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Clements Bernard Walker PLLC
4500 Cameron Valley Parkway
Suite 350
Charlotte, NC 28211

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DETLEF SCHIERSTEDT¹

Appeal 2015-004923
Application 13/817,539
Technology Center 1600

Before ULRIKE W. JENKS, RICHARD J. SMITH, and
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a medicinal product. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellant, the real party in interest is the inventor Detlef Schierstedt. (Appeal Br. 1.)

STATEMENT OF THE CASE

Claims on Appeal

Claims 1–3, 5, 8, 11, 12, and 15 are on appeal.² (Claims Appendix, Appeal Br. 8–9.) Claim 1 is illustrative and reads as follows:

1. A sympathomimetic-free medicinal product for treating irritations of the nasal mucosa by a cold, by hay fever, a dry nose and/or sympathomimetic dependence in the form of drops, sprays, or rinses characterized by comprising either a) mint oil and camphor, or b) menthol, mint oil, and camphor with a) and b) also including: i) at least one humectant comprising water-soluble or water-dispersible natural or synthetic polymers that form gels or viscous solutions in aqueous systems, said at least one humectant present in said sympathomimetic-free medicinal product an amount of from 0.1 to 5% by weight, ii) essential oils, and iii) pH control agents and/or tonicizing agents.

Examiner's Rejection

Claims 1–3, 5, 8, 11, 12, and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Friedlaender³ and Zellner.⁴ (Ans. 2.)

FINDINGS OF FACT

We adopt as our own the Examiner's findings and analysis concerning the scope and content of the prior art. The following findings are included for emphasis and reference convenience.

² Claims 9–10 and 13–14 are withdrawn from consideration as being drawn to non-elected inventions. (Final Act. 2, dated March 11, 2014.) Claims 4, 6, and 7 are cancelled pursuant to an amendment entered by the Advisory Action dated July 25, 2014, at 2.

³ Friedlaender et al., US 2008/0145459 A1, published June 19, 2008 (“Friedlaender”).

⁴ Zellner, US 6,528,081, issued Mar. 4, 2003 (“Zellner”).

FF 1. Friedlaender teaches a method for treating epiphora (excessive tearing or watering of the eyes), most commonly caused by nasal congestion, by administering a composition to the nasal cavity, such as by a nasal spray. (Friedlaender Abstract; ¶¶ 5, 7, and 75.)

FF 2. The Examiner finds that Friedlaender's composition is a medicinal product in accordance with the limitations of claims 1 and 3, but does not expressly teach that the nasal spray comprises mint oil. (Final Act. 7–8, citing Friedlaender Abstract; ¶¶ 5–8, 10, 12–17, 35, 39, 55–57, 61–63, and 75.)

FF 3. The Examiner finds that the Friedlaender composition “can be in spray form and can comprise camphor, eucalyptus oil (essential oil), and menthol.” (*Id.* at 7, citing Friedlaender Abstract; ¶¶ 7, 12–15, 35, 39, 63, and 75.)

FF 4. The Examiner finds that Friedlaender teaches that its composition “can comprise up to 2% lipids in addition to the already present eucalyptus oil.” (Final Act. 7, citing Friedlaender ¶ 52.)

FF 5. The Examiner finds that Zellner teaches a nasal spray solution that can “contain essential oils including mint oil, eucalyptus oil, and camphor oil . . . [t]he mint oil provides for an antiseptic and refreshing effect, and stimulates concentration.” (Final Act. 8, citing Zellner Abstract; col. 2, ll. 20–58.)

ISSUE

Whether a preponderance of evidence of record supports the Examiner's conclusion of obviousness under 35 U.S.C. § 103(a).

PRINCIPLES OF LAW

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at 417.

ANALYSIS

We adopt the Examiner's findings and agree with the Examiner's conclusion that claims 1–3, 5, 8, 11, 12, and 15 would have been obvious to a person of ordinary skill in the art at the time of the invention. (Final Act. 7–13; Adv. Act. dated June 30, 2014; Adv. Act. dated July 25, 2014; Ans. 3–16.) Appellant's arguments are addressed below. Our consideration of the rejection is limited to separately argued claims 1 and 3.

Claim 1

Appellant argues that Friedlaender is “directed to the treatment of epiphora” and that “[t]he solution to swelling of the mucous membranes of the nose and dry nose, is not a treatment for epiphora.” (Appeal Br. 6.) Appellant also argues that a person of ordinary skill “would not look to the treatment of epiphora as it is not in the relevant field,” and thus would not consider the Friedlaender reference or the combination of Friedlaender and Zellner. (*Id.* at 6–7.)

Appellant argues further that Friedlaender teaches away “from employing any other essential oils other than eucalyptus oil.” (*Id.* at 7, citing Friedlaender Abstract; ¶¶ 10, 19–22, and 26.) In particular, Appellant argues that the treatment for epiphora, as taught by Friedlaender, is substantially free of lipids and “a lipid is light oil – such as mint oil.” (Appeal Br. 7.) According to Appellant, one of skill in the art would avoid mint oil and therefore not consider the combination of Friedlaender in view of Zellner. (*Id.*, citing Friedlaender ¶¶ 36 and 37.)

We are not persuaded by Appellant’s arguments, and address each below.

Intended Use

Appellant argues that “[e]ven though the method of administering treatment by Friedlaender [] is via the nose, the medical condition is not the same nor is it related. The solution to swelling of the mucous membranes of the nose and dry nose, is not a treatment for epiphora.” (Appeal Br. 6.)

We are not persuaded. Appellant’s claim 1 is directed to a *composition* “for treating irritations of the nasal mucosa,” not a method of treatment. (Appeal Br. 8.) Moreover, the preamble language of claim 1 merely states a purpose or intended use of the composition, and is not a claim limitation. (Ans. 3–4); *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997); *see also Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002) (“[T]he patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure.”).

Relevance of Friedlaender

Appellant argues that “a person of ordinary skill in the art would not look to the treatment of epiphora as it is not in the relevant field.” (Appeal Br. 6.) We understand Appellant’s argument to be that Friedlaender is non-analogous art, but we are not persuaded.

It is well settled that “[t]wo 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 Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011)(citing *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Here, Friedlaender is in the same field of endeavor as Appellant; namely, compositions to alleviate nasal congestion⁵ by administration of the composition to nasal passages via a nasal spray. (Ans. 7–9; FF 1–4.) For the same reason, Friedlaender is also reasonably pertinent to the problem addressed by Appellant’s claimed invention.

Teaching Away

Appellant argues that Friedlaender “teach[es] away from employing any other essential oils other than eucalyptus oil. . . . More specifically a lipid is a light oil – such as mint oil.” (Appeal Br. 7.) Appellant asks, “[w]hen the treatment for epiphora is substantially free of lipids other than eucalyptus oil, and the reasoning (why one of ordinary skill in the art would

⁵ The Specification states that “[i]n common cold [], hay fever, . . . or dry nose, the nasal mucosa is subject to swelling.” (Spec. 1, ¶ 2.)

avoid mint oil) is clearly explained in [Friedlaender], why would one seek to combine these references?” (*Id.*)

We are not persuaded. Friedlaender teaches that “substantially free” does not mean no other lipids; rather, lipids other than eucalyptus oil may be present up to about 2% by weight of the composition. (Ans. 14–15; FF 4.) Here, claim 1 does not recite an amount of any lipid, such as (apparently) mint oil.⁶ (Appeal Br. 8.) Moreover, Friedlaender does not teach away because it does not criticize, discredit, or otherwise discourage the claimed invention. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

As for the combination of Friedlaender and Zellner, we are persuaded by the Examiner’s conclusion that:

One of ordinary skill in the art would have been motivated to [incorporate the mint oil of Zellner into the nasal spray composition of Friedlaender] to provide antiseptic properties to the nasal spray of Friedlaender with the additional benefit of stimulating concentration. There would have been a reasonable expectation of success as [Friedlaender] teach[es] that additional lipids other than eucalyptus oil can be incorporated into the composition up to 2% by weight . . . and both [Friedlaender and Zellner] teach nasal spray compositions which comprise eucalyptus oil in combination with camphor.

(Final Act. 9.)

Accordingly, for the reasons of record and the reasons set forth above, we affirm the rejection of claim 1 for obviousness.

⁶ We acknowledge Appellant’s statement in the Reply Brief that “mint oil is not a lipid.” (Reply Br. 1.) However, this appears to be contrary to Appellant’s statement that “lipid is a light oil – such as mint oil.” (Appeal Br. 7.) In any event, if mint oil is not a lipid, it would not be subject to the lipid percentages taught by Friedlaender. (*See* Friedlaender ¶¶ 13 and 52.)

Claim 3

Claim 3 is dependent on claim 1 and further recites that the medicinal product is “characterized by further containing panthenol.” (Appeal Br. 8.) Appellant argues that “[t]here is no disclosure in Friedlaender [] or Zellner for panthenol” and therefore “no proper rejection against claim 3 can be made by the combination of these references under 35 U.S.C. § 103.” (*Id.*)

We are not persuaded. As pointed out by the Examiner, Friedlaender’s composition “can comprise D-panthenol.” (Final Act. 7, citing Friedlaender ¶ 55.) Accordingly, for this reason, and for the reasons of record and as set forth above, we affirm the rejection of claim 3 for obviousness.

CONCLUSION OF LAW

A preponderance of evidence of record supports the Examiner’s conclusion that claims 1 and 3 are obvious under 35 U.S.C. § 103(a). Claims 2, 5, 8, 11, 12, and 15 were not separately argued and fall with claim 1.

SUMMARY

We affirm the rejection of all claims on appeal.

TIME PERIOD FOR RESPONSE

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

AFFIRMED