

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 KAREL ABRAHAM KUIJPERS,
SERGEY MICHAILOVICH MEL'NIKOV, and ARJEN SEIN

Appeal 2006-1584
Application 10/139,118
Technology Center 1700

Decided: September 29, 2006

Before KIMLIN, WALTZ, and TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

and

ORDER REMANDING THE APPLICATION TO THE EXAMINER

Appellants appeal the rejection of claims 1-17, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to homogenized and acidified edible oil-in-water emulsion and a process of making the emulsion. Claims 1 and 10 are illustrative:

1. A homogenised and acidified edible oil-in water emulsion, comprising:
 - about 30 to about 75% (wt) edible oil,
 - about 0.5 to about 10% (wt) egg yolk derived emulsifier,
 - about 0.01 to about 1% (wt) casein salt that is water soluble above Ph [sic, pH] 5.5,
 - about 70 to about 25% (wt) water,
 - about 0.1 to about 20% (wt) edible acid,
 - said emulsion having a final Ph [sic, pH] of 3.0 to about 5.0 wherein homogenisation has been carried out before the emulsion is acidified.

10. A process for preparing a homogenised and acidified edible oil-in-water emulsion, the emulsion comprising:
 - about 30 to about 75% (wt) edible oil,
 - about 0.5 to about 10% (wt) egg yolk derived emulsifier,
 - about 0.01 to about 1% (wt) casein salt that is water soluble above about Ph [sic, pH] 5.5,
 - about 70 to about 25% (wt) water,
 - about 0.1 to about 20% (wt) edible acid, and
 - said emulsion having a final Ph [sic, pH] of about 3.0 to about 5.0,the process comprising the steps of:

- (a) preparing a mixture comprising edible oil, water phase, egg-yolk derived emulsifier, casein salt which is soluble above Ph [sic, pH] 5.5
- (b) homogenisation of the mixture
- (c) acidification of the mixture of step b).

The Examiner relies upon the following evidence to reject the claims:

Wander	GB 1,527,526	Oct. 4, 1978
Bialek	US 5,897,905	Apr. 27, 1999

Belle Lowe, *Experimental Cookery* 269-273 (2d ed. 1937)
21 C.F.R. §§ 169.3-169.150 (1982)

The Examiner rejects claims 1-10 and 13-16 under 35 U.S.C. § 103(a) as unpatentable over Wander in view of 21 C.F.R. §§ 169.3-169.150 and Lowe.¹ To reject claims 11, 12, and 17, the Examiner adds Bialek.

We sustain the rejection of claims 1-9 and 15, but we do not sustain the rejection of claims 10-14, 16, and 17. We further remand the Application to the Examiner for further consideration and action. Our reasons follow.

OPINION

Focusing first on claim 1, we note that this claim is directed to an emulsion containing specified ingredients and having a pH in a specified range. The claim also recites a particular process sequence requirement, i.e., homogenization is to occur before acidification.

The Examiner has found that Wander teaches or suggests an emulsion having all the claimed ingredients in amounts within or overlapping the claimed ranges and with a pH overlapping the claimed pH. With respect to claim 1, the disclosure in Wander is sufficient to establish a *prima facie* case of obviousness. A *prima facie* case of obviousness typically exists when the ranges of a claimed composition encompass and/or overlap the ranges disclosed in the prior art. *In re Geisler*, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997).

Appellants argue that Wander does not disclose the specific amount of casein salt employed in the presently claimed invention (Br. 9). We do not find this argument persuasive because Wander suggests using amounts in the

¹ The listing of claim 18 instead of 16 in the Answer is harmless error.

claimed range. Wander discloses including 0.3-4 wt%, preferably 0.5-2 wt% milk protein on page 1, lines 24-25 and then defines “milk protein” as preferably a casein salt, i.e., sodium or potassium caseinate at page 1, lines 51-54. Therefore, Wander suggests using amounts of casein salt (0.3-4 wt%, 0.5-2 wt%) overlapping the claimed amount of about 0.01 to about 1 wt%.

Appellants further argue that Wander does not disclose the addition of acid after homogenization (Br. 9). The process is somewhat different. Wander discloses fully emulsifying the oil within a water, milk protein, emulsifier, carbohydrate mixture, and then adding the acid. The mixture is then completely emulsified in a colloid mill or high pressure homogenizer (Wander p. 1, l. 92 to p. 2, l. 11). We agree that in Wander homogenization does not occur before the addition of acid, however, the ingredients and concentrations are the same or substantially the same. This is enough to establish a *prima facie* case of obviousness with respect to the emulsion product such that the burden is shifted to Appellants to show that, in fact, the difference in processing results in a patentable difference in the product. *See In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (A[D]etermination of patentability is based on the product itself.); and *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972) (In order to be patentable, a product must be novel, useful and unobvious. In our law, this is true whether the product is claimed by describing it, or by listing the process steps used to obtain it.).

We conclude that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 1-9 and 15, and that Appellants have not sufficiently rebutted this *prima facie* case of obviousness.

The process claims stand on a different footing. To meet the requirements of the claimed process, the homogenization must occur before the acidification. The Examiner finds that Wander discloses “[t]he concept of adding acid to the emulsion after homogenisation” in Example 1 (Answer 4). But, Example 1 does not disclose homogenization before addition of acid; all that is disclosed is fully emulsifying the oil. This emulsification seems to involve nothing more than stirring as disclosed on page 2, lines 4-6 of Wander. The Examiner does not explain how this or any other portion of Example 1 supports the finding that the concept of homogenizing before acidification is disclosed.

The deficiencies of Wander are not cured by 21 C.F.R. §§ 169.3-169.150 and Lowe. Those references are relied upon for other aspects of the claimed subject matter.

We conclude that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the subject matter of claims 10, 13, 14, and 16.

Turning to the rejection of claims 11, 12, and 17, we note that the Examiner relied upon Bialek in this rejection solely for a suggestion of using a high pressure homogenizer to perform homogenization. Wander also discloses using a high pressure homogenizer to completely emulsify the emulsion, but this complete emulsification occurs after the addition of acid. Therefore, adding the high pressure homogenizer of Bialek to perform the homogenization of Wander does not cure the deficiency of Wander as relied upon by the Examiner. In Wander, homogenization occurs after acidification, not before homogenization as required by the claimed process.

We conclude that, on this record, the Examiner has not established a *prima facie* case of obviousness with respect to claims 11, 12, and 17.

However, we note that Bialek discloses a step of homogenizing an emulsion before adding acid to form a food dressing. We, therefore, remand this Application to the Examiner to consider whether an obviousness rejection based on the combination of Wander and Bialek, along with any other relevant evidence, should be applied to claims 1, 10, and other claims dependent thereon. The relevant question is whether one of ordinary skill in the art would have found it obvious to have homogenized the emulsion of Wander before acidification based on the evidence in Bialek that similar emulsions were homogenized before acidifying.

CONCLUSION

In summary, we sustain the Examiner's rejection of claims 1-9 and 15, but do not sustain the rejection of claims 10-14, 16, and 17. We further remand the Application to the Examiner for consideration of a rejection. Therefore, we AFFIRM-IN-PART and REMAND.

In addition to affirming the Examiner's rejection of one or more claims, this decision contains a remand. 37 C.F.R. ' 41.50(e) (2005) provides that "[w]henever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review."

Regarding any affirmed rejection, 37 CFR ' 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board." The effective date of the affirmation is deferred until conclusion of the proceedings before the

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Examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the Examiner do not result in allowance of the Application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

This Remand to the Examiner pursuant to 37 C.F.R. ' 41.50(a)(1) (2005) is made for further consideration of a rejection. Accordingly, 37 C.F.R. ' 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this Remand by the Board.

AFFIRMED-IN-PART and REMANDED

clj

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