

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AHMAD AKASHE
and
STEVEN E. HILL

Appeal No. 2005-2629
Application No. 10/377,474

ON BRIEF

Before KIMLIN, PAK and OWENS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-20.

Claims 1 and 13 are illustrative:

1. A method to reduce the rate of oxidation of omega-3 or omega-6 polyunsaturated lipids in an aqueous emulsion, the method comprising blending soy protein into the emulsion in an amount effective for slowing the rate of oxidative rancidity of the omega-3 or omega-6 polyunsaturated lipid in the emulsion.

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13. An aqueous emulsion comprising

an omega-3 or omega-6 polyunsaturated lipid; and

at least about 0.5 percent soy protein, the amount of soy protein in the emulsion effective for reducing the oxidation of the omega-3 or omega-6 polyunsaturated lipids by at least 8 times as compared to a control emulsion stored for about the same time and at about the same temperature with the same amount of omega-3 or omega-6 lipids, wherein the control emulsion does not have an oxidation stabilizer.

The examiner relies upon the following references in the rejection of the appealed claims:

Chang et al. (Chang)	5,077,069	Dec. 31, 1991
Cope et al. (Cope)	5,700,782	Dec. 23, 1997
Blauel et al. (Blauel)	5,536,523	Jul. 16, 1996

Appellants' claimed invention is directed to a method for reducing the rate of oxidation of omega-3 or omega-6 polyunsaturated lipids in an aqueous emulsion. The method entails adding an effective amount of soy protein to the emulsion. The claims are also directed to the stabilized emulsion itself. According to appellants, the claimed invention allows "for the formulation of food products containing healthful functional ingredients, such as the omega-3 or omega-6 polyunsaturated lipids, and have an extended shelf life that is feasible for commercial applications and consumption" (page 3 of principal brief, last paragraph).

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Appealed claims 1-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Cope. Claims 1-18 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cope in view of Chang. Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cope in view of either Blauel alone, or in further combination with Chang.

Appellants do not separately argue any of the claims on appeal. Accordingly, claims 1-18 stand or fall with claim 1, and claims 19-20 stand or fall together.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we find that the examiner's rejections are well-founded and in accordance with current patent jurisprudence. Accordingly, we will sustain the examiner's rejections for essentially those reasons expressed in the Answer, and we add the following primarily for emphasis.

We consider first the examiner's § 102 rejection over Cope. Appellants do not dispute the examiner's factual determination that Cope, like appellants, describes an aqueous emulsion comprising an omega-3 polyunsaturated lipid and soy protein, nor do appellants challenge the examiner's calculations which demonstrate that the emulsions of Cope comprise concentrations of

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the omega-3 polyunsaturated lipids and soy protein in amounts taught in the present specification.¹ Appellants' specification discloses that "the emulsion of the invention comprises from about 0.1 to about 50 percent polyunsaturated omega-3 or omega-6 lipids and from about 0.5 to about 5 percent soy protein" (see sentence bridging pages 4 and 5). Consequently, since Cope describes aqueous emulsions that comprise concentrations of omega-3 polyunsaturated lipids and soy protein that are disclosed by appellants to reduce the rate of oxidation of the lipids, we find it reasonable to conclude that the soy protein-containing aqueous emulsions of Cope reduce the rate of oxidation of the omega-3 polyunsaturated lipid component of the emulsion. It is well settled that when a prior art composition reasonably appears to be substantially the same as a claimed composition, it is eminently fair to place upon an applicant the burden of proving that the prior art composition does not possess characteristics attributed to the claimed composition. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

¹ Please see pages 10 and 11 of the Examiner's Answer.

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In the present case, while appellants make the argument that the emulsions of Cope contain components that are not recited in the appealed claims, appellants have advanced no compelling rationale, let alone objective evidence, which demonstrates that the soy protein of Cope would be rendered ineffective as an antioxidant by the components of the reference composition. As pointed out by the examiner, appealed claim 1 does not quantify the amount of reduction in the rate of oxidation. Moreover, the claims on appeal, by virtue of using "comprising," do not preclude the presence of additional components which are not recited. Since the USPTO does not have the facilities and wherewithal to test the properties of prior art compositions, it is fair to place upon appellants the burden of establishing that the emulsions of Cope do not exhibit a reduction in the rate of oxidation of the lipids due to the presence of the soy protein. Appellants maintain that the formulation of Cope is not identical with the composition of the appealed claims. However, it is not necessary that the compositions be identical in order to fairly place upon appellants the burden of demonstrating that the soy protein of Cope does not reduce the rate of oxidation of the omega-3 polyunsaturated lipid.

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Appellants also contend that "given the fact that soy protein is only an optional ingredient, such option suggests that the levels of the soy protein in Cope may not effect [sic, affect] the stability of the composition" (page 11 of principal brief, third paragraph). However, as noted by the examiner, Cope exemplifies an aqueous emulsion comprising soy protein.

Appellants rely upon Examples 3 and 4 of the present specification to demonstrate that soy protein does not exhibit an anti-oxidative effect in all compositions. Example 3 shows that soy protein has no anti-oxidative effect when added to bulk oil rather than an emulsion, whereas Example 4 "shows that the soy protein has limited antioxidative effect without naturally occurring isoflavones" (page 3 of Reply Brief, last paragraph). However, these examples are not probative to the issue of whether the soy protein of Cope exhibits an anti-oxidative effect on the disclosed aqueous emulsions which comprise omega-3 poly-unsaturated lipids.

Turning to the § 103 rejection of claims 1-18 over Cope in view of Chang, it logically follows that our rationale in support of sustaining the examiner's § 102 rejection over Cope is also applicable to affirming the examiner's § 103 rejection.

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Regarding the § 103 rejection of claims 19 and 20 over the combined teachings of Cope, Blauel and Chang, we agree with the examiner that Blauel evidences the obviousness of using soy protein in the claimed range of about 0.5 to about 5% of the emulsion. Blauel discloses concentrations of soy protein within the claimed range which stabilize an aqueous emulsion comprising nutritionally desirable omega-3 fatty acids. Accordingly, we concur with the examiner that one of ordinary skill in the art would have found it obvious to use the claimed amounts of soy protein in the aqueous emulsions of Cope for the purpose of stabilizing the emulsions. It is not necessary for a finding of obviousness that the prior art also teach the effect of reducing the rate of oxidation of the omega-3 polyunsaturated lipids. Appellants have not established that the prior art use of soy protein to stabilize the emulsion would not also bring about the anti-oxidant effect. Appellants' argument that Blauel does not teach that the soy protein isolate would be effective as an anti-oxidant does not address the thrust of the examiner's rejection.

As a final point, we note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected

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results, which would serve to rebut the prima facie case of obviousness established by the examiner.

In conclusion, based on the foregoing and the reasons well-stated by the examiner, the examiner's decision rejecting the appealed claims is affirmed.

AFFIRMED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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