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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte OZ CABIRI

Appeal 2017-004669
Application 13/472,112
Technology Center 1700

Before: LINDA M. GAUDETTE, MARK NAGUMO, and
JENNIFER R. GUPTA, *Administrative Patent Judges*.

GUPTA, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellant² appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 15–18 and 23–27. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ In this Decision, we refer to the Specification filed May 15, 2012 (“Spec.”), the Non-Final Office Action mailed January 15, 2016 (“Final Act.”), the Appeal Brief filed July 14, 2016 (“Appeal Br.”), the Examiner’s Answer mailed December 1, 2016 (“Ans.”), and the Reply Brief filed January 27, 2017 (“Reply Br.”).

² Appellant identifies Medimop Medical Projects Ltd. as the real party in interest as. Appeal Br. 1.

The subject matter of the claims on appeal relates to a selectively powered battery-operated transdermal drug-delivery device. *See* Spec. 1. Sole independent claim 15, reproduced below from the Claims Appendix of the Appeal Brief, is representative of the claims on appeal.

15. A selectively powered battery-operated drug-delivery device comprising:

a unitary housing having a battery and a complete battery circuit therein;

a needle disposed within said housing and projectable at least partially out of said housing for administering a drug within said housing to a user;

a selectively-removable isolator, said isolator disposed in a first position whereat said isolator contacts a battery terminal within said housing so as to interrupt the complete battery circuit, such that no power is provided to the device;

said isolator configured to be movable to a second position whereat the complete battery circuit is uninterrupted by said isolator, such that power is provided to the device; and

an adhesive surface disposed along a side of the unitary housing, configured for fastening the device to the skin of the user, said adhesive surface being provided with a selectively removable protective cover, said isolator being an integral extension of the protective cover extending into the housing in the first position, whereby removal of the protective cover moves the isolator from the first position to the second position, thereby connecting the complete battery circuit to provide power to the device.

Appeal Br. A-1 (Claims App.)

DISCUSSION

The Examiner maintains the rejections under 35 U.S.C. § 103(a) of claims 15–18, 24, and 27 over Yodfat et al. (WO 2009/125398 A2, published October 15, 2009) (“Yodfat”) and Garde (US 6,377,848 B1,

issued April 23, 2002) (“Garde”), and claims 23, 25, and 26 over Yodfat, Garde, and Selevan (US 2009/0209896 A1, published August 20, 2009). Non-Final Act. 3–6.

We focus on independent claim 15 is deciding this appeal.

Claim 15 is directed to a selectively powered battery-operated drug-delivery device that includes a unitary housing having a battery and a complete battery circuit, a selectively-removable isolator, and an adhesive surface, with a selectively removable protective cover, disposed along a side of the unitary housing, configured for fastening the device to the skin of the user. Appeal Br. A-1 (Claims App.) According to claim 15, the selectively-removable isolator is configured to be movable from a first position to a second position. When in the first position, “said isolator contacts a battery terminal within said [device’s] housing so as to interrupt the complete battery circuit, such that no power is provided to the device.” *Id.* When in the second position, “the complete battery circuit is uninterrupted by said isolator, such that power is provided to the device.” *Id.* In addition, claim 15 requires the “isolator being an integral extension of the protective cover extending into the housing in the first position, whereby removal of the protective cover moves the isolator from the first position to the second position, thereby connecting the complete battery circuit to provide power to the device.” *Id.*

The dispositive issue before us in this appeal is:

Has the Examiner reversibly erred in finding that a person of skill in the art would have had a reason to adapt Garde’s isolator pull tab to Yodfat’s device by making the isolator pull tab integral with the protective cover of Yodfat’s adhesive strip? We answer this question in the affirmative.

The Examiner finds that Yodfat discloses all elements of claim 15's device except "an isolator configured to be moveable from a first position to a second position and the [isolator] being an integral extension of the protective cover." Non-Final Act. 3 (citing Yodfat ¶¶ 20, 187, 212, Figs. 2c, 11a).

The Examiner finds that Garde discloses a drug delivery device including a housing having battery 22, where the battery includes selectively-removable pull tab (isolator) 43. Non-Final Act. 3; Garde 6:39–53, Fig. 8A. Garde's pull tab 43 is disposed in a first position where the isolator contacts a battery terminal within said housing so as to interrupt the battery circuit, such that no power is provided to the device—i.e., when the pull tab is physically disposed between the cathode of power source 22 and the first battery terminal of control circuitry 24, thus, interrupting the battery circuit. *Id.* In addition, Garde's pull tab 43 is configured to be movable to a second position where the complete battery circuit is uninterrupted by said isolator—i.e., when the user removes pull tab 43 from the controller, a spring force, such as that provided by battery holder 45, urges power source 22 against the first battery terminal of control circuitry 24, causing electrical contact, and thus, providing power to the device. Non-Final Act. 4; Garde 6:39–53, Fig. 8A. The Examiner finds that Garde teaches that pull tab 43 ensures that battery 22 is not being drained prior to the user removing pull tab 43, which is advantageous when the manufacturer of the drug delivery device ships the device with batteries in place. Non-Final Act. 4; Garde 6:54–67.

The Examiner determines that one of ordinary skill in the art would have been led, based on Garde, to include a pull tab (isolator) in Yodfat's

device to ensure the battery is not drained prior to the user removing the pull tab (e.g., during shipping). Non-Final Act. 4. The Examiner's acknowledges that the combination of Yodfat and Garde teach the protective cover and isolator as separator components of the drug-delivery device, but determines that "having the isolator extend from said protective cover and the isolator being pre-attached [(integral)] to the cover" would be a matter of engineering choice. *Id.* (citing Manual of Patent Examining Procedure (MPEP) § 2144.04 (9th ed., Jan. 2018)).

Appellant argues that "Garde does not disclose, teach or suggest, anywhere in the reference, that the pull tab 43 is attached in any manner to anything, much less to a removable protective cover of [an adhesive surface of] the device, much less being integral therewith." Appeal Br. 5.

Appellant's argument is persuasive of reversible error. Although Garde may provide a reason for using a pull tab (isolator) in Yodfat's device, because the Examiner has not established a reason for making the pull tab on Yodfat's modified device "an integral extension of" Yodfat's protective cover extending into the housing, whereby removal of the protective cover moves the isolator from a first position to a second position, "thereby connecting the complete battery circuit to provide power to" Yodfat's device, the Examiner's obviousness determination is based on improper hindsight reasoning. Non-Final Act. 3–4. In other words, the Examiner has not adequately explained why it would have been desirable to integrate Garde's pull tab with Yodfat's protective cover rather than include Garde's pull tab as a separate component in Yodfat's device to prevent the battery in Yodfat's device from being drained prior to removing the pull tab.

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Because this deficiency is present in all the appealed rejections, we reverse the rejections of claims 15–18 and 23–27.

DECISION

For the above reasons, the rejections of claims 15–18 and 23–27 are reversed.

REVERSED