

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte RANDALL S. BLAUN

Appeal No. 2005-1586
Application No. 10/317,530

ON BRIEF

Before WALTZ, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.
JEFFREY T. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 14, all of the pending claims. We have jurisdiction under 35 U.S.C. § 134.

OPINION

Appellant's invention relates to dry mix potato products and processes for preparing them. In one aspect, the invention provides a dry mix useful for preparing a low-carbohydrate potato product, comprising: dried potato and cauliflower. (Brief, pp. 2-3). Representative claims 1 and 2 are reproduced below:

1. A dry mix for preparing a low-carbohydrate potato product, comprising: dried potato and cauliflower.
2. A method for preparing the mix of claim 1 for serving by mixing with water to provide a suitable consistency for final preparation.

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

Cremer	3,987,210	Oct. 19, 1976
Bosley, Jr. et al. (Bosley, Jr.)	4,238,517	Dec. 09, 1980
Hamann et al. (Hamann)	4,293,582	Oct. 06, 1981
Fazzolare et al. (Fazzolare)	4,834,996	May 30, 1989
Pirrotta et al. (Pirrotta)	4,970,084	Nov. 13, 1990
Gagliardi et al. (Gagliardi)	5,955,130	Sep. 21, 1999

The Examiner entered the following rejections:¹

1. Claims 1, 4, 5 and 7-14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Gagliardi.

2. Claims 2, 3 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gagliardi as applied to claims 1, 4, 5 and 7-14 and further in view of Pirrotta, Fazzolare, Hamann, Cremer or Bosley.

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. Based upon our review we agree with the Examiner's obviousness determination.²

We start with the claim language. *Gechter v. Davidson*, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997); *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). In proceedings before the U.S. Patent and Trademark Office (USPTO), claims must be interpreted by giving words their broadest reasonable meanings in their ordinary usage, taking into account the written description found in the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed.

¹ The Examiner's reasons for rejecting the claims appear in the Office Action mailed May 29, 2003.

Cir. 1997)("[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification."); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.").

Applying these principles, we note that the subject matter of claim 1 is directed to a dry mix that is capable of preparing "a low-carbohydrate potato product." The specification discloses "[b]y the term 'low-carbohydrate' is meant an amount of a food in a 100 gram serving which supplies less than about one fourth of the daily recommended intake of carbohydrate for a low-carbohydrate diet. Generally, a 'low-carbohydrate diet' is defined as any diet that includes less than 100 grams of carbohydrate for an average person per day. Thus, all of the products of the invention will have carbohydrate in minor amounts, preferably in an amount of no more than 25 grams per serving." (Specification, pp. 4-5).

2 Appellant has not provided separate arguments for the appealed claims. Thus, we will limit our

However, the claimed invention does not specify the conditions that are required to transform the “dry mix” to a “low-carbohydrate potato product.” Thus, the subject matter of claim 1 is directed to a dry mix comprising dried potato and cauliflower.

The Examiner has determined that Gagliardi “discloses preparation of a dehydrated potato product, including potato powder and egg yolk (binder), which can also include cauliflower (Example 3, [Ex. 3] and Claim 8). The product can be shaped and heated and used as a filling or topping. It would have been obvious to select a mixture of potato and cauliflower as part of the final product to obtain the added benefits of both vegetables as well as simply depending upon consumer appeal and personal preference.” (Office Action mailed May 29, 2003, p. 3).

Appellant argues that “[t]he claims defining this invention have been rejected over Gagliardi, et al., alone or in combination with other references. However, none of these references taken in any possible combination address either the preparation of a low-carbohydrate potato product or Appellant's invention.” (Brief, p. 5).

discussion to claims 1 and 2 as representative of the rejected claims.

Appellant's argument is not persuasive. It is well known that an intended use of an old composition does not render the composition claim patentable. See *In re Pearson*, 494 F.2d 1399, 1403 [181 USPQ 641] (CCPA 1974); *In re Zierden*, 411 F.2d 1325, 1328, 162 USPQ 102, 106 (CCPA 1969). As stated above, the claimed invention is directed to a dry mix. Gagliardi is suggestive of a dry mix comprising potato and cauliflower. The claimed subject matter is not limited to a low carbohydrate product, i.e., the dry mix does not have to have low carbohydrate properties. The dry mix must be capable of being mixed with other ingredients to produce a low carbohydrate product. Appellant has not argued or directed us to evidence that establishes the product of Gagliardi is not capable of being mixed with components suitable for producing a low carbohydrate product.

Claims 2, 3 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gagliardi, in view of Pirrotta, Fazzolare, Hamann, Cremer or Bosley. We select claim 2 as representative.

Appellant traversed this rejection for the reasons presented in the discussion of the § 103 rejection over Gagliardi alone and because the secondary references do not allegedly supply the teachings missing from the Gagliardi reference. (Brief, p. 10). Specifically, Appellant argues that without the present

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invention teaching of how to modify the processes and formulations from among those known generally, to achieve a low-carbohydrate potato product, there would be no teaching at all of this basic feature of the invention. (Brief, p. 10).

Appellant's arguments are not commensurate in scope with the claimed subject matter. The subject matter of claim 2 is directed to a method of preparing the dry mix of claim 1. As stated above, the dry mix of claim 1 is not limited to having "low carbohydrate" properties. Gagliardi is suggestive of a dry mix comprising potato and cauliflower and thus is suggestive of a method of making such a dry mix. The addition of the secondary references does not detract from the teachings of Gagliardi.

Based on our consideration of the totality of the record before us, having evaluated the stated rejections in view of Appellant's arguments, we conclude that the subject matter of claims 1 to 14 is unpatentable under § 103 as stated in the Examiner's rejections.

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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)(1)(iv).

AFFIRMED

THOMAS A. WALTZ)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY T. SMITH)	
Administrative Patent Judge)	

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