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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AUGUST J. BORSCHKE

Appeal 2018-004224
Application 14/794,026
Technology Center 1700

Before MICHAEL P. COLAIANNI, LILAN REN, and
MICHAEL G. McMANUS, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134 the final rejection of claims 1–24. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM.

Appellant’s invention is directed to systems that contain active ingredients that can be characterized as having a pharmacological effect and are useful for therapeutic purposes (Spec. 1:2–4).

Claim 1 is illustrative:

A system for the administration of a therapeutic composition, the system comprising:

a substrate portion having an upstream end and a downstream end, the upstream end allowing for passage of drawn atmospheric air into the substrate and the downstream end adapted for positioning into a user’s mouth for draw upon the substrate and inhalation of atmospheric air by the user,

a lozenge portion incorporating a source of active ingredient in a pharmaceutically acceptable form, the lozenge portion providing for oral ingestion of the active ingredient,

the lozenge portion and the substrate portion being physically separate from one another but in contact with each other, the lozenge being positioned at the downstream end of the substrate, and

the lozenge and substrate portions being positioned so that the lozenge portion and a portion of the substrate portion can be located in the user’s mouth during use, to provide for delivery of active ingredient from the lozenge and drawn air through the substrate.

¹ Appellant is the Applicant, Niconovum USA, Inc., which, according to the Brief, is the real party in interest. Br. 1.

Appellant appeals the following rejections:

1. Claims 1–4, 7, 11, 14, and 16–24 are rejected under 35 U.S.C. § 103 as unpatentable over Mascarelli (US 5,048,544, iss. Sept. 17, 1991) in view of Gross (US 5,799,663, iss. Sept. 1, 1998).
2. Claims 5, 6, and 8–10 are rejected under 35 U.S.C. § 103 as unpatentable over Mascarelli in view of Gross and Smith (US 6,041,790, iss. Mar. 28, 2000).
3. Claim 12 is rejected under 35 U.S.C. § 103 as unpatentable over Mascarelli in view of Gross, and Folkman (US 2,445,476, iss. July 20, 1948).
4. Claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable over Mascarelli in view of Gross, Tucker (US 2013/0192620 A1, pub. Aug. 1, 2013), and Park (US 2009/0139533 A1, pub. June 4, 2009).
5. Claim 15 is rejected under 35 U.S.C. § 103 as being unpatentable over Mascarelli in view of Gross, and Klein (US 2003/0146116 A1, pub. Aug. 7, 2003).

Appellant’s arguments focus on the subject matter of independent claim 1 only (Br. 4–12). Appellant’s only arguments regarding rejections (2) to (5) are that the additional applied references fail to cure the alleged deficiencies of the combination of Mascarelli and Gross (*id.* at 12–14). Therefore, claims 2 to 24 will stand or fall with our analysis of the rejection of claim 1 under rejection (1).

FINDINGS OF FACT & ANALYSIS

The Examiner's findings and conclusions with respect to claim 1 are located on pages 3 to 4 of the Final Action. The Examiner finds that Mascarelli teaches a system for administering a therapeutic composition that includes an edible lollipop portion 12 incorporating a source of nicotine positioned at a downstream end of a handle 14 (i.e., a substrate) (Final Act. 3). The Examiner finds that Mascarelli teaches that the handle portion is constructed to have the dimensions of a conventional cigarette, but Mascarelli does not disclose that the upstream end allows the passage of drawn atmospheric air into the substrate (*id.* at 4). The Examiner finds that Gross teaches a nicotine oral delivery device designed to simulate a conventional cigarette wherein the substrate 12 is a hollow tube having a plug of permeable material disposed in the tube (*id.*). The Examiner finds that Gross teaches placing nicotine containing material 16 at the downstream end of the device (e.g., the mouthpiece) (*id.*). The Examiner concludes that it would have been obvious to configure the substrate of Mascarelli as taught by Gross in order to simulate accurately the feel of a cigarette so as to further satisfy the user's need to manipulate a cigarette-like object (*id.*).

Appellant argues that there is no reason to combine Gross' tubular substrate with Mascarelli's lollipop because Mascarelli's hard lollipop portion covers the entire end of handle 14 and is closed (Br. 5). Appellant contends that although Mascarelli and Gross provide ways to provide nicotine to a user without smoking, each reference achieves this goal in different ways (*id.* at 7-8). Appellant contends that Mascarelli's and Gross' systems are different such that certain features that are relevant to one design are not relevant to the other (*id.* at 8). Appellant argues that Mascarelli's

lollipop structure requires a closed end to achieve the desired sucking by the user (Br. 8). Appellant argues that replacing Mascarelli's handle with a tubular substrate would require completely altering the physical structure of the hard lozenge part so as to provide the ability to draw air through the entire unit thereby frustrating Mascarelli's purpose as a lollipop (*id.* at 9). Appellant contends that one of ordinary skill in the art would have understood that Mascarelli's disclosed lollipops, in the traditional sense, allow for complete suction between the lozenge portion and the user's oral cavity (*id.* at 11). Appellant contends that the Examiner engaged in impermissible hindsight in concluding that one of ordinary skill in the art would have combined the teachings of Mascarelli and Gross (*id.* at 12).

The Examiner correctly finds that Appellant's arguments regarding Mascarelli's lollipop requiring complete suction are based on mere conjecture (Ans. 10). Appellant does not direct us to any portion of Mascarelli which discloses that the lozenge portion must be solid for the lollipop to function. The Examiner finds that a lollipop with a hole through it can still function as a lollipop (*id.*). Appellant does not dispute this finding (No Reply Brief filed). Appellant has not shown that modifying Mascarelli to include a tubular handle with a hole in the lozenge portion would frustrate Mascarelli's purpose (i.e., a cigarette substitute that fulfills the psychological and physical (nicotine) requirement of a smoker) (Mascarelli, col. 2, ll. 25–30).

The Examiner provides a reasoned analysis based upon the teachings of Gross as to why one of ordinary skill in the art would have used a tubular substrate in Mascarelli's cigarette substitute (Final Act. 3–4). Specifically, the Examiner finds that one of ordinary skill in the art would have

Appeal 2018-004224
Application 14/794,026

configured Mascarelli's cigarette substitute to use a tubular substrate to fulfill the psychological needs of the smoker by allowing the user to draw on the cigarette substitute and also providing the smoker's physical need for nicotine (Final Act. 4). The Examiner's reasoning is based upon the teachings of the references, not impermissible hindsight. Appellant's arguments do not convince us of reversible error in the Examiner's rejection.

On this record, we affirm the Examiner's § 103 rejections of record.

DECISION

The Examiner's decision is affirmed.

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

ORDER

AFFIRMED