

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN KARWOWSKI,
C.Y. WANG and RANDY G. YOUNG

Appeal 2007-0726
Application 10/264,561
Technology Center 1700

Decided: August 7, 2007

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and CATHERINE
Q. TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
decision rejecting claims 1-34. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and REMAND.

I. BACKGROUND

The invention relates to the production of baked or fried snacks.
These snack products contain an edible core material (e.g., nuts, seeds, dried
fruit, etc.) coated with an expanded, chip-like crispy textured coating

(Specification ¶ 1). The coating is formed by alternately applying an aqueous component (e.g., water or an aqueous sugar solution) and a preblended dry flour and starch mixture to form a doughy coating on the tumbling edible core material, heating (baking or frying) to cook and expand the dough, and cooling (Specification ¶¶ 20, 24 and 50). In addition to containing a wheat flour component, the preblended dry mixture includes two starches, namely, an unmodified pregelatinized waxy starch and a raw potato starch (Claim 1). Claim 1 is illustrative of the subject matter on appeal:

1. A method for making a snack having an expanded, crispy, textured coating comprising:

- a. tumbling an edible core material;
- b. alternately applying an aqueous component and a preblended dry mixture on the tumbling edible core material to form a dough coating on the edible core material, said preblended dry mixture comprising about 10% by weight to about 60% by weight of a pregelatinized waxy starch, about 10% by weight to about 70% by weight of a wheat flour component, and about 2% by weight to about 30% by weight of a raw potato starch which is not chemically modified, said percentages being based upon the weight of said preblended dry mixture,
- c. heating the dough-coated core material to substantially reduce the moisture content of the dough and to substantially expand the dough, and
- d. cooling the expanded dough-coated core material to obtain individual pieces having a core material coated or encased in an expanded, cellular coating which has a crispy, texture.

The Examiner relies on the following prior art references to show unpatentability:

Chino

US 4,053,650

Oct. 11, 1977

Mochizuki	US 4,499,113	Feb. 12, 1985
Lanner	US 5,433,961	Jul. 18, 1995

Specifically, the Examiner rejects claims 1-34 under 35 U.S.C. § 103(a) as unpatentable over Lanner in view of Chino and Mochizuki. According to the Examiner, it would have been obvious to one of ordinary skill in the art to have included an unmodified pregelatinized waxy starch and raw potato starch in the starchy flour dry coating mixture of Lanner because the inclusion of these ingredients in flour/starch-type core coatings was well known in the art as evidenced by Chino and Mochizuki (Answer 6).

II. GROUPING OF CLAIMS

For purposes of review, Appellants group the claims as follows:

Group 1: claims 1, 2, 4, 5, 7, 9-15, 17-22, and 25-27

Group 2: claims 3, 16, 23, and 24; and

Group 3 claims 6, 8, and 28-34 (Br. 6-10).¹

We select claim 1 as representative for Group 1 and claim 3 for group 2. 37 C.F.R. § 41.37(c)(1)(vii)(2004). For Group 3, due to differences in the scope of the claims, we will consider both claims 6 and 28.

III. ISSUE

The overarching issue is: Have Appellants shown that the Examiner's rejection is flawed or overcome the rejection through a showing of secondary indicia of nonobviousness? *See In re Kahn*, 441 F.3d 977, 985-

¹ Appellants include claims 6 and 8 with the first group of claims as well as the third group of claims. Based on the subject matter of the claims and the arguments of Appellants, we treat claims 6 and 8 as standing or falling with claims 28-34 of the third group.

86, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.” (emphasis omitted)).

IV. FINDINGS OF FACT

In considering the issue on appeal, we first review the teachings of the prior art applied by the Examiner and consider (1) the scope and content of those references, (2) the differences between what is encompassed by claims 1, 3, 6, and 28 and the prior art, and (3) the level of ordinary skill in the art of food coating evinced by the prior art.

The record supports the following Findings of Fact (FF) by a preponderance of the evidence:

1. Appellants’ invention and all of the applied prior art references are directed to the same field of endeavor, i.e., the field of coating edible food particles with a flour-based coating. In each process, the particles or cores (seeds, nuts, dried fruit, etc.) are alternately coated with a dry mixture and an aqueous solution such as a sugar solution. In each process, the dry mixture contains flour, starch or mixtures thereof.
2. Claim 1 requires the dry mixture include a pregelatinized waxy starch in its unmodified form and a raw potato starch in addition to the wheat flour component (Claim 1).
3. Lanner generally describes using starchy flour mixtures which expand upon cooking to form a crisp material. Lanner suggests the use of a blend of cereal flour and pregelatinized starch. Lanner discusses a range of useful flours. Pregelatinized *modified* waxy

starch is mentioned as a preferred pregelatinized starch. (Lanner, col. 6, ll. 15-28).

4. Lanner does not specifically disclose the use of an unmodified pregelatinized waxy starch or a raw potato starch in the dry mixture (Lanner in its entirety).
5. The dry mixture of Lanner may further contain seasoning, flavoring, leavening agents, and other additives such as other fine particulates that can adhere to the edible cores during the coating process (Lanner, col. 6, ll. 24-28).
6. Raw potato starch and unmodified pregelatinized waxy starch were known ingredients for use in dry flour/starch-based mixtures for food coatings (Appellants' admission, Reply Br. 5; Chino, col. 2, ll. 19-22, Example 5; Mochizuki, col. 1, ll. 24-34 and col. 2, ll. 16-40).
7. Chino provides several examples of useful flours and starches for use in a dry mixture including cereal flours such as wheat flour and rice flour and such starches as alpha waxy maize starch, or corn starch (Chino, col. 2, ll. 19-22; Example 5).
8. Chino also recognizes that wheat flour and raw potato starch are non-expandable and that the ratio of non-expandable flours or starches to expandable flours or starches determines whether leavening agent is required (Chino, col. 2, ll. 26-42). "Potato starch" as used by Chino refers to potato starch in its raw form based upon the specific terminology used in the art (Answer 8). If the starch is modified, it is labeled "modified" and if the starch is cooked, it is labeled "pregelatinized." (*id.*).

9. Mochizuki notes that, in the past, a Japanese snack product, “Onorokemame,” was made from a wheat flour and expandable pregelatinized starch flour such as pregelatinized waxy corn flour (Mochizuki, col. 1, ll. 24-34).
10. Mashed potato flour (i.e., pregelatinized potato flour) was known as a less expandable starch flour that provides good savor (Mochizuki, col. 1, ll. 24-34).
11. Chino is directed to coated cores of crisp texture such as coated peanuts and “Onor Okemane” (Chino, col. 1, ll. 12-26) produced by alternately coating with an aqueous syrup solution and a flour and/or starch composition and roasting or frying (Chino, col. 1, ll. 27-35; col. 1, ll. 10-23).
12. In the past, expansion or “puffing” was done naturally and therefore it was impossible to satisfactorily control the outside shape of the final products, it taking a very skilled artisan to properly attain the desired texture and hardness in the coating layer (Chino, col. 1, ll. 36-45). Chino suggests the use of a mold to decrease the difficulty of obtaining the desired puffing, hardness, and texture as well as to obtain a uniformly expanded coating (Chino, col. 1, l. 65 to col. 2, l. 9).
13. The Mochizuki process provides a snack product with a coating that expands at a desired rate during frying and is crisp and palatable (Mochizuki, col. 1, ll. 15-19). Mochizuki eliminates the use of costly baking molds, the coated cores instead being conventionally deep fried (Mochizuki, col. 1, ll. 38-49; col. 4, ll. 28-30).

14. Lanner's continuous coating process is an improvement over the batch process of Mochizuki (Lanner, col. 1, l. 19 to col. 2, l. 9). Lanner's improvement is directed to the apparatus used to convey the cores, Lanner using a tumbling bed that allows continuous treating of the cores. (Lanner, col. 1, ll. 28-30; *see also* Mochizuki, col. 4, ll. 24-27 and Lanner, Fig. 1A; col. 2, l. 60 to col. 3, l. 15).
15. Lanner and Mochizuki suggest baking or frying the coated cores (Lanner, col. 1, ll. 30-31; Mochizuki, col. 4, ll. 28-30; Lanner, col. 6, l. 66 to col. 7, l. 3).
16. The coater device of Lanner is a tumbler coater (Lanner, col. 3, ll. 4-10). Lanner exemplifies a rotating drum (*id.*, Fig. 1A-B) and troughs with internal augers (Lanner, col. 3, ll. 16-33). Rotating pans are also mentioned (*id.*). There is no mention of a continuous belt or belt coater in Lanner.
17. Rotating drums and pans are different from belt coaters as evidenced from Appellants' Specification (Specification ¶ 55). Appellants' Specification discusses conventional tumbling bed coating equipment such as pan coaters, revolving pans, or rotating drums (Specification ¶ 55) and separately discusses an alternative "conventional belt coater" (*id.*). According to the Specification a belt coater employs a continuous belt to tumble a bed of edible cores (*id.*).

V. PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007)(quoting 35 U.S.C. § 103(a)).

The analysis is objective and is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S. Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.

In *KSR*, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S. Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12, 148 USPQ 459, 464 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

KSR, 127 S. Ct. at 1740, 82 USPQ2d at 1396. When the issue is whether a combination of known prior art elements is obvious, the operative question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court made clear that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* In that case, a reason for making the combination supported by specific reasoning with a rational underpinning is required. *Id.* The Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate review, this analysis should be made explicit. *Id.* However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences

and creative steps that a person of ordinary skill in the art would employ.”
KSR, 127 S. Ct. at 1741, 82 USPQ2d at 1396.

The Supreme Court also stated that the principles underlying the Court’s opinion in *United States v. Adams*, 383 U.S. 39, 40, 148 USPQ 479, 480 (1966) are instructive. *KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1395-96. Aside from articulating the principle that when substituting one known element for another known element “the combination must do more than yield a predictable result,” *Adams*, 383 U.S. at 50-51, 148 USPQ at 483, the *Adams* Court relied upon the “the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *Adams*, 383 U.S. at 51-52, 148 USPQ at 483. According to the *Adams* court, “[w]hen Adams designed his battery, the prior art warned that risks were involved in using the types of electrodes he employed. The fact that the elements worked together in an *unexpected* and *fruitful* manner supported the conclusion that Adams’s design was not obvious to those skilled in the art.” *KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1395 (emphasis added). This corollary principle provides a way for an applicant to overcome an obviousness rejection.

The Federal Circuit concluded that it would have been obvious to combine (1) a mechanical device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) an electronic, processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Enters., Inc. v. Fishier-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1691 (Fed. Cir. 2007)

(“[a]ccommodating a prior art mechanical device that accomplishes [a known goal associated with learning the sounds of letters] to modern electronics would have been reasonably obvious to one of ordinary skill in designing children’s learning devices”). In reaching that conclusion, the Federal Circuit recognized that “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.”

Leapfrog, 485 F.3d at 1161, 82 USPQ2d at 1690-91 (citing *KSR*, 127 S. Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Leapfrog*, 485 F.3d at 1162, 82 USPQ2d at 1692 (citing *KSR*, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396).

The obviousness determination is made from the vantage point of the person of ordinary skill in the art. That person is a “hypothetical person who is presumed to know the relevant prior art.” *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995). “In determining this skill level, the court may consider various factors including ‘type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.’” *Id.* “In a given case, every factor may not be present, and one or more factors may predominate.” *Id.*

VI. ANALYSIS

Interestingly, while the Briefs and Answer of record in this appeal were written before the Supreme Court's recent pronouncements on obviousness in *KSR*, the issues as developed in those documents seem to foreshadow the Supreme Court's development of the law. Of particular interest is the Supreme Court holding that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 127 S. Ct. at 1739, 82 USPQ2d at 1395. The issue in such cases becomes "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*

A. Group 1, Claim 1

With regard to claim 1, there is no dispute that the prior art elements in question were known in the art of preparing crispy expanded coatings on edible cores. Appellants admit that the two ingredients, unmodified pregelatinized waxy starch and raw potato starch required by the claim, were "individually known in the art." (FF 6; Reply Br. 5). Moreover, Chino and Mochizuki suggest the use of these ingredients in coatings similar to that of Lanner (FF 1, 3, 6-11). This fact alone supports a conclusion that it would have been obvious to use these known ingredients in the coating of Lanner. The prior art use of these ingredients in the same coating environment evinces that the ingredients had established functions in this environment and concomitantly that an artisan would have used these ingredients in the coating of Lanner in order to obtain such functions.

Moreover, this use of known ingredients constitutes an optimization of the starch composition within Lanner's starchy flour mixture and is the

type of optimization that “flows from ‘the normal desire of scientists or artisans to improve upon what is already generally known.’” *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1368, 82 USPQ2d 1321, 1335-36 (Fed. Cir. 2007) (quoting *In re Peterson*, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003)). That the artisans in the food coating art sought to optimize the properties of the dry mixture and were able to do so is evident from the various discussions of starch and flour ingredients, their properties, and their effects within the references (FF 3, 5, 7-10). Therefore, we determine that the experimentation involved comes within the teachings of the art. *See Pfizer v. Apotex*, 480 F.3d at 1367, 82 USPQ2d at 1335 (quoting *In re Fay*, 347 F.2d 597, 602, 146 USPQ 47, (CCPA 1965) (“To support the board's decision that ‘routine experimentation within the teachings of the art’ will defeat patentability requires a primary determination of whether or not appellants’ experimentation comes within the teachings of the art.”)).

We acknowledge that the applied prior art references do not expressly state the reasons for combining raw potato starch with the other dry flour and starch ingredients of Lanner, but in this case such reasons are not necessary to support a conclusion of apparent obviousness. Such reasons are only required when the combination “is more than a simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement,” *see KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1396. The present case involves merely the simple selection of known starches for use in a starch-containing flour mixture. This combination of familiar (i.e., known) flour and starch ingredients would have been obvious since it would have been expected to yield predictable results in accordance with the established functions of

those ingredients (as explained below). *See KSR*, 127 S. Ct. at 1739, 82 USPQ2d at 1395.

In any event, while the references do not expressly state what properties raw potato starch bring to the coating, i.e, what its established functions are, that those of ordinary skill in the art knew what those properties were can be inferred from the references. *See KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (“As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”).

It can be inferred from the teachings of Mochizuki regarding mashed potato starch as adding a savory taste, that those of ordinary skill in the art would have added raw potato starch for taste reasons as well as to control expandability and bubbling, the raw potato starch being known, as evidenced by Chino, as non-expandable (FF 7, 9). Both Mochizuki and Chino provide further evidence that those of ordinary skill in the art knew how to control expansion by selecting appropriate amounts of the various expandable and non-expandable flours and starches. Common sense also tells us that adding raw potato starch would make the coating more “potato-chip-like” upon frying. We also note that Lanner is not particularly limiting as to the contents of the dry flour mixture, and specifically suggests adding pregelatinized starch, a genus including unmodified pregelatinized waxy starch, and specifically suggests a preference for the closely related modified pregelatinized waxy starch (FF 3). Those of ordinary skill in the art would have selected any of the flours and starches known for use in the art and

combined them in amounts selected to obtain their known predictable effects on taste, texture, and expansion.

When the Examiner has shown that the combination of familiar elements according to known methods yields no more than predictable results, the combination is likely to be obvious. *See KSR*, 127 S. Ct at 1739, 82 USPQ at 1395. Appellants can overcome or rebut the rejection such as by showing (1) that the references teach away from the combination, (2) their improvement is more than the predictable use of these ingredients, or (3) the application of the techniques involved was beyond the ordinary artisan's skill level. *See KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1395 (quoting *Adams*, 383 U.S. at 50-51, 148 USPQ at 483) (“when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious” and “[t]he fact that the elements worked together in an *unexpected* and *fruitful* manner supported the conclusion that Adams’s design was not obvious to those skilled in the art.” (emphasis added)); and *KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1396 (“if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

Appellants contend that they are not using the known unmodified pregelatinized waxy starch and raw potato starch ingredients for known purposes (Reply Br. 5). Appellants proceed to describe the particular purposes for which they use the ingredients (*id.*).

According to Appellants:

The claimed preblended mixture comprises a pregelatinized waxy starch which, upon hydration, provides an extensible surface film prior to heating and temporarily traps moisture below the expandable film surface upon heating. The raw potato starch helps reduce, control, or eliminate bubbling and provides a non-flaky, crunchy, chip-like texture. In addition, the raw potato starch not only promotes crunchiness and a chip-like texture, but also reduces oil pick-up or absorption during frying. See paragraphs [0034] and [0040]. Applicants' composition and method produce an expanded, cellular coating which has a crispy texture without the need for a baking mold.

(Id.)

Applying the law to the facts of this case, we determine that Appellants have not shown that the use of pregelatinized waxy starch and raw potato starch in the starch/flour mixture of Lanner is more than the predictable use of prior art food ingredients according to their established functions.

The prior art expressly or inferentially teaches functions or purposes for adding pregelatinized waxy starch and raw potato starch which are similar to Appellants' purposes, i.e., to control expansion and bubbling and affect taste and texture. However, we acknowledge that, as argued by Appellants, the applied references do not disclose all of Appellants' reasons for adding unmodified pregelatinized waxy starch and raw potato starch to the dry mixture (Br. 6-7; Reply Br. 1-2). For instance, the references do not specifically discuss the moisture trapping ability of the extensible surface film created by the hydration of pregelatinized waxy starch prior to heating (Reply Br. 5). However, that the applied prior art does not disclose all of

Appellants' reasons for adding these starches is not alone enough to rebut the case of obviousness. *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996) (“the motivation in the prior art to combine the references does not have to be identical to that of the applicant to establish obviousness.”). What Appellants must do is show that the results of adding unmodified pregelatinized waxy starch and raw potato starch were not predictable, i.e., the results would have been unexpected to one of ordinary skill in the art. Appellants advance no convincing objective evidence of unexpected results.

Appellants further contend that Chino and Mochizuki “teach away” from the combination. We do not agree that the references “teach away” in the sense that there is no prima facie case of obviousness. “In general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.” *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). For instance, a reference will teach away if it leaves the impression that the product would not have the property sought by the applicant. *Gurley*, 27 F.3d at 552-53, 31 USPQ2d at 1131-32. Neither Chino nor Mochizuki teaches that a coated edible core cannot be obtained when including pregelatinized waxy starch and raw potato starch along with flour in the dry coating mixture or that such a mixture is undesirable. The references taken as a whole simply teach that continuous processing (Lanner) may be more efficient than batch processing (Mochizuki) and that using a mold during expansion can sometimes make it easier to control shape, texture, and hardness (Chino) (FF 10-12). That there are some alternatives for some aspects of the processing is not a teaching away from

using the claimed ingredients in the dry starchy flour mixture of Lanner in the context of the facts of this case. *See In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004) (mere disclosure of alternatives is not a teaching away). While the “teach away” test is a useful general rule, care must be taken not to adopt it in the abstract. *Gurley*, 27 F.3d at 553, 31 USPQ2d at 1132. “Although a reference that teaches away is a significant factor to be considered in determining unobviousness, the nature of the teaching is highly relevant, and must be weighed in substance.” *Id.*

Appellants have not shown that the use of the raw potato starch and pregelatinized waxy starch in the claimed preblend coating mixture is more than a predictable use of known ingredients. Moreover, Appellants have not shown that the prior art teaches away from using these ingredients in the preblend coating mixture of Lanner.

We note that another way to overcome the rejection would be through a showing that the combination was beyond the skill of one in the snack food coating art. *KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1396 (“if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”); *see also Leapfrog*, 485 F.3d at 1161, 82 USPQ2d at 1692. No such convincing evidence of the skill level, much less what was beyond the skill level, of the food coating artisan is advanced by Appellants.

Based on the totality of record, including due consideration of the Appellants’ arguments, we determine that the preponderance of evidence weighs most heavily in favor of the obviousness of claim 1 within the meaning of 35 U.S.C. § 103, claims 2, 4, 5, 7, 9-14, 17-22, and 25-27 falling

with claim 1. Appellants have not overcome the rejection by showing insufficient evidence of obviousness or by a showing of secondary indicia of nonobviousness. *See In re Kahn*, 441 F.3d at 985-86, 78 USPQ2d at 1335 (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.” (emphasis omitted)).

B. Group 2, Claim 3

With respect to Group 2, Appellants contend that none of the cited references teaches or suggests frying the dough-coated material as required by the claims (Br. 8-9). According to Appellants, Chino discloses that it is impossible to control the shape of coated edible cores that are fried as disclosed in Lanner and Mochizuki (*id.*).

The Examiner finds that Lanner teaches frying (Answer 10). The Examiner also finds that, if it is obvious to use potato starch as shown in the prior art, then, the same property will be obtained when it is used in the process of Lanner (*id.*).

We select claim 3 to represent the issues on appeal. The issue is: Have Appellants shown there is insufficient evidence to support the Examiner’s conclusion that it would have been obvious to one of ordinary skill in the art to fry an edible core coated with the claimed mixture?

Appellants have not convinced us that the evidence is insufficient to support the rejection.

As a first matter, Chino does not disclose that frying according to Lanner will not work, only that one can control shape by using a mold (FF 10). Moreover, as evidenced by Mochizuki, those of ordinary skill in the art

considered molds as costly and there would have been motivation to eliminate them for that reason (FF 11). Frying according to Lanner would have been recognized as a viable alternative to cooking in a mold as disclosed in Chino.

A preponderance of the evidence supports the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art to fry an edible core coated with the claimed mixture.

C. Group 3, Claims 6 and 28

With respect to Group 3, Appellants contend that none of the references teaches or suggests the claimed continuous belt as recited in independent claim 28. We note that claims 6 and 8 require a belt coater while claims 28-34 require a continuous belt. The Examiner contends that the tilted rotating bed of Lanner is the same as the claimed belt coater because it performs the same function (Answer 6). The issue is: Does a preponderance of the evidence support the Examiner's finding that the tilted rotating bed of Lanner is the same as the claimed continuous belt or belt coater of the claims?

Appellants' Specification, as well as the applied prior art, indicate that the tumbling bed of Lanner is not a belt coater; nor does it contain a continuous belt (FF 14-15). The fact that, as found by the Examiner, the tumbling bed of Lanner performs a function equivalent to the function of the belt coater with a continuous belt does not mean that the tumbling bed is a belt coater or has a continuous belt as required by the claims. The claims require the use of a belt coater or continuous belt and the Examiner has failed to establish that such a device was used by Lanner. Nor does the

Examiner offer any reasoning establishing the obviousness of the use of such a device.

Because the finding of the Examiner is not adequately supported by the evidence, we do not sustain the rejection of claims 6, 8, and 28-34 under 35 U.S.C. § 103(a).

D. Remand

While the Examiner's findings and analysis were inadequate to support the rejection of claims 6, 8, and 28-34, we note that Appellants' own Specification indicates that belt coaters with continuous belts were known in the art for coating edible cores (Specification ¶ 55). Therefore, we remand this Application to the Examiner for further consideration of the obviousness of the methods of claims 6, 8, and 28-34.

VII. CONCLUSION

In summary, we sustain the rejections of claims 1-5, 7, and 9-27 under 35 U.S.C. § 103(a), but do not sustain the rejection of claims 6, 8, and 28-34. Further, we remand the Application to the Examiner to further consider the patentability of claims 6, 8, and 28-34 in light of the discussion above.

VIII. DECISION

The decision of the Examiner is **AFFIRMED-IN-PART** and the application **REMANDED TO THE EXAMINER**.

Appeal 2007-0726
Application 10/264,561

IX. TIME PERIOD FOR RESPONSE

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

AFFIRMED-IN-PART

and

REMANDED

cam

HOLLANDER LAW FIRM, PLC
Suite 305
10300 Eaton Place
Fairfax, VA 22030