

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 WILLIAM M. McCARRICK

Appeal 2007-0172
Application 10/461,361
Technology Center 1700

ON BRIEF

Before ADAMS, GRIMES, and LINCK, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a multi-flavored dessert cake. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

BACKGROUND

The specification describes “a multi-flavored dessert cake comprising a plurality of sponge cake portions. . . . At least one sponge cake portion is soaked with a syrup having a first flavor . . . , and at least one other sponge cake portion is soaked with a syrup having a second flavor,” the “second

flavor [being] different from the first flavor.” (Specification 2-3.) In addition, the specification states that the cake preferably “further comprises at least one filling portion that has a third flavor that is also different from the first and second flavors.” (*Id.* at 3.) The specification also describes various combinations of flavors that may be included in the cake. (*Id.* at 3-4.)

DISCUSSION

1. CLAIMS

Claims 1 and 3-20 are pending and on appeal. The claims have been argued in several groups. We will focus on one claim from each group – claims 1, 3, 4, 7, 11, and 15, which are representative. Claims 19 and 20 stand or fall with claim 1. Claims 5 and 6 stand or fall with claim 4. Claims 8-10 stand or fall with claim 7. Claims 12-14 stand or fall with claim 11. Claims 16-18 stand or fall with claim 15. 37 C.F.R. § 41.37(c)(i)(vii).

Claims 1, 3, 4, 7, 11, and 15 read as follows:

1. A multi-flavored dessert cake comprising a plurality of sponge cake portions, each sponge cake portion capable of absorbing a flavored syrup, wherein at least one sponge cake portion is soaked with a syrup having a first flavor and at least one other sponge cake portion is soaked with a syrup having a second flavor, the second flavor being different from the first flavor; the cake further comprising at least one filling portion having a third flavor that is different from the first and second flavors; and wherein the first, second, and third flavors comprise one of the following flavor combinations:

i) a first flavor combination in which one of the first, second, and third flavors comprises a lemongrass flavor, another of the first, second, and third flavors comprises a mango flavor, and another of the first, second, and third flavors comprises a caramel flavor;

- ii) a second flavor combination in which one of the first, second, and third flavors comprises a mulled wine flavor, another of the first, second, and third flavors comprises a rhubarb flavor, and another of the first, second, and third flavors comprises an elderflower flavor;
- iii) a third flavor combination in which one of the first, second, and third flavors comprises a lavender flavor, another of the first, second, and third flavors comprises a basil flavor, and another of the first, second, and third flavors comprises a cassis flavor; or
- iv) a fourth flavor combination in which one of the first, second, and third flavors comprises a passion fruit flavor, another of the first, second, and third flavors comprises a mint flavor, and another of the first, second, and third flavors comprises a eucalyptus flavor.

3. The multi-flavored dessert cake of claim 1 wherein the first, second, and third flavors comprise the first flavor combination.

4. The multi-flavored dessert cake of claim 3 wherein the cake further has the following additional flavors: pineapple, ginger, pandan, and coconut.

7. The multi-flavored dessert cake of claim 1 wherein the first, second, and third flavors comprise the second flavor combination.

11. The multi-flavored dessert cake of claim 1 wherein the first, second, and third flavors comprise the third flavor combination.

15. The multi-flavored dessert cake of claim 1 wherein the first, second, and third flavors comprise the fourth flavor combination.

Thus, claim 1 is directed to a cake comprising two sponge cake portions and a filling portion, each having a different flavor. The flavors comprise one of the following flavor combinations: (i) lemongrass, mango,

and caramel; (ii) mulled wine, rhubarb, and elderflower; (iii) lavender, basil, and cassis; and (iv) passion fruit, mint, and eucalyptus.

Claim 3 depends from claim 1 and identifies the flavor combination as lemongrass, mango, and caramel. Claim 4 depends from claim 3 and recites that the cake also contains pineapple, ginger, pandan, and coconut flavors.

Claim 7 depends from claim 1 and identifies the flavor combination as mulled wine, rhubarb, and elderflower. Claim 11 depends from claim 1 and identifies the flavor combination as lavender, basil, and cassis. Claim 15 depends from claim 1 and identifies the flavor combination as passion fruit, mint, and eucalyptus.

2. OBVIOUSNESS

Claims 1 and 3-20 stand rejected under 35 U.S.C. § 103 as obvious over Ultimate Cake¹ in view of Fresh Ways² and Bake Me.³ The Examiner states that:

“Ultimate Cake” disclose[s] a multi-flavored cake. The cake comprises a plurality of sponge cake portions. The cake portions are soaked with kirsch-flavored syrup and are filled with multiple layers of creams, raspberries and strawberries. The book teaches various variations in making the syrup by adding different kinds of flavoring such as Cointreau, Grand Marnier, rum, Tia Maria, Kirs[c]h, orange, lemon, coffee.

(Answer 3.) The Examiner states that Ultimate Cake “does not disclose syrup having the flavorings and filling having the flavoring as claimed, [or]

¹ Barbara Maher, *Ultimate Cake* 65 & 153 (Debbie Major et al. eds., 1996).

² Time-Life Books Inc., *Fresh Ways with Pastries & Sweets* 74-77 (Jason McManus et al. eds. 1988).

³ Newspaper article (newspaper and author unknown), *Bake Me an Opera Cake*, Dubai (2000-2001).

cake portions soaked with syrup having different flavorings as claimed.”
(*Id.* at 4.)

The Examiner also states that Fresh Ways “discloses different types of cake having sponge layers and different filling material such as passionfruit, espresso, lime and rum, [and] chocolate mousse” and that Bake Me “discloses multilayer cakes with different flavorings such as saffron, Moroccan mint tea, Iranian spiced orange tea, rose petal [t]ea, rose water, [and] pistachio nuts.” (*Id.*)

The Examiner argues that:

Cake having multiple flavors is well known in the art as shown by the cookbooks and the article. It would have been obvious to one skilled in the art to soak the sponge portions with different kinds of flavored syrups when one wants to obtain different flavors and taste. The cake cookbook teaches syrup can be prepared to have different flavor[s] by adding various kind[s] of ingredient[s].

(*Id.*) The Examiner argues that it would have been obvious to include different specific flavors depending on the available ingredients and the desired taste. (*Id.*)

In essence, the Examiner “takes the position that the changing of flavor and the use of any specific flavor in the making of a cake would have been obvious to one skilled in the art.” (*Id.* at 5.) The Examiner relies on *In re Levin*, 178 F.2d 945, 948, 84 USPQ 232, 234 (CCPA 1949) for the rule that

new recipes or formulas for cooking food which involve the addition or elimination of common ingredients . . . do not amount to invention merely because it is not disclosed that, in the constantly developing art of preparing food, no one else

ever did the particular thing upon which the applicant asserts his right to a patent.

(Answer 5.)

We conclude that claim 1 would have been *prima facie* obvious over the references applied by the Examiner. Ultimate Cake describes a sponge cake having three sponge layers. (Ultimate Cake 65.) The bottom two layers are sprinkled with kirsch-flavored syrup to form syrup-soaked layers. (*Id.*) Between the bottom two sponge layers is a filling comprising whipped cream and strawberries and between the top two sponge layers is a filling comprising whipped cream and raspberries. (*Id.*) Ultimate Cake also describes a stock syrup that can be used for flavored syrups in layer cakes. (*Id.* at 153.) Ultimate Cake describes adding various flavors to the syrup, including kirsch, other liqueurs, rum and citrus, and coffee. (*Id.*) Ultimate Cake also describes caramel syrup for use in cakes. (*Id.*)

Bake Me describes “an Arabic opera cake, a variation on the traditional chocolate opera cake.” Bake Me indicates that the “traditional version consists of three layers of sponge, soaked in rich syrup and layered with two types of cream filling,” the layers representing “the different acts in the operatic performance.” The “Arabic version incorporates many of the spices and flavours of the Middle East, such as saffron, Moroccan mint tea, Iranian spiced orange tea, Omani rose petal tea, rose water and pistachio nuts.” Bake Me also describes other “variations of the traditional opera cake, including a lemon grass and coconut creation . . . and a peppermint and chocolate version.”

As noted above, Bake Me specifically describes an opera cake including lemon grass and coconut flavors. Based on the teachings in Bake

Me and Ultimate Cake of combining various flavors, we conclude that it would have been obvious to include a layer soaked in caramel syrup in the lemon grass and coconut cake. In addition, based on the teaching in Ultimate Cake of incorporating strawberries and raspberries in the filling, we conclude that it would have been obvious to incorporate different fruit, such as mango, into the cake filling. Thus, we conclude that a multi-flavored cake according to claim 1, which contains lemongrass, mango, and caramel, would have been obvious.

Appellant argues that “the Examiner is plainly ignoring the specific limitations set out in claim 1 and instead is simply taking the position that any recipe for a known class of food product (in this case, a cake) is *per se* obvious and unpatentable.” (Br. 5.) Appellant also argues that “the same rules must be uniformly applied across all fields of patentable subject matter insofar as the establishment of a *prima facie* case of obviousness is concerned.” (*Id.*)

We agree with Appellant that the Examiner appears to have relied on a *per se* rule. In particular, the Examiner appears to have taken the position that it would have been obvious to add any ingredient to cake and has not considered the particular ingredients being claimed. “[R]eliance on *per se* rules of obviousness is legally incorrect.” *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). We agree with Appellant that the same obviousness standards apply to food products as to other products.

See, e.g., In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Nevertheless, for the reasons discussed above, we conclude that claim 1 would have been *prima facie* obvious over the combination of

Ultimate Cake and Bake Me. Appellant's arguments do not overcome this prima facie case of obviousness. Therefore, we affirm the rejection of claim 1 under 35 U.S.C. § 103. Claims 19 and 20 fall with claim 1. However, because our reasoning differs from that of the Examiner, we designate our affirmance as a new ground of rejection, in order to give Appellant a fair opportunity to respond.

Claim 3 identifies the flavor combination as lemongrass, mango, and caramel. Appellant argues that “the cited references do not teach or disclose this specific combination of flavors.” (Br. 6.) However, for the reasons discussed above, we conclude that this combination of flavors would have been obvious. Therefore, we affirm the rejection of claim 3 under 35 U.S.C. § 103, but designate our affirmance as a new ground of rejection.

Claims 4-6 depend from claim 3 and require that the cake also contains pineapple, ginger, pandan, and coconut flavors. Claims 7-10 require the flavor combination of mulled wine, rhubarb, and elderflower. Claims 11-14 require the flavor combination of lavender, basil, and cassis. Claims 15-18 require the flavor combination of passion fruit, mint, and eucalyptus.

Appellant argues that the cited references do not disclose these combinations of flavors. (Br. 7-8.) We conclude that the Examiner has not set forth a prima facie case that cakes containing the specific flavors recited in claims 4-18 would have been obvious. We therefore reverse the rejection of claims 4-18 under 35 U.S.C. § 103.

SUMMARY

We affirm the rejection of claims 1, 3, 19 and 20 under 35 U.S.C. § 103 and reverse the rejection of claims 4-18 under 35 U.S.C. § 103. Because our reasoning differs from that of the Examiner, we designate our affirmance as a new ground of rejection under 37 C.F.R. § 41.50(b), in order to give Appellant a fair opportunity to respond. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

AFFIRMED-IN-PART, 37 C.F.R. § 41.50(b)

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Administrative Patent Judge)
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Eric Grimes)
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Application No. 10/461,361

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