

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID W. NELSON

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Appeal No. 2002-2275  
Application No. 09/652,357

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ON BRIEF

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Before COHEN, ABRAMS, and BAHR, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-19 and 22, which are all of the claims pending in this application.

We REVERSE.

### BACKGROUND

The appellant's invention relates to a device for capturing and restraining a pest such as an insect and to a method for capturing an insect with the device. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hughes	2,962,836	Dec. 6, 1960
Shuster <u>et al.</u> (Shuster)	4,052,811	Oct. 11, 1977

Claims 1-19 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shuster in view of Hughes.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 13) and the final rejection (Paper No. 7) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 11) and Reply Brief (Paper No. 14) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention relates to a device for capturing insects or other small pests without having to handle them directly, by manually capturing the pest by attachment to a pressure responsive adhesive on a substrate which can be folded over on itself. Claim 1 sets forth the invention in the following manner:

1. A device for restraining an insect comprising a continuous planar sheet substrate said substrate comprised of a homogeneous material and having a top side and a bottom side, said substrate having an adhesive distributed on said top side to form an engagement area, said engagement area not encompassing two lateral side areas on said top side of said substrate, said top side of said substrate and said engagement area further comprising a compressible, and hydrophilic pliable material, whereby when said sheet is manually manipulated so that when said engagement area on said top side covers said insect and a force is manually applied to said substrate from said bottom side, said insect will cause said substrate to collapse and form a concave depression which closely conforms to the shape of said insect and therefore partially embed said insect within said substrate wherein the body of said insect may displace said substrate without rupturing the body of said insect and said engagement thereby increases the total contact area between said adhesive and said insect, and removable means to cover said adhesive area prior to use.

The examiner has rejected this claim on the basis that the subject matter recited therein would have been obvious<sup>1</sup> to one of ordinary skill in the art in view of Shuster and Hughes. While the examiner has not made specific findings regarding the disclosure of Shuster as compared to the subject matter recited in claim 1, it would appear that the examiner believes Shuster discloses all except for the removable means to cover the adhesive prior to use. However, the examiner expresses the view that to add this feature to the Shuster device would have been obvious in view of the teachings of Hughes. See Paper No. 7, pages 3 and 4. Absent from the examiner's explanation of the rejection is an expression of the suggestion which would have motivated one of ordinary skill in the art to make the proposed modification to Shultz.

We find ourselves in agreement with the appellant that the rejection is fatally defective and cannot be sustained. Our reasoning follows.

Shuster is directed to a device for capturing insects crawling on inaccessible surfaces such as walls and ceilings. It comprises a handle 14 upon the top of which a rigid body 12 is fastened. Body 12 carries a roll of adhesive material 30 such as masking tape (column 2, line 6) on a spool 44 and a sponge-like triangular support pad

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<sup>1</sup>The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

28 over which the tape is extended with its free end being held by an anchoring element  
31. In use, the tacky side of the tape is pressed against the insect, which is  
“immobilized without being crushed because of the resilient backing provided by the  
pad” (column 2, lines 56-58). The used portion of the tape is then removed and a new  
section pulled into place over the support pad. See column 2, line 53 et seq.

With respect to the recitation set forth in the appellant’s claim 1, it is our opinion  
that Shuster fails to disclose or teach that the substrate which has an adhesive on its  
top side further comprises the compressible and hydrophilic pliable material described  
in the claim, that is, a substrate of such construction that when force is applied to an  
insect captured by the adhesive, the substrate will collapse and form a concave  
depression closely conforming to the shape of the insect and partially embedding the  
insect to increase the total contact area between the adhesive and the insect. In the  
Shuster device, the compressible material is not part of the substrate that carries the  
adhesive, but is a separate element. In addition, while Shuster describes the sponge-  
like pad as “constituting a resilient support to avoid squashing of the insect on the wall  
or ceiling surface,” (column 1, lines 36-38), there is no teaching that the “flexible  
adhesive tape such as commercial masking tape,” even when supported by the  
sponge-like element, possesses such characteristics as to perform in the manner  
prescribed by claim 1 when the device is pressed against an insect on a surface.  
Finally, even if it is conceded that masking tape is hydrophilic, this aspect of the terms

of claim 1 is not met by Shuster, for the claim requires that both the compressibility and the hydrophilic properties be in the substrate.

Thus, contrary to position taken by the examiner, Shuster fails to disclose or teach that the substrate comprises both the adhesive and the compressible and hydrophilic material. This deficiency is not cured by Hughes, even considering, arguendo, that Hughes teaches providing removable means to cover the adhesive area prior to use, and that suggestion exists which would have motivated one of ordinary skill in the art to utilize such a feature in the Shuster device.

It therefore is our conclusion that the combined teachings of Shuster and Hughes fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we will not sustain the rejection. Since all of the remaining claims are dependent from claim 1, it follows that the rejection of those claims also will not be sustained.

#### CONCLUSION

The rejection of claims 1-19 and 22 is not sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN  
Administrative Patent Judge

NEAL E. ABRAMS  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP  
P.O. BOX 34385  
WASHINGTON, DC 20043-9998