



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/783,510	10/09/2015	DOMINICK DANIEL MARTINO	5854-16 U.S.	1895
34678	7590	09/11/2020	EXAMINER	
Norman E. Lehrer Norman E. Lehrer, P.C. 52 Berlin Road Suite 1000 Cherry Hill, NJ 08034			SHAH, JAY B	
			ART UNIT	PAPER NUMBER
			3791	
			MAIL DATE	DELIVERY MODE
			09/11/2020	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOMINICK DANIEL MARTINO

Appeal 2020-001003
Application 14/783,510
Technology Center 3700

Before ANTON W. FETTING, ULRIKE W. JENKS, and
AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), the Appellant¹ appeals from the Examiner's final decision to reject claims 1, 4–6, 8, and 10–12, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as Sensonics, Inc. Appeal Br. 1.

CLAIMED SUBJECT MATTER

The Appellant's invention "is directed toward devices for use in administering olfactory or smell tests. The devices are hand held and operated and can be used in threshold tests, discrimination tests and identification tests." Spec. 1, ll. 7-9.

Claim 1 is the only independent claim, is representative of the subject matter on appeal, and is reproduced below:

1. A hand held olfactory tester comprising:

an elongated housing having a forward portion and a rear portion, the forward portion including an opening adjacent the forward most end thereof;

a single odorant chamber located within said forward portion and containing an odorant therein, said single odorant chamber having a nozzle at the forward end thereof and being moveable axially between a forward position and a backward position within said housing;

a wick having a rear end located within said odorant chamber and a forward end extending forwardly thereof into said nozzle;

means for moving said odorant chamber along with said wick between said forward and backward positions, said moving means including a thumb engagable member located on the exterior of said housing intermediate the ends thereof and is engagable by a person holding said housing;

spring means for biasing said odorant chamber backwardly into its backward position;

said forward end of said wick being exposed to the outside of said housing through said nozzle and through said opening in said housing when said odorant chamber and said wick are moved into their forward position so that vapors from the odorant that had been wicked to the forward end of said wick can be smelled by a patient, and

means for sealing the forward end of said wick from the outside of said housing when said wick is in its backward position to prevent vapors from escaping from said housing, said sealing means including an O-ring located between the forward end of said nozzle and said forward most end of said housing.

Appeal Br. 9 (Claims App.).

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Pendergrass, Jr. (“Pendergrass”)	US 5,565,148	Oct. 15, 1996
Bartsch et al. (“Bartsch”)	US 2002/0066967 A1	June 6, 2002
Harris	US 2004/0068916 A1	Apr. 15, 2004
Djupesland	US 2004/0112378 A1	June 17, 2004
Manne	US 2008/0313789 A1	Dec. 25, 2008
Pardes et al. (“Pardes”)	US 2009/0152306 A1	June 18, 2009

REJECTIONS

Claims 1, 8, 11, and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over by Manne, Bartsch, Djupesland, and Pendergrass.

Claims 4–6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Manne, Bartsch, Djupesland, Pendergrass, and Harris.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Manne, Bartsch, Djupesland, Pendergrass, and Pardes.

OPINION

The Appellant contends that the Examiner’s rejection of independent claim 1 is in error because “[c]laim 1 requires that there be a single odorant chamber within the housing” whereas Manne “shows a plurality of scent

containers 64 located within the tube or housing 62.” Appeal Br. 4.

Conversely, the Examiner finds

Claim 1 does not require that there only be a single odorant chamber within the housing. Claim 1 recites “A hand held olfactory tester **comprising** ... a single odorant chamber”. Per MPEP 2111.03 I, “comprising” is a transitional phrase that is “inclusive or open-ended and does not exclude additional, unrecited elements or method steps”. The Office notes that by having a plurality of chambers, as taught by Manne, the limitation of the apparatus ‘comprising’ a single chamber is met. The claims do not recite that the tester **consists** of only a single chamber.

Ans. 3.

“During examination, ‘claims ... are to be given their broadest reasonable interpretation consistent with the specification, and ... claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Bond*, 910 F.2d 831, 833 (Fed.Cir.1990)). The term “comprising,” when used in the preamble of a claim, permits the inclusion of other elements or materials in addition to those specified in the claim. *See In re Baxter*, 656 F.2d 679, 686 (CCPA 1981); *see also* MPEP § 2111.03(I). Although it is “acknowledge[d] that the term ‘comprising’ raises a presumption that the list of elements is nonexclusive, . . . ‘[c]omprising’ is not a weasel word with which to abrogate claim limitations.” *Dippin' Dots, Inc. v. Mosey*, 476 F.3d 1337, 1343 (Fed.Cir.2007) (citations omitted). “The presumption raised by the term ‘comprising’ does not reach into each of the [elements] to render every word and phrase therein open-ended” (*id.*), and must be read in view of the Specification (*see In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir.

2010)). *See also* MPEP § 2111.03(I) (“The determination of what is or is not excluded by a transitional phrase must be made on a case-by-case basis in light of the facts of each case.”).

Here, we agree with the Appellant that the ordinary and customary meaning of the term “single” is “one and only one.” Reply Br. 2; *see also* Merriam-Webster Dictionary (“(1): consisting of or having only one part, feature, or portion . . . (2): consisting of one as opposed to or in contrast with many . . . (3): consisting of only one in number”) (<https://www.merriam-webster.com/dictionary/single>). The Specification is consistent with this meaning in (1) differentiating the Appellant’s tester capable of being administered using one hand and having a chamber and thumb engagable member from the prior art “Sniffin’ Sticks” having “a number of tubular odorant chambers” whereby two hands are needed to administer the test, (2) describing a housing with “an odorant chamber,” (3) consistently referring to “the odorant chamber,” (4) describing the cylinder as “having a chamber 22 therein,” and (5) depicting the device with only one chamber. Spec. 2–4, Figs. 2–7. Although the preamble of claim 1 provides for a “tester comprising” the listed elements, the term “comprising” as used in the preamble does not reach into the element of a single chamber to negate the meaning of single as understood by one in the art, and as indicated in the Specification, as consisting of one and only one.

The Examiner does not dispute that Manne discloses a tester with multiple chambers. *See* Final Act. 4 (“the plurality of containers shown also include a single container”); Ans. 3. And we do not see, nor does the Examiner direct attention to, any embodiment or teaching in Manne of a tester with only one chamber. Thus, we agree with the Appellant that the

Examiner's finding that Manne teaches a single odor chamber is unsupported. *See* Appeal Br. 4; Reply Br. 2. The Examiner relies solely on Manne for teaching the claimed limitation of a single chamber (Final Act. 4; Ans. 3) and fails to rely on the teachings of Bartsch, Djupesland, Pendergrass, Harris, or Pardes in any manner that would remedy this deficiency.

Therefore, we do not sustain the Examiner's rejections of independent claim 1 and dependent claims 4–6, 8, and 10–12 under 35 U.S.C. § 103.

CONCLUSION

The Examiner's decision to reject claims 1, 4–6, 8, and 10–12 under 35 U.S.C. § 103(a) is not sustained.

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 8, 11, 12	103	Manne, Bartsch, Djupesland, Pendergrass		1, 8, 11, 12
4–6	103	Manne, Bartsch, Djupesland, Pendergrass, Harris		4–6
10	103	Manne, Bartsch, Djupesland, Pendergrass, Pardes		10
Overall Outcome				1, 4–6, 8, 10–12

REVERSED