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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL F. DAVIS, PERCY D. PHILLIPS,  
JAMES WILLIAM ROGERS, LISA E. BROWN, and  
JAMES DEMOPOLOUS

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Appeal 2019-005089  
Application 15/042,868  
Technology Center 1700

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Before MONTÉ T. SQUIRE, DEBRA L. DENNETT, and  
LILAN REN, *Administrative Patent Judges*.

REN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1–8, 10–13, 15–19, 21, and 22. *See* Final Act. 5, 6, 13, 14, 19, 20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as RAI Strategic Holdings, Inc. Appeal Br. 1.

### CLAIMED SUBJECT MATTER

“The present disclosure relates to aerosol delivery devices such as smoking articles that may utilize electrically generated heat for the production of aerosol (e.g., smoking articles commonly referred to as electronic cigarettes).” Spec. 1:4–6. Independent claims 1, 8, 17, and 19 reproduced below, are illustrative of the claimed subject matter:

1. An adapter for mating a container of aerosol precursor composition with an aerosol delivery device having a refillable reservoir, the adapter comprising:

a body having a container-side end and an opposing, device-side end that are sealably connectable with respectively the container and aerosol delivery device, and the body defining a passageway between the container-side and device-side ends for transfer of aerosol precursor composition from the container into the refillable reservoir,

wherein the container-side end is configured to engage a valve of the container during refilling of the reservoir, the container-side end defining separate and distinct filling and mating ports, the filling port being for transfer of aerosol precursor composition from the container into the refillable reservoir during engagement of the container-side end and valve, and the mating port defining an inner cavity sized to receive therein a matching portion of the valve for connection therewith.

8. An adapter for mating a container of aerosol precursor composition with an aerosol delivery device having a refillable reservoir, the adapter comprising:

a body having a container-side end and an opposing, device-side end that are sealably connectable with respectively the container and aerosol delivery device, and the body defining a passageway between the container-side and device-side ends for transfer of aerosol precursor composition from the container into the refillable reservoir,

wherein the device-side end includes a valve configured to engage the aerosol delivery device during refilling of the reservoir, the aerosol delivery device defining separate and

distinct filling and airflow ports, the filling port being for transfer aerosol precursor composition from the container into the refillable reservoir during engagement of the valve and the aerosol delivery device in which the airflow port is closed by the valve to prevent the aerosol precursor composition from passing through the airflow port, the airflow port being for a flow of air through a portion of the aerosol delivery device when the valve and aerosol delivery device are disengaged,

wherein the valve includes a depressible valve body including a first valve member and a second valve member, the first valve member being for opening a passageway to aerosol precursor composition within the container, and the second valve member being for closing the airflow port, when the valve body is depressed, and

wherein the airflow port defines an inner cavity, and the second valve member includes a matching portion, the inner cavity being sized to receive therein the matching portion of the second valve member.

17. A method of mating a container of aerosol precursor composition with an aerosol delivery device having a refillable reservoir for refilling the aerosol delivery device, the method comprising:

sealably connecting an adapter with the container and aerosol delivery device, the adapter comprising a body having a container-side end and an opposing, device-side end that are sealably connectable with respectively the container and aerosol delivery device, and the body defining a passageway between the container-side and device-side ends for transfer of aerosol precursor composition from the container into the refillable reservoir; and

transferring aerosol precursor composition from the container through the passageway and into the reservoir to thereby refill the reservoir,

wherein the container-side end is configured to engage a valve of the container during refilling of the reservoir, the container-side end defining separate and distinct mating and filling ports, the mating port defining an inner cavity sized to receive therein a matching portion of the valve for connection

therewith, the filling port being for transfer of aerosol precursor composition from the container into the refillable reservoir during engagement of the container-side end and valve.

19. A method of mating a container of aerosol precursor composition with an aerosol delivery device having a refillable reservoir for refilling the aerosol delivery device, the method comprising:

sealably connecting an adapter with the container and aerosol delivery device, the adapter comprising a body having a container-side end and an opposing, device-side end that are sealably connectable with respectively the container and aerosol delivery device, and the body defining a passageway between the container-side and device-side ends for transfer of aerosol precursor composition from the container into the refillable reservoir; and

transferring aerosol precursor composition from the container through the passageway and into the reservoir to thereby refill the reservoir,

wherein the device-side end includes a valve configured to engage the aerosol delivery device during refilling of the reservoir, the aerosol delivery device defining separate and distinct airflow and filling ports, the airflow port being for a flow of air through a portion of the aerosol delivery device when the valve and aerosol delivery device are disengaged, the filling port being for transfer aerosol precursor composition from the container into the refillable reservoir during engagement of the valve and the aerosol delivery device in which the airflow port is closed by the valve to prevent the aerosol precursor composition from passing through the airflow port,

wherein the valve includes a depressible valve body including a first valve member and a second valve member, the first valve member being for opening a passageway to aerosol precursor composition within the container, and the second valve member being for closing the airflow port, when the valve body is depressed, and

wherein the airflow port defines an inner cavity, and the second valve member includes a matching portion, the inner

cavity being sized to receive therein the matching portion of the second valve member.

Claims Appendix (Appeal Br. 25, 26–27, 28–30).

#### REFERENCES

The prior art references relied upon by the Examiner are:

<b>Name</b>	<b>Reference</b>	<b>Date</b>
Kribs	US 2014/0283946 A1	Sept. 25, 2014
Levitz	US 2016/0120227 A1	May 5, 2016
Scott	WO 2016/128717 A1	Aug. 18, 2016

#### REJECTIONS

The Examiner rejects claims 21 and 22 under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph. Final Act. 5.

Claims 1–5, 7, 8, and 10–12 are rejected under 35 U.S.C. § 102(a)(2) as being anticipated by Scott. Final Act. 6.

Claims 1 and 6 are rejected under 35 U.S.C. § 102(a)(2) as being anticipated by Kribs. Final Act. 13.

Claims 8, 12, 13, and 16–19 are rejected under 35 U.S.C. § 102(a)(2) as being anticipated by Levitz. Final Act. 14.

Claim 15, 21, and 22 are rejected under 35 U.S.C. § 103 as being unpatentable over Levitz. Final Act. 19, 20.

Claim 21 is rejected under 35 U.S.C. § 103 as being unpatentable over Scott. Final Act. 19.

OPINION

*Written Description*

Appellant does not address the Examiner's rejection of claims 21 and 22 for failing to meet the written description requirement. *Compare* Appeal Br. 5 (listing "Grounds of Rejection to be reviewed on Appeal" which does not include the written description rejection), *with* Final Act. 5. The written description is summarily affirmed.

*Claim 1 (Scott)*<sup>2</sup>

Appellant argues that Scott does not disclose "a body having a container-side end and an opposing, device-side end," as recited in claim 1. Appeal Br. 8. According to Appellant, cylinder 229 "is not an end much less a container-end of the female component 204 (body), nor is there any other end (device-side end) of the female component 204 that is opposite the cylinder 229." *Id* at 7. (emphasis removed).

Appellant, however, acknowledges that "Scott's cylinder is a body that includes opposing ends that engage respectively the male component 202 and electronic cigarette 276." Appeal Br. 7–8; Reply Br. 2 (stating the same). As Scott undisputedly discloses: "The male component 202 of the valve assembly is disposed in the neck of a liquid dispenser bottle 274. The female component 204 of the valve assembly is disposed in the reservoir of a smoking-substitute device, e.g. e-cigarette, 276." Scott 17:16–19. To the extent that Appellant's argument implies that the recited "container-side

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<sup>2</sup> Appellant argues for the patentability of claims 1–5 and 7 over Scott as a group with claim 1 being the representative claim. *See* Appeal Br. 6–9. These claims stand or fall together with regard to the anticipation rejection over Scott. *See* 37 C.F.R. § 41.37(c)(1)(iv).

end” excludes a prior art structure having “a terminating surface which is proximal to the container of aerosol precursor solution” — which is an undisputed finding by the Examiner (Ans. 15) — Appellant has not sufficiently explained why.

Moreover, the Examiner points out that the recited “‘container-side end’ does not require the discussed structure of being outside of the electronic cigarette or smoking device and does not require where the claimed adapted cannot or does not fit within the smoking device.” Ans. 15. Appellant does not argue otherwise. *See* Reply Br. 2–3. No error has been identified in this aspect of the rejection.

Appellant next argues that the Examiner reversibly erred in finding that Scott slot 220a discloses “an inner cavity sized to receive therein a matching portion of the valve for connection therewith” as recited. Appeal Br. 9. Appellant acknowledges that Scott discloses tongue 208a which “defines the side of a cavity into which the tab 208a is sized to fit when the adapter is engaged” as the Examiner finds. Ans. 15; *compare* Final Act. 26 (stating the same), *with* Appeal Br. 9 (“Appellant acknowledges that the Examiner also relies on protrusion 208a (described as tongue 208a) for the valve . . .”). Appellant also acknowledges that “the tongue 208a is actually a component of a valve assembly 200.” Appeal Br. 9.

Appellant, however, argues that “tongue is not a valve.” Appeal Br. 9. This argument is not persuasive because it is incommensurate in scope with the claim language which requires only that “an inner cavity sized to receive therein a matching portion of the valve . . .” Appellant also argues that “‘the side of a cavity’” is not itself a cavity” (*id.*) which is incommensurate



in scope with the claim language and therefore unpersuasive. The rejection is sustained as no reversible error has been identified.

*Claim 8 (Scott)*<sup>3</sup>

In rejecting claim 8, the Examiner finds that the prior art structure is identical to the recited adapter structure where as “the interaction of the adapter with the container of aerosol precursor composition and the aerosol delivery device having a refillable reservoir is considered to be intended use of the adapter.” Final Act. 3, 9 (“Thus the interaction between the adapter and the aerosol delivery device is considered to be intended use and not structurally limiting on the adapter itself.”).

Appellant does not address this aspect of the rejection but only argues that the Examiner’s findings are “not consistent with Scott.” *See* Appeal Br. 11. We are not persuaded as Appellant’s argument does not structurally distinguish the prior art and does not identify error in the Examiner’s findings. *See Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) (“[A]pparatus claims cover what a device *is*, not what a device *does*.”). Appellant’s remaining arguments including that “the partially inwardly extending portion 264 is not a port much less a filling port” do not support the argument with evidence or specificity. *Id.* at 11 (emphasis removed). The rejection is accordingly sustained.

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<sup>3</sup> Appellant argues for the patentability of claims 8 and 10–12 over Scott as a group with claim 8 being the representative claim. *See* Appeal Br. 9–11. These claims stand or fall together with regard to the anticipation rejection over Scott. *See* 37 C.F.R. § 41.37(c)(1)(iv).

*Claim 21 (Scott)*

Claim 21 depends from claim 8 and additionally recites “wherein the valve body is a unitary valve body that defines the first valve member and the second valve member.”

Appellant argues that the Examiner reversibly erred in finding that strut 257 and collar 238 in Scott are the first and second valve members recited in claim 21. Appeal Br. 12. Appellant’s conclusory statement that “the stopper 241 clearly does not define the strut 257 or the collar 238” (*id.*) is unelaborated and does not identify error in the Examiner’s findings. Appellant’s other arguments including that the modification of the prior art structure would render the prior art unsatisfactory for its intended purpose (*id.*) are likewise unelaborated and unsupported with evidence.

With regard to Appellant’s argument that the recited “unitary valve body” means “a single body,” (*id.*) even under Appellant’s interpretation, the Examiner’s finding is unchallenged that “it has generally been recognized that making the parts integral or separable when the operation of the device is not otherwise changed is within the level of ordinary skill in the art.” *Compare id., with* Final Act. 20; *see also In re Mullin*, 481 F.2d 1333, 1335–36 (CCPA 1973) (holding that an intermediate structure in prior art may nonetheless anticipate). The rejection of claim 21 over Scott is sustained as a result.

*Claim 1 (Kribs)*<sup>4</sup>

Appellant argues that the Examiner erred in rejecting claim 1 over Kribs because “the Examiner concedes that ‘Kribs . . . is silent to the nozzle

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<sup>4</sup> Appellant argues for the patentability of claims 1 and 6 over Kribs as a group with claim 1 being the representative claim. *See* Appeal Br. 14–15.

further comprising a valve.” Appeal Br. 14 (citing Final Act. 25). Appellant’s argument, however, is not based on the Examiner’s findings with regard to claim 1 over Kribs but instead based on the Examiner’s statement with regard to the rejection of a different claim in a previous office action. *See* Final Act. 13 (analyzing the anticipation rejection of claim 1 over Kribs); Final Act. 21–27. As the Examiner points out correctly, “Appellant is conflating two different claimed embodiments in this argument that is not commensurate in scope with the *two different* claimed embodiments reflected in claims 1 and 8.” Ans. 18.

Appellant’s remaining arguments are conclusory and do not identify reversible error in the Examiner’s findings. *See* Appeal Br. 14–15. For example, Appellant argues that second portion 126 of Kribs does not define the bore 132 (filling port) without explaining why the Examiner erred. *Id.* at 15. The rejection of claim 1 over Kribs is sustained as a result.

*Claim 8 (Levitz)*<sup>5</sup>

In rejecting claim 8, the Examiner finds, among others, that Levitz discloses a ball valve 26, spring loaded ball 30, and teeth 84 meeting the recited valve, depressible valve body and first valve, respectively. Final Act. 15.

Appellant argues that the Examiner erred because spring loaded ball 30 and teeth 84 “are completely separate components, with the teeth 84 in

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These claims stand or fall together with regard to the anticipation rejection over Kribs. *See* 37 C.F.R. § 41.37(c)(1)(iv).

<sup>5</sup> Appellant argues for the patentability of claims 8, 12, 13, 15, 16, and 21 over Levitz as a group with claim 8 being the representative claim. *See* Appeal Br. 15–16. These claims stand or fall together with regard to the anticipation rejection over Levitz. *See* 37 C.F.R. § 41.37(c)(1)(iv).

fact not having any connection to the spring-loaded ball 30.” Appeal Br. 16. Appellant’s argument is not persuasive because it is not supported by evidence. Moreover, Appellant’s argument is not persuasive because it is incommensurate in scope with the claim language which does not require the recited components to be connected.

With regard to the limitation that “the inner cavity being sized to receive therein the matching portion of the second valve member,” Appellant acknowledges that Levitz discloses a second valve member (spring loaded ball 30) “pressed into contact with” an airflow port (chimney 50). Appeal Br. 16.

The Examiner finds that “[t]he pressing of the ball into the chimney can be considered to be a matching portion that is receiving by the cavity of the chimney” because “at least a portion of the ball valve fits into the cavity of the chimney in order to facilitate the taught closing the of the valve.” Ans. 18. The Examiner reasons that “[i]f the portion did not match, i.e. fill the cavity space, then the device would not function as taught where the valve blocks the air passage while the precursor solution flows into the reservoir.” *Id.* Appellant argues that “the Examiner fails to establish that Levitz explicitly or inherently discloses that at least a portion of the ball valve fits into the cavity of the chimney” (Reply Br. 10) without addressing the Examiner’s findings. Because Appellant fails to identify reversible error in the rejection, the rejection of claim 8 over Levitz is sustained.

*Claim 21 (Levitz)*<sup>6</sup>

Appellant argues that the Examiner reversibly erred in finding that spring loaded ball 30 of Levitz is a valve body which “defines the first valve member and the second valve member” as recited in claim 21. Appeal Br. 17. Appellant’s conclusory statement that spring loaded ball 30 “does not define the teeth 84” (*id.*) is unelaborated and does not identify error in the Examiner’s findings. Appellant’s other arguments including that the modification of the prior art structure would render the prior art unsatisfactory for its intended purpose (*id.*) are likewise unelaborated and unsupported with evidence.

With regard to Appellant’s argument that the recited “unitary valve body” means “a single body,” (*id.*) even under Appellant’s interpretation, the Examiner’s finding is unchallenged that “it has generally been recognized that making the parts integral or separable when the operation of the device is not otherwise changed is within the level of ordinary skill in the art.” *Compare id., with* Final Act. 20. The rejection of claim 21 over Levitz is sustained as a result.

*Claims 17 & 18 (Levitz)*<sup>7</sup>

Appellant argues that the Examiner reversibly erred in finding that Levitz discloses a “container-side end [that] is configured to engage a valve

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<sup>6</sup> Appellant argues for the patentability of claims 15 and 21 over Levitz as a group with claim 21 being the representative claim. *See* Appeal Br. 16–18. These claims stand or fall together with regard to the anticipation rejection over Levitz. *See* 37 C.F.R. § 41.37(c)(1)(iv).

<sup>7</sup> Appellant argues for the patentability of claims 17 and 18 over Levitz as a group with claim 17 being the representative claim. *See* Appeal Br. 18–21. These claims stand or fall together with regard to the anticipation rejection over Levitz. *See* 37 C.F.R. § 41.37(c)(1)(iv).

of the container” as recited in claim 17. Appeal Br. 20. Appellant argues that that “Levitz at best discloses that the device-side end (and not container-side end) is configured to engage the valve of the container.” *Id.* Appellant cites as support Levitz’s disclosure that “[t]he flexible ball valve assembly 211 is positioned within the neck 207 of the refill interface 200 . . . .” *Id.* (citing Levitz ¶ 20).

We are not persuaded because the cited portion of Levitz does not support Appellant’s argument. The disclosure that Levitz valve assembly 211 “is positioned within the neck 207” does not preclude base portion 241 to be configured to engage valve assembly 211 as the Examiner finds. *See* Final Act. 16.

Appellant also argues that the Examiner erred in finding Levitz sidewall 243 is the recited mating port because “the base portion 241 and sidewall 243 are completely separate and distinct elements[.]” Appeal Br. 20. We are not persuaded by this argument because the argument is incommensurate in scope with the claim language which requires only that “the container-side end defining separate and distinct mating and filling ports.” We further note that the Examiner’s finding is supported by the record as Appellant acknowledges that “the base portion surround[s] the sidewall.” *Id.* (citing Levitz ¶ 119).

Appellant argues that no portion of valve assembly 211 “is received within any cavity defined by the flange 247.” *Id.* Appellant, however, does not elaborate on why the Examiner reversibly erred in finding that components 211/213/215 which are shown to be connected with flange 247 discloses the recited “inner cavity sized to receive therein a matching portion

of the valve for connection therewith.” *Compare id.*, with Final Act. 16; *see also* Ans. 19–20.

Appellant lastly argues that the Examiner erred in the findings of the filling port. Appeal Br. 20–21. Appellant, however, does not identify error in the Examiner’s finding that a “passageway could have the filling port at the beginning of the passageway, as taught by Levitz.” *Compare* Reply Br. 13, with Ans. 20. Absent identification of reversible error in the Examiner’s findings, the rejection is sustained.

*Claim 19 (Levitz)*

Appellant argues that the Examiner reversibly erred in finding that crown 32 of Levitz is a valve. Appeal Br. 23. Appellant, however, does not structurally distinguish the prior art from the component recited in the claim. “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co.*, 909 F.2d at 1468. Appellant’s argument is also unelaborated without sufficient explanation as to why the Examiner erred in finding that crown 32 of Levitz discloses the recited component. We therefore decline to disturb the Examiner’s fact finding here.

As to Appellant’s argument that spring loaded ball 30 and teeth 84 (which the Examiner finds to disclose the recited valve body and first valve member, respectively) are unconnected, the argument is incommensurate in scope with the claim language. More specifically, the claim language that a “valve includes a depressible valve body including a first valve member and a second valve member” does not require a particular physical configuration of the valve body and the first valve member. The rejection of claim 19 is sustained.

*Claim 22 (Levitz)*

Claim 22 depends from claim 19 and additionally recites: “wherein the valve body is a unitary valve body that defines the first valve member and the second valve member, the first valve member defined by the unitary body opening the passageway, and the second valve member defined by the unitary body closing the airflow port, when the adapter is sealably connected with the container and aerosol delivery device and the valve body is thereby depressed.”

In arguing that the Examiner reversibly erred here, Appellant argues that crown 32 of Levitz “does not define the ball 30.” Appeal Br. 24. The argument is unelaborated and does not identify error in the Examiner’s findings. Appellant’s other arguments including that the modification of the prior art structure would render the prior art unsatisfactory for its intended purpose (*id.*) are likewise unelaborated and unsupported with evidence.

With regard to Appellant’s argument that the recited “unitary valve body” means “a single body,” (*id.*) even under Appellant’s interpretation, the Examiner’s finding is unchallenged that “it has generally been recognized that making the parts integral or separable when the operation of the device is not otherwise changed is within the level of ordinary skill in the art.” *Compare* Appeal Br. 24, *with* Final Act. 20. The rejection of claim 22 over Levitz is sustained as a result.

## CONCLUSION

The Examiner’s rejections are affirmed.

In summary:



DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
21, 22	112(a) or 112, first paragraph	Written description	21, 22	
1-5, 7, 8, 10-12	102(a)(2)	Scott	1-5, 7-8, 10-12	
1, 6	102(a)(2)	Kribs	1, 6	
8, 12-13, 16-19	102(a)(2)	Levitz	8, 12-13, 16-19	
15, 21, 22	103(a)	Levitz	15, 21, 22	
21	103(a)	Scott	21	
<b>Overall Outcome:</b>			1-8, 10-13, 15-19, 21, 22	

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)(1)(iv).

AFFIRMED