

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ARTI BEDI  
and ELIZABETH F. BURGESS

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Appeal No. 2005-1598  
Application 10/103,162

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ON BRIEF

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

WARREN, *Administrative Patent Judge*.

*Decision on Appeal*

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 37, 39, 41 through 67 and 69, all of the claims in the application.

Claims 37, 43, 53, 64 and 67 illustrate appellants' invention of a packaged food product comprising a frozen dough or batter food product and a packaged topping composition, wherein the latter, at the stated conditions, is sufficiently fluid to allow the food product to be dipped into the topping and the topping adheres to the food product, and are representative of the claims on appeal:<sup>1</sup>

37. A packaged food product comprising, in combination:

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<sup>1</sup> We have copied these claims as they stand of record in the amendment of February 24, 2003, including the term "glycerine." We use the customary spelling "glycerin" in our opinion. "Glycerin" is synonymic with "glycerol." *See, e.g., The Condensed Chemical Dictionary* 502 (10th ed., Gessner G. Hawley, ed., New York, Van Nostrand Reinhold Company, 1981).

a frozen dough or batter food product; and

a packaged topping composition which if exposed to room temperature for a time taken to warm the frozen food product is sufficiently fluid that the topping composition can be applied to the warmed food product by dipping the warmed food product in the topping composition,

wherein the topping composition is sufficiently fluid at 32°F to allow the warmed food product to be dipped into the topping, and topping adheres to the warmed food product.

43. The packaged food product of claim 37 wherein the topping composition comprises fat, flavoring, water, high-fructose corn sweetener, and water-activity reducing agent.

47. The packaged food product of claim 37 wherein the topping composition comprises

from about 12 to about 20 weight percent fat;

from about 30 to about 60 weight percent flavoring;

from about 9 to about 22 weight percent water; and

from about 2 to about 30 weight percent high fructose corn sweetener; and

from about 1 to 15 weight percent glycerine.

53. A method of preparing a food product, the method comprising

providing a packaged food product comprising

a frozen food product; and

a topping composition which if exposed to room temperature for less than 5 minutes after removal from frozen storage is sufficiently fluid that the topping composition can be applied to the food product by dipping the food product in the topping composition;

warming the food product; and

dipping the warmed food product into the topping composition, wherein the topping composition is sufficiently fluid to allow the warmed food product to be dipped into the topping and topping adheres to the food product.

64. A packaged food product comprising, in combination:

a frozen dough or batter food product; and

a packaged topping composition which if exposed to room temperature for less than 5 minutes after removal from frozen storage, is sufficiently fluid to allow the food product to be dipped into the topping, and topping adheres to the food product.

and wherein the topping composition comprises

from about 12 to about 20 weight percent fat;

from about 30 to about 60 weight percent flavoring;

from about 9 to about 22 weight percent water; and

from about 2 to about 30 weight percent high fructose corn sweetener; and

from about 1 to 15 weight percent glycerine as water activity reducing agent.

67. A method of preparing a food product, the method comprising

providing a packaged food product comprising

a frozen dough or batter food product; and

a topping composition which if exposed to room temperature for a time taken to warm the frozen food product is sufficiently fluid that the topping composition can be applied to the food product by dipping the food product in the topping composition;

warming the food product; and

applying the topping to the food product by dipping the warmed food product into the fluid, whereby fluid topping adheres to the food product; and

wherein the topping composition comprises:

from about 12 to about 20 weight percent fat;

from about 30 to about 60 weight percent flavoring;

from about 9 to about 22 weight percent water; and

from about 2 to about 30 weight percent high fructose corn sweetener; and

from about 1 to 15 weight percent glycerine

wherein the topping is contained in a package of a size and shape that allows the food product to be dipped into the topping in the package.

The references relied on by the examiner are:

Ludder et al. (Ludder)	3,442,435	May 6, 1969
Scherwitz et al. (Scherwitz)	4,379,176	Apr. 5, 1983
Thota et al. (Thota)	6,203,828	Mar. 20, 2001

(filed Dec. 3, 1999)

The examiner has rejected appealed claims 37, 39, 41 through 48, 51 through 67 and 69 under 35 U.S.C. § 103(a) as being unpatentable over Scherwitz in view of Ludder (answer, pages 4-6), and appealed claims 48 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Scherwitz in view of Ludder as applied to claims 37, 39, 41 through 48, 51 through 67 and 69, further in view of Thota (answer, page 6).<sup>2</sup>

Appellants group the claims as claims 37, 39 and 41 through 52, claims 53 through 63, claims 64 through 66, and claims 67 and 69, stating that the claims in each group stand or fall

together with the independent claim in that group (brief,<sup>3</sup> pages 10). The first grouping of claims includes claims 49 and 50 which are separately rejected in the second ground of rejection. Appellants rely on the same arguments made with respect to the first ground of rejection in addressing the second ground of rejection, and accordingly, claims 48 and 50 stand or fall with the other claims in that group (*id.*, page 21). Thus, we decide this appeal based on appealed independent claims 37, 53, 64 and 67 as representative of the respective groups and the grounds of rejection. 37 CFR § 1.192(c)(7) (2003); *see also* 37 CFR § 41.37(c)(1)(vii) (September 2004).

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the answer and to the brief for a complete exposition thereof.

#### *Opinion*

Appellants call attention to our prior decision in appeal 2003-0632 entered in application 09/648,702 on May 29, 2003, and frame certain arguments here in view thereof (brief, e.g., pages 4 and 11-13). The present appealed claims differ from those before us in the prior appeal. Thus, while the same prior art is applied in the present and prior appeals, we must consider the limitations in the present appealed claims with respect to whether a *prima facie* case of obviousness has been established by the examiner and, if so, whether appellants have rebutted the same based on the record before us in this appeal. *Cf. In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976).

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported position advanced by the examiner that, *prima facie*, the claimed packaged food product encompassed by appealed claims 37 and 64 and the claimed method of preparing a food product with that packaged food product encompassed by appealed claims 53 and 67 would have been obvious over the teachings of Scherwitz to one of ordinary skill in

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<sup>2</sup> The examiner has withdrawn the ground of rejection under the judicially created doctrine of obviousness type double patenting because application 09/648,702 applied in the rejection is abandoned (answer, page 2). *See below* p. 4.

<sup>3</sup> We consider the brief filed February 5, 2004

this art at the time the claimed invention was made.<sup>4</sup> Accordingly, since a *prima facie* case of obviousness has been established by the examiner, we again evaluate all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellants' arguments in the brief and the evidence in the specification and in Declaration Under 37 C.F.R. § 1.132 of Mr. Kittleson (Kittleson declaration)<sup>5</sup> to the extent argued in the brief. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

In order to review the examiner's application of prior art to appealed independent claims 37, 53, 64 and 67, we first interpret these claims by giving the terms thereof the broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art in light of the written description in the specification unless another meaning is intended by appellants as established in the written description of the specification, and without reading into the claims any limitation or particular embodiment disclosed in the specification. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The plain language of claim 37 specifies a packaged product comprising any manner of frozen dough or batter product and any manner of packaged topping composition, wherein the topping composition contains any manner of ingredients to the extent that the composition is sufficiently fluid *at 32°F* so that the warmed food product can be dipped to any extent, however small, into such composition and the composition adheres to any extent, however small, to the warmed food product. Claim 43, dependent on claim 37, specifies that such a topping composition can comprise fat, flavoring, water, high-fructose corn sweetener, and water-activity reducing agent, and claim 47, similarly dependent, specifies weight percent ranges for the same ingredients, further specifying glycerin as the water-activity reducing agent. The term "water-activity reducing agent" is defined by appellants as a "humectant," and it is further disclosed that

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<sup>4</sup> A discussion of Ludder and of Thota is not necessary to our decision. *See In re Kronig*, 539 F.2d 1300, 1302-04, 190 USPQ 425, 426-28 (CCPA 1976).

such “ingredients are well known in the chemical and food processing arts,” and “can be any . . . ingredient . . . that . . . is able to reduce the freezing temperature of the topping” (specification, page 19).

The plain language of claim 53 specifies a method of preparing a food product from a packaged food product comprising any manner of frozen food product and any manner of packaged topping composition, wherein the topping composition contains any manner of ingredients to the extent that the composition is sufficiently fluid *after exposure to room temperature for less than 5 minutes after removal from frozen storage* so that the warmed food product can be dipped to any extent, however small, into such composition and the composition adheres to any extent, however small, to the food product. The ingredients in the topping composition are specified in claims 57 and 61, dependent on claim 53, in the same manner as in claims 43 and 47, respectively.

The plain language of claim 64 specifies a packaged food product comprising any manner of frozen dough or batter product and a packaged topping composition, wherein the topping composition contains the specified ingredients within the specified weight percent ranges, including glycerin as the water-activity reducing agent, to the extent that the composition is sufficiently fluid *after exposure to room temperature for 5 minutes after removal from frozen storage* so that the food product can be dipped to any extent, however small, into such composition and the composition adheres to any extent, however small, to the food product.

The plain language of claim 67 specifies a method of preparing a food product from a packaged food product comprising any manner of frozen dough or batter product and any manner of packaged topping composition, wherein the topping composition contains the specified ingredients, including glycerin as the water-activity reducing agent, within the specified weight percent ranges to the extent the composition is sufficiently fluid *after exposure to room temperature for a time taken to warm the frozen food product* so that the warmed food product can be dipped to any extent, however small, into such composition and the composition adheres to any extent, however small, to the warmed food product, wherein the package

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<sup>5</sup> The Kittleson declaration was originally filed in application 09/648,702 (*see above* p. 4) and was filed in the present application on July 14, 2003, the examiner admitting the declaration in the Office action mailed July 21, 2003.

containing the topping is of a size and shape permitting the food product to be dipped therein to any extent, however small.

The term “comprising” as used in the claims as a transitional term as well as to modify the contents of the packaged food product and the ingredients in the topping compositions, with its ordinary open-ended meaning, and thus, the claims encompass products and methods which include other elements and ingredients, limited only by the limitations with respect to the topping composition being “sufficiently fluid” for dipping the product and adhering to the food product as specified. *See generally, Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) (“The claimed composition is defined as comprising - meaning containing at least - five specific ingredients.”); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”).

We determine that food can be frozen by the consumer at 32°F (*see, e.g.*, specification, page 1, ll. 22-24; *cf.* page 6, l. 3, page 17, ll. 6-7, and page 19, ll. 24-25). Appellants disclose “room temperature (e.g., 25C)” (specification, e.g., pages 5 and 16), that is, for example, 77°F, and that “[t]he time taken to warm a food product to an eating temperature will vary depending on factors such as the composition and size of the food product and the method of warming” (page 16, ll. 27-29).

Based on this record, we determine that the temperature at which the topping composition must be “sufficiently fluid” after exposure to room temperature after removal from frozen storage for *less than* 5 minutes in claim 53 and *for* 5 minutes in claim 64 is no less than and generally, somewhat above 32°F. The temperature at which the topping composition is “sufficiently fluid” under the limitations of claim 67 is another matter. This is because the claim simply requires that the topping composition is exposed to room temperature for the time taken to warm the frozen food product without limitation as to warming time and means, and thus, includes the consumer merely placing the frozen food product and packaged topping composition on the countertop to warm to room temperature which can be 77°F. Thus, we interpret claim 67 to encompass methods wherein the specified topping composition has a temperature of 77°F.

We find that appellants further disclose that “[d]ipping can include simply bringing a food product into contact with a fluid topping” (specification, page 3, ll. 16-17). Thus, in the context of the language of the appealed claims, we interpret the term “dipping” to mean contacting the topping composition with the warmed food product at least to the extent, however slight, that the warmed food product is in sufficient contact with the topping composition such that some amount, however small, of the topping composition adheres to the warmed food product.

Turning now to Scherwitz, we find that the reference would have disclosed to one of ordinary skill in the culinary arts a frozen food product comprising a frozen dough product, such as a breakfast pastry product, and a packaged “icing” topping composition, wherein the “icing composition . . . has a substantially temperature independent viscosity (isoviscous) such that it will remain pliable and spreadable at conditions ranging from freezer conditions to room temperature,” and the “consumer or user” may thaw the food product and/or warm it in warming means (col. 1, ll. 6-18). The icing composition is placed on the warmed food product, and thus the composition is subjected to a wide variety of temperature conditions, from freezing to room temperature, and has the objective of being “soft and spreadable both at freezer conditions and which will also remain soft and spreadable but not too runny at room temperature and above” (col. 1, ll. 19-26, and col. 1, l. 61, to col. 2, l. 2). These conditions are taught to obtain where the icing composition has the “critical” ingredients in the “critical parameters” of 12-20 weight percent fat, 30-60 weight percent sugar, that is, flavoring, and 9-22 weight percent water, wherein the ratio of liquid oil to liquid oil plus shortening is 0.26 to 0.43:1, and further can contain additional ingredients, including corn syrup solids; the compositions having, among other properties, substantially temperature independent viscosity and “good cling to the underlying bakery product” (col. 2, l. 28, to col. 4, l. 51). In the Scherwitz Example, “[s]amples were stored at 0° F,” and “[t]hereafter, the samples were placed upon a warm raised donut for evaluation” by a “panel of skilled individual testers,” wherein “[i]t was compared with a control icing which was fresh” with respect to, *inter alia*, “Ease of Application,” with the result that “[o]n all significant characteristics, the product of the present invention, compared very favorably with a conventional control icing, even though the product . . . had been subjected to

drastic freeze/thaw cycles” (col. 5, lines 29-51). The testing temperature of 0° F is, of course, well below 32°F and indeed, room temperature of 77°F.

The icing composition of the Scherwitz Example includes the three critical ingredients of fat, including the ratio of kinds of fats, sugar and water in amounts falling within the prescribed ranges and fat ratios (specification Table, cols. 4-5). Also present are corn syrup solids, salt and liquid dextrose (*id.*), which the examiner finds to be “humectants which are water activity reducing” agents (answer, pages 5-6), and appellants disclose as much (specification, page 19). We find that the icing composition of the Scherwitz Example further includes “Invertose,” which is better known by its chemical synonym “invert sugar,” is a mixture of glucose and fructose, and is a well known humectant for foodstuffs, particularly confections.<sup>6</sup> *See In re Ahlert*, 424 F.2d 1088, 1091-92, 165 USPQ 418, 420-21 (CCPA 1970) (notice may be taken “of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute”).

The examiner submits that one of ordinary skill in this art would have obviously found in Scherwitz the teaching that topping compositions containing the specified ingredients in the amounts indicated and other ingredients, are “sufficiently fluid at 32 degrees F to allow dipping the food into the topping because the topping is pliable and spreadable at freezing temperature,” pointing out that “spreading and dipping are known alternative techniques for applying a topping composition to a food product,” such that the selection of the method of application would have been a matter of choice (answer, pages 4-5). The examiner further finds that the corn syrup solids, dextrose and salt in the Scherwitz Example composition are known “humectants which are water activity reducing agents” and that “[g]lycerine is a well known humectant,” thus concluding that the use of different humectants to perform that art-recognized function would have been obvious (*id.*, pages 5-6). The examiner also finds that if the package containing the icing permits the icing to be accessed by a utensil for spreading, the package obviously “allows for the dipping of the food product in the package” (*id.*, page 6).

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<sup>6</sup> *See generally*, *The Condensed Chemical Dictionary* 563 (10th ed., Gessner G. Hawley, ed., New York, Van Nostrand Reinhold Company, 1981); *McGraw-Hill Dictionary of Scientific and Technical Terms* 1047 (5th ed., Sybil P. Parker, ed., New York, McGraw-Hill, Inc. 1994).

Appellants submit that the Scherwitz “toppings are not necessarily formulated from the ‘same ingredients’ as Applicants’ toppings and do not necessarily have the same fluidity properties” (brief, page 13). Appellants argue that the claimed topping ingredients contain overlapping amount of the ingredients that Scherwitz teaches are “critical” to be pliable and spreadable at freezer conditions, and further contain “ingredients that cause the claimed toppings to be more fluid than the [Scherwitz] toppings,” contending that “[f]ormulations that include ingredients to achieve these fluidity properties are described in Applicants’ specification, but are not described or suggested by” Scherwitz (*id.*, pages 13-15). In this respect, appellants contend that the “specification starting at page 18, line 28, describes a topping that includes high fructose corn syrup and a water activity reducing agent such as glycerine to achieve the described fluidity properties” (*id.*, page 15).

Appellants further submit that evidence in the specification and the Kittleson declaration show that the Scherwitz toppings “do not necessarily have the same fluidity as Applicants’ toppings, and are not necessarily dippable,” contending that the reference does not disclose that the toppings are sufficiently fluid to be dippable at the temperatures specified by the claims, and thus, one of ordinary skill in this art following the reference “would not have necessarily arrived at a topping formulation that can be applied by dipping . . . at the claimed low temperature conditions” (*id.*; emphasis original; *see also* pages 18-21). Appellants allege that the evidence of record establishes that the toppings of Scherwitz “have significantly different low temperature fluidity properties compared to” the claimed toppings, and “are not necessarily dippable at reduced temperature, e.g., at 32°F” (*id.*, pages 15-16). Appellants point to the vanilla, chocolate and comparative topping compositions at specification pages 24-26, contending that the same contain “amounts of powdered sugar, water, and oil/shortening that fall with the [Scherwitz] ‘critical parameters’” but “have drastically different low temperature fluidity properties” as shown at page 26, noting that the claimed topping compositions contain “glycerine in combination with high fructose corn syrup” (*id.*, page 16).

Appellants contend that the “same point is evinced” by the Kittleson declaration in which it is reported that a claimed topping composition “exhibited a viscosity at 32F of approximately 162,000 centipoise” and “was capable of having a warmed food product dipped into the topping without mechanical scooping or spreading, so the food product displaces the fluid topping and

causes the fluid topping to flow around and coat the food product, i.e., the topping can be applied to the food product by ‘dipping’ the food product into the topping at 32F” (*id.*). Appellants point out that the tested Scherwitz “comparative” composition had “a viscosity at 32F of approximately 698,000 centipoise” and “was not capable of having a warmed food product dipped into the topping so the food product displaces the topping and coats the food product, i.e., the topping is not dippable at 32F” (*id.*, pages 16-17).

The examiner responds that “the claims do not recite any specific fluidity measurement,” and points out that the Scherwitz toppings “remain soft and spreadable even at freezing conditions” which are “a lower temperature than 32 degrees F” (answer, page 7). The examiner finds that the Scherwitz compositions contain water activity reducing agents as shown in the Example thereof which “contains 1.916 % corn syrup which is closed [*sic*, close] to about 2% as claimed[,] . . . .449% salt and 3.167 [%] dextrose[,] . . . the amounts fall within the range claimed” (*id.*, pages 7-8). The examiner submits that “[t]he measurement of fluidity is recited in relation to being capable of dipping and the [Scherwitz] topping is capable of being dipped at the temperature claimed because it is soft and pliable,” pointing out that “page 17 of the specification discloses, while dipping is preferred, the topping may also be applied by spreading” (*id.*, page 8).

The examiner finds with respect to the evidence at specification pages 24-26, that the same “only shows the difference in viscosity; there is no showing of a correlation between viscosity and the ability of being dipped into,” and since “[t]he claims do not contain any limitation on viscosity . . . [it] is not a point to be considered” (*id.*, pages 8-9). The examiner finds with respect to the evidence in the Kittleson declaration that “the declaration does not make any correlation between viscosity and the ability to be dipped into,” contending that the showing that the Scherwitz topping has a viscosity of 698,000 cps falls within the range of 500,000-10,000,000 cps disclosed at specification page 18 which allows “for application by dipping,” thus establishing that the Scherwitz “topping is capable of being dipped into” (*id.*, page 9). The examiner finds that the report in the declaration that “the dough product would become deformed upon attempting to dip into the Scherwitz composition” is incomplete because the declaration does not state “what deforming means and there is no showing of how the product is deformed,” and that “[t]here is no positive statement or showing that the dough product can not be dipped

into the Scherwitz composition” (*id.*). The examiner further finds that the evidence in the specification, and thus also in the Kittleson declaration which involves the same composition, is not commensurate in scope with the claims because there is no specifically claimed composition which corresponds to the ingredients of the tested compositions, including dextrose and other ingredients (*id.*, page 9).

We find substantial evidence in Scherwitz supporting the examiner’s position. We determine that Scherwitz would have taught to one of ordinary skill in the culinary arts the “critical” ingredients in the “critical” amounts along with other ingredients required to obtain icing compositions having the properties taught in the reference and applied to a warm dough product. Scherwitz would have taught that additional ingredients can be used in the icing compositions, as illustrated by the icing composition of the Example which was “stored at 0° F” and “[t]hereafter . . . placed upon a warm raised donut for evaluation.” Thus, Scherwitz would have reasonably taught that the disclosed icing compositions have “a substantially temperature independent viscosity” so as to be “pliable and spreadable” to warmed dough products at “freezing conditions,” including 0° F, and at “room temperature,” including 77° F, with “good cling to the underlying bakery product.”<sup>7</sup>

We recognize that Scherwitz would not have specifically disclosed that the icing compositions are “sufficiently fluid” at and somewhat over 32°F and at room temperature, including 77°F, such that the dough product is “dippable” therein with the composition “adhering” to the product to the extent required by appealed claims 37, 53, 64 and 67, as we have interpreted them above. We agree with the examiner that the application of a topping composition to a warmed dough food product or any other food product by dipping would have been merely an obvious alternative to the application by spreading the composition on the food product to the ordinary consumer, as appellants disclose (specification, page 17, ll. 16-19). As the examiner points out and we determined above, the claim limitations do not present a specific measure of the property of “sufficiently fluid” of the claimed topping compositions other than

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<sup>7</sup> It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, *see In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir.

the “dipped” and “adhering” limitations. Thus, the claim limitations do not reasonably appear to distinguish the claimed topping compositions from the icing compositions having the properties of “substantially temperature independent viscosity” and “pliable and spreadable” with “good cling” to the warmed dough product disclosed by Scherwitz and evinced in the reference Example by the testing of an icing composition after storage at 0° F with the reported results. Indeed, we find that the icing compositions having the properties taught by the reference reasonably appear to necessarily inherently permit the warmed dough product to be dipped therein so as to adhere thereto at and somewhat over 32°F and at room temperature, including 77°F, at least to the extent claimed even though the reference is silent with respect to this method of applying the icing composition to the dough product. *See In re Skoner*, 517 F.2d 947, 950-51, 186 USPQ 80, 82-83 (CCPA 1975) (“Appellants have chosen to describe their invention in terms of certain physical characteristics . . . . Merely choosing to describe their invention in this manner does not render patentable their method which is clearly obvious in view of [the reference]. [Citation omitted.]”).

With respect to the separately argued claims, we find that the icing compositions of Scherwitz reasonably appear to fall within the topping compositions encompassed by product claim 37 and method claim 53, neither of which specifies the ingredients of the topping composition. *See generally, Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1845-46 (Fed. Cir. 1989) (“That the ‘813 patent discloses a multitude of effective combinations does not render any particular formulation less obvious. This is especially true because the claimed composition is used for the identical purpose. [Citations omitted.]”). Indeed, the packaged food product comprising a frozen food product and a topping composition and the preparation of a food product therefrom disclosed in the Scherwitz Example reasonably appears to be identical to the claimed packaged frozen food product and the method of preparing a food product therewith encompassed by appealed claims 37 and 53. *See generally, In re Spada*, 911 F.2d 705, 708-09, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255-56, 195 USPQ 430, 433-34 (CCPA 1977).

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1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

We further find that the Scherwitz Example composition differs from the specified topping compositions of product claim 64 and of method claim 67 solely in that it contains invertose instead of glycerin, both humectants and thus, water activity reducing agents, as the amounts of fat, sugar as flavoring, water, high fructose corn sweetener, and the water activity reducing agent in the Scherwitz Example composition fall within the weight percent ranges specified in the claims. We agree with the examiner that one of ordinary skill in this art armed with the knowledge in this art with respect to humectants, would have modified the compositions of Scherwitz, including the composition of the Example, by using other known humectants, including glycerin, with and in place of the humectants used by the reference in following the teachings of the reference in the reasonable expectation of obtaining an icing composition having the properties taught by the reference. *See generally, 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.]”).

Thus, based on this evidence, we determined that one of ordinary skill in this art routinely following the teachings of Scherwitz would have reasonably arrived at the claimed packaged food products and methods of preparing a food product using such packaged food products encompassed by appealed claims 37, 53, 64 and 67, including each and every limitation thereof arranged as required by the claims, without recourse to the disclosure in appellants’ specification. Therefore, the burden falls upon appellants to establish by effective argument or objective evidence that the claimed products and methods encompassed by appealed claims 37, 53, 64 and 67 patentably distinguish over the packaged frozen food product taught in the Scherwitz Example even though the rejection is based on § 103. *Best*, 562 F.2d at 1255-56, 195 USPQ at 433-34 (“Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. *See In re Ludtke*, [441 F.2d 660, 169 USPQ 563 (CCPA 1971)]. Whether the rejection is based on ‘inherency’ under 35 USC 102, on ‘prima facie obviousness’ under 35 USC 103, jointly or alternatively, the burden of proof is the same,

and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. [Footnote and citation omitted.]"); *Skoner*, 517 F.2d at 950-51, 186 USPQ 80, 82-83; cf. *Spada*, 911 F.2d at 708-09, 15 USPQ2d at 1657-58 (Fed. Cir. 1990) ("The Board held that the compositions claimed by Spada 'appear to be identical' to those described by Smith. While Spada criticizes the usage of the word 'appear', we think that it was reasonable for the PTO to infer that the polymerization by both Smith and Spada of identical monomers, employing the same or similar polymerization techniques, would produce polymers having the identical composition.").

Furthermore, while the issue here has been framed by the examiner as one of obviousness under § 103(a), because it reasonably appears that the packaged frozen food product containing the icing composition disclosed and tested in the Scherwitz Example falls within appealed claims 37 and 53, such evidence establishes a lack of novelty of the claimed invention as encompassed by the appealed claims that is, of course, "the ultimate of obviousness." *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982) Thus, to the extent that the packaged frozen food product containing the icing composition disclosed and tested in the Scherwitz Example anticipates the claimed packaged frozen food product encompassed by appealed claims 37 and 53, the case of obviousness cannot be rebutted by evidence. *Fracalossi*, 681 F.2d at 794, 215 USPQ at 571.

We agree with the examiner that appellants have not carried their burden of patentably distinguishing Scherwitz. We do not agree with appellants contention that the compositions of Scherwitz are not necessarily formed of the same ingredients in the same amounts disclosed in the specification and specified in the claims. No ingredients are specified for the topping compositions of claims 37 and 53, and we find no basis in either of these claims or in the written description in the specification to read any limitation(s) respecting the presence of specific ingredients in particular amounts into these claims. The ingredients of the claimed topping compositions are specified only in claims 64 and 67, and the sole ingredient encompassed by these compositions that is not taught by Scherwitz is glycerin. This is because both the specifically claimed compositions and those of Scherwitz each have the same fat, flavoring and water ingredients in the same weight percent ranges disclosed by Scherwitz and specified in the claims to be "critical," and, as the examiner finds, Scherwitz discloses that high fructose corn

syrup can be present and illustrates its use in the Example composition in an amount falling within the claimed weight percent range which has a lower limit of “about 2” weight percent. We find that the humectants dextrose and invertose are present in the Scherwitz Example composition in amounts, separately and combined, falling within the weight percent range for “glycerine” in each of these claims. As we discussed above, the use of different humectants for the same purpose to obtain the same and similar results was within the ordinary skill in this art. Accordingly, appellants have not established by argument alone that the compositions with the attendant properties taught by Scherwitz, including that of the Example, would not be “sufficiently fluid” to permit “dipping” the warmed food product in the topping composition at the specified temperature and the topping composition “adhering” thereto to the extent claimed.

Turning now to the evidence relied on by appellants, the evidence in the specification and the declaration is based on the same first inventive composition at specification page 24 and the comparative composition representing Scherwitz at specification page 25, with the evidence in the specification further including the second inventive composition at specification page 25 which is not in the declaration.<sup>8</sup> These three compositions were compared with respect to viscosity at 0°F with the results reported at specification page 26 (*see* page 25, ll. 4-8), which, as the examiner finds, is not accompanied by an explanation correlating the results with the requirements in the claims with respect to “sufficient fluidity” as defined by “dipping” and “adhering” at and slightly above 32°F and at 77°F, there being no limitation with respect to viscosity in the claims.

The first invention composition and the comparative composition representing Scherwitz are compared in the declaration with respect to viscosity at 32°F with the results reported at ¶ 6. The two compositions were further compared with respect to “sufficient fluidity.” In this latter respect, the declaration includes the visual observation that, at 32°F, the first inventive composition allows “a relatively soft dough product to be dipped into the low viscosity, fluid topping, such that the topping flows and coats the dough product and adheres to the dough product, without damaging the dough product” while the composition representing Scherwitz “is not ‘dippable’ as described and claimed” (¶¶ 5. and 7.). The declaration includes the further

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<sup>8</sup> Appellants do not rely on Examples 3 and 4 at specification page 25.

visual observation that the composition representing Scherwitz “was not of sufficiently low viscosity and fluidity to be applied to a soft dough product by dipping” and in “attempting to dip the dough product . . . the dough product would become deformed . . . [and] [t]he topping did not flow and did not coat the dough product” (¶ 8.). On this basis, declarant Kittleson concludes that Scherwitz “does not describe how to make a topping composition that is dippable as described and claimed” (¶ 10.), and opines “that one of skill in the food topping art would not have found it obvious to prepare a dippable topping formulation, as described and claimed” (¶ 11.).

We do not agree with appellants that the evidence in the specification and in the Kittleson declaration establishes that the icing compositions of Scherwitz do not have “sufficient fluidity” as claimed. Appellants have the burden to submit an explanation or evidence with respect to the practical significance of the results shown vis-à-vis the teachings of Scherwitz and why the results would have been considered unexpected. *See generally, In re Geisler*, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997); *In re Merck*, 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed. Cir. 1986); *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985); *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972); *In re D’Ancicco*, 439 F.2d 1244, 1248, 169 USPQ 303, 306 (1971). This burden is not met by declarant’s opinion with respect to the teachings of the entirety of Scherwitz based on a comparison which does not represent the sole illustrative Example composition and the teachings presented in this respect, *see Lindner*, 457 F.2d at 508, 173 USPQ at 358 (“[M]ere conclusory statements in the specification and affidavits are entitled to little weight when the Patent Office questions the efficacy of those statements. [Citations omitted]”), and certainly with respect to the ultimate legal issue of obviousness in this case, which is entitled to no weight. *See In re Reuter*, 651 F.2d 751, 759, 210 USPQ 249, 256 (CCPA 1981).

The significant differences between the first inventive composition and the composition representing Scherwitz in the declaration and the specification are, respectively, 15.72 and 14.68 weight percent fat, although the ratios 0.3715:1 and 0.3713:1 are the same; 44.92 and 59.99 weight percent sugar (flavoring); 13.93 and 12.27 weight percent water; 9.91 and 3.25 weight percent high fructose corn syrup (HFCS); 12.35 and 5.54 weight percent total corn syrup (HFCS and corn syrup solids (CSS)); 5.00 and *no* weight percent glycerin; and 20.27 and 8.28 weight

percent total humectants (HFCS, CSS, dextrose, salt glycerin), the differences in total humectants being greater than the presence and absence of glycerin. We find that the second inventive composition in the specification has some minor differences in ingredients compared with the first inventive composition because the second inventive composition further contains 3.37 weight percent cocoa, and otherwise contains significant differences in the same respects with the comparative composition representing Scherwitz.

We find no disclosure in the specification and in Scherwitz which accounts for these significant differences in amounts of ingredients. As the examiner points out and we found above, both the inventive compositions and the composition representing Scherwitz contain the same “critical” ingredients of fat, including the ratio of kinds thereof, sugar and water in the same “critical” weight percent ranges taught by Scherwitz to be critical to obtaining a substantially temperature independent viscosity topping composition that will remain pliable and spreadable and cling to the warmed food product at 0°F to room temperature, even with additional ingredients which can be included as shown by the Scherwitz Example composition. We further find no explanation or evidence with respect to the practical significance of the differences in amounts of ingredients in the testimony of declarant Kittleson.

With respect to appealed claims 37 and 53, as the examiner points out, these claims do not specify any ingredients for the claimed topping compositions and thus, the composition representing Scherwitz *per se* meets the limitations of these claims if it is “sufficiently fluid” as claimed, notwithstanding the significant differences in the amounts of ingredients, including the presence and absence of glycerin, and the differences in performance of the first inventive composition vis-à-vis the performance of the composition representing Scherwitz as reported at specification page 26 and by declarant Kittleson.

We refer to our previous findings and discussion of the results reported at 0°F in the specification (*see above* p. 16). We agree with the examiner that the declaration provides no correlation between the viscosity measurements and the reported visual observations with respect to dipping “the relatively soft dough product” into the topping compositions at 32°F, and that viscosity is not a claim limitation. We further find in the declaration no correlation between the visual observations and the claim limitations with respect to “sufficiently fluid” for “dipping” the warmed “product” into the topping composition to any extent and the composition “adheres”

to the warmed “product” to any extent at or somewhat above 32°F, as we have interpreted these limitations above. Indeed, claims 37 and 53 do not require that the “product” must be a “relatively soft dough product” and that the topping composition “flows and coats the dough product and adheres to the dough product, without damaging the product” at that temperature. In these respects, we note the examiner’s finding that the viscosity reported for the comparative composition representing Scherwitz falls within the viscosity range disclosed for the claimed compositions at 32°F in the specification. We find no evidence that the same differences between the inventive composition and the composition representing Scherwitz would not obtain at room temperature, including 77°F.

Thus, on this record, in the absence of an explanation or evidence with respect to the practical significance of the results shown vis-à-vis the teachings of Scherwitz and why the results would have been considered unexpected in the context of the limitations of the appealed claims, we find that the evidence fails to establish that the claimed packaged food product containing a frozen food product and a packaged topping composition and the method of preparing food product therefrom encompassed by claims 37 and 53 exclude a packaged food product containing a frozen food product and a packaged topping composition and the method of preparing a food product therefrom within the teachings of Scherwitz and the Scherwitz Example.

With respect to appealed claim 63 and 67, which specifies weight percent ranges for the composition ingredients, fat, sugar as flavoring, water, high fructose corn syrup and glycerin, as the examiner finds, the weight percents of fat, sugar as flavoring, water, and high fructose corn syrup in the composition representing Scherwitz fall within the claimed weight percent ranges for these ingredients. Thus, the sole difference in the compositions should be the presence and absence of glycerine. In view of the significant differences in the amounts of ingredients, the practical significance of which has not been explained on the record, we find that the evidence relied on by appellants does not establish a side-by-side comparison of the claimed and Scherwitz compositions which reflects the actual difference in performance based on glycerin alone. *See In re Dunn*, 349 F.2d 433, 439, 146 USPQ 479, 483 (CCPA 1965) (“[W]e do not feel it an unreasonable burden on appellants to require comparative examples relied on for non-obviousness to be truly comparative. The cause and effect sought to be proven is lost here in the

welter of unfixed variables.”); *see also In re Heyna*, 360 F.2d 222, 228, 149 USPQ 692, 697 (CCPA 1966). Furthermore, the evidence in the specification and the declaration at 32°F does not address the range of fluidity permitted by claim 67 which includes dipping the warmed product into a composition at room temperature, including 77°F, as we interpreted this claim above.

On this record, we further find that while the evidence establishes that a relatively soft dough product is easily dipped and coated in the first inventive composition containing glycerin but not in the composition representing Scherwitz which contains no glycerin, the evidence is not commensurate in scope with the claims. We find that while the composition used to represent the teachings of Scherwitz does fall within the teachings of the reference, the Scherwitz Example icing composition is in fact the closest prior art to each of claims 37, 53, 64 and 67, which composition was not compared, and indeed, it reasonably appears from the reported performance of this composition in the Scherwitz Example, that the same would perform in similar manner to the tested inventive compositions. This, of course, points to the difference between the claimed topping composition and the icing composition of the Scherwitz Example, which is the presence of the humectants glycerin and invertose, respectively. In view of this and additional differences in the weight percent of other ingredients, we find no evidence or scientific explanation establishing that the results reported for the tested composition representing Scherwitz alone and vis-à-vis the tested inventive compositions would obtain with respect to the icing composition of the Scherwitz Example. *See, e.g., In re Kulling*, 897 F.2d 1147, 1149-50, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990) (objective evidence directed to optional embodiments); *In re Clemens*, 622 F.2d 1029, 1035-36, 206 USPQ 289, 295-96 (CCPA 1980)(the temperature limitation was “very broad” and the “narrow range of data did not provide a basis “for predicting the relative performance” of the claimed and prior art resins “at temperatures at which the latter would be expected to perform well”); *Lindner*, 57 F.2d at 508, 173 USPQ at 358 (“The claims, however, are much broader in scope, covering mixtures of numerous compounds, and . . . “there is no ‘adequate basis for reasonably concluding that the great number and variety of compositions included by the claims would behave in the same manner as the [single] test composition.”).

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in Scherwitz in view of Ludder and as further combined with Thota with appellants' countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 37, 39, 41 through 67 and 69 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2005).

*AFFIRMED*

