

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VINCENT P. BASILICE and JOSEPH P. BASILICE

Appeal No. 97-0938
Application 08/292,502¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, McQUADE
and CRAWFORD, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 15 through 17 and 19 through 22, all of the claims pending in the application.

¹ Application for patent filed August 18, 1994. According to appellants, the application is continuation of 08/081,351, filed June 28, 1993, now U. S. Patent No. 5,366,448, issued November 22, 1994.

The invention relates to a device which is adapted to be mounted on a conventional eye drop squeeze bottle to facilitate the administration of medication to a patient's eye. Claim 15 is illustrative and reads as follows:

15. An eye drop dispensing device for a squeeze bottle dispenser for administering fluid eye medication in drop dosages to an eye of a patient, said device comprising:

a cylindrical, dome-shaped collar, said collar including an opening extending along a collar axis, said opening adapted to receive a dispenser nozzle of the dispenser;

attachment means to secure said collar to the dispenser; and

a positioning means for assisting in an eversion of a lower eyelid to form a bowed configuration suitable to receive drops of the medication deposited from the outlet opening when the patients' head is in an erect orientation to provide a corresponding horizontal primary gaze position to a patient's eye selected to receive medication, the dispensed eye drop dropping vertically from the outlet opening to contact the bowed configuration of the eyelid before any contact with the eye, said positioning means extending away from said collar and including an outer end such that an axial displacement measured along said collar axis, between an edge of said outer end of said positioning means adjacent the outlet opening when the dispenser is attached to said device, and the outlet opening, is less than about 10 mm.²

² The term "the outlet opening" as it appears in claim 15 lacks a proper antecedent basis, an informality which is deserving of correction in the event of further prosecution before the examiner. Given the underlying disclosure, we understand this term to refer to the outlet opening on the nozzle of the bove dispenser.

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The reference relied upon by the examiner as evidence of obviousness is:

Herrick 4,605,398 Aug. 12, 1986

Claims 15 through 17 and 19 through 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Herrick.³

Reference is made to the appellants' brief (Paper No. 14) and to the examiner's answer (Paper No. 16) for the respective positions of the appellants and the examiner with regard to the merits of this rejection.

Herrick discloses an eye drop dispensing device 12 which is adapted to be removably attached to an eye drop squeeze bottle or container 14 having a fluid dispensing opening 18. The device 12 includes a support guide member 40 extending from a housing member 20 for everting the user's lower eyelid to allow unhindered administration of the fluid from a dispensing position above the eye as shown in Figure 8. As described by Herrick,

³ In the final rejection (Paper No. 11), claims 15 through 17 and 19 through 22 also were rejected under the judicially created doctrine of obviousness-type double patenting. The examiner has since withdrawn this rejection in view of the terminal disclaimer filed on September 13, 1996 (Paper No. 17). See the advisory letter mailed October 11, 1996 (Paper No. 18).

[t]he dispensing device includes an elongated housing member having a hollowed-out central area which extends axially therethrough and which terminates at one end thereof in a container-receiving opening which is in axial alignment therewith and which is adapted to receive the fluid-dispensing opening and to support the container. The hollowed-out central area terminates at the other end thereof in a fluid-dispensing tip which is in axial alignment with the container-receiving opening. The fluid-dispensing tip has a selected length in a tapered passageway having two spaced opposed openings, one opening of which has a larger diameter than the other opening. The tapered passageway extends axially between the two opposed openings and is positioned with the larger diameter opening of the tapered passageway adjacent the fluid-dispensing opening in the container so as to receive fluid therefrom and which is adapted to direct the fluid received therefrom into and through the tapered passage to the other opening. The other opening dispenses a controlled number of drops of fluid therefrom. The support guide member includes a first end which is operatively coupled to the elongated [sic] housing member with the fluid-dispensing tip extending in a predetermined direction from the fluid-dispensing tip and having a second opposed end which is located in the predetermined direction and at a distance greater than the selected length of the fluid-dispensing tip. The second opposed end terminates in a curvilinear, blade-like everting member having an outer ribbed edge which is adapted to be positioned against the outer skin below the lower eyelid and over a portion of the bone structure defining the eye socket of a user wherein the outer ribbed edge is capable of being urged against a bone structure with the skin therebetween to urge the skin in a downward direction which everts the lower eyelid from the eye of a user, enabling drops of fluid to be directed into the eye in the absence of interference from the lower eyelid [column 2, line 49 through column 3, line 19].

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The examiner concedes that Herrick's eye drop dispensing device does not meet the limitation in claim 15 requiring that the "axial displacement measured along said collar axis, between an edge of said outer end of said positioning means adjacent the outlet opening when the dispenser is attached to said device, and the outlet opening, is less than about 10mm" (see page 4 in the brief). In this regard, Herrick does not specify any particular axial displacement measured along the axis of the collar (housing member 20) between an edge of the outer end of the positioning means (support guide member 40) adjacent the outlet opening (fluid dispensing opening 18 of container 14) and the outlet opening. Nonetheless, the examiner concludes that the "less than about 10mm" axial displacement recited in claim 15 would have been an obvious matter of design choice (See pages 4 and 5 in the answer).

The appellants' disclosure indicates that the claimed axial displacement is an important, if not critical, factor in allowing eye drop medication to be administered in the manner recited in claim 15, i.e., with the patient's head in an erect position. The disclosure also indicates that this particular mode of

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medication administration is easier and more efficient than the conventional mode, exemplified by the Herrick reference, wherein the patient's head is tilted back. In this regard, the Herrick reference is completely devoid of any suggestion that eye drops could be administered as recited in claim 15. Under these circumstances, the examiner's unsupported conclusion that the "less than about 10mm" axial displacement recited in claim 15 would have been an obvious matter of design choice is not well taken (see In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 8-9 (CCPA 1975)).

Moreover, the collar (housing member 20) of Herrick's eye drop dispensing device 12 essentially encloses the outlet opening (fluid dispensing opening 18 of container 14) associated therewith (see Figure 9). Thus, Herrick's eye drop dispensing device would not appear to be structurally capable of administering eye drop medication in the manner recited in claim 15 even if it were provided with the "less than about 10mm" axial displacement at issue. This further distinguishes the eye drop dispensing device claimed over that disclosed by Herrick.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 15 or of claims 16, 17 and 19 though 22

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which depend therefrom.

The decision is reversed.

REVERSED

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| HARRISON E. McCANDLISH |) | |
| Administrative Patent Judge |) | |
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| JOHN P. McQUADE |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
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| MURRIEL E. CRAWFORD |) | |
| Administrative Patent Judge |) | |