

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT K. SCHULTZ, CONSTANTINOS SIOUTAS

Appeal No. 97-2736
Application 08/067,221¹

ON BRIEF

Before MEISTER, FRANKFORT and STAAB, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1 through 9 as amended subsequent to the final rejection in a paper filed March 23, 1995 (Paper No. 9). Claims 1 through 9 are all of the claims remaining in the

¹Application for patent filed May 26, 1993.

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application.

Claims 10 through 18 have been canceled.

Appellants' invention relates to a hand held aerosol actuator or metered dose inhaler of the type used to treat pulmonary disorders such as asthma, chronic bronchitis, and emphysema. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim appears in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Lankinen	4,940,051	Jul. 10,
1990		
Pritchard	5,048,729	Sep.
17, 1991		

Claims 1 through 4 and 7 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pritchard.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pritchard in view of Lankinen.

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Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make

reference to the examiner's answer (Paper No. 17, mailed December 12, 1995) for the examiner's reasoning in support of the rejections, and to appellants' corrected brief (Paper No. 16, filed October 16, 1995) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of claims 1

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through 4 and 7 through 9 under 35 U.S.C. § 103, we note that Pritchard discloses a hand held aerosol actuator which comprises an aerosol source (12, 24, 14, 38) capable of expelling a turbulent aerosol dose of drug comprising particles of respirable size, and a chamber (defined within mouthpiece 22) having walls defining a constriction aperture (60). The aerosol source in Pritchard "communicates" with the chamber and comprises an exit orifice (36, 37) that directs the aerosol along an axis into the

chamber. At least a portion of the walls which define the constriction aperture in Pritchard are "opposite the exit orifice" and the constriction aperture therein is coaxial with the exit orifice. As recognized by the examiner (answer, page 3), the constriction aperture (60) of Pritchard has a radius of about 1mm (column 2, lines 31-34) and a cross sectional area of about 0.03 square centimeters, while the constriction aperture of appellants' claimed aerosol actuator is required to have a significantly larger cross sectional area of 0.2 to 0.6 square centimeters.

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To address the difference between the aperture size in Pritchard and that in the claimed aerosol actuator, the examiner urges that Pritchard (column 3, lines 8-11) suggests that the small constriction aperture (60) therein might have a size which differs from the disclosed dimensions. From this disclosure, the examiner then concludes that

Since Pritchard recognizes that a plurality of dimensions including the aperture diameter may differ from those disclosed, it would have been obvious to modify Pritchard to employ any well known or desired dimensions including a diameter which would result in a cross sectional area of 0.2-6cm².

Contrary to the examiner's position, we do not believe that the suggestion found in Pritchard at column 3, lines 8-11 is such as to suggest "any... desired dimensions" for the aperture (60). In this regard, we share appellants' view as expressed on pages 5 and 6 of the brief that the disclosure of Pritchard, when considered as a whole, would not have in any way been suggestive of a cross sectional area for the small aperture (60) therein which would fall within appellants'

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claimed range. While some latitude on the size of the aperture (60) in Pritchard is certainly provided for, the degree of any such size variation is limited by the other disclosure in Pritchard (column 1, lines 44-50) concerning the function of the aperture (60) in allowing less than 10 percent, and desirably less than 5 percent, of the emitted gas stream from the exit orifice of the aerosol source to pass therethrough. Given the clear disclosure in Pritchard that the aperture (60) is on the order of about 2mm in diameter and the limitations on the function of the aperture in the aerosol apparatus of Pritchard, we find it incomprehensible that one of ordinary skill in the art would have contemplated sizing the aperture (60) in the manner urged by the examiner, that is, so as

to make the aperture of Pritchard 250% larger than the disclosure therein would seem to indicate is appropriate.

In our opinion, the examiner's above position is based on impermissible hindsight gleaned from appellants' own

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disclosure and not from any fair teaching or suggestion found in the applied Pritchard patent. Absent the disclosure of the present application, it is our opinion that one of ordinary skill in the art would not have been motivated to modify the aerosol apparatus of Pritchard in the manner urged by the examiner so as to arrive at the subject matter set forth in appellants' independent claim 1 on appeal. Thus, the examiner's rejection of appellants' claims 1 through 4 and 7 through 9 under 35 U.S.C. § 103 based on Pritchard will not be sustained.

We have also reviewed the patent to Lankinen applied by the examiner in the § 103 rejection of dependent claims 5 and 6. However, we find nothing in this reference which would supply that which we have noted above to be lacking in the basic reference to Pritchard. Accordingly, the examiner's rejection of claims 5 and 6 on appeal under 35 U.S.C. § 103 will likewise not be sustained.

As should be apparent from the foregoing, the decision of the examiner rejecting claims 1 through 9 of the present

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application is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
LAWRENCE J. STAAB)	
Administrative Patent Judge)	

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