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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD L. RETALLICK III

Appeal No. 98-3360
Application No. 08/556,099[1]

ON BRIEF

Before MEISTER, ABRAMS, and FRANKFORT, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

[1]Application for patent filed November 9, 1995.

This is an appeal from the decision of the examiner finally rejecting claims 1-3,[2] which constitute all of the claims of record in the application.

The appellant's invention is directed to an apparatus and method for treating the lungs. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

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

Watson et al. (Watson)	4,446,864	May 8, 1984
PCT Application (Mangum)	WO 93/00952	Jan. 21, 1993

THE REJECTION

Claims 1-3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mangum in view of Watson.

The rejection is explained in Paper No. 5.

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[2]Entry of an amendment after the final rejection was permitted upon the filing of a notice of appeal.

The opposing viewpoints of the appellant are set forth in the Brief and the Reply Brief.

OPINION

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See ***Uniroyal ,Inc. V. Rudkin-Wiley* Corp.**, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

As stated in the opening paragraphs of the specification, the appellant’s invention permits the simultaneous administration of oxygen, a nebulized bronchodilator, and an additional medicant to a patient with low or no respiratory function who is intubated with an endotracheal tube and whose breathing is being assisted by a manually operated resuscitator. The invention is manifested in claim 1 by the recitation of a number of components that are connected together in a particular fashion. Included among these is a T-shaped tube having a bottom opening connected to a nebulizer and side openings connected to a resuscitator on the one hand and to one branch of a Y-shaped tube on the other hand. The base opening of the Y-shaped tube is connected to the endotracheal tube that is in the patient’s trachea. Installed in the other branch opening in the Y-shaped tube is a self-sealing plug through which liquid medication can be injected. The result of this arrangement is that the nebulizer can add nebulized medication into the stream of gas supplied to the endotracheal tube by the resuscitator, and liquid medication can subsequently be injected into the stream that has issued from the nebulizer.

The primary reference applied by the examiner is Mangum, which also is directed to an apparatus for treating the lungs. Mangum discloses a device in which a powered resuscitator delivers a breathing mixture to the inlet of a T-shaped tube whose bottom opening is exposed to a nebulizer reservoir and whose outlet is connected to an endotracheal tube. Mangum also teaches introducing a liquid medication into the system. However, Mangum does so through an injection port in the wall of the reservoir of the nebulizer (pages 4 and 1; Figure 11). There is no element like or comparable to the Y-shaped tube recited in the appellant’s claim 1 that is connected to the system downstream of the outlet of the nebulizer, and which provides the means for injecting a liquid medication at that point. This deficiency is not cured by considering the teachings of Watson, which was added for its showing of a manual resuscitator.

Claim 3 recites the method of the invention. It requires feeding a nebulized mist of bronchodilator into a stream of oxygen, and injecting from the needle of a pre-filled syringe a medicant in liquid form directly into the stream of oxygen and nebulized mist of bronchodilator. Since Mangum teaches adding

the liquid to the reservoir of the nebulizer, where such a stream does not exist, the requirements of claim 3 are not met. As was the case above, the defect is not cured by the secondary reference.

It therefore is our conclusion that the combined teachings of the two applied references fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in any of the claims, and the rejection cannot be sustained.

The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER Administrative Patent Judge	)	
NEAL E. ABRAMS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CHARLES E. FRANKFORT Administrative Patent Judge	)	

NEA/jlb

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