

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 MARIA DOLORES MARTINEZ-SERNA VILLAGRAN,
BRENT RAY JOHNSON, and LOUIS BERNARD VONDERHAAR

Appeal No. 2006-3110
Application No. 10/185,846

ON BRIEF

Before ADAMS, LINCK, and LEBOVITZ, Administrative Patent Judges.

LEBOVITZ, Administrative Patent Judge.

DECISION ON APPEAL

This appeal involves claims to dough containing potato fiber. The examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 134. We affirm.

Background

The instant application describes a “snack dough” that contains potato fiber, starch, and water. Specification, page 2, lines 8-21. The dough can be shaped into snack pieces, such as chips, and then cooked to form a finished snack product. Id., page 2, lines 23-24. “The advantages of preparing such food products from a dough rather than from sliced, whole potatoes include homogeneity or uniformity in the end

food products and the ability to more closely control the separate steps involved in the preparation of the food products.” Id., page 1, lines 20-26.

Discussion

Claims

Claims 1-20 are appealed. The claims stand or fall together since Appellants have not separately argued their patentability. We select claim 1 as representative:

1. A dough comprising:
 - (a) from about 0.1% to about 4% added potato fiber;
 - (b) from about 35% to about 85% starch-based material; and
 - (c) from about 10% to about 50% added water.

Obviousness under 35 U.S.C. § 103

Claims 1-20 stand rejected as obvious under 35 U.S.C. § 103(a) over Feeney¹ in view of Roney².

The Examiner rejected the claims as being obvious over the combination of Feeney and Roney. Feeney teaches a potato-based dough that is improved by the addition of a “water absorbent fibrous cellulosic material.” Feeney, column 2, lines 35-40. Preferred cellulosic materials are high in pectin, especially materials derived from citrus peel and sugar beet pulp. Id., column 2, lines 40-44. Other fibrous cellulosic materials can be utilized in the dough that contain a water-soluble and water-insoluble fiber component. Id., column 2, lines 53-57; column 10, lines 8-17. According

¹ Feeney et al. (Feeney), U.S. Pat. 4,876,102, issued Oct. 24, 1989

² Roney et al., (Roney), U.S. Pat. No. 6,645,546, issued Nov. 11, 2003

to the Examiner, Feeney's dough meets the starch and water limitations of claim 1, but does not contain "added potato fiber." Answer, pages 3-4. The Examiner urged, however, that it would have been obvious to have replaced Feeney's cellulosic material with potato fiber since it meets Feeney's fiber requirement and would be "compatible" with the potato-based dough. Id., page 3, paragraph 3. The Examiner cited Roney for its teaching of potato fiber. Roney, column 1, Table 1. Roney characterizes it as a "typical fiber" used in formulating "healthy" food products. Id., column 1, lines 40-43.

Appellants challenged the rejection, arguing that neither reference suggests the use of potato fiber in dough. Brief, page 3, paragraph 6. Furthermore, Appellants contended, the cited references do not teach or suggest "that potato fiber is cellulosic, and as such, potato fiber further would not be acceptable in Feeney." Id., page 4. Finally, it was argued that the prior art teaches away from the choice of potato fiber because it does not meet the "organoleptic" properties "desired" by Roney. Id.

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." In re Sang Su Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art.

"[T]he teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art."

In re Kahn, 441 F.3d 977, 987-988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

The Feeney patent addresses the problem of how to maintain the texture and flavor of fried potato products made from dough containing dehydrated potato flakes. See generally Feeney, columns 1-2. Feeney's solution is to add water absorbent fibers ("fibrous cellulosic materials") to the dough. Id., column 1, lines 5-13. The addition of fibrous cellulosic materials to the potato-based dough improves it by making the dough more "workable." Id., column 3, lines 13-17. When the dough is utilized to prepare a fried food, a product with "increased crispness and texture" is produced. Id. The preferred fibers are disclosed in the patent to be citrus peel and sugar beet pulp, but significantly Feeney does not restrict its teaching to these materials. Id., column 2, lines 40-44. Other sources are described as suitable when they contain a water-soluble fibrous component and a water-insoluble fibrous component. Id., column 2, lines 53-60; column 3, lines 64-68; column 10, lines 8-17. In this context, while there is no specific teaching to use potato fiber, we do see clear directions to go outside the four corners of Feeney's patent to pick other fibers having the requisite properties to improve fried food potato-based products.

Feeney provides explicit guidance on how to select cellulosic materials that are useful to improve the potato dough. The patent repeatedly emphasizes that a significant factor in choosing the cellulosic material is that it have "high water absorbency."

It is therefore an object of this invention to create improved fried food products made from a potato-based dough, wherein said dough and the food products made therefrom are improved by the addition of a fibrous cellulosic material, said material having a high water absorbency. The source of the fibrous cellulosic material for use in this invention is preferably high in pectin (i.e., it contains at

least 15% pectin) ... However, certain other sources of fibrous cellulosic material can be utilized to achieve a cellulosic material having the requisite water absorbency and can be satisfactorily utilized in the invention disclosed herein.

Id., column 1, line 64-column 2, line 8.

The requisite water absorbency is achieved, according to Feeney, by using cellulosic fibers which have high pectin content or which are a mix of water-insoluble and water-soluble fibers. The cellulosic material "should contain approximately 0.5% to approximately 25% of the water-soluble fibrous component." Id., column 11, lines 1-3. Feeney also explains that when water-insoluble fibers having their own inherent water-soluble component are utilized, a "synergistic effect" is observed. Id., column 11, lines 25-34. The benefit of adding fiber to dough for its water binding capacity is acknowledged in the Roney patent, as well. Roney, column 2, lines 5-10.

A skilled artisan reading the Feeney patent would recognize its general teaching that any fiber having the requisite water binding capacity would improve a fried potato-based food when added to its dough. Although Feeney says that certain fibers are preferred, other fiber sources are described by Feeney as suitable, and accordingly equivalent for improving the product's properties. Potato fiber, as established by Roney, comprises a water-soluble fiber content of 18%, which is within the range required by Feeney. Roney, column 1, lines 40-60; Feeney, column 11, lines 1-3. Roney lists potato fiber among typical fibers used in formulating food products. Roney, column 1, lines 40-60. Moreover, Feeney encourages the use of fibrous materials having their own inherent water-soluble component to obtain synergistic effects. Feeney, column 11, lines 25-34. It is our view that these facts provide adequate

motivation for the person of ordinary skill in the art to have selected potato fiber for Feeney's potato-based dough.

Furthermore, we agree with the Examiner that the choice of a potato fiber for Feeney's potato dough would have been reasonably suggested to the skilled worker when Feeney's purpose is to make such products as potato chips and french fried potatoes (Feeney, column 14, lines 59-61). Its addition to the dough would not reasonably be expected to "negatively influence" the taste of the finished fried food product, as warned against in Feeney, since it is from the same original source, i.e., potato. Id., column 11, lines 42-45. Thus, we conclude that the Examiner has provided sufficient evidence to establish a case of prima facie obviousness.

Appellants argued that the references do not teach or suggest that potato fiber is cellulosic. Brief, page 4. According to Feeney, a "cellulosic fiber" is "a dietary fiber comprised of at least about 20% cellulose or modified cellulosic material." Feeney, column 3, lines 50-53. The Examiner provided evidence in the Answer that vegetable fibers contain 50-80% cellulose, meeting Fenney's definition of a cellulosic fiber. Although Appellants had the opportunity to rebut this, they did not further address this issue. Accordingly, we find that the Examiner has provided sufficient evidence that potato fiber is cellulosic.

It was maintained by Appellants that Roney teaches away from the use of potato fiber since it would not be "tasteless and sugar-free" as required by Roney. Brief, page 4. We do not find this argument persuasive. First, Appellants stated it was well-known in the art that potato fiber contains "glucose" which is "distinct, noticeable and therefore not tasteless," but provided no supporting evidence to substantiate this

position. Arguments of counsel cannot take the place of evidence lacking in the record.

Estee Lauder Inc. v. L’Oreal, S.A., 129 F.3d 588, 593, 44 USPQ2d 1610, 1615 (Fed. Cir. 1997). Secondly, as pointed out by the examiner, the rejection does not rely on Roney for its teaching of what fiber to use in a cooked food product. Answer, page 6. Roney’s relevance was for its teaching of the composition of potato fibers. Finally, we note that Feeney’s dough contains added reducing sugars (e.g., glucose, maltose, and lactose), and Feeney did not find them averse. Feeney, column 13, lines 38-39; column 17, lines 59-60. Appellants’ argument is inconsistent with this fact.

For the foregoing reasons, it is our opinion that the examiner has provided the evidence necessary to establish a prima facie case of obviousness. Accordingly, we affirm the rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Feeney in view of Roney. Claims 2-20 fall with claim 1 since Appellants did not specifically challenge the rejection of these claims. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

Other Issues

If prosecution in this application is resumed, we direct the Examiner’s attention to U.S. Pat. No. 4,315,954 which describes a snack product containing potato fiber.

Summary

The rejection of claims 1-20 over prior art is affirmed.

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

AFFIRMED

Donald E. Adams)
Administrative Patent Judge)
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)
) BOARD OF PATENT
Nancy J. Linck)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
Richard M. Lebovitz)
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