

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte NOEL ROLON, WILLIAM PAGELS,  
and RICHARD EGAN

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Appeal No. 1997-0881  
Application No. 08/367,508

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ON BRIEF

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Before WINTERS, WILLIAM F. SMITH, and ROBINSON, Administrative Patent Judges.  
ROBINSON, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-5 and 8-10, all of the claims pending in the case.

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

1. A method of making more than one punchout from a single dried blood spot, the method comprising the steps of:

making a first punchout in said dried blood spot, said first punchout having first boundaries; and



paper wherein the combination of both punchouts is the minimum surface area required for testing.

### **Discussion**

#### **The rejection under 35 U.S.C. § 103**

Obviousness is a legal conclusion based on the underlying facts. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750 (Fed. Cir. 1991); Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1595-97 (Fed. Cir. 1987). Here, the dispositive question is whether one of ordinary skill in this art at the time of the invention would have found it obvious to make a first punchout in a dried blood spot, which had previously been deposited on filter paper, and sequentially make at least a second punchout in the same dried blood spot, wherein the boundaries of the second punchout are entirely outside of the boundaries of the first punchout and the second punchout has an inner portion removed therefrom which is the first punchout.

The examiner has cited Yee as disclosing a blood testing method which utilizes filter paper which is first spotted with blood and allowed to dry. Samples are removed from the filter paper using one or more punchouts in a predefined manner to obtain a uniform volume of the blood sample. (Answer, page 4). The examiner acknowledges

that Yee (id.):

does not specifically disclose a second punchout having a second boundary, wherein the second boundary is entirely outside of a first boundary of the first punchout so that said second punchout has an inner portion removed therefrom, said inner portion forming said first punchout.

The examiner cites Sadler as similarly teaching a blood testing method utilizing filter paper that is spotted with blood, wherein the blood is allowed to dry, and more than one punchout is made from the sample. Referring to Figure 1, the examiner urges that the disclosure of Sadler could be interpreted to disclose a first punchout and that the second punchout would be the remaining blood spot wherein the second boundaries is defined by the periphery of the spot. (Answer, page 5).

In considering Yee and Sadler, the examiner has pointed to no factual evidence which would reasonably suggest the manipulative steps of the claims on appeal which would result in a second or subsequent punchout of the filter paper containing the blood sample wherein the boundaries of the second punchout are entirely outside the boundaries of the first punchout and wherein the second punchout has an inner portion removed therefrom which is the first punchout. Both Yee and Sadler disclose the use of multiple punchouts; but in each case the areas punched out do not overlap in the manner required by the claims. Yee may reasonably be said to teach methods of punching out samples which would maximize the area on the filter paper spotted with the blood (Yee, Figure 2). In addition, the visual impact of Figure 1 of Sadler might suggest a physical similarity to the resulting punchouts of the claims. However, the examiner's analysis of this figure (Answer, page 5) does not provide for a second punchout as required by the claims. In those

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instances where the prior art uses a plurality of punchouts, none are similar to or would reasonably direct one skilled in this art to the method claimed.

The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On these circumstances, we are constrained to reach the conclusion that the examiner has failed to provide the evidence necessary to support a prima facie case of obviousness as to the claimed method. Where the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). Therefore, the rejection of claims 1-5 and 8-10 under 35 U.S.C. § 103 is reversed.

#### **Other issues**

Upon return of the application to the group, we would urge the examiner and appellants to resolve the apparent inconsistency raised by claim 5 which requires that "said second boundaries are tangential to said first boundaries" and claim 1, on which claim 5 ultimately depends, which requires that "said second boundaries are entirely outside of said first boundaries." It would not appear possible for the boundaries to be tangential to each other and yet have one boundary entirely outside the other.

#### **Summary**

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To summarize, the decision of the examiner to reject claims 1-5 and 6-8 under 35  
U.S.C. § 103 is reversed.

**REVERSED**

SHERMAN D. WINTERS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
WILLIAM F. SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
DOUGLAS W. ROBINSON	)	
Administrative Patent Judge	)	

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