

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN HAWK and
JAMES MEADOWS

Appeal 2007-2209
Application 10/457,115
Technology Center 1700

Decided: October 31, 2007

Before PETER F. KRATZ, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-18, the only claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and REMAND.

Claims 1 and 10 are illustrative of Appellants' invention and are reproduced below:

1. A method for increasing irrigation efficiency, comprising, providing an anionic non-crosslinked polyacrylamide; and applying said polymer to established turf.

10. A method for increasing irrigation efficiency, comprising: providing an anionic non-crosslinked polyacrylamide; injecting said polyacrylamide into an irrigation system to provide a water/polyacrylamide mixture; and applying said water/polyacrylamide mixture to established turf.

The Examiner relies on the following prior art references to show unpatentability:

Miller	5,927,003	Jul. 27, 1999
Krysiak	US 2004/0069031 A1	Apr. 15, 2004

The Examiner made the following rejections:

1. Claims 1-8 and 10-18 under 35 U.S.C. § 102(b) as anticipated by Miller.
2. Claim 9 under 35 U.S.C. § 103 as unpatentable over Miller in view of Krysiak.

DISCUSSION

Appellants maintain that Miller's disclosure is limited to application of a polymer to dirt or other growth media in which seed can be planted, grow, and later become established. (App. Br. 2). Appellants contend that

method claims 1-8 and 10-18 do not read on Miller because the appealed claims require the step of applying a non-crosslinked polyacrylamide to *established* turf. (App. Br. 2; Reply Br. 1).

The Examiner contends that the invention of Miller “clearly relates to retaining an initial load of water that is significantly better than those of the prior art” (Ans. 6-7) and “clearly indicate that the retention characteristics are crucial to successful sod/turf production” (Ans. 7). According to the Examiner, there is “a reasonable basis to believe that the argued ‘applying a polymer to established turf’” is “inherently possessed in Miller.” (Ans. 7).

We are in agreement with Appellants that the embodiments described in Miller are limited to the application of polyacrylamide to a *growth medium*. See, e.g., Miller, Ex. 1-3; see also, col. 12, ll. 26-28 (“[r]etention characteristics are crucial to successful . . . sod/turf production.”). Miller discloses “the use of linear, non-gelling water-soluble polymers, copolymers, and the like to improve the availability of water and nutrients to green house and nursery vegetable, ornamental and floral stock during their growth and development, when added to *support materials* and used as part of the *growing media*.” (Miller col. 1, ll. 9-14). According to Miller, “[t]he water-soluble polymer can be dispersed within the *support material* by physical mixing. Alternatively, the polymer is dissolved in water and dispersed within the material as an aqueous solution.” (Col. 7, ll. 34-42) (emphasis added). While Miller teaches that seedlings may be planted in a growth medium containing the polymer (see, e.g., Ex. 6), Miller fails to expressly or inherently disclose application of the polymer to established

turf, i.e., application to a structure which includes a growth medium plants/grasses and roots¹.

Contrary to the Examiner's contention, a finding that Miller might appreciate that the disclosed polymer could be applied to established turf is not sufficient to show anticipation of the claimed step of actually applying the polymer to established turf. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) and *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (A reference is anticipatory within the meaning of § 102 if it discloses each and every claim limitation either expressly or inherently). Accordingly, we find that the Examiner failed to establish a prima facie showing of anticipation as to claims 1-8 and 10-18. Because the Examiner's rejection of claim 9 under 35 U.S.C. § 103 as unpatentable over Miller in view of Krysiak is based on the same, improper finding of inherency discussed above, we likewise reverse this rejection.

REMAND

Although we have concluded that the Examiner's findings are insufficient to establish unpatentability of the claimed invention under 35 U.S.C. § 102, it appears to us that the claims may be unpatentable under 35 U.S.C. § 103 in view of Miller. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007) (In an obviousness determination, the question to be asked is "whether the improvement is more than the predictable use of prior art elements according to their established functions."). Accordingly, we

¹ *See* The American Heritage® Dictionary of the English Language, Fourth Edition (2006).

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remand this case to the Examiner for further consideration of a rejection of claims 1-18 under 35 U.S.C § 103(a) as unpatentable over Miller.

The application is Remanded to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this Remand by the Board.

REVERSED AND REMANDED

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STINSON MORRISON HECKER LLP
ATTN: PATENT GROUP
1201 WALNUT STREET, SUITE 2800
KANSAS CITY, MO 64106-2150