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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
JULIEN PLOJOUX, ET AL. : EXAMINER: FELTON, MICHAEL J.
SERIAL NO: 14/370,410 :
FILED: JULY 2, 2014 : GROUP ART UNIT: 1747
FOR: AN AEROSOL GENERATING :
DEVICE AND SYSTEM WITH
IMPROVED AIRFLOW

REQUEST FOR RECONSIDERATION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

Commissioner:

In response to the Office Action dated April 5, 2016, Applicant respectfully requests the Examiner's reconsideration in view of the following remarks.

Remarks begin on page 2 of this paper.

REMARKS

Regarding the Office Action and the Claims:

Claims 16-29 are pending and under examination. Applicant respectfully requests favorable reconsideration of this application, and traverses the Examiner's rejection of claims 16-29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,954,979 ("Counts") in view of U.S. Patent No. 5,505,214 ("Collins").

Rejection under 35 U.S.C. § 103(a):

The Office cannot properly ascertain the differences between the claimed invention and the prior art without consideration of both the claimed invention and the prior art as a whole. *See* M.P.E.P. § 2141(II); *see also* § 2142.02. Even in view of such consideration, Counts in view of Collins would not have put the public in possession of the claimed invention. And, a person of ordinary skill in the art would not have looked to either of these references if attempting to produce the claimed invention. Here, a review of the cited references as a whole, including the cited portions therein, reveals that they fail to support the Office Action's allegations of obviousness.

The Office Action admitted that "Counts et al. do not disclose the heater element is in the form of a pin or blade that extends into the substrate"—a feature recited in independent claims 16 and 28. Office Action, p. 4. It then asserted that it would have been obvious to use the alternate arrangement of Collins to cure these deficiencies. *See id.*

Without conceding to any of these assertions, Applicant respectfully submits that Counts and Collins, taken separately or in combination, still do not disclose or suggest at least "wherein a distal end of the first air flow channel and a distal end of the second air flow channel meet at an air outlet positioned around a base of the heater element"—a feature also recited in independent claims 16 and 28.

First, this feature is not addressed anywhere in the Office Action. For example, the claim terms “meet,” “an air outlet,” and “a base” do not appear in the Office Action. The Office Action is therefore not “complete as to all matters,” including “the patentability of the invention as claimed.” Rule 1.104(b) and 1.104(a), respectively. So, the next action—if not a Notice of Allowability—cannot be made final. Nevertheless, this paper constitutes a complete reply in compliance with each of Rule 1.111(a), (b), and (c).

Second, a combination of Counts and Collins would not meet the above-quoted claim element. This is true even in consideration of the Office Action’s asserted obviousness of using the “alternate arrangement of [the] heating element and substrate as disclosed by Collins” in an attempt to remedy Counts’ deficiency of failing to disclose the heater element is in the form of a pin or blade that extends into the substrate. Office Action, p. 4.

For example, as depicted in Fig. 7 of Collins, the plurality of heaters 123 are arranged to heat material 127 in disposable unit 121. *See Collins*, Fig. 7 and col. 11, ll. 9-17. Heater elements 123, however, are isolated from airflow through the device. For example, plugs 137 and 47 “are air-tight,” and plug 47 “includes an air-tight hole” for wires 48 to pass from control circuit 24 to heating elements 123. *See id.*, col. 11, ll. 26-33. This is consistent with Collins’ teaching that “[t]he permanent heaters of the present invention are isolated from the tobacco flavor air passageway and aerosol cavity. This isolation minimizes condensation of aerosol onto the heaters and therefore minimizes aerosol residue reheating and undesirable flavor generation.” *Id.*, col. 4, l. 66 to col. 5, l. 3; *see also* col. 4, ll. 52-56. This is also consistent with Collins’ teaching that “it would therefore be desirable to be able to provide an electrically-heated smoking article in which the heating elements are reusable, and of which the volume of disposable portions is thus minimized.” *Id.*, col. 2, ll. 12-15.

This arrangement is entirely counter to that of Counts. Instead, Counts teaches arrangements where airflow is specifically directed past, around, or near the heater elements.

See, e.g., Counts, Figs. 2, 3, 6, 7, and 10, and col. 4, ll. 25-28; col. 6, ll. 1-14; col. 12, ll. 14-16; and col. 16, ll. 25-31.

So, using the arrangement of heater and substrate as taught in Fig. 7 of Collins, in the system of Counts, would not result in the claimed “distal end of the first air flow channel and a distal end of the second air flow channel meet[ing] at an air outlet positioned around a base of the heater element,” as recited in independent claims 16 and 28.

This also indicates that the cited references cannot be combined as proposed in the Office Action, because Counts and Collins essentially teach away from their proposed combination. It is impermissible to combine cited references where the references teach away from their combination. *See* M.P.E.P. § 2145(X)(D)(2). This is a significant factor to be considered in an obviousness determination. *See* M.P.E.P. § 2145(X)(D)(1) (“The Nature of the Teaching Is Highly Relevant”), which explains that “[a] prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness.”

And, the proposed combination of Counts with Collins is improper, at least because it would change the principle of operation of the cited references. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. § 2143.01(VI) (internal citation omitted).

Here, the system of Counts relies on the heater elements breaking the wrapper of the cigarette 23 to allow air to be drawn transversally into the cigarette. *See, e.g.*, Counts, col. 16, ll. 38-41. The benefit of this arrangement is that it mimics the resistance to draw characteristics of a conventional cigarette. *See id.*, col. 2, ll. 44-48. So, with each successive puff on the cigarette, another breach is formed in the wrapper and the resistance to draw

reduces. This mimics a conventional cigarette, which has a resistance to draw that reduces as the cigarettes get shorter/combust.

But if the heating element and substrate arrangement described in Counts were replaced with the heating element and substrate arrangement described in Collins, the system of Counts would no longer operate in the way it was designed and described. There would be no breaching of a wrapper, and the resistance to draw would remain unchanged throughout operation. This would change the principle of operation of Counts and render it unable to operate as intended. So, the Office Action cannot rely on a combination of Counts and Collins. See M.P.E.P. § 2143.01(VI).

Based on similar reasoning, Counts and Collins cannot be combined as proposed in the Office Action, because the references teach away from their proposed combination. It is also impermissible to combine cited references where the references teach away from their combination. See M.P.E.P. § 2145(X)(D)(2). This is a significant factor to be considered in an obviousness determination. See M.P.E.P. § 2145(X)(D)(1) (“The Nature of the Teaching Is Highly Relevant”), which explains that “[a] prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness.”

The Office Action could not have reached an obviousness conclusion based on Counts and Collins without the impermissible use of the hindsight benefit afforded by Applicant’s disclosure. See M.P.E.P. § 2142. The facts that may be gleaned from Counts and Collins would not have put the public in possession of the claimed invention, and do not enable a conclusion of obviousness. Modification of Counts and/or Collins also would not have been predictable to a person of ordinary skill in the art in seeking to achieve the claimed features.

Applicant’s claims thus do not read on Counts and Collins, whether these references are considered separately or in combination. The pending claims are therefore nonobvious and should be allowable. Applicant respectfully requests withdrawal of the rejection.

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