

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY S. LONG

Appeal No. 2003-2129
Application No. 09/557,044

ON BRIEF

Before KIMLIN, WALTZ and POTEATE, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-12.

Claims 1 and 9 are illustrative:

1. A process for protecting an agricultural crop from freezing which comprises applying an effective amount of a freeze protection compound to the agricultural crop, the agricultural crop in a living and growing condition, the freeze protection compound including a fermented biomass material as an active ingredient for the purpose of protecting the agricultural crop from freezing.

9. A composition for the freeze protection of an agricultural crop, the composition including a fermented biomass as an active

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ingredient for the purpose of protecting the agricultural crop from freezing.

The examiner relies upon the following references as evidence of obviousness:

Janke et al. (Janke) WO 97/34960 Sep. 25, 1997
(PCT International Application)

Kobayashi 05-328859 Dec. 14, 1993
(Japanese Unexamined Patent Publication)

Appellant's claimed invention is directed to a process for protecting an agricultural crop from freezing, and a composition that is used in such a process. The process entails applying a fermented biomass material to the agricultural crop.

Appealed claims 1-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kobayashi in view of Janke.

We have thoroughly reviewed the respective positions advanced by appellant and the examiner. In so doing, we concur with appellant that the examiner has not established a prima facie case of obviousness for process claims 1-8. Accordingly, we will not sustain the examiner's rejection under § 103 of claims 1-8. We will, however, sustain the examiner's rejection of claims 9-12.

We consider first the examiner's rejection of process claims 1-8 under § 103 over the combined teachings of Kobayashi and Janke. While Kobayashi discloses a process for protecting

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agricultural crops from freezing by applying a composition to the crop, the examiner appreciates that Kobayashi does not teach the claimed application of a fermented biomass material. The process of Kobayashi entails spraying a liquid aqueous solution or emulsion of waxes, or resins, or a combination of both to the agricultural crop. To remedy the deficiency of Kobayashi, the examiner cites Janke for its teaching of utilizing a fermented biomass material as a deicing or anti-icing composition for roads, bridges, runways, taxiways and other outdoor surfaces. Based on the Janke disclosure, the examiner concludes that it would have been obvious for one of ordinary skill in the art "to modify the method of Kobayashi by using a fermented biomass as the spray material as disclosed by Janke et al. so as to use material that is inexpensive and widely-available in large quantity" (page 4 of Answer, first paragraph). However, we agree with appellant that Janke's disclosure of treating inorganic, inanimate structures as roads and bridges with a fermented biomass material in order to prevent icing would not have provided the requisite motivation for one of ordinary skill in the art to use the fermented biomass material of Janke for treating living, organic material, such as the claimed agricultural crop. Appellant presents a persuasive argument that

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"[l]iving tissues are delicate structures and inherently require careful consideration in the selection and use of chemical freeze protectants" (page 10 of Brief, second paragraph). On this point, the examiner has not demonstrated that one of ordinary skill in the art would have had a reasonable expectation of effectively preventing freezing of an agricultural crop without damaging the crop during the application process. Stated otherwise, the examiner has not established that one of ordinary skill in the art would have had a reasonable expectation that fermented biomass material would not cause harm to an agricultural crop. Without the establishment of such a reasonable expectation of success, all that can be concluded from the present record is that it may have been obvious to try the fermented biomass material of Janke, which is taught to be effective on inorganic structures such as roadways, on a living agricultural crop. Manifestly, obvious to try is not the proper standard for establishing obviousness under § 103.

The examiner's rejection of composition claims 9-12 is another matter. The composition claims on appeal simply define a composition which includes a fermented biomass as an active ingredient, and appellant cannot deny that Janke, indeed, discloses a composition which includes a fermented biomass as an

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active ingredient. Since it is not necessary for Janke to disclose appellant's use for the fermented biomass composition, we find that Janke describes the claimed composition within the meaning of 35 U.S.C. § 102. The recited statement of intended use, i.e., "for the freeze protection of an agricultural crop," does not serve as a limitation which further defines the claimed composition. It is well settled that a prior art composition does not undergo a metamorphosis into a different composition when an applicant uses the prior art composition in a way not described in the prior art. In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Hence, since anticipation is the epitome of obviousness, we find that appealed claims 9-12 are obvious over Janke, considered alone. Moreover, we find that the claimed fermented biomass material is unpatentable over the admitted prior art found in the Background section of appellant's specification.

In conclusion, the examiner's rejection of claims 1-8 under 35 U.S.C. § 103 is reversed, whereas the examiner's rejection of claims 9-12 under 35 U.S.C. § 103 is affirmed. As a result, the examiner's decision rejecting the appealed claims is affirmed-in-part.

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

AFFIRMED-IN-PART

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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THOMAS A. WALTZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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LINDA R. POTEATE)	
Administrative Patent Judge)	

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