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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HUBERT HOELZ, STEFAN LUSTENBERGER, TORSTEN KUEHN, HERBERT WACHTEL, and ROLF KUHN

Appeal 2015-000046
Application 11/560,267[1]
Technology Center 3700

Before PHILIP J. HOFFMANN, JAMES A. WORTH, and BRUCE T. WIEDER, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1, 3–5, 7–9, 11–13, 15, 16, and 18–20. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] According to Appellants, the real party in interest is Boehringer Ingelheim Pharma GmbH & Co. KG. (Appeal Br. 2.)

CLAIMED SUBJECT MATTER

Appellants' claimed "invention relates to a powder inhaler having at least one specially sharpened needle for the precise piercing or cutting open of capsules." (Spec. 1.)

Claims 1, 9, and 16 are the independent claims on appeal. Claim 1 is illustrative and is reproduced below (emphasis added):

> 1. An inhaler for delivering a powdered medicament from a capsule, comprising: *at least one needle having a diameter of 1.00-2.00 mm, a solid substantially circular cross-section about a central longitudinal axis*, and *a triangular point defined by three substantially equally shaped bevels meeting at a tip* located on the central longitudinal axis, wherein the at least one needle operates to perforate or cut open the capsule by piercing the capsule and withdrawing therefrom to produce an aperture through which to release the powdered medicament.

REJECTIONS

Claims 1, 4, 5, 16, and 19 are rejected under 35 U.S.C. § 103(a) in view of Ohki (US 5,715,811, iss. Feb. 10, 1998) and Haroldsen (EP 582,276 A1, pub. Feb. 9, 1994).

Claims 3 and 18 are rejected under 35 U.S.C. § 103(a) in view of Ohki, Haroldsen, and Koss (US 4,541,427, iss. Sept. 17, 1985).

Claims 7, 8, and 20 are rejected under 35 U.S.C. § 103(a) in view of Ohki, Haroldsen, and Hochrainer (US 2001/0008637 A1, pub. July 19, 2001.)

Claims 9, 12, and 13 are rejected under 35 U.S.C. § 103(a) in view of Hochrainer (US 5,947,118, iss. Sept. 7, 1999), Ohki, Haroldsen, and Altermatt (US 5,263,475, iss. Nov. 23, 1993.)

Claim 11 is rejected under 35 U.S.C. § 103(a) in view of Hochrainer '118, Ohki, Haroldsen, Altermatt, and Koss.

Claim 15 is rejected under 35 U.S.C. § 103(a) in view of Hochrainer '118, Ohki, Haroldsen, Altermatt, and Hochrainer '637.

ANALYSIS

With regard to claim 1, the Examiner finds that

> Ohki is silent as to the needle having a diameter of 1.00-2.00 mm and the point being defined by three equally shaped bevels. However, Haroldsen teaches a needle that includes a diameter of 1.00-2.00 mm (see col. 3 ln. 25) and a triangular point defined by three equally shaped bevels (see Fig. 17C & 18A).

(Final Action 2–3.)

Appellants argue that

> Haroldsen (EP 582276) is very specific that the shaft of the needle should be nonround, and specifies all types of non-round cross-sections. (See, col. 1, lines 39–49; col. 2, lines 24–37; col. 3, lines 13–15, 29–48.) The cross-section of the needle of FIG. 17C, which the Examiner cites, is triangular and non-round. (See, col. 5, lines 3–6.)

(Appeal Br. 7.) Appellants further argue that "the needle of Haroldsen (EP 582276) does not have a 'diameter' as the Examiner asserts. Indeed, the evidence on record is irrefutable in that the needle of Haroldsen (EP 582276) must be formed of non-round stock to meet its objective." (*Id.* at 8.)

The Examiner answers that Ohki "discloses a substantially circular cross-sectional needle 16" and that

> [t]he modification to the Ohki needle was to only modify the tip of Ohki to be the three triangular bevel configuration taught by Haroldsen (Fig 17C) as well as to have the size range of 1.00-

> 2.00 mm taught by Haroldsen (col. 3 ln. 25) in order to provide a well-known needle shape configuration.

(Answer 11.)

With regard to the Examiner's finding that "Haroldsen teaches a needle that includes a diameter of 1.00-2.00 mm" (Final Action 3), Haroldsen does not refer to a "diameter" but rather states that "[i]n its broadest dimension, the width of the non-round wire may range from about 0.001 to about 0.075 inches." (Haroldsen, col. 3, ll. 23–25.) Haroldsen further discloses that "[t]he term 'non-round' wire is intended to embrace any wire that in cross-section has a shape other than round." (*Id.* at col. 3, ll. 29–31.) In short, Haroldsen discloses a needle having a *non-round wire* with a *broadest width* "from about 0.001 to about 0.075 inches." (*See id.* at col. 3, ll. 23–25.)

With regard to a triangular point, Haroldsen discloses that "[i]n a particularly useful embodiment of this invention, the cross-sectional shape of the point section formed by tapering is essentially the same as the cross-sectional shape of the non-round wire, over a substantial portion of the point section." (Haroldsen, col. 4, ll. 51–55; *see also* Appeal Br. 7.) In other words, the triangular point disclosed in Haroldsen is formed, not by tapering a round wire to a triangular point, but by tapering a triangular wire to a triangular point. (*Id.* at col. 5, ll. 21–24, Figs. 17C, 18A.) The Examiner does not "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements" of Ohki and Haroldsen to taper a round wire to a triangular point. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007).

Therefore, we are persuaded that the Examiner erred in rejecting claim 1. Independent claims 9 and 16 contain similar language and for similar reasons, we are persuaded that the Examiner erred in rejecting claims 9 and 16, and dependent claims 3–5, 7, 8, 11–13, 15, and 18–20.

DECISION

The Examiner's rejections of claims 1, 3–5, 7–9, 11–13, 15, 16, and 18–20 under 35 U.S.C. § 103(a) are reversed.

REVERSED