

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SUSAN AJESKA, LAURENCE DON BELL,  
JAMES R. LUGG, ROBERT L. MANGAN, and KRISTA C. SHELLIE

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Appeal No. 2002-2145  
Application No. 09/113,808

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ON BRIEF

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Before GARRIS, OWENS, and DELMENDO, Administrative Patent Judges.  
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-9, which are all of the claims in the application.

The subject matter on appeal relates to a method for disinfecting insect pests in a citrus fruit which comprises

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placing the fruit in a gaseous atmosphere that comprises up to 0.05% oxygen by volume. Further details of this appealed subject matter are set forth in representative independent claim 1 which reads as follows:

1. A method for disinfecting insect pests in a citrus fruit with minimal adverse effect on desirable fruit quality comprising placing said citrus fruit infested with insect pests in a gaseous atmosphere that comprises up to 0.05% oxygen by volume, and is sufficient to maximize killing of said insect pests, with the balance inert gases, at a temperature in the range of about 14° C to about 18° C for a time in the range of about 16 [sic, 15]<sup>1</sup> days to about 21 days.

All of the claims on appeal stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Liston in view of Urushizaki and Florida Entomologist.<sup>2</sup>

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.

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<sup>1</sup> A comparison of amendment C (paper no. 13) with amendment B (paper no. 10) reveals that the appellants have inadvertently introduced an error into claim 1 by typing the number "16" rather than "15". This error has no impact on the issues before us particularly since the claim feature affected by this error has not been a subject of argument in the brief. In any event, the error should be corrected in any further prosecution that may occur.

<sup>2</sup> As indicated on page 6 of the brief, the appealed claims will stand or fall together. Therefore, in assessing the merits of the rejection before us, we will focus only on claim 1 which is the sole independent claim in this application. 37 CFR 1.192(c)(7) (2001).

OPINION

For the reasons set forth in the answer and below we will sustain this rejection.

The appellants argue that Liston is from a non-analogous art and accordingly that the rejection is improper for this reason alone. As the appellants appreciate, two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). According to the appellants, the Liston reference is neither from the same field of endeavor nor reasonably pertinent to the particular problem with which the appellants are involved. We cannot agree.

For the reasons expressed in the answer, we find that Liston is from the same field as the appellants' endeavor. The contrary view expressed in the brief and in the Staby and Shellie declarations of record is not well taken for a number of reasons.

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First, the appellants incorrectly restrict the Liston reference to disinfesting insect pests in agronomic commodities as opposed to horticultural commodities such as citrus fruit. As accurately noted by the examiner, Liston's disinfesting method is directed to food products generally. Although certain (but not all) of the food products expressly identified by patentee constitute agronomic commodities, this fact does not somehow restrict Liston's broad teaching. Similarly, the appellants inappropriately restrict the field of their endeavor. For example, the appellants restrict their field of endeavor not only to a method of disinfesting insect pests in citrus fruit specifically but also to such a method wherein the gaseous atmosphere comprises the here claimed amount of oxygen (e.g., see item 3 in the Staby declaration). In effect, the appellants appear to define this field as being limited to the specific method recited in appealed claim 1. It is simply improper and unrealistic for the appellants to artificially define their field of endeavor in such a restricted manner. From our perspective, the fields of endeavor represented by Liston and by the appealed claims are the same, namely, disinfesting insect pests in food products generally.

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In addition to the foregoing, we consider the Liston reference to be analogous prior art because, in our view, it is reasonably pertinent to the particular problem with which the appellants are involved. We find no persuasive merit in the appellants' argument that "Liston's 'particular problem' is not pest abatement in horticultural products such as citrus fruit" (brief, page 12). This is because the appellants again have been unduly restrictive in defining the particular problem with which they are involved. Unlike the appellants, we do not perceive the problem with which they are involved as being limited to pest abatement in horticultural products such as citrus fruit specifically. In this regard, it is clear from the subject specification disclosure that at least one of the particular problems with which the appellants are involved relates to the killing of insect pests without regard to the specific food product on which the pests are located. Certainly, this is logical since the method in question would be ineffective if it did not result in the pests being killed. Thus, based on logic alone, pest-kill would necessarily constitute the particular problem with which the appellants were involved, in the first

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instance, in developing the here claimed invention. Moreover, this conclusion is supported by the specification disclosure. This is because the first five of the eight specification examples (which form the basis of the here claimed invention) are focused solely on pest kill or mortality. Indeed, the pest mortality tested in examples 1 and 4 did not even involve fruit. Under these circumstances, it is apparent that pest-kill, by itself, constituted a particular problem with which the appellants were involved in developing their claimed invention.

For the reasons set forth above and in the answer, we are unconvinced by the appellants' argument that the Liston reference is from a non-analogous art.

We also are unpersuaded by the argument expressed in the brief and in the Staby declaration that an artisan would not have been motivated to combine the applied prior art in such a manner as to result in a method of the type encompassed by appealed claim 1. As explained in the answer, the artisan would have utilized Liston's method of disinfecting insect pests in food products generally for the purpose of disinfecting pests in citrus fruit specifically in view of the Florida Entomologist

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reference. Regarding this issue, the appellants seem to believe (see item 4 of the Staby declaration) that the pest abatement teaching in Florida Entomologist (e.g., see the last three paragraphs on page 544) is unrelated to citrus fruit. When read in context (e.g., see the first paragraph of the "Toxicity . . ." article in question which begins on page 543), however, this teaching plainly is in relation to fruit generally and therefore citrus fruit specifically.

Likewise, we fully share the examiner's reasoning and ultimate conclusion that an artisan, in practicing Liston's method on citrus fruit specifically, would have utilized temperatures within the here claimed range so as to maintain fruit quality pursuant to the teachings of Urushizaki. The appellants are incorrect in their belief that the aforementioned obviousness conclusion is not proper because "the Urushizaki patent says nothing about the abatement of pests of any kind in any food commodity" (Staby declaration, item 6). It is true that the Urushizaki disclosure is focused on conditions which maintain the quality of food such as citrus fruit without regard to pest abatement just as examples 6-8 of the subject specification are

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focused on food quality without regard to pest abatement. Nevertheless, an obviousness conclusion is appropriate for the simple reason that an artisan would have considered the maintenance of food quality pursuant to Urushizaki's teaching to be desirable in a method for disinfesting pests in food products such as citrus fruit.

It is here appropriate to express our observation that the appellants' arguments amount to an attack of the applied references considered individually. It is well settled, however, that one cannot show nonobviousness by attacking references individually where the rejection is based on a combination of references. In re Keller, 642 F.2d 413, 426, 208 USPQ 871, 882 (CCPA 1981). This because the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. Keller, 642 F.2d at 425, 208 USPQ at 881.

For the reasons discussed above and in the answer, it is our determination that the combined teachings of the references applied by the examiner would have suggested practicing Liston's method on citrus fruit specifically, in view of the of the Florida Entomologist reference, and at temperatures of the type

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taught by Urushizaki to maintain an acceptable level of fruit quality. The resulting method would have satisfied each of the argued requirements of appealed claim 1. In this latter regard, it is necessary to point out that the appellants have somewhat misconstrued the requirements of the appealed claims. More particularly, after noting that the gaseous atmosphere of the Florida Entomologist reference excludes oxygen, the appellants state "Applicants' claims, by contrast, call for a gaseous atmosphere that must contain some oxygen, though at a concentration no higher than 0.05% by volume" (brief, page 16). In response to this statement, we reiterate the examiner's correct observation that the appealed claim 1 language "up to 0.05% oxygen by volume" encompasses the complete absence of oxygen.<sup>3</sup>

The circumstances recounted above and in the answer lead to a determination that the reference evidence adduced by the examiner establishes a prima facie case of obviousness which the appellants have not successfully rebutted with argument and/or evidence of non-obviousness. See In re Oetiker, 977 F.2d 1443,

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<sup>3</sup>We additionally reiterate the examiner's correct point that Liston's teaching also would have suggested oxygen contents within the here claimed range.

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1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We shall sustain, therefore, the examiner's § 103 rejection of claims 1-9 as being unpatentable over Liston in view of Urushizaki and the Florida Entomologist reference.

The decision of the examiner is affirmed.

AFFIRMED

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
TERRY J. OWENS	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

BRG/vsh

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