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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GAETAN PAINCHAUD, SYLVAIN LANZI, XAVIER JULIA, and GUILLAUME GREVIN

Appeal 2016-005380
Application 12/891,366
Technology Center 3700

Before EDWARD A. BROWN, ARTHUR M. PESLAK, and SEAN P. O'HANLON, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gaetan Painchaud et al. ("Appellants") appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–7 and 9–13.[1] An oral hearing pursuant to 37 C.F.R. § 41.47 was held on June 28, 2018. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] Rexam Healthcare La Verpilliere S.A.S. is identified as the real party in interest. Appeal Br. 3.

THE CLAIMED SUBJECT MATTER

Appellants' invention is directed to "dispensing predetermined metered quanities" of "ophthalmic liquid such as collyrium or eyewash in the form of drops." Spec. ¶ 2. Claim 1, reproduced below with italics added, is illustrative of the claimed subject matter.

> 1. A device for dispensing predetermined metered quantities of liquid, the device including an end-piece comprising a hat-shaped sealing member that can take up a liquid release position, allowing liquid to flow out of the device, and a non-return position preventing liquid from flowing back into the device, wherein:
>
> the end-piece further comprises an inner core and an outer top casing, the outer top casing having a top surface with an orifice for releasing liquid from the device;
>
> the sealing member, having a top portion with an outer sidewall, is fastened between the inner core and the outer top casing in a leak-tight manner to prevent any liquid from escaping into the outer casing, the outer top casing circumscribing and substantially covering the outer sidewall of the sealing member;
>
> *the top portion of the sealing member comprises a liquid-passing channel and a flared shape opening that flares from and surrounds said channel, said flared shape opening defining a metering element* for metering out the liquid to be dispensed, the metering element for forming drops of liquid; and
>
> the metering element is disposed in the immediate vicinity of the orifice in the top surface of the outer top casing for releasing the liquid from the device.

REJECTIONS

1) Claims 1–7 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ryder (US 5,154,325, issued Oct. 13, 1992) and Wilner (US 6,076,709, issued June 20, 2000).
2) Claims 9–13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dark (US 2003/0094467 A1, published May 22, 2003) and Wilner.

DISCUSSION

Rejection 1

The Examiner finds that Ryder discloses most of the limitations of claim 1 except for "dispensing predetermined metered quantities of liquid or that the sealing member is provided with a metering element for forming drops of the liquid for metering out the liquid to be dispensed." Non-Final Act. 3. The Examiner finds that "Wilner discloses a member 20 (see Fig. 2) able to dispense predetermined metered quantities of liquid (col. 2, lines 58-59) in the form of drops with a liquid dispensing channel opening (50) and a metering element with a flared shape (54) that flares from and surrounds the channel." *Id.* at 3–4. The Examiner concludes that it would have been obvious to one of ordinary skill in the art "to modify the sealing member (224b) [of Ryder] with the drop dispensing flared structure, as taught by Wilner, and nozzle (232) of Ryder to accommodate any design change to the sealing member[] to accurately dispense and control drop formation." *Id.* at 4.

Appellants contend that "it would not have been obvious to have formed a metering element in the sealing member (i.e., element 224b) of Ryder" because "Wilner discloses forming the metering element in the tip of

the nozzle thereof." Appeal Br. 13. In support of this contention, Appellants argue that in the proposed combination, "the metering element would not function properly given the structure and operation of Ryder, particularly with the disclosed configuration of the nozzle (232) with the opening (234) therein." *Id.* Appellants argue that Ryder's "opening (229) opens and closes thanks to the deformation of the sealing member 224(b) . . . . However, the metering element (34) of Wilner is rigid and cannot be deformed; thus, it cannot perform any movement during the delivery of the liquid." *Id.* at 13–14. Appellants continue that if one of ordinary skill in the art were to modify Ryder with Wilner, the rigid nature of Wilner's metering element would lead one of ordinary skill in the art to modify Ryder's outer casing 232, not sealing member 224b. *Id.* at 14.

The Examiner does not directly address Appellants' argument that one of ordinary skill in the art would be led by Wilner to modify Ryder's outer casing 232 rather than sealing member 224b. Ans. 2–3. Rather, the Examiner responds that "[m]odifying the end of Ryder's sealing element as taught by Wilner would retain the functionality of Ryder's invention while adding the benefit of dispensing accuracy as taught by Wilner." *Id.* at 2. We do not sustain the rejection of claim 1 for the following reasons.

The Examiner correctly finds that Wilner discloses a flare shaped metering element 54, which is located in dropper conduit 50. *See* Wilner, 2:52–58, Figs. 1, 2. The Examiner does not, however, direct us to any disclosure in Wilner that such a flare shaped metering element is located in a sealing member. Ryder discloses a discharge aperture 234 in outer casing 232 for the passage of liquid. Ryder, 6:36–40. In light of the placement of Wilner's metering element in the dropper conduit, the Examiner does not

adequately explain why it would have been obvious to modify Ryder's sealing member 224b with Wilner's metering element as opposed to modifying the corresponding element in Ryder's device, namely discharge aperture 234 of outer top casing 232. *See* Ryder Fig. 8. Consequently, we do not sustain the rejection of claim 1 because it is not supported by a rational underpinning. Claims 2–7 depend from claim 1. Appeal Br. 21–22 (Claims App'x). We do not sustain the rejection of claims 2–7 for the same reasons.

Rejection 2

The Examiner finds that Dark discloses most of the limitations of independent claim 9 except for "a metering element comprising a cone shaped portion that flares from and surrounds the liquid-passing channel of the sealing member." Non-Final Act. 5. The Examiner finds that "Wilner discloses a member (20) (see Fig. 2) able to dispense predetermined metered quantities of liquid (col. 2, lines 58-59) in the form of drops with a liquid dispensing channel opening (50) and a metering element with a cone-flared shape (54) that flares from and surrounds the channel." *Id.* The Examiner concludes that it would have been obvious "to modify top portion (68) of the sealing member (60) of Dark . . . with the drop dispensing structure as taught by Wilner to accurately dispense and control drop formation." *Id.* at 5–6 (citing Wilner 1:40–42).

Appellants contend that the Examiner's modification of Dark with Wilner "is nothing more than an unsupported conclusion that ignores the structure and operation of both Dark and Wilner." Appeal Br. 17–18. According to Appellants, "Wilner discloses forming the metering element in

the tip of the nozzle thereof, so it is not at all clear why the Examiner would assert that it would have been obvious to have formed the metering member in the sealing member instead." *Id.* at 18. The Examiner does not directly address Appellants' arguments but maintains that "[i]t would have been well within the ambit of one skilled in the art [to] borrow the teachings of Wilner to modify Dark to arrive at the claimed invention while reaping the benefits taught by the prior art." Ans. 3. For the following reasons, we do not sustain the rejection of claim 9.

Dark's element 60 surrounds "the upwardly extending portion **48** of the upwardly extending plug **44**." Dark ¶ 82, Fig. 25. Element 60 comprises a "dispensing orifice perimeter **68**." *Id.* Dispensing orifice 68 fits around upwardly extending plug 44 to "form a locking seal." *Id.* ¶ 84. "The locking seal functions to maintain the fluid dispensing valve **10** closed against outside forces until the pressure against the dispensing valve body **60** is great enough, and sustained long enough, to overcome the friction and drag the dispensing orifice perimeter **68** off of the upwardly extending plug **44**." *Id.* The Examiner does not adequately explain how Wilner's cone-shaped flare portion would be incorporated into Dark's element 60 and thereby "defin[e] a metering element" as required by claim 9 in light of the fact that element 60 surrounds plug 44. Further, similar to the rejection of claim 1, the Examiner does not explain why one of ordinary skill in the art would place Wilner's metering element in Dark's seal member 60 as opposed to the area near element 34. We, thus, do not sustain the rejection of claim 9 because it is not supported by a rational underpinning. Claims 10–13 depend directly or indirectly from claim 9. Appeal Br. 23 (Claims

App'x). We do not sustain the rejection of claims 10–13 for the same reasons.

DECISION

The Examiner's decision rejecting claims 1–7 and 9–13 is reversed.

REVERSED