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12/851,420	08/05/2010	NI DING	050623.01391	1682
45159	7590	11/23/2016	EXAMINER	
SQUIRE PB (Abbott) 275 BATTERY STREET, SUITE 2600 SAN FRANCISCO, CA 94111-3356			MILLIGAN, ADAM C	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* NI DING

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Appeal 2015-005434  
Application 12/851,420  
Technology Center 1600

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Before JEFFREY T. SMITH, KAREN M. HASTINGS, and  
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection under 35 U.S.C. § 103(a) of claims 1, 3–10, 12, and 13. We have jurisdiction under 35 U.S.C. § 6.

We REVERSE.

Claim 1 reads as follows:

1. A kit, comprising:

a pouch;

a medical device with a drug in the pouch;

a porous or permeable container in the pouch; and

an antioxidant in the porous or permeable container such that the medical device with the drug is placed outside of the porous or permeable container;

wherein the antioxidant is a volatile antioxidant and evaporates and fills the space of the pouch.

Appellant requests review of the Examiner's rejection of claims 1, 3–10, 12 and 13 rejected under 35 U.S.C. § 103(a) as unpatentable over Sirhan (US 2003/0083646 A1, published May 1, 2003), Carlyle (US 2003/0204239 A1, published October 30, 2003), and Hui (US 2002/0081228 A1, published June 27, 2002). Final Act. 3–4; App. Br. 5. We need only address claim 1.

Independent claim 1 is directed to a kit that is essentially a package (pouch) enclosing a medical device and a porous/permeable container containing a volatile antioxidant that fills the package (pouch) to protect the medical device. App. Br. 8.

We refer to the Examiner's Final Action for a statement of the rejection. Final Act. 3–4.

After review of the respective positions provided by Appellant and the Examiner, we REVERSE the Examiner's prior art rejection for the reasons presented by Appellant. We add the following.

The Examiner found Sirhan's vapor deposition chamber corresponds to the claimed pouch. Ans. 6; Sirhan ¶ 149. Alternatively, the Examiner found Hui discloses a pouch acting as a vapor deposition chamber and, thus, determined it would have been obvious to replace Sirhan's vapor deposition chamber with the gas permeable pouch of Hui in view of Hui's teachings. Final Act. 4; Ans. 5–6; Hui Figure 15, ¶ 95.

Appellant's position that one of ordinary skill would not consider a pouch as recited in claim 1 to encompass the vapor deposition chamber of Sirhan's device is persuasive. App. Br. 8, 10. We agree with Appellant that the Examiner has not adequately explained why one skilled in the art would have substituted Hui's sterilization pouch for Sirhan's vapor deposition chamber. App. Br. 12. The Examiner has not provided an adequate technical explanation of how one skilled in the art would modify Sirhan's device to operate with Hui's sterilization pouch given that Sirhan's device is for a highly controlled vapor deposition under vacuum while Hui's pouch is for gas diffusion that does not lead to deposition. *Id.* at 13.

Moreover, the Examiner has not adequately explained how Sirhan's fence, which serves to mask portions of the medical device (stent) from being coated by the therapeutic material (antioxidant), operates as a porous or permeable container holding the therapeutic material (antioxidant). Sirhan ¶¶ 60, 172, 183, 189.

Accordingly, we reverse the Examiner's prior art rejection of claims 1, 3–10, 12, and 13 for the reasons presented by Appellant and given above.

Related Appeal No. 2014-009457 (Application No. 12/851,414 by the same inventor; and identified as a related appeal at App. Br. 3) involved method claims directed to similar subject matter, that is, packaging of a

medical device by providing an antioxidant in a container within the packaging/pouch containing the medical device. The rejection of those claims under 35 U.S.C. § 103 over primarily the combined teachings of Pettersson (US 6,065,597, issued May 23, 2000) and Cotterman (US 2002/0153511 A1, published October 24, 2002) was affirmed. Although the Examiner has already indicated that Petterson and Cotterman were considered on the signed Information Disclosure Statement dated February 12, 2014, we leave it to the Examiner and Appellant to determine whether prior art issues are raised by the references applied in that related appeal to the claims here in light of the decision in Appeal No. 2014-009457. The Board relies on the involved parties to focus the issues and decides those issues based on facts and arguments presented by the involved parties. *See Ex Parte Frye*, 293 F. 1013 (BPAI 2010 (precedential)). While the Board is authorized to enter a new ground of rejection, this authority is discretionary. See 37 C.F.R. § 41.77(b). We decline to consider the obviousness of the currently appealed claims in light of the above noted references as such a rejection is not before us for review on appeal.

ORDER

The Examiner's prior art rejection under 35 U.S.C. § 103(a) is reversed.

REVERSED