

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM J. MCLERNON, III

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Appeal No. 1996-2645  
Application 08/229,910<sup>1</sup>

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ON BRIEF

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Before WILLIAM F. SMITH and SPIEGEL, Administrative Patent Judges, and  
MCKELVEY, Senior Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims  
1 through 10, all the claims pending in the application.

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<sup>1</sup> Application for patent filed April 19, 1994.

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Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. An allergy test strip for use in determining if a person has allergic reactions to allergens, consisting of

a perforated layer of non-allergenic material having an adhesive layer on a back side thereof;

said perforated layer having a top side with at least one perforation extending from said top side through the material and through the back side adhesive layer.

The references relied upon by the examiner are:

Saunders, Jr. (Saunders)	3,894,531	July 15, 1975
Gardiner	4,228,796	Oct. 21, 1980
Smith et al. (Smith)	5,254,109	Oct. 19, 1993

The reference made of record and relied upon by this merits panel is:

Schaar	3,073,304	Jan. 15, 1963
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Claims 1 through 10 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Gardiner, Saunders and Smith. We reverse the examiner's rejection and institute a new ground of rejection. In addition, we raise other issues for consideration by the examiner.

### DISCUSSION

The linchpin of the examiner's rejection is Gardiner. Gardiner describes an insulin injection guide (10) which comprises a flexible, flat sheet-like material (12) of generally rectangular shape. The material (12) has a plurality of holes (32) passing therethrough

which may be numbered to assist the user in selecting a proper hole for administering an injection of insulin. Secured to one edge of the material (12) are a pair of straps (20) and (22). These straps are covered on both sides with a felt-like material that forms one half of a connecting means sold under the trademark Velcro. The other half of the connectors are mounted on support pads (24) and (26) attached to the other edge of the material (12) in line with the straps (20) and (22). Gardiner teaches that in using the device (10), the material (12) is placed over the forward part of a person's thigh and the straps (20) and (22) are wrapped around the person's leg and are secured to the pads (24) and (26). After the guide is placed on the leg, the proper hole is selected and the user administers an injection to his/her thigh through the selected hole.

It is clear from the disclosure of Gardiner that the insulin injection guide is intended to be repeatedly used by a person for daily injections of insulin by securing the device to their thigh for an injection, pulling the straps apart so as to remove the device, and reattaching the straps together around their thigh when it is time for the next injection. This is clearly seen from the passage on lines 65-68 of column 2 in Gardiner:

While the guide 10 may not be placed on the user's leg in the exact position each time it is utilized, the user will find that he positions the same in substantially the same position each time the device is used.

The rejection is premised upon the reasoning that since adhesive layers for fixing a planar sheet material to a surface are notoriously well known in the art, it would have been

obvious to one of ordinary skill in the art to substitute an adhesive layer for the straps (20) and (22) taught in the device of Gardiner as an art recognized equivalent for accomplishing the same result. We do not agree with this reasoning since Gardiner discloses the use of reusable straps for securing the device to a person's thigh with the clear intent that the device is to be used repeatedly. An adhesive layer is normally intended to attach a planar sheet-like material such as a bandage to a person's skin once. Upon being removed from the person's skin, the adhesive layer becomes ineffective and is disposed of. Therefore, an adhesive layer would not allow the device of Gardiner to be repeatedly reused and reattached to a person's thigh, and as a consequence would destroy the function and purpose of the Gardiner device. The remaining references do not rectify the deficiencies of Gardiner.

For these reasons, we reverse the rejection under 35 U.S.C. § 103.

NEW GROUND OF REJECTION UNDER 37 CFR § 1.196(b)

Claims 1 through 3 and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Schaar.

Schaar describes a perforated adhesive tape suitable for use as surgical and first-aid tape bandages. The tape consists of a perforated layer of material (41) having an adhesive layer (49) on a back side thereof, wherein the perforated layer (41) has a top side with at least one perforation (42) extending from the top side through the material and

through the back side adhesive layer (49). See Figures 1-3 in Schaar. The perforations (42) provide ventilation and aeration of the skin of a person to whom the adhesive tape is applied. The adhesive layer (49) is faced with a protective facing sheet and sterilized. See Figure 5 in Schaar where the numeral 59 designates a facing sheet in the process of being stripped from the adhesive layer (51) as it is passing over and past the outer peripheral edge (58).

While Schaar does not explicitly recite that the material (41) out of which the tape is made is non-allergenic, it is reasonable to conclude that the material (41) is non-allergenic since the tape is intended to be applied to the skin of a human being. We understand that the tape taught by Schaar is not described as being useful as an allergy test strip as recited in the preamble of claims 1 and 2. However, in our view, this language of the claims only recites an intended use of the device and does not serve to further limit the claimed device. Neither the claims nor the specification recite specific structural features of the device, e.g., size of the perforations, etc., which would allow one to conclude that the claimed device is structurally different than the tape of Scaar. On this record, the preamble language does not serve to distinguish the claimed device from the tape described by Schaar.

#### OTHER ISSUES

From reviewing the rejection of the claims, it does not appear that the examiner has considered the full scope of the claims on appeal. As a consequence it may be that the examiner's search is incomplete. In particular, from reviewing the application file, it does not appear that the examiner searched in the following classes and subclasses which appear to be relevant in determining the patentability of the claims: class 604/ subclasses 304, 307 and class 602/ subclasses 41+, in particular subclasses 47 and 59.

As a consequence of the action we take today, claims 4 and 6-10 are free of rejection. Upon return of the application, the examiner is urged to re-evaluate the full scope of the claims and ensure that a complete search of the prior art has been performed.

#### TIME PERIOD FOR RESPONSE

This opinion contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53, 131, 53, 197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (1.197(c)) as to the rejected claims.

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(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner...

(2) Request that the application be reheard under 1.197(b) by the Board of Patent Appeals and Interferences upon the same record...

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED-37 CFR § 1.196(b)

William F. Smith	)	
Administrative Patent Judge	)	
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	)	
	)	
Fred E. McKelvey, Senior	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Carol A. Spiegel	)	
Administrative Patent Judge	)	

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