

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT D. ROSENTHAL

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Appeal No. 96-2855  
Application 08/190,227<sup>1</sup>

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ON BRIEF

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Before THOMAS, JERRY SMITH, and HECKER Administrative Patent Judges.

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<sup>1</sup> Application for patent filed February 01, 1994. According to the appellant, this application is a continuation -in- part of 08/007,967, filed 01/22/93, now U.S. Patent No. 5,576,544, which is a continuation of 07/717,198, filed 06/18/91, now U.S. Patent 5,204,532, which is a continuation -in- part of 07/682,249, filed 04/09/91, now U.S. Patent No. 5,068,536, which is a continuation -in- part of 07/565,302, filed 08/10/90, now U.S. Patent No. 5,077,476, which is a continuation -in- part of 07/544,580, filed 06/27/90, now U.S. Patent 5,086,229, which is a continuation -in- part of 07/298,904, filed 01/19/89, now U.S. Patent No. 5,028,787.

Appeal No. 96-2855  
Application No. 08/190,227

HECKER, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 6, all of the claims pending in the present application.

The invention relates to a procedure for verifying the accuracy of a non-invasive blood glucose measurement instrument through the use of an invasive (in-vitro) measurement instrument. Representative independent claim 6 is reproduced as follows:

6. A procedure for verifying the accuracy of a non-invasive blood glucose measurement instrument, comprising the steps of:

taking a first blood glucose measurement of a user with a measurement instrument whose accuracy has been independently verified;

taking a second blood glucose measurement of said user with said non-invasive measurement instrument; and

comparing said second measurement with said first measurement in order to determine the accuracy of said non-invasive measurement instrument.

The Examiner relies on the following reference:

Regimand            Re. 34,070            Sep. 22, 1992

Appeal No. 96-2855  
Application No. 08/190,227

(effectively filed Jul. 29,  
1988)

Claims 1 through 6 stand rejected under 35 U.S.C.  
§ 103 as being unpatentable over Regimand.

Rather than reiterate the arguments of Appellant and  
the Examiner, reference is made to the brief, reply brief and  
answer for the respective details thereof.

#### OPINION

We will not sustain the rejection of claims 1  
through 6 under 35 U.S.C. § 103.

#### ANALOGOUS ART

Appellant argues in the Reply Brief:

First, the Answer has failed to establish  
that the Regimand neutron gauges for detecting the  
asphalt content of bituminous paving mix are in the  
same field as the present invention, which relates  
to non-invasive quantitative measurement of analytes  
in the blood. There is no evidence of record that  
one skilled in the art of non-invasive biochemical  
analysis would look to the industrial neutron gauge  
art for solutions to problems encountered in that  
field.

In determining whether a claim would have been  
obvious at the time of the invention, the Examiner must first

Appeal No. 96-2855  
Application No. 08/190,227

determine the scope and content of the prior art. Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). "Although § 103 does not, by its terms, define the 'art to which [the] subject matter [sought to be patented] pertains,' this determination is frequently couched in terms of whether the art is analogous or not, *i.e.*, whether the art is 'too remote to be treated as prior art.'" In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992) (citing In re Sovish, 769 F.2d 738, 741, 226 USPQ 771, 773 (Fed. Cir. 1985)).

In making this determination, we must consider two criteria. First, it must be determined if the prior art is from the same field of endeavor, regardless of the problem addressed. Secondly, even if the prior art is not in the same field of endeavor, it must be determined whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. In re Clay, *supra*, 966 F.2d at 658-659, 23 USPQ2d at 1060.

The Examiner states (Answer at page 4):

The instant invention belongs to the prior art of clinical analytical chemistry and calibration and accuracy are [a] mainstay of the field.

Appeal No. 96-2855  
Application No. 08/190,227

However, Regimand cannot be considered to be within Appellant's field of endeavor merely because both relate to analytical chemistry. Regimand measures asphalt content using a neutron source and detector. Appellant measures glucose in blood using a near-infrared energy source and detector. We find measuring blood content to be a totally different field than measuring asphalt content. We are not inclined to hold, as the Examiner contends, that any or all chemical analysis should be

considered the same field of endeavor. This is especially so without any evidentiary support.

However, Regimand may still be analogous if it is "reasonably pertinent to the particular problem with which the inventor is involved." *Id.* See also In re Paulsen, 30 F.3d 1475, 1481, 31 USPQ 2d 1671, 1675-76 (Fed. Cir. 1994). A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have (not could have) commended itself to an inventor's attention in considering his problem. Thus the

Appeal No. 96-2855  
Application No. 08/190,227

purposes of both the invention and the prior art reference are important in making this determination.

Regimand calibrates field gauges by transferring calibration data via a master gauge (column 3, lines 3-11). At column 5, lines 64-67, Regimand states "This calibration procedure would be carried out whenever calibration is required, such as due to the use of a new type or variation of paving mix." With respect to Appellant's invention, at page 4, lines 26-34 of the specification it recites with respect to non-invasive blood glucose measurement instruments:

Although such instruments are very accurate, there may arise a need due to regulatory regulations or other circumstances to independently verify the accuracy of such instruments. The procedure of the present invention permits the accuracy of non-invasive instruments to be periodically checked in a quick and easy manner. The instrument can be used after the accuracy check only if the measured accuracy is within preset limits.

We find the purpose of Regimand to be quite different than that of Appellant. Transferring calibration data to field instruments, due to a new asphalt mix

Appeal No. 96-2855  
Application No. 08/190,227

(Regimand), is not reasonably pertinent to Appellant's checking non-invasive blood glucose measurement field instruments for accuracy, as claimed. Similarly, the asphalt calibration approach of Regimand does not logically commend itself to an inventor's attention concerning the calibration of non-invasive blood glucose measurement field instruments of the type claimed.

Thus, we find that Regimand is not reasonably pertinent and is non analogous art. Therefore, we will not sustain the rejection of claims 1 through 6.

We have not sustained the rejection of claims 1 through 6 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

Appeal No. 96-2855  
Application No. 08/190,227

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