

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YASUHIRO GODA

Appeal No. 1996-1240
Application 08/044,961¹

ON BRIEF

Before JOHN D. SMITH, OWENS and SPIEGEL, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 2 and 5. These are all of the claims remaining in the application.

¹ Application for patent filed April 8, 1993.

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THE INVENTION

Appellant claims a method for making a microorganism fertilizer, i.e., a fertilizer which makes microorganisms multiply faster. Appellant states that when the fertilizer is applied to soil, it causes phenomenal multiplication of fluorescent Pseudomonas which are contained in the soil and which break down environmental pollutants in the soil and significantly suppress the common scab of potatoes grown in the soil (specification, pages 2 and 4). Claim 2 is illustrative and reads as follows:

2. A method for manufacturing a microorganism fertilizer comprising the steps of adding medium-temperature and high-temperature Actinomycetes as seed bacteria to an organic substance, culturing, spreading and agitating said medium and high-temperature Actinomycetes and said organic substance in an isolated propagation bed to cause said medium-temperature Actinomycetes to multiply during an initial stage of culturing so that the multiplication of miscellaneous bacteria is partially suppressed, and then raising and maintaining a temperature of said organic substance at 40 to 63EC so that said high-temperature Actinomycetes are selectively cause to multiply.

THE REFERENCE

Pinckard et al. (Pinckard) 5,100,455 Mar. 31,
1992

THE REJECTION

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Claims 2 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pinckard.

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the aforementioned rejection is not well founded. Accordingly, we reverse this rejection.

Pinckard discloses a method wherein plant material having a 10:1 to 30:1 carbon:nitrogen ratio is composted to produce a microbially active humic substance which is mixed with chemically contaminated soil to bioremediate the soil (col. 4, lines 3-6; claim 1). The organisms in the compost include Actinomycetes (col. 5, lines 38-40). The soils to which the compost was applied by Pinckard include soils which contain, *inter alia*, sewage sludge (col. 8, lines 63-68).

The examiner argues that Pinckard's sewage sludge is equivalent to appellant's organic substance (answer, page 4). This argument is not well taken because appellant's culturing of the Actinomycetes takes place after the Actinomycetes have

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been added to the organic substance, whereas in Pinckard's method, the culturing takes place during the formation of the compost before it is applied to the sewage sludge-containing soil. The examiner

does not explain, and it is not apparent, where Pinckard discloses or suggests culturing Actinomycetes in the presence of an organic substance.

Pinckard does not state whether the Actinomycetes are medium or high temperature Actinomycetes. The examiner argues that Pinckard's Actinomycetes inherently are medium and high temperature Actinomycetes (answer, page 5). The examiner, however, provides no evidence or technical reasoning in support of this argument. When an examiner relies upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. &

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Int. 1990). Inherency "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." *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986).

The examiner argues that it is reasonable to conclude that as the temperature rises in the Pinckard method, the dominant species, which Pinckard states are Actinomycetes and Pseudomonas

(col. 5, lines 38-40), will be thermophiles which, the examiner asserts, have an incubation temperature of 50-60EC (answer, page 4). This argument is not persuasive because the examiner has provided no evidence or technical reasoning which shows that the temperature in Pinckard's method increases to 50-60EC. The examiner merely provides speculation, and such speculation is not a sufficient basis for a *prima facie* case of obviousness. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA

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1962).

For the above reasons, we find that the examiner has not set forth a factual basis which is sufficient to support a holding of *prima facie* obviousness of the method recited in either of appellant's claims 2 or 5. We therefore reverse the examiner's rejection.

DECISION

The rejection of claims 2 and 5 under 35 U.S.C. § 103 over Pinckard is reversed.

REVERSED

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JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
TERRY J. OWENS))
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
CAROL A. SPIEGEL)	
Administrative Patent Judge)	

TJO/pgg
Koda & Androlia
10100 Santa Monica Blvd.
Suite 2340
Los Angeles, CA 90067