

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* CLAUDE IMBERT

Appeal No. 95-5014  
Application 07/742,675<sup>1</sup>

ON BRIEF

**MAILED**

**JAN 31 1996**

**PAT.&T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Before STONER, Acting Chief Administrative Patent Judge, and  
CALVERT and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 1-7, 10-15, and 17-20. Claims 8, 9, and 16, the remaining claims of the application, have been objected to as being dependent upon a rejected base claim, as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

<sup>1</sup> Application for patent filed August 7, 1991.

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The appellant's invention is directed to a syringe sprayer and a dose limiting means therefor. As best seen in Figure 4 of the drawings, the syringe sprayer comprises a barrel [21] body which creates an internal chamber [23] for retaining and delivering a liquid medicament [35] to a patient. The barrel has an open proximal end [22] for receiving an elongate plunger rod [31] with a stopper [29] on its distal end which is in sliding engagement with the internal wall of the barrel. A spray nozzle [37] having a spray aperture [41] at its distal end [40] is located at a tip portion [25] of the distal end [27] of the barrel and houses a flexible one-way valve [45] which allows for single direction flow of the medicament from the chamber to the patient, and additionally prevents the syringe from being refilled. In addition, a dose limiting housing [47] fits circumferentially around the plunger rod and limits the amount of medicament to be administered to the patient by preventing the plunger rod from being advanced into the syringe barrel.

The subject matter before us on appeal is illustrated by reference to independent claims 1 and 15, both drawn to a syringe sprayer. Copies of these claims as found in Appendix I to the main brief (Paper No. 14) are appended hereto.

#### ***THE REFERENCES***

The prior art references relied upon by the examiner to support the final rejection are:

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|                    |           |               |
|--------------------|-----------|---------------|
| Wolf et al (Wolf)  | 4,767,416 | Aug. 30, 1988 |
| Manska             | 4,919,167 | Apr. 24, 1990 |
| Ennis, III (Ennis) | 4,923,448 | May 08, 1990  |

#### **THE REJECTIONS**

Claims 1, 2, 12, 13, and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ennis in view of Manska.

Claims 3-7, 10, 11, 15 and 17-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ennis in view of Manska and further in view of Wolf.

Reference is made to the Examiner's Answer (Paper No. 15, mailed November 1, 1994) for the examiner's complete reasoning in support of the above noted rejections. Appellant's arguments thereagainst are found in the main brief<sup>2</sup> (Paper No. 14, filed August 15, 1994) and in the reply brief (Paper No. 16, filed November 21, 1994).

#### **OPINION**

At the outset, we note that no rejection with respect to prior art has been made against claim 12 throughout the prosecution of this application. It is apparent from the record, however, that appellant has agreed with the examiner's assertion that claim 12 was intended to be rejected over Ennis in view of

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<sup>2</sup> The first filed brief of April 26, 1994 (Paper No. 12) was found to be defective. The corrected brief filed August 15, 1994 (Paper No. 14) is considered to be the main brief.

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Manska<sup>3</sup>, as he has noted in the main brief, the paragraph spanning pages 5 and 6. As the record reflects, the examiner and appellant appear to be in agreement that the claim was intended to be rejected and thus in the interest of expediting prosecution, claim 12 will be viewed by this panel of the Board as if it has been rejected over Ennis in view of Manska.

In reaching our conclusions on the obviousness issues raised in this appeal, we have carefully considered appellant's specification and claims, the applied references, and the respective viewpoints advanced by appellant and the examiner. As a consequence of our review, we have made the determinations that follow.

The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. See *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). Additionally, the test for obviousness is what the combined teachings of the prior art would have suggested to one of

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<sup>3</sup> The examiner groups claim 12 with the rejection of claims 3-7, 10-11, 15, and 17-20 under 35 USC 103 over Ennis in view of Manska and Wolf (see the top of page 3 of the Examiner's answer). However, it is apparent that Wolf is unnecessary surplusage in the rejection of claim 12 as Ennis and Manska alone are stated as meeting all of the limitations of the claim and Wolf adds nothing to the rejection with respect to claim 12. Therefore, claim 12 is considered to be rejected along with claims 1, 2, 13, and 14 over Ennis in view of Manska as noted by appellant (main brief, page 6). Regardless, appellant has admitted on the record (Paper No. 14, page 6) that claim 12 is not separately patentable and therefore will stand or fall with claim 1 from which it depends.

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ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It is not necessary that suggestion to combine the teachings of references be found within the four corners of the references themselves. A conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan rather than the lack thereof. *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985).

In the present case, the prior art to Ennis as pointed to by the examiner is directed to a syringe with a spray nozzle tip. With regard to the rejection of claims 1, 2, 12, 13, and 14, the examiner contends that Ennis teaches appellant's invention with the exception of a valve within the nozzle that allows fluid to flow from the syringe to a patient, only upon a required pressure being present. The examiner then applies *Manska* who teaches a check valve to account for the deficiency in Ennis. The examiner states:

"Manska teaches the use of a fluid pressure-controlled check valve for use in/with medical devices to prevent reverse flow (column 1, lines 1-34), and specifically for use in/with a syringe (column 8, line 61 - column 9, line 44). In view of the teachings of *Manska*, it would have been obvious to one

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of ordinary skill in the art to use the check valve assembly with a syringe sprayer as taught by Ennis III so as to prevent reverse flow of the medicament" (answer, page 5).

While the examiner has relied upon the combined teachings of Ennis and Manska and applied a rationale that proposes a modification of the Ennis syringe on the basis of the disclosure of Manska, we, on the other hand, consider these combined teachings on the basis of a modification of the check valve assembly of Manska, particularly as shown in Figure 4, in light of the disclosure of Ennis.<sup>4</sup> That is, we find that the use of a syringe attached at inlet port [112] of the check valve assembly of Manska as suggested in his disclosure at column 9, line 2, et seq., results in a syringe with a valve tip assembly as in appellant's invention. The only limitation of independent claim 1 not met by Manska alone is that of having a "spray nozzle." We conclude that it would have been obvious to one having ordinary skill in the art to add a spray nozzle to the

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<sup>4</sup> As pointed out by the court in *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 267 (CCPA 1961),

where a rejection is predicated on two references each containing pertinent disclosure which has been pointed out to the applicant, we deem it to be of no significance, but merely a matter of exposition, that the rejection is stated to be on A in view of B instead of B in view of A, or to term one reference primary and the other secondary.

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outlet port [116] of Manska in order to provide for an atomized delivery of the medicament, if so desired, in light of the teaching of Ennis that spray nozzle tips are known to be used in combination with syringes for this purpose. Accordingly, the examiner's rejection of claims 1-2 under 35 U.S.C. § 103 based on the combined teachings of the applied Ennis and Manska patents is sustained.

Further, we agree with the examiner that because the appellant has chosen not to challenge with any reasonable specificity before this Board the rejection of the dependent claims 12-14, they will be grouped with independent claim 1 from which they depend, and will fall therewith. See *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987).

Turning now to the rejection of claims 3-7, 10, 11, 15 and 17-20 under 35 U.S.C. § 103 as being unpatentable over Ennis in view of Manska and further in view of Wolf, we observe that claims 3-7, 15 and 17-20 require "dose limiting means." According to appellant's specification [page 14], the "dose limiting means" is a housing [47] having a C-shaped cross-section which partially surrounds the plunger rod and which interacts between the flange [32] of the plunger rod and the barrel flange [26] of the proximal end [22] of the barrel to limit the distal motion of the plunger rod with respect to the barrel. Under *In re Donaldson Co., Inc.*, 16 F3d. 1189, 1194, 1195, 29 USPQ2d 1845,

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1850 (Fed. Cir. 1994), we are constrained to interpret appellant's "dose limiting means" as being "limited to the corresponding structure, materials or acts described in the specification and equivalents thereof...".

The examiner makes the general assertion that it would have been obvious to one having ordinary skill in the art, based on Wolf, to modify Ennis by providing dose limiting means in the form of indicia on the barrel of the syringe. The examiner further takes the position that the operator of the syringe would use such indicia to visually determine the amount of medicament being delivered and consequently such indicia can be viewed as dose limiting means. We do not find the examiner's position in this regard to be well founded. On the contrary, we agree with appellant that when the teachings of Ennis, Manska, and Wolf are considered collectively, it does not appear that there is any corresponding structure taught or disclosed which would have suggested to one of ordinary skill in the art the recited "dose limiting means" of appellant's claims on appeal. We further do not consider that the "indicia" of Wolf as cited by the examiner would be an equivalent means of appellant's "dose limiting means" as construed under 35 USC § 112, sixth paragraph, and in light of *Donaldson*, and therefore, the limitations of claims 3-7, 15 and 17-20 are not met by the combined teachings of Ennis, Manska, and Wolf.

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Further, we cannot agree with the examiner's rationale that the operator of the syringe in using the indicia of Wolf as a guide for delivering a desired amount of medicament can correspond to appellant's "dose limiting means." It has been established under long-standing precedent that it is not permissible to read a means plus function limitation of a claim on a human being or a part of a human being. See generally *In re Bernhardt*, 417 F.2d 1395, 163 USPQ 611 (CCPA 1969). Accordingly, the examiner's rejections of claims 3-7, 15, and 17-20 under 35 U.S.C. § 103 cannot be sustained.

Once again, however, because the appellant has chosen not to challenge with any reasonable specificity before this Board the rejection of the dependent claims 10-11, we again conclude that they must be grouped with independent claim 1 from which they depend, and will fall therewith. See *In re Nielson*, *supra*.

On a further point, we are mindful that the appellant is free to claim his invention in broad terms, and that he is entitled to the broadest reasonable interpretation of the claim language. However, because a patentee has the right to exclude others from making, using and selling the invention covered by the patent (35 USC 154), the public must be apprised of exactly what the patent covers, so that those who would approach the area circumscribed by the claims of a patent may more readily and

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accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. It is to this that the second paragraph of 35 USC 112 is directed. See *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970).

Upon careful review of this appeal, we observe that claims 3 and 15 require

"dose limiting means also including override means for allowing delivery of all of the liquid in said chamber."

When we turn to appellant's disclosure to ascertain the meaning of this claim limitation, we find nothing identified therein as "override means." Thus, we find no indication that one of ordinary skill in the art would be sufficiently apprised from a reading of the original specification so as to know exactly what would be encompassed by the recited "override means." See *In re Donaldson Co., Inc.*, *supra*. Therefore, we conclude that the original specification does not provide sufficient support so as to provide proper antecedent basis for the claim terminology, and we find it necessary to reject claims 3-7, 15, and 17-20 under 35 U.S.C. § 112, second paragraph, as being indefinite, pursuant to our authority under the provisions of 37 CFR 1.196(b).

Claims 8, 9, and 16 have been indicated by the examiner to contain allowable subject matter, and therefore, are not before us for consideration in this appeal. However, these

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dependent claims suffer from the same deficiency as noted above with regard to claims 3 and 15. Therefore, under 37 CFR 1.196(d), we recommend to the examiner that they also be rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

**In summary:**

The examiner's rejection of claims 1, 2, 12, 13, and 14 under 35 U.S.C. § 103 as being unpatentable over Ennis in view of Manska is sustained.

The examiner's rejection of claims 10-11 under 35 USC § 103 as being unpatentable over Ennis in view of Manska and further in view of Wolf, is also sustained.

The examiner's rejection of claims 3-7, 15, and 17-20 under 35 U.S.C. § 103 as being unpatentable over Ennis in view of Manska and further in view of Wolf is reversed.

A new ground of rejection of claims 3-7, 15, and 17-20 under 35 U.S.C. § 112, second paragraph, has been added pursuant to 37 CFR 1.196(b). A recommendation under 1.196(d) has been made to reject claims 8, 9, and 16 under 35 U.S.C. § 112, second paragraph.

A period of two months is set in which the appellant may submit to the Primary Examiner an appropriate amendment, or a showing of facts or reasons, or both, in order to avoid the grounds set forth in the Statement of the Board of Patent Appeals and Interferences under the provisions of 37 CFR 1.196(d) and/or

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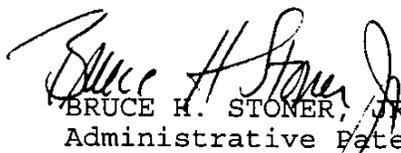
prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record with respect to the new rejection under 37 CFR 1.196(b) if the appellant so elects.

Upon conclusion of the proceedings before the Primary Examiner on remand, this case should be returned to the Board by the Primary Examiner so that the Board may either adopt its decision as final or render a new decision on all of the claims on appeal, as it may deem appropriate. Such return for this purpose is unnecessary if the application is abandoned expressly or as a result of an unanswered Office action, allowed, or again appealed.

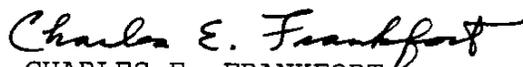
37 CFR 1.136.(a) does not apply.

**AFFIRMED-IN-PART**

**37 CFR 1.196(b) and 1.196(d)**

  
BRUCE H. STONER, JR., Acting Chief)  
Administrative Patent Judge )

  
IAN A. CALVERT )  
Administrative Patent Judge )

  
CHARLES E. FRANKFORT )  
Administrative Patent Judge )

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APPENDIX

**1.** A syringe sprayer comprising:

an elongate barrel having an open proximal end, a chamber for retaining fluid and a tip portion extending from a distal end of said barrel having a passageway therethrough communicating with said chamber;

a stopper slidably positioned in fluid-tight engagement inside said barrel;

an elongate plunger rod projecting proximally from said stopper and extending outwardly from said proximal end of said barrel; and

a spray nozzle extending outwardly from said tip portion of said barrel having a conduit therethrough in fluid communication with said passageway, a distal end of said nozzle having a spray aperture in fluid communication with said conduit; and

said nozzle including internal valve means for allowing liquid under pressure in said chamber to flow distally through said conduit and said aperture while preventing unpressurized liquid in said chamber from flowing through said aperture.

**15.** A syringe sprayer comprising:

an elongate barrel having an open proximal end, a chamber for retaining liquid and a tip portion extending from a distal end of said barrel having a passageway therethrough communicating with said chamber;

a stopper slidably positioned in fluid-tight engagement inside said barrel;

an elongate plunger rod projecting proximally from said stopper and extending outwardly from said proximal end of said barrel, said plunger rod including a radially extending flange on the proximal end of said plunger rod;

a spray nozzle extending outwardly from said tip portion of said barrel having a conduit therethrough in fluid communication with said passageway, a distal end of said nozzle having a spray aperture in fluid communication with said conduit;

said nozzle including internal valve means for allowing liquid under pressure in said chamber to flow distally through said conduit and said aperture while preventing unpressurized liquid in said chamber from flowing through said aperture;

said internal valve means including one-way valve means for preventing liquid flow through said conduit in a proximal direction toward said chamber; and

dose limiting means for preventing delivery of a pre-determined amount of liquid in said chamber through said passageway by limiting the distal motion of said plunger rod with respect to said barrel, said dose limiting means also including override means for allowing delivery of all of the liquid in said chamber.