

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 THOMAS J. ERNST,
ROBERT S. LEPP, and JANET R. JACKSON

Appeal 2006-2115
Application 09/862,077
Technology Center 1700

Decided: November 30, 2006

Before GARRIS, WARREN, and JEFFREY T. SMITH, *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 1 through 3, 5 through 9, 11 through 16, and 19 through 22. Claims 17, 18, 24, and 25 are also of record and have been allowed by the Examiner (Answer 5).

The appeal was heard on October 17, 2006.

Claims 1, 3, 14, and 19, copied from the Claims Appendix to the Brief,¹ illustrate Appellants' claimed invention and are representative of the claims on appeal:

1. A method of inhibiting the growth of *Tyrophagus putrescentiae* in a stored, tallow coated pet food product, said method comprising the step of adding a *Tyrophagus putrescentiae* growth inhibiting amount of conjugated linoleic acid to the pet food product prior to storage.

3. A method in accordance with Claim 1 wherein adding conjugated linoleic acid to the pet food product comprises the steps of:

- adding conjugated linoleic acid to a meal pre-mix;
- extruding the conjugated linoleic acid containing premix to form the pet food product;
- cutting the pet food product to size; and
- drying the pet food product.

8. A method of inhibiting the growth of *Tyrophagus putrescentiae* in a stored, tallow coated pet food product, said method comprising the step of adding conjugated linoleic acid to the pet food product prior to storage so that the dry pet food contains at least 0.3% by weight conjugated linoleic acid.

14. A method of manufacturing a pet food product having storage inhibition against growth of *Tyrophagus putrescentiae*, said method comprising the steps of:

- adding conjugated linoleic acid to a meal pre-mix;
- extruding the conjugated linoleic acid containing premix to form the pet food product;
- cutting the pet food product to size;
- drying the pet food product; and
- coating the pet food with animal tallow.

19. An extruded farinaceous pet food product having storage retained inhibition against growth of *Tyrophagus putrescentiae* comprising a meal

¹ We consider the Brief filed February 3, 2006.

pre-mix and at least 0.3% by weight conjugated linoleic acid and a coating of at least 2% by weight animal tallow.

The references relied on by the Examiner are:

Franzen	US 4,282,254	Aug. 4, 1981
Wheeler	US 5,662,953	Sep. 2, 1997
Lowe	GB 2 355 382 A	Apr. 25, 2001

(Published United Kingdom Patent Application)

The Examiner has rejected appealed claims 1 through 3, 5 through 9, 11 through 16, and 19 through 22 under 35 U.S.C. § 103(a) as being unpatentable over Lowe in view of Franzen and Wheeler (Answer 3-5).

Appellants separately argue independent claims 1, 8, 14 and 19 as representative of the appealed claims (Br. 9, 11, and 14). Thus, we decide this appeal based on claims 1, 8, 14 and 19. 37 C.F.R. § 41.37(c)(1)(vii) (2005).

We affirm.

We refer to the Answer and to the Brief and Reply Brief for a complete exposition of the positions advanced by the Examiner and Appellants.

OPINION

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 methods and products encompassed by claims 1, 8, 14 and 19 would have been obvious over the combined teachings of Lowe, Franzen and Wheeler to one of ordinary skill in this art at the time the claimed invention was made. Accordingly, 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 Reply 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).

We agree with the Examiner's findings of fact from Lowe and Franzen² and conclusions of law based on this evidence (Answer 3-8), to which we add the following for emphasis.

The Examiner finds that Lowe would have disclosed a method of making a dog food composition by blending conjugated linoleic acid ("CLA") with other ingredients "in amounts from 3.5-7g/kg" (Answer 3 and 5-6, citing Lowe at Abstract). The Examiner determines that the addition of CLA in this manner by Lowe meets the requirement in the claimed methods to add CLA, including the claimed amount, to the same ingredients, holding that the claim requirement that CLA is added to inhibit the growth of *Tyrophagus putrescentiae* constitutes recognition of an additional beneficial result for an old process (Answer 3 and 5-6). The Examiner finds that Lowe coats formed dog food with "duck-based digest" for palatability, rather than a tallow coating in an amount as claimed, and that Franzen would have disclosed coating dog food with a coating containing 6% tallow (Answer 4 and 6-7, citing Lowe at Abstract and 3:1-9, and Franzen col. 4, ll. 55-66). On this basis, the Examiner determines that "it would have been obvious to coat the composition of Lowe with a known tallow coating in place of the duck digest" (Answer 4 and 6).

Appellants submit that one of ordinary skill in this art would not have found in Lowe and Franzen any teaching or suggestion to combine the same leading to the addition of a *Tyrophagus putrescentiae* growth inhibiting amount of CLA to a tallow coated pet food product as claimed without hindsight (Br. 12; Reply Br. 2). Appellants do not dispute that Lowe teaches a method which includes the step of adding CLA to pet food compositions, but point out that Lowe does not disclose either the claimed methods of manufacture and of use which include the specific step of adding CLA to pet food compositions for the purpose of inhibiting the growth of *Tyrophagus putrescentiae*, or a tallow coated pet food product containing this ingredient for the stated purpose (Br. 12-13; Reply Br. 2-3).

Appellants contend that Franzen adds an amino acid palatability enhancer to dog food, thus teaching away from Lowe which teaches weight-reducing dietary dog food compositions (Br. 13; Reply Br. 3-4). In this respect, Appellants argue that “it is likely that enhancing the taste of dog food . . . would cause an increase in a dog’s appetite” (*id.*). Appellants point out that Franzen does not teach adding CLA to the dog food composition and coating that composition with tallow (Br. 13; Reply Br. 2).

Thus, Appellants argue that Lowe and Franzen “are directed toward diverse products having different objectives” such that Franzen teaches away from Lowe, and therefore, would not have been combined by one of ordinary skill in the art to arrive at the claimed invention (Br. 13; Reply Br. 2-4).

² A discussion of Wheeler is unnecessary to our decision. See *In re Jones*, 958 F.2d 347, 349, 21 USPQ2d 1941, 1942 (Fed. Cir. 1992); *In re Kronig*,

The plain language of claims 1 and 8 encompass methods of inhibiting the growth of the mite *Tyrophagus putrescentiae* in any tallow coated pet food product, and that of claim 14 encompasses methods of manufacturing such a pet food product which has the property of inhibiting the growth of said mite. The method of claim 14 comprises at least the four specified process steps including the steps of adding CLA to any manner of a meal pre-mix and extruding the pre-mix. The claimed method further includes the step of coating the formed pet food with at least some amount of animal tallow. The same initial four steps specified for the method of manufacture of claim 14 can constitute the methods of claims 1 and 8 as evinced by claims 3 and 9, respectively dependent thereon. Indeed, the methods of claims 1 and 8 are directed to making tallow coated food products, and thus would include the further step of coating the formed pet food with animal tallow as in the method of claim 14.

The plain language of product-by-process claim 19 specifies any extruded farinaceous pet food product which comprises at least 0.3% by weight CLA and a coating containing at least 2% by weight animal tallow, and exhibits the property of inhibiting the growth of *Tyrophagus putrescentiae*. Thus, the claimed products include those prepared by the methods encompassed by claims 1, 8 and 14.

We find that Lowe would have disclosed to one of ordinary skill in this art a method of making a farinaceous dog food containing CLA, which can be present in the range of 3.5 to 7.0g/kg, comprising the steps of adding CLA to a meal pre-mix; extruding the pre-mix; cutting the extrudate to

539 F.2d 1300, 1302-04, 190 USPQ 425, 426-28 (CCPA 1976).

size; drying the cut extrudate; and coating the dried extrudate with a duck-based digest (Lowe, e.g., Abstract, 3:25-5:6, 5:17-26, and Example 1).

Lowe discloses that the dog food product increases the rate of passage of food through the intestine, thereby reducing caloric intake and thus, weight of the dog, and that the CLA “further increases this caloric restriction” (Lowe 3:25-4:6). Lowe further discloses that the dog food product should include nutritional ingredients “for proper maintenance of the dog” (Lowe 4:18-27). Lowe still further discloses that the dog food product must be palatable, and “a preferred way of achieving high palatability is to apply a duck-based digest as an outer coating to the product” (Lowe 3:1-9 and 4:15-17).

We find that Franzen would have disclosed that the palatability of a nutritionally complete dog food for dogs is increased by the use of one or more of eight specific L-amino acid as palatants which can be combined with other ingredients to form a coating composition that is applied to the surface of extruder-kibbled, that is, pelleted,³ nutritional dog food (Franzen, e.g., col. 2, l. 52, to col. 4, l. 10). In Franzen Example I, a coating comprising an L-amino acid and “6% of bleachable fancy tallow” is coated on extruder-kibbled dog food (Franzen col. 4, ll. 55-66).

The difference between the CLA containing dog food products and methods of making the same encompassed by claims 1, 8, 14, and 19 and as disclosed by Lowe is the absence of a tallow containing coating for Lowe’s dog food. The difference between these claimed inventions and the dog

³ See, e.g., **kibble**, *The American Heritage Dictionary Of The English Language* 962 (4th ed., Boston, Houghton Mifflin Company. 2000).

food products and methods of making the same disclosed by Franzen is the absence of CLA in the dog food product. The Examiner addressed only the difference involving the teachings of Lowe, the primary reference.

We find that one of ordinary skill in the dog food art would have been interested in manufacturing nutritional dog food that is palatable to a range of dogs. This is evinced by the teachings with respect to palatability in Lowe and Franzen, and indeed, Franzen is directed to preparing palatable nutritional dog foods with specific palatability ingredients.

On this record, we find that one of ordinary skill in this art would have been motivated by the desire to provide palatable dog food to combine Lowe and Franzen. We determine that the combined teachings of these references prima facie would have led this person to use the tallow containing coating of Franzen Example I in place of the duck-based digest coating used by Lowe in the reasonable expectation of obtaining a palatable dog food with a different palatability. We do so without recourse to the teachings of Appellants' specification. Indeed, an express suggestion to substitute Franzen's palatable coating for that of Lowe for the same purpose is not necessary. *Cf. In re Fout*, 675 F.2d 297, 299-301, 213 USPQ 532, 536 (CCPA 1982) ("Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious," citing *In re Siebentritt*, 372 F.2d 566, 567-68, 152 USPQ 618, 619 (CCPA 1967)); *Ex parte Novak*, 16 USPQ2d 2041 (Bd. Pat. App. & Int. 1989), *aff'd. mem.*, 16 USPQ2d 2043 (Fed. Cir. 1990).

We are not persuaded by Appellants' argument that the canine dietary objectives of Lowe and Franzen are so diverse that one of ordinary skill in

the art would have been led away from combining these references without the benefit of hindsight provided by Appellants' specification. Indeed, Lowe discloses that the nutritional maintenance of a dog is important even though caloric intake reduction is an objective of the dog food, and that the palatability of the dog food is important to attract the dog. Franzen is also interested in making nutritional dog food palatable for the same purpose. We do not find in Appellants' arguments any explanation or evidence establishing that these disclosures of the references teach away from the claimed methods and products encompassed by claims 1, 8, 14 and 19. *See, e.g., In re Kahn*, 441 F.3d 977, 985-89, 78 USPQ2d 1329, 1334-38 (Fed. Cir. 2006) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." (quoting *In re Gurley*, 27 F.3d 551, 553 [31 USPQ2d 1130, 1131], (Fed. Cir. 1994))); *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1145-46 (Fed. Cir. 2004) (prior art "disclosure does not criticize, discredit, or otherwise discourage the solution claimed"). Indeed, Appellants have not established that one of ordinary skill in this art would have expected the presence of CLA in Lowe's dog food product to interfere with the palatability properties imparted by Franzen's coating.

We also cannot agree with Appellants that the mere difference in purpose for adding CLA to dog food is sufficient to patentably distinguish the claimed inventions over the combination of Lowe and Franzen. Indeed, as the Examiner points out, it is well settled that the mere discovery of a new

property or benefit of an old composition or process will not, without more, be dispositive of the nonobviousness of the claimed invention over the reference. *See, e.g., In re Woodruff*, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990); *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 782-83, 227 USPQ 773, 779 (Fed. Cir. 1985). In other words, the discovery of a new benefit of an old process or property of an old product does not render that process or product again patentable simply because those practicing the process or using the product may not have appreciated the results produced thereby. *See, e.g., W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983) (“[I]t is . . . irrelevant that those using the invention may not have appreciated the results[,] . . . [otherwise] it would be possible to obtain a patent for an old and unchanged process.” (citations omitted)); *In re Skoner*, 517 F.2d 947, 950, 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].” (citations omitted)).

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of Lowe, Franzen and Wheeler with Appellants’ countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 1 through 3, 5 through 9, 11 through 16, and 19 through 22 through would have been obvious as a matter of law under 35 U.S.C. § 103(a).

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The Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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