

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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIA DOLORES MARTINEZ-SERNA VILLAGRAN,
JOAN CAROL WOOTEN, JIANJUN LI,
DONALD RAY PATTON and EILEEN MARIE BOYLE

Appeal No. 2004-2164
Application 09/553,894

ON BRIEF

Before WARREN, OWENS and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner in the answer and appellants in the brief, and based on our review, find that we cannot sustain the grounds of rejection advanced on appeal: appealed claims 1 through 5 and 7 through 15 under 35 U.S.C. § 103(a) as being unpatentable over Villagran et al. (Villagran); appealed claims 6 under 35 U.S.C. § 103(a) as being unpatentable over Villagran in view of Gisaw et al. (Gisaw); and appealed claim 3 under 35 U.S.C. § 112, second paragraph,

as misdescriptive and not further limiting appealed claim 2 on which it depends.^{1,2}

It is well settled that in order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) ("When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted.] This suggestion or motivation need not be expressly stated. [Citation omitted.]"); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988).

The claimed method for preparing a dehydrated product in appealed claim 1, on which the rest of the appealed claims depend, requires "forming a homogeneous wet mash," adding a material thereto, which can be a starch, that alters the content of free amylose or free amylopectin, and drying the "wet mash." The examiner submits that

[i]t would have been obvious that the dough, used to make the fabricated chips in [Villagran], is substantially equivalent to appellant's [sic] wet mash since the dough is composed of potato flakes and 46.5% added water, which is sufficient to prepare a wet potato mash in situ, and instant mashed potatoes are prepared by adding water to potato flakes. [Answer, page 3; see also page 4.]

Appellants submit that the "dough" on which the examiner relies is not disclosed by Villagran to be a "wet mash," contending that the only disclosure of a "wet mash" in the reference is prepared from cooked potatoes to which no starch has been added (brief, page 3).

We agree with appellants. We find that the dough disclosed by Villagran comprises a

¹ Appellee claims 1 through 15 are all of the claims in the application. *See* the appendix to the brief.

² Answer, pages 3-4.

number of “dry dough ingredients,” including added starch, which contain water and/or absorb water, and comprises up to about 46.5 wt.% of “added water” which is combined with the “dry dough ingredients” (e.g., col. 4, ll. 3-8, and cols. 10-11). Villagran teaches that “a loose, dry dough” is prepared by adding a “water pre-blend” of various materials to the dry “starch-based material mixture and emulsifier blend” in a mixer, and illustrates the preparation of “loose, dry dough” (e.g., (col. 13, l. 58, to col.. 14, l. 6, and col. 21, ll. 36-67).

We determine that the term “mash” in appealed claim 1 has the customary, dictionary definition of a mixture of starches or grains.³ However, the “mash” in claim 1 must be “wet,” which latter term has the customary, dictionary definition of “[c]overed or saturated with a liquid, esp. water; moistened[,] . . . [n]ot yet dry or firm; *wet paint*.”⁴

In comparing the claim term “wet mash” in appealed claim 1 with the “loose, dry dough” of Villagran, we find that the “dough” does not fall within the claim term. Indeed, the examiner has not established that one of ordinary skill in this art working within the disclosure of Villagran would have added the water pre-blend to the dry dough ingredients or mash in the mixer in such manner to as to result in forming a “wet mash.”

Accordingly, on this record, we determine that the examiner has not established a *prima facie* case of obviousness of the claimed invention encompassed by appealed claims 1 through 5 and 7 through 11 over Villagran alone within the meaning of § 103(a), and thus reverse this ground of rejection. We further reverse the ground of rejection of appealed claim 6 under § 103(a) on the same basis because Gisaw does not cure the deficiency that we find in Villagran with respect to the claimed method encompassed by this claim.

Considering now the ground of rejection of appealed claim 3 under § 112, second paragraph, the initial burden of establishing a *prima facie* case on any ground under the second paragraph of § 112 rests with the examiner. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), *citing In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (“As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of

³ *See, e.g., The American Heritage Dictionary, Second College Edition* 769 (Boston, Houghton Mifflin Company, 1982).

⁴ *Id.*, 1374.

unpatentability.”). In making out a *prima facie* case of non-compliance with this statutory provision on the basis that a claim is indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention, the examiner must establish that when the language of the claim is considered as a whole as well as in view of the written description in the specification as it would be interpreted by one of ordinary skill in the art, the claim in fact fails to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

We determine that appealed claim 3 further modifies appealed claim 2 on which it depends, by specifying a Markush group of materials which provide the required “a native starch or modified starch.” Contrary to the examiner’s position, we find no requirement in either of these claims, in appealed claim 1 on which claim 2 depends, or in any definition of the term “starch” in the written description in the specification, for a “pure starch,” and thus determine that one of ordinary skill in this art would not consider claim 3 to be misdescriptive. Indeed, we note that the members of the Markush group in claim 3 are not starches *per se* because they contain other compounds.

Accordingly, we reverse this ground of rejection.

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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PETER F. KRATZ)	
Administrative Patent Judge)	

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