

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES V. STOUT

Appeal 2006-3386
Application 10/448,569
Technology Center 3600

Decided: March 12, 2007

Before STUART S. LEVY, ROBERT E. NAPPI, and LINDA E. HORNER,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

James V. Stout (“Appellant”) seeks our review under 35 U.S.C. § 134 of the Examiner’s final rejection of claims 3 and 4, the only claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

Appellant invented a method and apparatus for delivering more than one agent in sequence into burrows and runs in order to effectively eradicate gophers and other rodents (Specification 1: 9-11). Claims 3 and 4 are reproduced below.

3. A system for killing rodents, comprising:
 - a delivery orifice for placing into an underground tunnel used by the rodents;
 - a first delivery mechanism delivering a first substantially odorless gaseous mixture to and through the delivery orifice for a first period of time, the first mixture specifically chosen to render the gophers¹ unconscious, preventing the gophers in the tunnel from blocking the tunnel against further application of gaseous mixture; and
 - a second delivery mechanism delivering a second gaseous mixture to and through the delivery orifice for a second period of time, after the first gaseous mixture is delivered, the second gaseous mixture specifically chosen to kill the gophers rendered unconscious by the first gaseous mixture.

¹ We note that the reference to “the gophers” throughout the remainder of this claim lacks proper antecedent basis.

4. A method for killing rodents, comprising the steps of

(a) placing a delivery orifice into an underground tunnel used by the rodents;

(b) delivering a first substantially odorless gaseous mixture to and through the delivery orifice for a first period of time, the first mixture specifically chosen to render the gophers² unconscious, preventing the gophers in the tunnel from blocking the tunnel against further application of gaseous mixture; and

(c) delivering a second gaseous mixture to and through the delivery orifice for a second period of time after the first gaseous mixture is delivered, the second gaseous mixture specifically chosen to kill the gophers rendered unconscious by the first gaseous mixture.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

McQueen	US 4,594,807	Jun. 17, 1986
Chu	US 5,349,778	Sep. 27, 1994

The following rejections are before us for review.

1. Claims 3 and 4 stand rejected under 35 U.S.C. § 102(b) as anticipated by Chu.
2. Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as obvious in view of McQueen.

² We note that the reference to “the gophers” throughout the remainder of this claim lacks proper antecedent basis.

FIRST ISSUE

Appellant contends the Examiner erred in rejecting claims 3 and 4 as anticipated by Chu, because Chu does not disclose using a first treatment to render a gopher unconscious and using a second treatment, after the first, to kill the gopher (Br. 6). The Examiner found that Chu teaches using both freezing air and hot air from the same apparatus and that the hot air would render a gopher unconscious and the cold air would then kill the gopher (Answer 3-4). The issue before us is whether Appellant has shown that the Examiner erred in finding claims 3 and 4 anticipated by Chu.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Chu discloses using a vortex tube to provide lethal temperatures to destroy undesirable organisms such as insects, termites, mildews, or tumors in a human body (Chu, col. 1, ll. 11-16).
2. Chu recognizes that rodents have a normal temperature range within which they can survive and thrive and that temperatures appreciably outside of the normal range are lethal especially if they are maintained for a long period of time (Chu, col. 1, ll. 46-51).
3. Chu teaches that cold air can be used to cool down an enclosed infestation area 19 to a sub-freezing lethal temperature for a long enough period to exterminate objectionable organisms and hot air can be used to heat up an enclosed

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infestation area 20 to an elevated lethal temperature for a long span of time to eliminate undesirable organisms (Chu, col. 3, ll. 41-49).

4. Chu discloses a method of using cold air and hot air in sequence at the same infestation area for a long enough period to exterminate organisms at the infestation area (Chu, col. 4, ll. 47-49).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted).

ANALYSIS

Claims 3 and 4 require that a first gaseous mixture, specifically chosen to render rodents unconscious, is delivered through a delivery orifice for a first period

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of time, and after the first mixture has been delivered, a second gaseous mixture, specifically chosen to kill the rodents, is delivered for a second period of time.

Chu does not disclose delivering a first substantially odorless gaseous mixture that has been specifically chosen to render the gophers unconscious, as required by claims 3 and 4. Rather, Chu teaches applying the cold and hot air at lethal temperatures for a long enough period of time to exterminate the organisms (Findings of Fact 1-3). In particular, Chu discloses using a vortex tube to apply cold and hot air in sequence at the same infestation area for a long enough period to exterminate organisms at the infestation area (Finding of Fact 4). The Examiner asserts that hot air will render a gopher unconscious and cold air will then kill the gopher (Answer 4). We disagree. Chu clearly teaches applying hot air and cold air at lethal temperatures to kill the gopher, not simply render it unconscious (Finding of Fact 3). Further, it is not inherent from Chu that applying the hot air would necessarily result in the gopher becoming unconscious. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to show anticipation by inherency. As such, we find that Chu does not anticipate the invention of claims 3 and 4.

CONCLUSIONS OF LAW

We conclude that the Examiner erred in rejecting claims 3 and 4 under 35 U.S.C. § 102(b) as anticipated by Chu.

SECOND ISSUE

Appellant contends the Examiner erred in rejecting claims 3 and 4 as obvious in view of McQueen, because McQueen does not teach or suggest using a first treatment to render a gopher unconscious and using a second treatment, after the first, to kill the gopher (Br. 8-10). The Examiner found that McQueen teaches a first step of destabilizing the pest, wherein being unconscious is clearly being destabilized, and a second step of applying a toxic agent to kill the pests (Answer 4). The issue before us is whether Appellant has shown that the Examiner erred in finding claims 3 and 4 obvious in view of McQueen.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. McQueen discloses a crawling pest eliminator system for eliminating cockroaches, ants, and spiders from residential and commercial structures (McQueen, col. 1, ll. 6-10).
2. McQueen discloses that the system is used to apply a flushing agent from a first aerosol canister 70 onto a treatment surface to cause the crawling pests to be flushed out of cracks (McQueen, col. 2, ll. 55-62).
3. McQueen discloses that a vacuum motor 26 is then turned on to suction the pests up through a vacuum hose 46 into a recovery bag 30 (McQueen, col. 2, l. 62 – col. 3, l. 3).
4. McQueen discloses that after the pests and their eggs have been vacuumed up, the vacuum motor 26 is turned off and a spray gun 96 is used to

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spray a residual from aerosol canister 72 onto the treatment surface (McQueen, col. 5, ll. 9-15).

PRINCIPLES OF LAW

To determine whether a prima facie case of obviousness has been established, we are guided by the factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art.

In addition to our review of the *Graham* factors, we must also consider “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006). From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art – i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention – support the legal conclusion of obviousness. *Id.*

ANALYSIS

Claims 3 and 4 require that a first gaseous mixture, specifically chosen to render rodents unconscious, is delivered through a delivery orifice for a first period of time, and after the first mixture has been delivered, a second gaseous mixture,

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specifically chosen to kill the rodents, is delivered for a second period of time. The object of the invention of claims 3 and 4 is to immobilize the rodents so that they remain within their hiding places for application of the second gaseous mixture.

McQueen does not teach or suggest this two step process. Instead, McQueen teaches a system to flush pests out of cracks in surfaces so that the pests can be vacuumed into a recovery bag (Findings of Fact 1-3). McQueen teaches that after the pests and their eggs have been vacuumed up, a residual is then sprayed onto the treatment surface (Finding of Fact 4). McQueen does not teach or suggest applying a gaseous mixture to render the pests unconscious. Rather, McQueen desires the opposite result, *viz.*, that the pests will be left capable of movement so that they will leave their hiding places to be suctioned into the recovery bag. As such, we see no teaching, suggestion, or motivation in McQueen that would have led one having ordinary skill in the art to the system or method recited in claims 3 and 4.

CONCLUSIONS OF LAW

We conclude that the Examiner erred in rejecting claims 3 and 4 under 35 U.S.C. § 103(a) as obvious in view of McQueen.

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DECISION

The decision of the Examiner to reject claims 3 and 4 is reversed.

REVERSED

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