

THIS OPINION IS NOT BINDING PRECEDENT

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE C. BUTLER and IRWIN S. MORSE

Appeal 97-2232
Application 08/209,268¹

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFER and LEE, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

Upon consideration of applicants' APPEAL BRIEF (Paper 14)
and the EXAMINER'S ANSWER (Paper 15), there being no reply
brief, it is

¹ Application for patent filed 14 March 1994. The real party in interest is Morse Enterprises Limited, Inc.

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ORDERED that the examiner's rejection of claims 1-21 as being unpatentable under 35 U.S.C. § 103 over Grybek, Wagner and Campbell is reversed.

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The claimed methods calls for the use of an aqueous solution containing three elements comprising (1) a chelating agent, (2) humic acid and (3) an alpha-keto acid to combat plant infestation by fungus (claim 1) or insects (claim 13). The examiner found prior art references describing application of each of the three elements, some in combination with others, to plants for a variety of reasons. Based on the prior art the examiner reasoned that the claimed methods would have been obvious.

Our appellate reviewing court recently made the following observation in Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999):

There is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. The relevant inquiry is whether there is a reason, suggestion, or

motivation in the prior art that would lead one of ordinary skill in the art to combine the teachings of the references, and that would also suggest a reasonable likelihood of success. Such a suggestion or motivation may come from the references themselves, from knowledge by those skilled in the art that certain references are of special interest in a field, or even from the nature of the problem to be solved. The district court never identified the source of the various claim limitations in the prior art, much less a motivation, teaching or suggestion to combine them.

The examiner has not identified in the prior art where there is a reason, suggestion or motivation to make the claimed three-element composition and use it to combat fungus and insects in plants. In our view, the only reasonable suggestion on this record for making applicants' three-element composition and using it to combat fungus and insects in plants is found in applicants' specification. Accordingly, the examiner's rejection is based on impermissible hindsight and must be reversed.

REVERSED.

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	FRED E. MCKELVEY, Senior)
	Administrative Patent Judge)
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	RICHARD E. SCHAFER) BOARD OF
PATENT		
	Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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	JAMESON LEE)
	Administrative Patent Judge)

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cc (via First Class Mail):

BANNER, BIRCH, McKEE & BECKETT
1001 G Street, N.W.
Washington, D.C. 20001-4597

BANNER & ALLEGRETTI, LTD.
1001 G Street, N.W.
Washington, D.C. 20001-4597