

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2007-0671
Application No. 10/836,174

ON BRIEF

Before ADAMS, MILLS, and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-16, which are all the claims pending in the application.

Claims 1, 2, and 5 are illustrative of the subject matter on appeal and are reproduced below:

1. A disposable medication dispenser comprising, in combination,
a canister for storing medication,
an electronic circuit for displaying the number of doses remaining in said canister, and
a housing for said electronic circuit permanently attached to said canister whereby said housing and said electronic circuit are discarded with said canister when the medication in said canister have been depleted.

2. A disposable medication dispenser as set forth in claim 1 wherein said disposable medication dispenser is an inhaler and wherein said housing permanently attached to said canister defines a mouthpiece through which said medication is dispensed, and wherein said electronic circuit includes a numerical display positioned on the exterior of said housing above said mouthpiece for direct viewing by a user of said dispenser when said mouthpiece is brought to the user's mouth.
5. A disposable medication dispenser as set forth in claim 1 wherein said electronic circuit includes one or more count presetting switches for presetting a count in said electronic circuit at the time said housing and said canister are combined during initial assembly.

The references relied upon by the examiner are:

Mishelevich et al. (Mishelevich)	5,363,842	Nov. 15, 1994
Wolf	5,809,997	Sep. 22, 1998

Merriam-Webster's Collegiate Dictionary (Dictionary), p. 865 (10th ed., Merriam-Webster, Inc. 1998)¹

GROUND OF REJECTION

Claims 1, 2, 6, 10, 11, and 13-16 stand rejected under 35 U.S.C. § 102(b) as anticipated by Wolf.

Claims 2-4, 7-9, and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Wolf and Mishelevich.

We reverse the rejection under 35 U.S.C. § 102(b). We vacate the rejection under 35 U.S.C. § 103 and remand the application to the examiner for further consideration.

¹ We were unable to locate this reference in the electronic file. Nevertheless, we were able to locate a copy of the reference outside of the record. Accordingly, we have attached a copy of the reference to this opinion.

DISCUSSION

Claim Construction:

To assist in our discussion of appellant's claimed invention we reproduce appellant's figure 3 below:

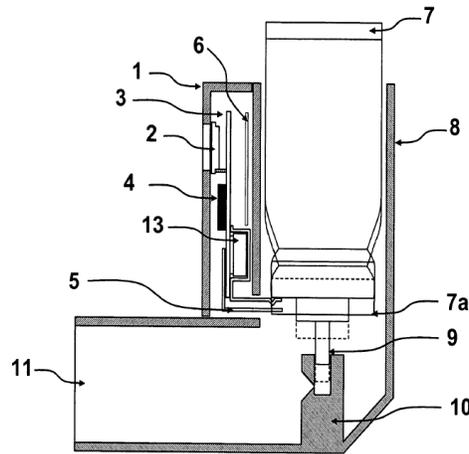


FIGURE: 3

Appellant's claim 1 is drawn to a disposable medication dispenser. The dispenser comprises the following three components in combination:

1. a canister **7** for storing medication,
2. an electronic circuit **2, 3, 4, 5, 6,** and **13**² for displaying the number of doses remaining in said canister, and
3. a housing **1** for the electronic circuit.

In addition, claim 1 requires that the housing for the electronic circuit is permanently attached to the canister. Claim 1 defines "permanent" to mean that when the medication in the canister is depleted the entire dispenser (including the housing, electronic circuit and canister) is discarded. Appellant's

² According of paragraph 32 of appellant's specification, "the electronic components include[d] an LCD screen [2], a populated printed circuit board (PCB) [3], a custom microprocessor [4], an activation switch [5], an audio buzzer [6], and a battery [13]."

specification provides further insight into how the components of the dispenser are permanently attached. Specifically, appellant discloses (specification, paragraph 31) that “[t]he canister [7] includes a nozzle [9³] which is received in and permanently held by an atomizing socket [10]. When the content of the canister [7] is depleted, the canister and the housing, along with the electronic counting circuitry . . . are discarded.”

According to the examiner (Answer, page 3), appellant has not limited the definition of the phrase “permanently attached.” Therefore, the examiner looked to the Dictionary for a definition of “permanent.” Id. According to the examiner (id.), the Dictionary defines “permanent” as “continuing or enduring without fundamental or marked change” From this the examiner concludes “when the canister is housed inside the housing it is permanently attached to the housing as per the broadest reasonable interpretation per dictionary definition.” We disagree with the examiner’s finding. Instead, we agree with appellant (Brief, page 4), the examiner’s interpretation of the term “permanent” is in conflict with the definition the examiner relies upon.

In our opinion, simply placing a canister in a housing does not necessarily provide for a permanent attachment of the canister to the housing. Instead, it simply means that the canister is in a housing. Therefore, we find the examiner’s construction of the phrase “permanently attached” insufficient as it says nothing

³ Appellant’s specification does not identify component “9”. As we understand the figures, element “9” refer to the nozzle. We will proceed with our deliberations with this understanding of the figures. We encourage both the examiner and appellant to work together to carefully review the specification and figures to insure that all numbered elements in the figures are accounted for in the specification.

with regard to whether the canister is removable or permanently attached to the housing. In contrast, according to appellant's claimed invention, the canister must be permanently attached to the housing. As discussed above, appellant's specification discloses how the canister may be permanently attached, e.g., the canister **7** includes a nozzle which is received in and permanently held by an atomizing socket **10**. Specification, paragraph 31. This attachment is such that when the canister is empty the entire dispenser is discarded. Stated differently, the canister cannot be removed to allow the housing to be reused with a different canister.

Claims 2-12 ultimately depend from and further limit the components of claim 1. Of claims 2-12, claims 5-12 require closer inspection. The examiner "asserts that [a]ppellant's [c]laims 5-12 are directed towards product-by-process claims rather than product claims itself [sic]" Answer, page 10, emphasis removed. According to the examiner (*id.*, emphasis removed),

[i]n [c]laim 5, [a]ppellant recites the "electronic circuit includes one or more count presetting switches for presetting a count in said electronic circuit at the time said housing and said canister are combined during initial assembly. Appellant's use of the recited claim language recites not only a structural element or product "the presetting switches" but also a process by which the device or product is to be assembled "combined during initial assembly." As such, [a]ppellant has essentially recited a process by which the product is to be assembled rather than an end product itself.

For his part, appellant argues that claims 5-12 contain limitations that are not product-by-process limitations and cannot be ignored." Brief, page 8-9. We agree. Claim 5 depends from and further limits the electronic circuit of claim 1. Specifically, claim 5 requires that the electronic circuit includes one or more

count presetting switches for presetting a count in the electronic circuit at the time the housing and canister are combined during initial assembly. Claim 6 depends from and further limits the switches of claim 5. Specifically, claim 6 requires that the one or more switches are positioned within the housing and are inaccessible to a user of the dispenser after the dispenser as been assembled. While claims 7-12 do not contain the term “assembly” or “assembled”, they depend directly or indirectly from claim 5.

The examiner appears to be of the opinion that because the phrase “during initial assembly” appears in claim 5 and the term “assembled” appears in claim 6 the claims must be drawn to a process of assembling the claimed dispenser. See Answer, page 10, wherein the examiner states “[a]ppellant’s use of the recited claim language recites not only a structural element or product ‘the presetting switches’ but also a process by which the device or product is to be assembled ‘combined during initial assembly.’” We disagree.

Claim 5 simply further limits the electronic circuit of claim 1 to include one or more count presetting switches for presetting a count in the electronic circuit at the time the housing and canister put together. Stated differently, the electronic circuit has at least one switch. The purpose of the switch is to preset a count in the electronic circuit when the housing and canister are put together. Why? So that the proper number of doses are reported on the display for the particular medicament in the canister. See, e.g., specification, paragraph 39,

[t]he manufacturer of the medication canister prints the amount of doses of medication on the canister [7] label. A special sequence of pressing the set switches [28], [29], [30] at the time of assembly

activates the LCD screen [2] to display the correct number of doses [15] in the medication canister [7]. The presetting switches [28], [29], [30] on the PCB board [3] permit the electric counting circuitry to be assembled with canisters of different capacity; thereby forming factory preset disposable dispenser of different capacities.

Neither claim 5, nor claim 6 require that any processing step be taken or that any particular component be produced in a particular manner (e.g., molded or die-casted). To the contrary, claims 5 and 6 and their dependent claims simply further define the structure of the dispenser and how the components are to be used. Accordingly, we agree with appellant that the limitations of claims 5-12 are not product-by-process limitations and they cannot be ignored. Brief, page 8-9.

Anticipation:

Claims 1, 2, 6, 10, 11, and 13-16 stand rejected under 35 U.S.C. § 102(b) as anticipated by Wolf. To assist in our discussion of Wolf we have reproduced Wolf's figures 13, 14 and 17a below:

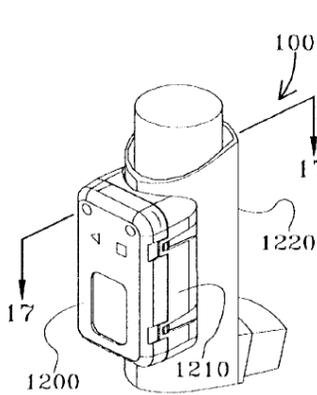


FIGURE 13

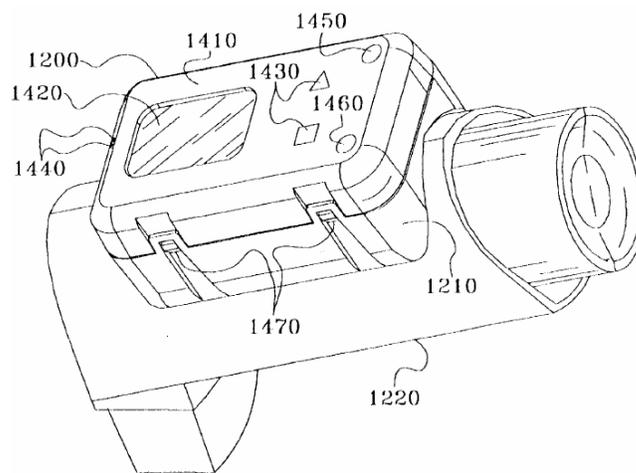


FIGURE 14

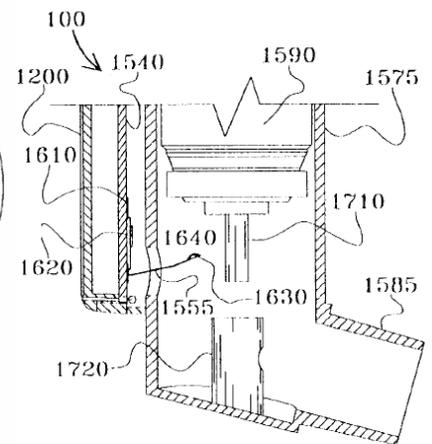


FIGURE 17a

According to the examiner (Answer, page 4),

Wolf teaches a disposable medication dispenser (**Figs. 12-17c**) comprising, in combination, a canister **1590** for storing medication, an electronic circuit **1200** for displaying the number of doses remaining in said canister, and a housing **1210** for said electronic circuit permanently attached to said canister whereby said housing and said electronic circuit are discarded with said canister when the medication in said canister have [sic] been depleted.

Contrary to the examiner's assertion, Wolf does not teach a device wherein the housing for the electronic circuit is permanently attached to the canister so that the housing, electronic circuit, and canister are discarded with the medicine in the canister is depleted. Instead, as appellant correctly points out (Brief, page 3), "Wolf teaches a dispenser that uses a replaceable canister rather than a canister permanently attached to the dispenser housing as claimed." Specifically, Wolf teaches an apparatus into which a

patient then inserts a prescribed drug in its manufacturer's actuator dispenser package (which has attached "piggyback" to it the apparatus of the present invention). . . . The patient may change out depleted drug dispenser packages as needed and replace with new ones. The apparatus of the present invention even records this event.

Wolf, column 3, lines 51-61. As Wolf explains (column 17, lines 8-12), "[t]he accessory chronology **1200** is attached to the adaptable housing **1210** via a snap latch system **1470**. There are two each snap latches **1470**. There are two each snap latches **1470** on both sides of the housing **1410** to securely hold the assembly between the devices **1200** and **1210**." In our opinion, the ability of Wolf's device to record when a patient changes out depleted drug dispenser packages (e.g., canisters) is hardly consistent with the requirement in appellant's

claimed invention that the housing and electronic circuit are discarded with the canister when the medication in the canister is depleted. To the contrary, it serves only to emphasize that Wolf's device is reusable and not permanently attached to the canister as opposed to the non-reusable (e.g. permanently attached and disposable) device set forth in appellant's claimed invention.

We disagree with the examiner's construction of appellant's claims to read on a device that is "capable of being discarded in its entirety once the contents of the canister have been depleted." Answer, page 9, emphasis added. This reading of appellant's claim infers that appellant's device is "capable of" being reused as in Wolf. This is, however, not what appellant has disclosed or claimed. The phrase "capable of" does not appear in appellant's claims. To the contrary, both appellant's specification and claims make very clear that the whole device is discarded when the medication in the canister is depleted. See, e.g., appellant's specification, paragraph 15, wherein appellant discloses that "[i]n accordance with the invention, the disposable canister housing and the canister and counting electronics which are contained in the housing, are simply discarded when the contents of the canister are depleted."

We recognize the examiner's assertion that appellant's specification does not disclose the type of "adhesive, sealing, locking or latching means that would inhibit or retain the canister 'permanently' inside the housing to the point at which the unit would become dysfunctional and/or the canister would be destroyed, if removed." Answer, page 10. However, in our opinion, this assertion has little, if any, bearing on the appellant's claimed invention. There is no requirement in

appellant's claimed invention that the canister is attached in such a manner that "the unit would become dysfunctional and/or the canister would be destroyed, if removed." Accordingly, we are not persuaded by the examiner's assertion.

"Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim." Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). For the foregoing reasons, it is our opinion that the examiner failed to demonstrate that every limitation of appellant's claimed invention is taught by Wolf. Accordingly, we reverse the rejection of claims 1, 2, 6, 10, 11, and 13-16 under 35 U.S.C. § 102(b) as anticipated by Wolf.

Obviousness:

Claims 2-4, 7-9, and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Wolf and Mischelevich.

According to the examiner (Answer, page 7),

Wolf teaches essentially all of the limitations including said disposable medication dispenser is an inhaler **1590** [and] wherein said housing permanently attached to said canister defines a mouthpiece **1585** through which said medication is dispensed, and wherein said electronic circuit includes a numerical display **1420** positioned on the exterior of said housing

According to the examiner (id.), Wolf differs from appellant's claimed invention in that the numerical display **1420** is not positioned above the "mouthpiece for direct viewing by a user of said dispenser when said mouthpiece is brought to the user's mouth." For the reasons set forth above under the heading "anticipation,"

we disagree with the examiner's findings with regard to Wolf. In short, Wolf does not teach a housing for the electronic circuit permanently attached to said canister.

The examiner relies on Mishelevich to teach "an inhaler with an electronic circuit wherein the display is position on the exterior about the mouthpiece so that the patient may receive feedback and view the effectiveness of the use of the device while the device is in use." (Id.) As presented to us for review, Mishelevich fails to make up for the deficiencies in Wolf as discussed above under the heading "anticipation."

The examiner makes no attempt to address the arrangement of the canister and the housing for the electronic circuit in Mishelevich's device, or how these structural features relate to appellant's or Wolf's device. Specifically, the examiner fails to address whether or not Mishelevich discloses a device wherein the housing for the electronic circuit is permanently attached to the canister, as required by appellant's claimed invention. For his part, appellant does not address the Mishelevich reference.

Accordingly, we vacate the rejection of claims 2-4, 7-9, and 12 under 35 U.S.C. § 103 as being unpatentable over the combination of Wolf and Mishelevich, and remand the application to the examiner for further consideration. Upon receipt of the application, we encourage the examiner to take a step back and reconsider appellant's claimed invention. In doing so, the examiner should pay particular attention to the foregoing discussion addressing the requirement in appellant's claimed invention that the housing for the

electronic circuit is permanently attached to the canister so that the whole device will be discarded when the medication in the canister is depleted. Then we encourage the examiner to consider Mishelevich, and any other available prior art⁴ alone or in combination teach or suggest a device having the requirements of appellant's claimed invention.

REVERSED-IN-PART, VACATED-IN-PART, and REMANDED-IN-PART

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Donald E. Adams)	
Administrative Patent Judge)	
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Demetra J. Mills)	APPEALS AND
Administrative Patent Judge)	
)	INTERFERENCES
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)	
Lora M. Green)	
Administrative Patent Judge)	

⁴ In this regard, we note that appellant's specification discloses that "[t]he electronic circuitry may be the same as the circuitry described in . . . Samiotes et al., Patent [No.] 5,505,192, permitting the PCB [3] and its components to be used in the dispenser shown in that patent or in the "disposable" dispenser contemplated by the present invention."

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