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RATNERPRESTIA 2200 RENAISSANCE BLVD SUITE 350 KING OF PRUSSIA, PA 19406			MATTER, KRISTEN CLARETTE	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALAN LANGFORD, FERGAL HENNESSY, and
MICHAEL HOLROYD

Appeal 2014-008371¹
Application 12/713,761²
Technology Center 3600

Before STEFAN STAICOVICI, TARA L. HUTCHINGS, and
AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final decision rejecting claims 1–3, 6–8, 11–30, and 33. We have jurisdiction under 35 U.S.C. § 6(b). The Appellants’ representative appeared for oral hearing in this appeal on December 7, 2016 (“Hearing”).

We AFFIRM.

¹ Throughout this opinion, we refer to the Appellants’ Appeal Brief (“Appeal Br.,” filed Apr. 7, 2014), Reply Brief (“Reply Br.,” filed July 22, 2014), and Specification (“Spec.,” filed Feb. 26, 2010), and to the Examiner’s Answer (“Ans.,” mailed May 27, 2014) and Final Office Action (“Final Act.,” mailed Aug. 6, 2013).

² According to the Appellants, “[t]he real Party [i]n Interest in this matter is TEVA Pharmaceuticals, Inc. by virtue of an assignment to Norton Healthcare Ltd.” Appeal Br. 1.

STATEMENT OF THE CASE

The Appellants' invention "relates to the field of inhalers used for the delivery of medicaments indicated for the treatment, or alleviation of the effects of any ailment including respiratory complaints and various systemic diseases, via the delivery of a medicament by the pulmonary route."

Spec. 1, ll. 13–16.

Claims 1, 7, 12, 16, 19, 25, and 33 are the independent claims on appeal. Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A metered dose aerosol actuator for use in dispensing medicament from a pressurized medicament container having a valve stem at one end for dispensing the medicament and a closed end opposite the valve stem, the actuator comprising:
 - a housing adapted to receive the container in an assembled position, the housing having a base and an open end opposite the base, the container in the assembled position being oriented with the valve stem proximate to the base and the closed end proximate to the open end so that when the housing is oriented in a use position with the open end facing upwardly, the container will be in an inverted orientation with the valve stem facing downwardly and the closed end facing upwardly;
 - a stem block extending from the base of the housing toward the open end of the housing;
 - a cavity in the stem block defining a mating surface that is adapted to engage the valve stem of the medicament container with the container in the assembled position;
 - a spray orifice in the stem block in fluid communication with the cavity via an outlet channel;
 - and a sump in the cavity extending from the outlet channel toward the base of the housing, the sump being molded in a continuous form and having a continuous

smooth, rounded interior surface without angles or corners where the medicament being dispensed could accumulate or deposit.

REJECTIONS

Claims 1–3, 6–8, and 11–30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (US 5,069,204, iss. Dec. 3, 1991) and Barnes (US 5,894,964, iss. Apr. 20, 1999). Final Act. 2–3.

Claim 33 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith, Barnes, and Engelbreth (US 6,345,617 B1, iss. Feb.12, 2002). *Id.* at 4.

ANALYSIS

The Appellants argue all of the claims as a group. Appeal Br. 4. We select claim 1 as representative; claims 2, 3, 6–8, 11–30, and 33 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(1)(c)(iv).

The Appellants contend the Examiner’s rejection is in error because Barnes is not analogous art. Appeal Br. 5–12; Reply Br. 1–3. Specifically, the Appellants argue that Barnes is not from the same field of endeavor as the claimed invention and is not reasonably pertinent to the particular problem with which the inventor is involved. *Id.* After careful consideration of the Appellants’ Appeal and Reply Briefs and of the arguments presented during the Hearing, for at least the reasons below, we disagree.

“Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's

endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Bigio*, 381F.3d 1320, 1325 (Fed. Cir. 2004).

We are not persuaded by the Appellants’ argument that Barnes does not pass the second test of being reasonably pertinent to the inventor’s particular problem. *See* Appeal Br. 8–11. The Appellants argue that the claimed invention is “directed to solving the problem of inconsistent doses.” *Id.* at 9. In contrast, the Examiner contends the invention is directed to the problem “being the accumulation and/or deposition of medicament.” Ans. 4 (citing Spec. 1, ll. 25–28). The Specification provides that “there remains a need for improved, superior sumps to address and solve the problem of medicament accumulation and/or deposition and the concomitant reduction in the dose available resulting in variations and inconsistencies of the actual dose administered, blockage of the spray orifice, and medicament flaking.” Spec. 1, ll. 25–28. The Declaration of Robert Clayborough, Ph.D, dated Sept. 7, 2012, and submitted by the Appellants on Sept. 10, 2012, provides, at paragraph 12, “a common problem with pMDI [medical inhaler] devices is internal blockages. Blockages can affect the efficacy of the device because it can lead to inconsistent dosing. . . . Suspensions have a tendency to agglomerate and this can often lead to blockages.” Thus, we agree with the Examiner that the invention is directed to the problem of medicament accumulation and/or deposition that can result in blockage of spray orifices.

Barnes is directed to an aerosol actuator with a mathematically continuous arrangement that minimizes nozzle blockage. Barnes, Abstract. The mathematically continuous arrangement provides that the surface of inner actuator chamber has no discontinuities such as corners or edges. *Id.*

at col. 2, l. 65 through col. 3, l. 3. This arrangement minimizes deposition (accumulation) of the composition material that results in nozzle blockage, i.e., blockage of the spray orifice. *Id.* at col. 8, ll. 11–15. Thus, Barnes similarly pertains to the problem of deposition of composition material that can result in blockage of a spray nozzle/orifice. As such, we find that Barnes is reasonably pertinent to the particular problem and constitutes analogous art.

We also find unpersuasive the Appellants’ argument that the Examiner impermissibly uses hindsight in defining the problem because the Examiner focuses on the solution rather than the problem. *See* Appeal Br. 11–12. Rather, we find the Examiner reasonably focuses on the problem of material accumulation that can lead to blockages. Moreover, to the extent that the Appellants argue the Examiner improperly used hindsight, the argument is of no import where the Examiner states a rationale for the modification, namely, “minimize[] nozzle blockage in the actuator for better medicament delivery to a user” (*see* Final Act. 3), that we determine is supported adequately by sufficient facts. *See In re Cree*, 818 F.3d 694, 702, n.3 (Fed. Cir. 2016). Thus, we are not persuaded that the Examiner’s rejection of independent claim 1 is in error, and we sustain the Examiner’s rejection of claim 1. We also sustain the rejections of claims 2, 3, 6–8, 11–30, and 33, as they fall with claim 1.

DECISION

The Examiner’s rejections of claims 1–3, 6–8, 11–30, and 33 under 35 U.S.C. § 103(a) are AFFIRMED.

Appeal 2014-008371
Application 12/713,761

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED