

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(2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE R. TEUFEL

Appeal No. 1997-2632
Application No. 08/163,902

ON BRIEF

Before KIMLIN, JOHN D. SMITH, KRATZ, Administrative Patent
Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final
rejection of claims 1-6, which are all of the claims pending
in this application.

BACKGROUND

Appellant's invention relates to a method of making an

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insecticidal soil amendment and the product thereof. According to appellant (specification, pages 2 and 3), diatomaceous earth (diatomite) is a known insecticidal agent and is used for other purposes, such as a filtering agent in brewery processes. Appellant discloses that spent filtering aids containing diatomite that have been used in a brewery process are clogged with organic material, hence they are not useful in that form as a soil amendment (specification, pages 3 and 4). The subject matter at issue herein relates to (1) appellant's disclosed method of treating such used filtering aids via composting to cause decay of the retained organics in the used filtering aid and (2) the product of such treatment. The compost product mixture is allegedly useful as an insecticidal soil amendment. See pages 5 and 6 of the specification. An understanding of the invention can be derived from a reading of exemplary claims 1 and 3, which are reproduced below.

1. A method for making an insecticidal soil amendment, comprising:

mixing a used filtering agent and a compostable material, the filtering agent being characterized in that the filtering agent includes diatomite that has retained certain organic particulates resulting from a prior use of the filtering agent, and composting the mixture a sufficient

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amount of time to cause decay of both the compostable material and the organic particulates retained by the diatomite, the composted mixture together forming the insecticidal soil amendment, and further, the decayed organic particulates providing nutrients for the resultant soil amendment.

3. An insecticidal soil amendment, comprising:

raw ground tree bark; and

a used filtering agent comprised substantially of diatomite, the diatomite being of a type that has retained certain organic particulates resulting from prior use of the filtering agent, and wherein the bark and filtering agent have been mixed and composted together such that the organic particulates retained by the diatomite substantially decayed, thereby making the diatomite usable as an insecticidal agent and producing nutrients for the composted mixture, the composted bark and filtering agent together forming the insecticidal soil amendment.

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

De Boodt et al. (De Boodt) 1985	4,494,975	Jan. 22,
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Weiergraber 1992	5,145,492	Sep. 08,
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Allen, "A Natural Earth That Controls Insects", Organic Gardening

and Farming (1992), pages 50-56.

The examiner additionally relies on appellant's admissions set forth in Paper No. 4 at page 3, lines 6-13 and

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at page 5, lines 8-10 of the Brief. See, e.g., final rejection, page 3 and answer, page 4.

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Allen taken with De Boodt further in view of Weiergraber¹.

OPINION

We have carefully reviewed the specification, claims and applied prior art, including all of the arguments advanced by the examiner and appellant in support of their respective positions. In so doing, we find ourselves in agreement with appellant's viewpoint that the examiner has not established a prima facie case of obviousness of the claimed method. Accordingly, we will not sustain the examiner's rejection of claims 1, 2, 4 and 5 for essentially those reasons advanced by appellant. However, we will sustain the examiner's § 103 rejection as it pertains to product claims 3 and 6 for essentially those fact findings and conclusions set forth in the answer and as further discussed below. Our reasons

¹ The admissions, as noted above, are also relied upon by the examiner in the rejection at issue herein.

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follow.

Rejection of Claims 1, 2, 4 and 5

Allen discloses the use of diatomaceous earth as an insecticide for protecting crops. Allen teaches that the "razor-like construction of a diatomite fragment is just right to disrupt the life process of insects . . ." (carryover sentence, pages 50 and 52). De Boodt discloses the use of tree bark as a promoter for and part of a composting mixture. Weiergraber discusses the use of a high temperature treatment of spent filter aids such as diatomite that may have been used in a brewery to remove organic contaminants therefrom. The heat treated product of Weiergraber is disclosed as being reusable as a filter aid.

The examiner's position is that a skilled artisan would have been motivated by the combined teachings of the applied references including the admissions, of record, to not only use Weiergraber's disclosed heat treatment method for regenerating spent brewery filter aid diatomite by removing organics therefrom but to also use a composting method corresponding to the method claimed herein for treating such spent diatomite to recover an insecticidal soil amendment.

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The examiner reasons, in effect, that composting would have been recognized by one of ordinary skill in the art as an alternative to the heat treatment process of Weiergraber for treating the spent filter aid to remove organic contaminants and reclaim its insecticidal properties (answer, pages 4-6).

Appellant acknowledges that "it is known to mix natural diatomite with soil or compost to create an insecticidal soil amendment for flower or planting beds" (brief, page 5). However, appellant asserts that the combined teachings of the applied references would not have suggested the claimed composting method for recovering an insecticidal form of diatomite from used filter agent retaining organic particulates. Rather appellant urges that the applied references would have taught one of ordinary skill in the art a method of making "an insecticidal soil amendment from diatomite that was previously used as a filtering agent by first heating the diatomite to regenerate its effectiveness as an insecticidal agent, and then adding it to soil or compost to make the amendment" (brief, page 6).

On this record, we agree with appellant. In particular, we note that there is no suggestion in the teachings of the

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references that composting would be an effective method to reactivate spent diatomite filtering agent for any purpose let alone for use as an insecticidally active material as part of a soil amendment.

It is our view that the motivation for the examiner's stated rejection appears to come solely from the description of the method at issue in appellant's specification. Certainly, the examiner has not convincingly established how the applied references' teachings would have led a skilled artisan to the herein claimed process. Thus, the record indicates that the examiner used impermissible hindsight when rejecting the claims. See W.L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); In re Rothermel, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we will not sustain the examiner's rejection of method claims 1, 2, 4 and 5 for the reasons set forth above and as developed in appellant's brief.

Rejection of Claims 3 and 6

Our disposition of the examiner's § 103 rejection as applied to claims 3 and 6 is another matter. Since appealed

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claims 3 and 6 are in product-by-process format, certain principles of patent jurisprudence apply. We note that the patentability of a product is a separate consideration from that of the process by which it is made. See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). Moreover, determination of the patentability of a product-by-process claim is based on the product itself. See In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). In other words, the patentability of the product does not depend on its method of preparation. See In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). Hence, if the claimed product is the same as or obvious from a product of the prior art that is made by a different process, the claim is unpatentable. See In re Marosi, 710 F.2d 799, 803, 218 USPQ 289, 292-293 (Fed. Cir. 1983). If the prior art product appears to be substantially the same as the claimed product, the burden is on the applicant to establish with objective evidence that the claimed product is patentably distinct from the product of the prior art. See In re Brown, 459 F.2d at 535, 173 USPQ at 688.

Here, as noted above, appellant has acknowledged that "it

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is known to mix natural diatomite with soil or compost to create an insecticidal soil amendment for flower or planting beds" (brief, page 5). Moreover, the examiner has relied on appellant's admitted fact that tree bark has been used in combination with diatomite in a compost (final rejection, page 3 and answer, page 3).

Since claims 3 and 6 are drawn to a soil amendment product that contains diatomite and composted bark that appears to substantially embrace the admitted prior art diatomite/tree bark compost product, we agree with the examiner that a prima facie case of obviousness of the claimed product has been established by the examiner. We note that no convincing argument or evidence has been furnished by appellant establishing a patentable distinction between appellant's soil amendment product and that of the prior art. Consequently on this record, we shall affirm the examiner's § 103 rejection of claims 3 and 6.

CONCLUSION

To summarize, the decision of the examiner to reject

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claims 1, 2, 4 and 5 under 35 U.S.C. § 103 is reversed. The decision of the examiner to reject claims 3 and 6 under 35 U.S.C. § 103 is affirmed.

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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)	BOARD OF PATENT
JOHN D. SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
PETER F. KRATZ)	
Administrative Patent Judge)	

PFK:lmb

BRUCE A. KASER
MILLER, NASH, WIENER, HAGER & CARLSEN
4400 TWO UNION SQUARE
601 UNION ST.
SEATTLE, WA 98101-2352

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FINAL TYPED: