

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TESSEMA DOSHO SHIFFERAW
and YODIT G. WOLDE

Appeal No. 2003-1197
Application No. 09/699,218

ON BRIEF

Before OWENS, TIMM, and JEFFREY T. SMITH, *Administrative Patent Judges*.
JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal the decision of the Primary Examiner finally rejecting claims 1 to 3, 9 and 20.^{1, 2} We have jurisdiction under 35 U.S.C. § 134.

¹ In rendering our decision, we have considered Appellants' arguments presented in the Brief, filed July 8, 2002 and the Reply Brief, filed December 26, 2002.

² The Examiner has indicated that claims 4 to 8 and 10 to 19 have been cancelled and the subject matter of claims 21 to 25 was allowable. (Answer, p. 2).

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Kincaid et al. (Kincaid) 5,382,443 Jan. 17, 1995

Leach 5,612,074 Mar. 18, 1997

The Wiley Encyclopedia of Packaging Technology, (1986) pp. 218-21. (Wiley).

The Examiner has rejected claims 1 to 3, 9 and 20 as unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Kincaid, Leach and Wiley.³ (Answer, p. 3).

Appellants assert that each claim is separately patentable. (Brief, p. 2). We will consider the claims separately only to the extent that separate arguments are of record in this appeal. Note *In re King*, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983); 37 CFR § 1.192(c)(7)(1999).

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants concerning the above-noted rejection, we refer to the Answer and the Briefs.

DISCUSSION

The subject matter of the appealed invention relates to a food product comprising an admixture of barley, flax, teff, and a binder which holds the admixture together.

³ The Examiner has indicated that the double patenting rejection has been withdrawn. (Answer, p. 3).

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According to the specification, the food product is suitable for healthy snack foods that provide nutrients and extra energy. (Page 1). Suitable binders include corn syrup, honey, canola oil and ground sunflower seeds. (Specification, p. 3). Flax seeds are a source of Omega-3 fatty acid and essential nutrients including calcium, iron, niacin, phosphorous and Vitamin E. (Specification, p. 3). Barley contains 8 to 10 percent protein, 62 to 65 percent starch, 1 to 3 percent fat and 2 to 3 percent mineral water. (Specification, p. 4). Teff seeds are a source of calcium, iron, protein and niacin. (Specification, p. 3). Claim 1, which is representative of the claimed invention, appears below:

1. A food product comprising an admixture of barley, flax and teff, and a binder which holds the admixture together.

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellant in support of their respective positions. This review leads us to conclude that the Examiner's § 103 rejection is well founded. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984). We affirm.

Leach describes a nutrient fortified food product such as a non-cooked food bar. These food bars contain grain, nuts, dried fruit and a binder for holding the ingredients together. (Col. 1). Leach discloses the food bars are designed to provide acceptable

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nutrition including non-animal protein, simple and complex carbohydrates, antioxidants, essential fatty acids, amino acids and lecithin. (Col. 2). Suitable ingredients include barley and flax seed. (Col. 3). The food bars are held together by the use of liquid ingredients including naturally occurring syrup such as honey and vegetable oils such as canola oil. (Col. 4). Leach does not disclose the inclusion of teff.

Kincaid describes ready to eat nutritional cereals that include barley and grain products such as teff. (Col. 7).

The Examiner included the Wiley reference for disclosing vacuum packaging of food products.

The distinction between the subject matter of claim 1 and the invention of Leach is the inclusion of teff. From our perspective, the idea of using teff in forming the nutritional food snack bar of Leach flows logically from the known nutritional properties of teff, thus establishing a *prima facie* case of obviousness. When determining the patentability of a claimed invention which combines known elements, “the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. [Citations omitted].” *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

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Evidence of a suggestion, teaching or motivation to combine may flow from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. *See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). One of ordinary skill in the art would reasonably expect that the addition of teff to the snack bar of Leach would add the nutritional properties of teff to the food product, e.g., calcium, iron, protein and niacin. “For obviousness under § 103, all that is required is a reasonable expectation of success.” *In re O’Farrell*, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). In light of the foregoing and for the reasons expressed in the Answer, it is our determination that the Examiner has established a *prima facie* case of obviousness.

Claim 2 defines the food product by specifying the parts of some of the compositional components. A person of ordinary skill in the art would have recognized the suitable ratios for including the specific components in the food product. Further, a person of ordinary skill in the art would have recognized that the amount of the components contained in the food product would have an effect on the taste and nutritional properties of the food product.

Leach discloses the admixed dry ingredients of the food product are held together by use of liquid ingredients that include honey and canola oil. (Col. 4). This disclosure renders obvious the subject matter of claims 3 and 9.

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The Examiner relied on the Wiley reference for teaching the suitability of vacuum sealing a food product. The Appellants' discussion of claim 20 fails to address the Examiner's motivation for using the Wiley packaging process in the packaging of the Leach food product.

Based on our consideration of the totality of the record before us, having evaluated the *prima facie* case of obviousness in view of Appellants' arguments, we conclude that the subject matter of claims 1 to 3, 9 and 20 would have been obvious to a person of ordinary skill in the art from the combined teachings of the cited prior art.

CONCLUSION

The Examiner's rejections of claims 1 to 3, 9 and 20 as unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Kincaid, Leach and Wiley is affirmed.

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Time for taking action

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

TERRY J. OWENS
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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EDWARD S. WRIGHT ESQ.
FLEHR, HOHBACH, TEST,
ALBRITTON & HERBERT LLP
SUITE 3400 FOUR EMBARCADERO CENTER
SAN FRANCISCO, CA 94111-4187