

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. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** ROBERT L. BILLMERS, BRUCE W. ASPLUND and DAVID F. HUANG

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Appeal No. 2001-2486  
Application 08/670,885

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HEARD: November 7, 2002

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Before LIEBERMAN, DELMENDO, and POTEATE, **Administrative Patent Judges**.

POTEATE, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1-4, 6, 16 and 18. Claims 7-12, 17 and 21-25 are also pending in the application. These claims stand objected to as dependent upon a rejected base claim, but have been indicated as allowable over the prior art. See Appeal Brief, Paper No. 30, received October 2, 2000, page 2, paragraph

Appeal No. 2001-2486  
Application 08/670,885

V; Examiner's Answer, Paper No. 32, mailed December 19, 2000,  
page 2, paragraph (3).

Claim 1 is representative of the subject matter on appeal  
and is reproduced below:

1. A hot melt composition comprising a starch, a plasticizer selected from the group consisting of a polyol and a polyacetic acid and essentially no water, the starch being present in an amount of less than about 30% by weight of the starch/plasticizer mixture, wherein the hot melt is food-grade.

The reference relied upon by the examiner is:

Grillo et al. (Grillo) 5,882,707 Mar. 16, 1999

#### **GROUND OF REJECTION<sup>1</sup>**

Claims 1-4, 6, 16 and 18 stand rejected under 35 U.S.C.  
§ 102(e) as anticipated by Grillo.

We reverse and remand to the examiner.

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<sup>1</sup> The final rejection of claims 1, 2, 7-8 and 16-18 under 35 U.S.C. § 102(b) as anticipated by Werner and of claims 3, 6 and 24 under 35 U.S.C. § 103 as unpatentable over Werner were withdrawn in view of appellants' amendment, Paper No. 21, received February 23, 2000. See Advisory Action, Paper No. 24, mailed March 17, 2000.

### DISCUSSION

Anticipation requires a disclosure, in a single prior art reference, of each element of the claims under consideration. **See W.L. Gore & Assocs. v. Garlock, Inc.**, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." **Trintec Indus. Inc. v. Top-U.S.A. Corp.**, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (citations omitted). The initial burden of establishing anticipation rests on the examiner.

In making a patentability determination, analysis must begin with the question "*what is the invention claimed?*" **Panduit Corp. v. Dennison Mfg. Co.**, 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir.) **cert. denied**, 481 US 1052 (1987). In the present case, the invention *claimed* is "a hot melt composition."

The examiner found that Grillo anticipates the claimed invention for the following reasons:

Appeal No. 2001-2486  
Application 08/670,885

Grillo et al. disclose a dry color concentrate. The concentrate comprises 12-100% carbohydrate and 0-81% plasticizer. The carbohydrate is selected from the group consisting of corn syrup solids, maltodextrin, tapioca dextrin, dextrose, sugar ect [sic]. . . ; a combination of carbohydrate can be used. The plasticizer includes glycerin. The concentrate can include colorants. The concentrate is used to coat food product. (see col. 2). The reference meets all the limitations of the cited claims. Since it is used to coat food product, it is an adhesive. The range of starch claimed falls within the range disclosed in the reference.

Office Action mailed April 22, 1999, Paper No. 17, paragraph bridging pages 2-3; see Final Rejection, page 2, paragraph 3. The examiner further maintains that because Grillo's concentrate is used to coat food products, "it inherently functions as an adhesive." Examiner's Answer, page 3.

According to appellants, Grillo cannot anticipate the invention because Grillo's concentrate is not a *hot melt* composition. Appeal Brief, page 5. In support of their position, appellants rely on the Rule 132 Declaration of Dr. Billmers (one of the named inventors) filed with appellants' amendment after final (see Paper Nos. 21 and 23). According to appellants, the data provided in Dr. Billmers' declaration demonstrates that a composition containing starch and glycerin as taught by Grillo forms a liquid mixture when formulated in

accordance with claim 1.<sup>2</sup> See **id.** Since the definition of a hot melt is "a thermoplastic material useful as an adhesive which is in the solid state at room temperature, but melts when the temperature rises" (Appeal Brief, page 5, citing page 1, lines 7-9 of the specification), Grillo's *liquid* concentrate cannot anticipate the claimed *hot melt* composition.

The examiner maintains that if the Grillo et al composition tested by Dr. Bilmers was not in a solid state and was not a hot melt, then the claimed composition cannot be in the solid state and cannot be a hot melt when formulated in accordance with claim 1 using 30% starch and 70% glycerin. **Id.**; see, **supra**, note 2.

We find the examiner's position more akin to the type of argument presented in a rejection under 35 U.S.C. § 112, first paragraph. However, enablement is not the issue before us. Rather, the issue is whether Grillo discloses a *hot melt* composition containing starch and glycerin in amounts which satisfy the claim 1 limitations. The test is not, as proposed by the examiner, whether Grillo teaches a composition comprising 30% starch and 70% glycerin.

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<sup>2</sup>Dr. Bilmers utilized a mixture of 30% starch, i.e., the maximum amount of solids recited in claim 1, and 70% glycerin. Appeal Brief, page 6.

Appeal No. 2001-2486  
Application 08/670,885

Contrary to the examiner, we find that appellants' evidence demonstrates that Grillo's dry color concentrate is not a *hot melt* composition as required by the claims when formulated using glycerin and starch in the amounts required by the claims. Accordingly, the rejection is reversed.

**REMAND TO THE EXAMINER**

This application is remanded to the examiner for action on the following matter:

37 CFR § 1.196(a) (July 2002) provides that "[t]he Board of Patent Appeals and Interferences, in its decision, may affirm or reverse the decision of the examiner in whole or in part *on the grounds* and on the claims *specified by the examiner* or remand the application to the examiner for further consideration."

(Emphasis added.) The examiner's rejection of claims 1-4, 6, 16 and 18 as anticipated by Grillo was based on Grillo's disclosure of a composition containing a starch and *glycerin*. As stated above, appellants have persuasively argued that Grillo does not anticipate the claimed invention when Grillo's composition is formulated using a starch and *glycerin*. However, Grillo also discloses a composition containing a starch and plasticizer (PEG

Appeal No. 2001-2486  
Application 08/670,885

8000) in amounts which fall within the limitations recited in claim 1. Specifically, Grillo teaches a *dry* concentrate containing 12% corn syrup solids (i.e., a starch which is present in an amount of less than about 30% by weight of the starch/plasticizer mixture) and 81% PEG 8000 (i.e., a plasticizer).

Grillo's requirement of a "dry" concentrate would appear to meet the claim 1 limitation requiring that the composition contain essentially no water. Further, Grillo's use of the dry color concentrate as a food coating meets the limitation that the composition is food-grade. Moreover, application of the composition by spraying to form a coating on a food product suggests that the composition is an adhesive. Accordingly, the examiner should revisit the issue of whether Grillo anticipates the claims in light of Grillo's example 14.

#### **SUMMARY**

The decision of the examiner is reversed.

The application is remanded to the examiner for action on the matter set forth above.

Appeal No. 2001-2486  
Application 08/670,885

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Eighth Edition, Aug. 2001), item (D)). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

**REVERSED & REMANDED**

PAUL LIEBERMAN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
LINDA R. POTEATE	)	
Administrative Patent Judge	)	

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Appeal No. 2001-2486  
Application 08/670,885

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