

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ALLAN DAGSLAND and RISTO VIRTANEN

Appeal No. 2005-1580
Application No. 09/068,374

ON BRIEF

Before PATE, McQUADE, and CRAWFORD, Administrative Patent Judges.
PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-14. These are all the claims in the application.¹

The claimed invention is directed to an inhalation device with an improved dosage indicating means. Markings representing dosage information are placed on the side of an indicating wheel which provides a visual indication to the user of the dosage information.

¹ It is noted that claim 12, which appears to be subject to appeal with the rest of the claims in the application, is not mentioned by the examiner in any of the rejections. We further note, that although the cover letter of the Final Rejection states that claims 1-14 are rejected, claim 12 is not mentioned in the body of the Final Rejection either. We assume that this is an oversight on the examiner's part, and the examiner intended claim 12 to be included in the obviousness rejections on appeal. Therefore, we will consider claim 12 to stand or fall with claim 1 from which it depends as we further consider this appeal. Note that appellant considers claim 12 as rejected on page 1 of the brief.

The claimed invention may be further understood by reference to the appealed claim 1 appended to Appellants' Brief.

The references relied upon by the examiner as evidence of obviousness are:

Virtanen	4,668,218	May 26, 1987
Hendricks	5,699,789	Dec. 23, 1997
Klein	5,482,030	Jan. 9, 1996

THE REJECTIONS

Claim 13 stands rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Claims 1, 2, 4-14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Virtanen.

Claims 1, 2, 4-14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Virtanen in view of Klein.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Virtanen in view of Klein and further in view of Hendricks.

For details with respect to these rejections and the arguments with respect thereto, reference is made to the Examiner's Answer and Appellants' Brief.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellants and the examiner. As a result of this review, we have determined that the examiner has not established a case of prima facie obviousness of the claims rejected

under Section 103. On the other hand, appellants have not addressed the 112, second paragraph, rejection of claim 13. We summarily affirm this rejection.

Turning first to the obviousness rejection which uses as its evidence the Virtanen reference alone, it is our view that the examiner has not established the prima facie obviousness of the claims on appeal. We disagree with the examiner's factual finding on page 4 of the Answer that the Virtanen reference has a radial component which allows at least a portion of the indicating wheel to be viewed, if by indicating wheel the examiner is referring to the side of the wheel. We have carefully considered the Virtanen reference and can find no disclosure that the side of the wheel is visible.

Secondly, we disagree with the examiner's conclusion that the provision of the relocated window and indicia on the side of the indicia wheel are a matter of design choice. We agree with the appellant, that this is not a simple matter of design choice but provides the feature of more visibly indicating the usage of the inhaler.

Furthermore, we do not agree with the examiner's conclusion that the specific location of the indicia on the wheel "fall[s] within the teaching of Virtanen". We believe that the examiner's argument that a specific feature falls within the teaching of the reference means that the feature is encompassed within the disclosure of the reference. This is clearly not the case with the present claims on appeal.

The examiner further argues that the claimed feature is old and well-known in the art. If this were, in fact, the case, then it would appear incumbent on the part of the

examiner to provide a reference or some other evidence indicating that this is true. In short, the examiner has provided no evidence that the features from appellant's claim 1 are obvious from the disclosure of Virtanen.

Turning to the rejection of Virtanen and Klein, we acknowledge that Klein shows an indicia wheel with a numerical indicia on the side of the wheel. This wheel is viewable through a window on an inhalent doser. However, with respect to this rejection the examiner provides no cogent reasoning supportive of any suggestion or motivation to combine the teachings of the two prior art references. We agree with the arguments found in the Appeal Brief that the examiner has provided no evidence that the indicia provided on the side surface of the disk is interchangeable with the indicia provided on the periphery. Notwithstanding the examiner's argument, it is our view that the obviousness rejection based on the combined teachings of Virtanen and Klein is premised on impermissible hindsight reconstruction. As such, the rejection cannot be affirmed.

We have further considered the Hendricks' reference used by the examiner in the rejection of claim 3, but find therein no evidence ameliorating the deficiencies in the two prior rejections discussed above.

Accordingly, all rejections under 35 U.S.C. §103 in the above noted appeal are reversed.

SUMMARY

The rejection of claim 13 under 35 U.S.C. § 112 second paragraph is affirmed. The rejections of claims 1-14 under 35 U.S.C. § 103 are reversed.

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

AFFIRMED-IN-PART

WILLIAM F. PATE, III)
Administrative Patent Judge)
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JOHN P. McQUADE) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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