

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVE SCHELLHAASS, LESLIE SKARRA, JOHN YASOSKY,
and CARL R. HOSENEY

Appeal 2007-0361
Application 10/294,542
Technology Center 1700

Decided: October 28, 2008

Before TONI R. SCHEINER, LORA M. GREEN, and
RICHARD M. LEOVITZ, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing of the decision entered August 29, 2007 (hereinafter "Decision"). That decision affirmed at least one rejection of record as to each of the appealed claims. After careful review and consideration of the arguments presented, we decline to make any substantive change in our previous opinion.

First, Appellants state:

Due to the large number of new rejections and technical errors and the misinterpretations of case law, an oral hearing, or in the alternative, a teleconference with the Board, Chief Judge and Group Director would be useful to resolve the issues presented herein and in the underlying appeal.

(Req. Rhg. 1.)

As to Appellants request for a hearing, there is no provision in the rules for a hearing on a Request for Reconsideration, and in any event, any request to waive the rules must be presented by petition to the Chief Administrative Patent Judge. 37 C.F.R. § 41.3. Moreover, Appellants are reminded that if they are unsatisfied with the Decision, they may appeal the Decision to the Court of Appeals for the Federal Circuit.

We have carefully read Appellants' Request for Reconsideration in its entirety, and it appears as if Appellants are attempting to prosecute the merits of the claims before this panel. Despite that observation, we address Appellants' major arguments below.

First, Appellants argue that the Board improperly addressed two articles that the Examiner had not addressed (Req. Rhg. 2). According to Appellants, the application should have been remanded to the Examiner, and that the fact that the panel addressed the references is a new rejection (*id.*). Appellants assert further that the articles "negate the obviousness and inherency rejections." (*Id.*)

Appellants argue further that the panel is inconsistent in finding that a tamale and crisp chip are relevant to the instant claims, but rejects the teachings of Toufeili and Inagaki because they do not relate to a tortilla (*id.* at 15). Appellants assert that the references are relevant as both are directed to bread-like items, as are some tortilla shells (*id.* at 30). According to

Appellants, Toufeili teaches that the modification of any of the starches from maize, rice, barley, and sorghum makes staling worse (*id.* at 30). Thus Toufeili contradicts the Examiner's position "that starch is starch and all are interchangeable." (*Id.* at 30-31.)

The Toufeili and Inagaki articles were addressed in response to Appellants' argument that "the Examiner has ignored relevant prior art which indicates that the addition of chemically modified starch is detrimental to shelf life as it relates to firming and/or staling, i.e., loss of flexibility. This teaching negates all support for the inherency rejection since use of starch does not inherently regard degradation." (App. Br. 22.) If Appellants felt that the final rejection was improper due to the Examiner's failure to properly treat those references,¹ they could have petitioned the Group Director to withdraw finality. (MPEP § 706.07(c); 37 C.F.R. § 1.181.)

Toufeili is drawn to pan bread, teaching that the "characteristics of pan bread have been reported to be sensitive to the proportion of A and B granules in wheat starch and to the botanical source of the starch." (*Id.* at 1855, second column.) Toufeili teaches that the starch used affected the sensory attributes of the breads (*id.* at 1857-58). Toufeili notes further that flours reconstituted with waxy barley starch yielded breads that staled faster,

¹ The Examiner stated with respect to the Toufeili and Inagaki articles that: 1) the references were not part of the rejection, and thus not relevant to the issues; and 2) the "articles discuss about specific waxy barley starch in specific bread product; the starch is not the same starch disclosed in Furcsik et al and the bread is not the same; thus a general conclusion cannot be drawn from the articles." (Ans. 15.)

with the progress of staling decreasing with increasing levels of cross-linking (*id.* at 1859).

Inagaki teaches that bread reconstituted with flour that had been reconstituted using cross-linked barley starch firmed faster at 25°C than control bread (Inagaki, Abstract).

Claim 1 is drawn to:

A thin degradation resistant cooked comminuted material based food product formed from a dough, said food product comprising:

comminuted material and plasticizer wherein:

the comminuted material includes a protein and starch containing material in the range of between about 70% and about 40% on a dry weight basis by weight of cooked food product, a portion of the starch of the comminuted material includes chemically modified starch at least a portion of which was chemically modified prior to forming a precursor to the cooked food product, said chemically modified starch being present in a weight ratio in the range of between 1.2:1 and about 1:50 by weight of the remainder of the starch on a dry weight basis; and

wherein the plasticizer includes water and chemically modified starch is effective to provide the cooked product a shelf life of at least 30 days.

Thus, claim 1 is not drawn to any particular starch, nor does it specify what chemical modification is used. In addition, it encompasses a large weight ratio, i.e., the “chemically modified starch being present in a weight ratio in the range of between 1.2:1 and about 1:50 by weight of the remainder of the starch on a dry weight basis.” The only limitation on which chemical modification is used, or which weight ratio of chemically modified starch within the broad claimed range is used, is that “the plasticizer includes water and chemically modified starch is effective to provide the cooked product a shelf life of at least 30 days.”

As noted in the Decision, “both Toufeili and Inagaki refer only to cross-linked waxy barley starch, and neither reference generalizes the results

to chemically modified starches generally.” (*Id.* at 8-9.) And as noted above, claim 1 is not limited to the use of any particular starch or to the use of cross-linked waxy barley starch as the chemically modified starch.

Second, Appellants argue that “the Examiner withdrew the anticipation rejections of claims 2 and 16 over Villagran in the Examiner’s Answer but failed to withdraw the rejections of the claims that depend from these claims and has yet to discuss in the rejections the amount of water defined in these claims.” (Req. Rhg. 2.)

Claims 1, 3, 14, 15, 18, 19, 26, 35 and 37-39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Villagran (Decision 10; Ans. 4). The only claim affected is claim 3, which depends from claim 2. Appellants, however, did not raise this issue in the Reply Brief which was filed in response to the Examiner’s Answer (Reply Br. 9-10), and thus we will not address it here.

Appellants argue further that the panel raised a new ground of rejection by pointing to Example 5 of Furscik for the unfilled tortilla, as the Examiner relied on Example 7 (Req. Rhg. 9). Appellants argue that Example 5 “in no way discloses or suggests that an unfilled tortilla has the shelf life stated by the Board,” thus the panel’s reliance on the example “is in technical error.” (*Id.*) Moreover, Appellants argue, Furscik is drawn to solving a “soggy, mushy problem,” and “not the degradation problem (as defined) solved by the present invention.” (*Id.* at 10.)

Appellants further argue that neither Example 5 nor Example 7 of Furscik use a chemically modified starch, and “[n]owhere is it shown that Furscik used a chemically modified starch but merely suggests that it can be used so long as it does not interfere with the function of the starch in the

tortilla.” (*Id.* at 10.) According to Appellants, that statement of Furscik appears to be contrary to the present invention, as it, as well as the two cited articles, provides “support for the proposition that the use of a chemically modified starch does not inherently retard degradation negating the anticipation rejection over Furscik.” (*Id.* at 10-11.)

We initially note as to Appellants numerous allegations that the panel improperly set forth new grounds of rejection, to the extent that we have applied the same art in a manner somewhat differently than the Examiner, this does not constitute a new ground of rejection. *See In re Boyer*, 363 F.2d 455, 458 n.2 (CCPA 1966); *see also In re Bush*, 296 F.2d 491, 496 (CCPA 1961). Furthermore, it is not a new ground of rejection to cite additional portions of the same reference relied upon by the Examiner. *In re Meinhardt*, 392 F.2d 273, 280 (CCPA 1968). We must consider a reference in its entirety for what it fairly suggests to one skilled in the art, and pointing to other portions of the same reference used by the Examiner is not viewed as being a new ground of rejection. *See In re Hedges*, 783 F.2d 1038, 1039 (Fed. Cir. 1986). Appellants should not be surprised by our reliance upon a different portion of the references because we must presume that Appellants have read all of the cited references in their entirety.

Moreover, in making our determination, we apply the preponderance of the evidence standard. *See, e.g., Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office). Appellants appear to be arguing that Office must be able to demonstrate with absolute certainty that the claimed product and the product of the prior art is the same in order to support a rejection of anticipation or obviousness.

As to shelf life, we acknowledge that Furcsik taught that the filled tortilla had a shelf life of at least two weeks (Furcsik, col. 10, ll. 6-12), but Appellants have not provided any reason as to why the ordinary artisan would not expect the unfilled tortilla to have a shorter shelf life. Moreover, The Decision set forth reasons as to why the Examiner had established by a preponderance of the evidence that claimed food product and the product disclosed by Furcsik appear to be the same (*See, e.g.*, Decision 4-5).

As also noted in the Decision (Decision 5-6 n. 1), the Office is not in the position to prepare the food products of the prior art in order to determine if that limitation is met. Thus, as stated in *In re Best*, 562 F.2d 1252 (CCPA 1977) (emphasis added):

Where . . . the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.... Whether the rejection is based on ‘inherency’ under 35 U.S.C. § 102, on ‘prima facie obviousness’ under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.

Id. at 1255.

Third, Appellants argue that “the Board has newly contended that buckwheat is a form of wheat to support a new rejection,” noting that “[b]uckwheat is not a form of wheat.” (Req. Rhg. 3.) Appellants argue further that the Board then applies a different standard by stating that “Counsel’s comments are not to be considered as they are not ‘fact’ of record,” and that “[c]ounsel has found no counsel arguments presented on

appeal that were not made during prosecution without objection.” (*Id.* at 8.) As to the Declaration of Dr. Hosenev, Appellants argue that the Board and Examiner erred in dismissing opinion based on experience as “opinion,” asserting that “data is no more ‘fact’ than someone’s opinion based on experience.” (*Id.* at 8-9.)

We do not find that we contended that buckwheat is a form of wheat in the Decision on Appeal. Specifically, we noted that the Examiner found that Villigran teaches a snack that comprises a dough made from a starch material, wherein of the starch based material, 0-75% is a flour such as corn or buckwheat, and 0.2-10% is a modified starch (Decision 10). The Examiner noted specifically, however, that Villigran does not specifically teach using wheat flour, but concluded that “[i]t would have been obvious to use wheat flour when a wheat product is wanted; Villagrán [] disclose[s] many other flours can be used. The selection of flour would have been a matter of preference depending on the taste and flavor desired.” (Decision 13-14.) We then concurred with the Examiner, noting again that the Examiner had addressed the issue of the use of wheat flour, and that Villigran had taught the use of buckwheat flour. Thus, the affirmance is based on the fact that Villigran teaches the use of different starches such as buckwheat and corn, thus it would have been *obvious* to use another starch such as wheat, and not on the basis that buckwheat flour is a form of wheat flour.

In addition, we did not dismiss Appellants’ arguments, but when Appellants make an assertion, such as the one made in response to the obviousness rejection over Villigran, that wheat flour may not be desirable, as wheat flour contains gluten; that assertion, without supporting data or

evidence, is just that, an assertion (Decision 15). Without such data and/or evidence, we do not know how much weight the assertion should be afforded, as Appellants did not argue that Villigran itself taught away from the use of wheat flour or the use of flour containing gluten. In addition, we did not dismiss the statements of Dr. Honeseay made in the Declaration, but explained why we did not find them convincing as to the issue being addressed (*see, e.g.*, Decision 7).

Appellants assert further that the panel entered other new grounds of rejection, such as where it was stated that how a tortilla is to be stored is merely intended use, as well as the panel's statement that a tamale roll is similar to a taco shell (*id.* at 12-14). Moreover, Appellants argue, "[t]he temperature of a product can change the condition of components, e.g., how much fat is liquid or solid, . . . , it is not intended use." (*Id.* at 12)

The composition (*i.e.*, the ingredients used) of the claimed food product remains the same whether it is stored at room temperature or in a freezer, which is why we stated that how the product is stored is merely intended use. In addition, while Appellants argue that the temperature of a product can change the condition of the components, there is no evidence on the instant record that claimed product undergoes such changes. Moreover, Appellants do not even assert that it does, but merely argue that it can. Finally, as noted by the Examiner, "[i]t would have been obvious to store the snack product in the refrigerator when one wants to keep it cold; this would have been a matter of choice." (Decision 14, quoting Ans. at 6.)

Fourth, Appellants argue that "the Board has made erroneous calculations of water content, which calculations and conclusions reached from the calculations are new rejections." (Req. Rhg. 3.) Appellants argue

further that the calculation is in error as it did not take into account the amount of water in the ingredients, only looking at added water, and did not take into consideration the cooking temperature and thickness of the product (*id.* at 7-8). According to Appellants, “the calculation of water content has no weight for an anticipation rejection since it would be impossible to calculate.” (*Id.* at 14.)

The Decision noted that the calculation was merely an estimation, *i.e.*, the Decision noted that “even if 30% of the water is lost, the comminuted material would comprise between about 70% and about 40% on a dry weight basis by weight of cooked food product.” (Decision 5.) Moreover, in our calculation, we stated we were making certain assumptions. That is, the Decision stated that “[i]f about 30% of the water is lost from a starting percentage of about 50% water, this would leave about 35% by weight water. With the flour component being about 50%, or 50 gm per 100 gm – this would mean 50 grams of starch and 35 grams water. Thus 50/85 or about 59% starch.” (Decision 6, n. 2.) But that calculation was prefaced with the observation of Appellants’ assertion that a tortilla can lose 30% of its moisture upon cooking, acknowledging further that Furcsik does not disclose how much water is lost, as well as stating that the USPTO has no facilities to determine the amount of water lost (Decision 5-6, n.1). What the calculation did support, however, is that the preponderance of the evidence supported the Examiner’s finding of anticipation, and thus the burden was properly shifted to Appellants to demonstrate how the product of Furcsik differed from the product claimed.

Fifth, Appellants argue that “contrary to the Examiner and the Board, the claims do properly define a flexible food product.” (Req. Rhg. 3.)

Appellants assert:

Another error in the Board’s opinion is when it quotes the Examiner at page 10 of the Opinion stating “The Examiner states that ‘[s]ince the product is made of the same materials as claimed, it inherently has the same shelf life as claimed.’” No proof of inherency is provided other than the alleged commonality of ingredients which is not proof and ignores the transformations from processing. It is the end product that is claimed, not the beginning ingredients, and, again, Villagran cooks until crisp while the invention is a flexible product negating any argument of inherency.

(Req. Rhg. 16.)

Sixth, Appellants argue that the panel made numerous technical errors (*id.* at 3.). According to Appellants, one such error is that frying makes a crisp product, without taking water in the ingredients, and comparing the dough to the finished product, into account (*id.*).

Appellants argue further that frying does not necessarily define a crisp product, as hamburgers and doughnuts are fried, but are not crisp (*id.* at 16-17). Appellants assert again that it is the water content that determines the crispness, and that once a product gets below 5% it is crisp, and Villigran achieves a crisp product by having 4% or less moisture (*id.* at 17). Thus, Appellants assert, Villagran adds modified starch to increase crispness (col. 5, l. 30), which is directly contrary to the instant invention wherein it is added to preserve flexibility (Req. Rhg. 15).

As noted in the Decision (Decision 10-11), the Specification teaches that the food product of the invention may be cooked by frying: Specifically, at paragraph 24, the Specification teaches that (emphasis added) “[t]he

dough may be cooked by any suitable . . . method, for example, radiant heat in an oven, *frying*, microwave cooking, etc. . . .” At paragraph 28, towards the end of page 13, the Specification teaches further that “frying, microwave[e] and other cooking methods can be used [are] known in the art and such cooking is conducted at high enough temperature for a sufficient time to also set the structure of the cooked product and achieve the desired coloring.” We further noted that the Specification, when discussing the methods of cooking, the Specification does not note anything as to the required flexibility of the product.

Paragraph 30 of the Specification then states (emphasis added) “[d]egradation *can* be tested by subjecting a tortilla to a stress test in which the product is randomly scrunched in one hand and squeezed for approximately three seconds.” The common usage of “can” is to indicate possibility or probability, thus its use in the above quoted text from the specification suggests that there are other ways in which degradation testing may be performed. That interpretation is also consistent with the disclosure in the Specification that the tortilla may be cooked by frying. Thus, as set forth in the Decision (Decision 12), we can not agree with Appellants’ proffered interpretation that the recitation of a certain shelf life limits the food product to one that is flexible.

Seventh, Appellants argue that the panel mischaracterized the law, most notably the *In re Spada* case (Req. Rhg. 3). Appellants assert further that the citation of this case “for the first time in the prosecution of this application represents a new rejection and thus, this case must be remanded to the Examiner for further prosecution to provide Appellant opportunity to respond to this new rejection.” (*Id.* at 4.)

As to *Spada*, Appellant argues that the holding of that case is limited to a property that is inherent to the composition of matter, whereas in the instant application, the claims are drawn to a final product, not the starting ingredients, and the final product can depend on more than just the starting ingredients (*id.*).

Citation of case law that was not cited by the Examiner does not constitute a new ground of rejection. Further, *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990), was cited for the proposition that “when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” In *Spada*, the monomers used by the prior art and by the Appellants in that case were the same, and the compositions were made by similar methods, thus the Office concluded that the compositions appeared to be the same. *Id.* at 708. The court agreed, concluding that “the Board correctly found that the virtual identity of monomers and procedures sufficed to support a *prima facie* case of unpatentability.” *Id.* See also *Best*, 562 F.2d at 1255 (CCPA 1977) (“Whether the rejection is based on ‘inherency’ under 35 U.S.C. § 102, on ‘prima facie obviousness’ under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.)

Similarly, in the instant case, the Examiner has found that the ingredients required by claim 1 are the same as those found in the prior art. And as neither the Specification nor the claims are limited to any particular cooking method, the burden is properly shifted to Appellants to demonstrate any differences between the prior art products and the claimed products.

Eighth, Appellants argue:

the Board fails to recognize that making food products is transformative of the ingredients and properties of a finished food product are created, not necessarily inherent, and that similar ingredients or even the same ingredients can produce different products. A finished food has properties that are dependent on more than just its ingredients. Complex interactions of ingredients can occur, ingredients change (starch can absorb water) compounds can change, chemical reactions can occur.

(Req. Rhg. 3.)

We recognize that cooking is a transformative process. However, Appellants claim 1 is extremely broad, and is not limited to any particular method by which the claimed product is “cooked”, any particular starch, any particular type of chemical modification, and encompasses a large ratio chemically modified starch to modified starch. The prior art applied against the claims had the same ingredients specified by claim 1, or made obvious those ingredients, thus establishing by a preponderance of the evidence that the products appear to be the same. Thus, the burden falls to Appellants to demonstrate the differences, which the Office is not in a position to do.

Ninth, Appellants argue that Villigran is drawn to a crisp product, and that the moisture content in claim 2 is substantially different from that in claim 2 (Req. Rhg. 3). According to Appellants, the difference “between a crisp product and a flexible product affects both the anticipation rejections and the obviousness rejections.” (*Id.* at 3-4.)

Again, Appellants’ argument does not sway us, because as discussed above, we do not interpret claim 1 as being limited to only a flexible product. We decline to read limitations from the Specification into the

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claims, a practice that the Court of Appeals for the Federal Circuit, our reviewing court, cautions against. *See SuperGuideCorp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into the claim limitations that are not part of the claim. For example, a particular embodiment in the written description may not be read into a claim when the claim language is broader than the embodiment.”). As discussed above, there is nothing in the Specification that unambiguously defines a degradation resistant cooked comminuted material based food as a flexible product. Finally, claim 2 was not rejected over the Villigran reference.

CONCLUSION

We have considered Appellants’ Request for Rehearing, but decline to make any substantive change in our previous opinion.

REHEARING DENIED

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