

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte W. DUDLEY JOHNSON

Appeal No. 98-0002
Application 08/300,089¹

ON BRIEF

Before COHEN, PATE, and McQUADE, Administrative Patent Judges.
PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 14
through 28. These are the only claims remaining in the

¹ Application for patent filed September 2, 1994.
According to applicant, the application is a continuation-in-
part of Application 07/898,012, filed June 12, 1992, now
Patent No. 5,343,652, issued September 6, 1994.

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application.

The claimed invention is directed to a method for exterminating insect pests wherein the pests are hidden behind a laser permeable solid barrier. In one embodiment, the laser is projected directly through the solid barrier. In another embodiment, a hole is made in the solid barrier and a laser delivery device is inserted in the hole so that laser light can be introduced directly into a space behind the barrier where the pests are present.

Claim 14, reproduced below, is further illustrative of the claimed subject matter.

14. A method for exterminating pests hidden behind or within a laser-permeable solid barrier, which comprises scanning the barrier with a laser beam, thereby bathing the barrier with laser light having a power and wavelength sufficient to pass through the barrier without substantially damaging the barrier and sufficient to exterminate a pest hidden behind or within the barrier.

The reference of record relied upon as evidence of obviousness is the German reference:

Germany (German '389A) 3,825,389 February
1990²

²Our understanding of the German reference is via an English-language translation, a copy of which is present in

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the application file.

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THE REJECTION

Claims 14 to 28 stand rejected under 35 U.S.C. § 103 as unpatentable over the German '389A reference. Although the examiner admits that it is unclear whether the German '389A reference laser would work when passed through a wooden barrier, the examiner states "it would [sic] have been obvious to employ a laser that could be passed through a wooden barrier and refocused past the barrier to destroy pests on the opposite side of the barrier" (answer, page 3). With respect to claim 22 and the claims dependent thereon, while the examiner admits that the German reference does not disclose using the laser scanner through a hole made in the barrier, the examiner concludes that "it would have been obvious to hole [sic] a barrier to increase the power toward the target species" (answer, page 3).

OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have determined that the applied prior art does not establish a prima facie case of obviousness with respect to the subject matter on appeal. Accordingly,

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the rejection on appeal is reversed. Our reasons follow.

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We are in agreement with the examiner's finding that the German reference is silent with respect to using the laser to kill pests behind a solid barrier. In fact, there is not a scintilla of evidence in the German patent that a barrier is contemplated in the method disclosed therein. We note that the German reference is directed to killing swarms of locusts which swarms are present in the open air. Inasmuch as the examiner may not resort to speculation, unfounded assumptions or hindsight reconstruction to support deficiencies in the factual basis of a rejection under 35 U.S.C. § 103, see In re GPAC Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995), we are constrained to reverse the rejection on appeal as it rests on no factual basis we can ascertain.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
WILLIAM F. PATE, III)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	

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Administrative Patent Judge)

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