

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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 CHARLES GAMBINO,  
MARK KING and  
MIKE BAUMAN

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Appeal No. 2006-1198  
Application No. 10/639,936

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ON BRIEF

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Before PAK, WARREN, and FRANKLIN, Administrative Patent Judges.  
FRANKLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 53 through 73. Claims 54, 60, 64, and 66 are representative of the subject matter on appeal and are set forth below:

54. A method for forming a baked freezer stable filled waffle comprising the steps of:
- a) providing an outer casing material of an uncooked batter having a first water activity level;
  - b) providing a fill material having a second water activity level, wherein the second water activity level is less than the first water activity level;

c) depositing a first portion of the uncooked batter onto a bottom plate of a waffle iron having a temperature of from 120 to 250 degrees Celsius;

d) allowing the first portion of the uncooked batter to partially cook and then depositing the fill material onto the partially cooked first portion of the batter;

e) depositing a second portion of the uncooked batter material over the fill material and closing the waffle iron; and

f) allowing the first and second batter portions to cook through thereby forming the baked freezer stable filled waffle.

60. The method as recited in claim 54 wherein step a) comprises providing a batter having: from 40 to 50% by weight water, from 35 to 40% by weight hard wheat flour, from 6 to 15% by weight shortening, from 3 to 7% by weight liquid whole egg, from 0.5 to 3% by weight whey, from 1 to 5% by weight granulated sugar, from 0.5 to 1% by weight baking soda, from 0.4 to 0.7% by weight sodium aluminum phosphate, from 0.25 to 1% by weight salt, and from 0.05 to 0.5% by weight monocalcium phosphate.

64. The method as recited in claim 54 wherein step b) comprises providing a fill material having from 35 to 80% by weight sweeteners and from 0.5 to 50% by weight of a fruit source.

66. The method as recited in claim 54 wherein step b) comprises providing a fill material comprising 35 to 80% by weight sweetener and at least one of water, a fruit source, a starch, a fat, a natural flavor, an artificial flavor, an emulsifier, an acidulant, a hydrocolloid gum, a salt, a coloring agent, an antimycotic preservative, a humectant, a fortificant, a protein, or mixtures thereof.

Claims 53 through 73 stand rejected under 35 U.S.C. § 103 as being obvious over Haynes Jacobson.

The examiner relies upon the following references as evidence of unpatentability:

Haynes-Jacobson

US 2002/0068115

June 6, 2002

Based upon the specific arguments regarding patentability of a particular claim provided by appellants on pages 15 through 18 of the brief, we consider claim 53 in this appeal.

We have carefully reviewed the evidence of record, the examiner's answer, and appellants brief. This review has led us to the following determinations.

## OPINION

### I. The 35 U.S.C. § rejection of claims 53 through 73

The examiner's position for this rejection is set forth on pages 3 through 6 of the answer. Beginning on page 15 of the brief, appellants discuss the limitations of independent claim 14. Appellants argue that the subject matter of their claims requires an outer casing material having a water activity level that is greater than that of the fill material. This is provided in steps A and B of claim 14. Appellants explain the benefits resulting from this claimed aspect of the invention. Brief, pages 15-16. Beginning on page 16 of the brief, appellants also argue that Haynes-Jacobson is directed to a method for forming a filled pancake. Appellants argue that the term "waffle" is only mentioned twice in the entire application. Appellants argue that their invention is directed toward a method forming a filled waffle which is a process completely unlike that for forming a filled pancake. Appellants argue that Haynes-Jacobson teaches that there are basically two methods disclosed for forming a filled pancake. In a first method two aliquots of batter are deposited onto a cooking surface and partially gelatinized. Another method, a single batter deposit is placed onto a cooking surface and after partial gelatinization a filling material is deposited onto the ungelatinized portion. Brief, pages 16-17. Appellants argue the only mention of water activity in Haynes-Jacobson is in paragraph 0077. Appellants argue there is no suggestion in Haynes-Jacobson for a method of forming a filled waffle wherein one creates another casing material having a higher water activity than that of a filling material as required by independent claim 54. On page 18 of the brief, appellants argue that their claimed invention is directed to a specific method for making a filled waffle and includes no more steps than that disclosed nor made obvious by Haynes-Jacobson. Appellants argue that the key among the steps is providing an outer casing material having a water activity than is higher than that of the filling material. In addition, appellants argue that their claimed invention requires a first deposit of an outer casing material into a waffle iron followed by partially cooking of the outer casing material. The filling material is then deposited over the uncooked portion of the outer casing material and a second deposit of outer casing material is placed over the filling material. The waffle iron is then closed and cooking is completed. Appellants argue that these steps are not disclosed or made obvious by Haynes-Jacobson.

At the bottom of page 4 of the answer, the examiner recognizes that Haynes-Jacobson does not specifically disclose the step of depositing a second portion of uncooked batter over the filled material where the water activity of the outer batter being more than the filling material. Hence, it is not disputed that Haynes-Jacobson does not specifically disclose an outer casing material having a first water activity level and a fill material having a second water activity level wherein the second water activity level is less than the first water activity level and depositing a second portion of uncooked batter material over the fill material enclosing the waffle iron. However, hence the rejection is not an anticipation rejection. This rejection is an obviousness rejection. We refer to the examiner's statement made on pages 5 through 6 of the answer. Therein, the examiner correctly states that Haynes-Jacobson does disclose that the food product can be waffles. See, for example, Paragraph 0037 of Haynes-Jacobson. The examiner points out that the one of ordinary skill in the art would recognize that a waffle is made in a close iron. Hence, the aspect of the appellants claimed invention is set forth in step e involving the closing of a waffle iron is self evidently suggested by Haynes-Jacobson.

The examiner also concludes that it is obvious to deposit a second layer of uncooked batter over the first layer to enclose the filling. The examiner also concludes that it would have been apparent to one of ordinary skill in the art that the second does not need to be precooked in making a waffle because a waffle is made in a closed iron and not on an open grill to a pancake. **See B.F. Goodrich Co. v. Aircraft Braking Sys, Corp.**, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1966)(“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.}”). **See, e.g., Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.**, 75 F.3d 1568, 1573, 37 USPQ 1626, 1629-30 (Fed. Cir. 1996)(“In this case, the reason to combine [the references] arose from the very nature of the subject matter involved, the size of the card intended to be enclose.”); **In re Gorman**, 933 F.2d 982, 986-87, 18 USPQ2d 1885, 1888-89 (Fed. Cir. 1991)(“The extent to which such suggestion [to select elements of various teachings in order to form the claimed invention] must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the applicant's invention.”);

**In re Dow Chem. Co.**, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)(“The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed process] should be carried out and would have a reasonable likelihood of success viewed in light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure.”); **In re Keller**, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)(“The test for obviousness is not whether the features of a secondary reference maybe bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the reference would have suggested to those of ordinary skill in the art.”); **see also In re O’Farrell**, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988)(“Obviousness does not require absolute predictability of success. ... There is always at least a possibility of unexpected results that would then provide an objective basis for showing the invention, although apparently obvious, was in law non obvious. [Citations omitted.] For obviousness under § 103, all that is required is a reasonable expectation of success. [Citations omitted.]”).

As made evident above, the reason provided by the examiner in the rejection need not be literally expressed in the applied references. The examiner concludes that it would be obvious to make the filling to have a water activity less than the outer batter to prevent water migration. The examiner states that Haynes-Jacobson recognizes the problem moisture migration and discloses that the filling with high water content results in soggy food product. The examiner states it would have been within the skill of one of ordinary skill in the art depending on taste, flavor, and texture desired regarding various compositions chosen for the waffle batter and filling. Answer, page 5.

It is true that Haynes-Jacobson teaches in paragraph 0037 that the moisture content of the batter dried portion of the food product is generally at least about 20% by weight preferably between about 25% by weight and 65% by weight. In paragraph 0077, Haynes-Jacobson states that a lower water activity filling can also have high bake stability and thus a longer shelf life.

Haynes-Jacobson states a filling with high water activity can cause moisture migration to the cross end result and a soggy food product thus comprising the product quality. We agree with the examiner that Haynes-Jacobson therefore suggests that the filling have a lower water activity. As stated by the examiner on page 5 of the answer, “[I]t would have been obvious to make the filling to have a water activity less than the outer batter to prevent water migration.”

We agree with the examiner’s statement made in the paragraph bridging pages 6 through 7 of the answer. The examiner states that a pancake is not cooked in a closed iron and as such, Haynes-Jacobson teaches that two aliquots of batter are partially cooked before they are brought together to make the filled pancake. However, the examiner states when making a waffle, it is not necessary to first make two separate partially cooked layers because when making a waffle a closed iron is used. Hence, the very manner in making a waffle suggests opposing a first partial of the uncooked batter onto the bottom plate of a waffle iron as required in appellants’ step c of claim 54, followed by allowing the first portion of that uncooked batter to partially cook and then depositing the thin material on the partially cooked first portion of the waffle pattern. Thereafter, depositing a second portion of the uncooked batter material over the film material enclosing the waffle iron would be readily apparent as stated by the examiner on page 7 of the answer. The examiner states that two layers are to be partially cooked before putting them together would require an extra waffle iron and extra time that is not needed in making the waffle because the waffle is not cooked on an open surface like a pancake. The examiner states that it was logical reasoning to deposit a first portion of uncooked batter in a waffle then allowing that first portion of the uncooked batter to partially cook and then depositing the film material onto the partially cooked first portion of the batter all by depositing a second portion of the uncooked batter between over the fill material and closing the waffle iron. What the examiner is stating page 7 of the answer is that the very nature of using a waffle iron suggests doing the steps as set forth in the grounds of claim 54. We agree.

Also, as stated on page 8 of the answer, the examiner states that he recognizes Haynes-Jacobson does not disclose some of the steps claimed but that the steps would have been obvious to one of ordinary skill in the art and viewing the teachings of Haynes-Jacobson and the general knowledge in the art about cooking pancakes and waffles. The examiner states that the cooking

of a waffle in a waffle iron is well known in the art and to arrive of the cooking of the two aliquots of batter at separate times to form a filled waffle product would have been obvious as explained above. The elevation to form a filling having water activity that is lower than the outer batter casing would have been obvious to one of ordinary skill in the art in view of the teachings of Haynes-Jacobson. We agree.

We note that we need only to consider claim 54 in this appeal because appellants' specific arguments as set forth on pages 15 through 19 are directed to claim 54. Appellants do not provide arguments regarding the patentability of any of the dependent claims. We note that appellants discuss the examiner's admission regarding certain dependent claims on page 17 of the brief, but do not provide arguments regarding why such claims are patentable with the applied art. Appellants' arguments specifically relate to claim 54.

## II. Conclusion

The 35 U.S.C. § 103 rejection of claims 53 through 73 as being obvious over Haynes-Jacobson is affirmed.



Appeal No. 1006-1198  
Application No. 10/639,936

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