

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 JANE BJORKSTROM, GORAN BODEMAR,
GUSTA LINDEWALD, and LARS-BORJE SJOBERG

Appeal 2006-2858
Application 10/169,910
Technology Center 1700

Decided: March 27, 2007

Before CHUNG K. PAK, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 1, 2, and 4 through 22. Claims 23 through 26, the other claims pending in the above-identified application, stand withdrawn from consideration by the Examiner as being directed to a non-elected invention. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

I. APPEALED SUBJECT MATTER

The subject matter on appeal relates to a nutritional drink comprising mainly proteins, carbohydrates, and salts (Specification 1, together with claim 1). The drink has an osmolarity of less than 600 mOsmol/kg water, preferably between 300 and 600 mOsmol/kg water, and an energy value of up to 85 kcal/100 ml drink, preferably 40-60 kcal/100 ml drink (Specification 3). According to page 3, lines 20-21, of the Specification, “[t]he energy value of the drink is linked to the osmolality [sic, osmolarity].” The Specification, at page 3, lines 7-8, also states that the “[t]he energy value...is related to the osmolality [sic, osmolarity].”

Details of the appealed subject matter are recited in illustrative claim 1, which is reproduced below:

1. An oral nutritional drink which can be ingested with good tolerance by persons likely to or currently suffering from nausea or who are expected to be sick when consuming food or drinks comprising proteins, carbohydrates, salts, the drink comprises at least one protein, at least one carbohydrate, and at least one salt, wherein the drink is clear and has an osmolality [sic, osmolarity] of not more than 600 mOsmol/kg water an energy value of 40-60kcal/100ml of the drink, wherein the nutritional drink is free of fat or when the protein is a defatted protein, the fat content of the drink is less than 0.2% based on the-weight of the defatted protein.

II. PRIOR ART

As evidence of unpatentability of the claimed subject matter, the Examiner relies upon the following references:

Millman	US 4,871,550	Oct. 3, 1989
Staples	EP 0 044 116 A1	Jan. 20, 1982

III. REJECTION

The Examiner has rejected the claims on appeal as follows:

- 1) Claims 1, 2 and 4 through 22 under 35 U.S.C. § 103(a) as unpatentable over the disclosure of Staples; and
- 2) Claim 12 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Staples and Millman.

IV. ISSUES

The dispositive question is whether Staples would have led one of ordinary skill in the art to provide the claimed energy value (defined in terms of kcal/100 ml of drink) to its nutritional drink comprising at least one protein, at least one carbohydrate and at least one salt within the meaning of 35 U.S.C. § 103.

V. PRINCIPLES OF LAW

Under 35 U.S.C. § 103, the obviousness of an invention cannot be established by combining the teachings of the prior art references absent some teaching, suggestion or incentive supporting the combination.

ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). This does not mean that the cited prior art references must specifically suggest making the combination.

B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988). Rather, the test for obviousness is what the combined teachings of the prior art references would

have suggested to those of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In evaluating the prior art references for a suggestion, it is proper to take into account not only the specific teachings of the references, but also any inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The fact that a specific embodiment is exemplified is not controlling since all disclosures of the prior art, including non-exemplified embodiments, must be considered. *In re Mills*, 470 F.2d 649, 651, 176 USPQ 196, 198 (CCPA 1972).

“In cases involving overlapping ranges, we and our predecessor court have consistently held that even a slight overlap in range establishes a *prima facie* case of obviousness.” *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). Moreover, optimization of a variable which is recognized in the prior art to be a result effective variable would ordinarily be within the skill in the art. *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980).

VI. RELEVANT FACTUAL FINDINGS

1. The Appellants have not disputed that Staples describes a nutritional drink comprising at least one protein, at least one carbohydrate (sweetener) and at least one salt (sodium ion) with an osmolarity ranging from 140 to 375 mOsmol/kg.

2. The Appellants have not disputed the Examiner's determination that one of ordinary skill in the art would have been led to employ the amount of the electrolytes and/or minerals recited in claim 12, as suggested by Millman, in the nutritional drink described in Staples.

3. The Appellants' only argument is that Staples would not have suggested the claimed energy value of 40-60 kcal/100ml of drink.

4. Staples' Example 1 shows a beverage having an energy value of 72 food Calories per 240 mililiter (30 food Calories per 100 ml (30 kcal per 100ml of beverage)) and an osmolarity of 276 mOsmol/kg.

5. Staples' disclosure is not limited to its Example 1. Staples, for example, describes beverages having an osmolarity ranging from 140 to 375 mOsmol/kg (not limited to an exemplified beverage having an osmolarity of 276 mOsmol/kg). These osmolarity values overlap with the Appellants' claimed and preferred osmolarity values.

6. The Appellants have acknowledged at page 3 of the Specification that the energy value is linked to or related to the osmolarity.

7. Staples, by teaching an osmolarity ranging from 140 to 375 mOsmol/kg, necessarily teaches beverages having corresponding energy values, including those claimed.

8. The Appellants have not disputed the Examiner's finding at page 3 of the Answer that:

[I]t would have been within the skill of the ordinary worker to add more ingredients to increase the caloric value of the drink. The reference discloses that in choosing the amounts and types of any of the ingredients, . . . they must be balanced to achieve the desired osmolarity and . . . the sweetener . . . limited in order to achieve the balance (page 13, lines 12-25).

This finding demonstrates that the calorific values (energy values) involved are a recognized result effective variable.

9. Calorific values are also well known in the nutritional art to be a result effective variable for weight control purposes.

10. Optimization of calorific values, a result effective value, is well within the ambit of one of ordinary skill in the art.

VII. ANALYSIS

The Appellants have not disputed the Examiner's finding at page 3 of the Answer that Staples describes a nutritional drink comprising at least one protein, at least one carbohydrate (sweetener) and at least one salt (sodium ion) with an osmolarity ranging from 140 to 375 mOsmol/kg (Br. 3-4). Nor have the Appellants disputed the Examiner's determination at page 6 of the Answer that one of ordinary skill in the art would have been led to employ the amount of the electrolytes and/or minerals recited in claim 12 in the nutritional drink described in Staples (*id.*). The Appellants' only argument is that Staples would not have suggested the claimed energy value of 40-60 kcal/100ml of the drink (Br. 3). In support of this position, the Appellants refer to a beverage in Staples' Example 1 which is said to have an energy value of 72 food Calories per 240 mililiter (30 food Calories per 100 ml (30 kcal per 100ml of the drink)) and an osmolarity of 276 mOsmol/kg (Br. 3 and Staples, Example 1).

Therefore, the dispositive question is whether Staples would have led one of ordinary skill in the art to provide the claimed energy value (defined in terms of kcal/100 ml of drink) to its nutritional drink comprising at least

one protein, at least one carbohydrate and at least one salt within the meaning of 35 U.S.C. § 103. On this record, we answer this question in the affirmative.

As recognized by the Examiner at page 3 of the Answer, Staples' disclosure is not limited to its Example 1. *In re Mills*, 470 F.2d 649, 651, 176 USPQ 196, 198 (CCPA 1972) (The fact that a specific embodiment is exemplified is not controlling since all disclosures of the prior art, including non-exemplified embodiments, must be considered.) Staples broadly describes beverages having an osmolarity ranging from 140 to 375 mOsmol/kg (not limited to an osmolarity of 276 mOsmol/kg). These osmolarity values overlap with the claimed and preferred osmolarity values discussed *supra*. The claimed energy values, according to page 3 of the Specification, are linked to or related to the osmolarity. Thus, Staples, by teaching beverages having an osmolarity ranging from 140 to 375 mOsmol/kg, necessarily teaches beverages having corresponding energy values, including those claimed. Accordingly, we determine that the selection of beverages having the claimed energy values from those taught in Staples would have been well within the ambit of one of ordinary skill in the art. As stated in *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003), “[i]n cases involving overlapping ranges, we and our predecessor court have consistently held that even a slight overlap in range establishes a *prima facie* case of obviousness.”

In any event, we observe that the Appellants have not disputed the Examiner's finding at page 3 of the Answer that:

[I]t would have been within the skill of the ordinary worker to add more ingredients to increase the caloric value of the drink.

The reference discloses that in choosing the amounts and types of any of the ingredients, . . . they must be balanced to achieve the desired osmolarity and . . . the sweetener . . . limited in order to achieve the balance (page 13, lines 12-25).

This finding demonstrates that the calorific value (energy value) involved is a recognized result effective variable. Thus, we concur with the Examiner that optimization of a calorific value, a result effective variable, is well within the ambit of one of ordinary skill in the art. *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) (Optimization of a variable which is recognized in the prior art to be a result effective variable would ordinarily be within the skill in the art.). This is especially true in this instance since the calorific values are well known in the nutritional art to be a result effective variable for weight control purposes.

Accordingly, for the factual findings set forth above and in the Answer, we concur with the Examiner that Staples alone, or in combination with Millman, would have rendered the subject matter recited in claims 1, 2, and 4 through 22 obvious within the meaning of 35 U.S.C. § 103.

VII. ORDER

The decision of the Examiner is affirmed.

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VIII. TIME PERIOD

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

AFFIRMED

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