,841. The examiner found there to be 14 patentably distinct inventions.

9. A restriction requirement was issued in Patent App. Ser. No. 341,207. The examiner found there to be ten patentably distinct inventions.

10. The patent examiner did not issue a double-patenting rejection in Patent App. Ser. No. 474,243, however, Complaint Counsel does not agree that this paragraph 10 is relevant to Motion No. 2.

11. The patent examiner did not issue a double-patenting rejection in Patent App. Ser. No. 480,243; however, Complaint Counsel does not agree that this paragraph 11 is relevant to Motion No. 2.

12. There were no terminal disclaimers filed in Patent App. Ser. No. 474,243; however, Complaint Counsel does not agree that his paragraph 12 is relevant to Motion No. 2.

13. There were no terminal disclaimers filed in Patent App. Ser. No. 480,243; however, Complaint Counsel does not agree that this paragraph 13 is relevant to Motion No. 2.

14. The invention claimed in the '762 Patent is patentably distinct from that claimed in the '388 Patent.

15. The invention claimed in the '843 Patent is patentably distinct from that claimed in the '388 Patent.

16. United States Patent No. 4,784,135 ("Blum") was cited to and considered by the examiner during the prosecution the '762 Patent.

17. Blum was cited to and considered by the examiner during the prosecution the '843 Patent.

18. R. Srinivasan, J.J. Wynne, & S.E. Blum, "Far-UV Photoetching of Organic Material," *Laser Focus* 62 (May 1983) was considered by the examiner during the prosecution the '388 Patent.

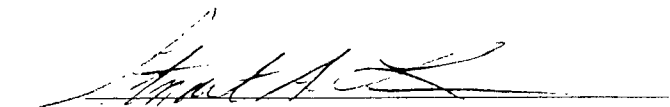
19. Blum discloses a laser that produces radiation at a wavelength of 193 nanometers in a series of pulses

20. Srinivasan discloses a laser that produces radiation at a wavelength of 193 nanometers in a series of pulses

21. Complaint Counsel does not contend that VISX has an obligation to disclose Keates, Karp, Girard, or Blum to the patent examiner during the prosecution of the '762 and '843 Patents.

THEREFORE:

In view of this order specifying undisputed facts FURTHER PROCEEDINGS in this action are directed pursuant to Rule 3 24(a)(5).



Stuart A. Levin
Administrative Law Judge

Date: December 15, 1998