

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 E. DONALD MURRAY

Appeal 2007-1213
Application 10/137,306
Technology Center 1700

Decided: July 27, 2007

Before BRADLEY R. GARRIS, CHARLES F. WARREN, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1 and 4. We have jurisdiction under 35 U.S.C. § 6 (2006).

We AFFIRM.

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Appellant's present invention directed to a foodstuff comprising a substantially undenatured canola protein isolate. Representative claim 1 is reproduced below:

1. In a food composition comprising a foodstuff and at least one component providing functionality to said food composition, said functionality being selected from the group consisting of solubility, viscosity, water binding, gelation, cohesion/adhesion, elasticity, emulsification, foaming, fat binding, film forming and fibre forming, the improvement which comprises at least partially replacing said at least one component for its specific functionality in a specific food composition by a substantially undenatured canola protein isolate having a protein content of at least about 100 wt %, as determined by Kjeldahl nitrogen N x 6.25, said canola protein isolate being capable of providing all such functionalities in food compositions.

The prior art set forth below is relied upon by the Examiner as evidence in rejecting the appealed claims:

Cameron US 4,418,013 Nov. 29, 1983

Charles Morris, *New Technology Isolates Canola Protein*, Food Engineering, 73-74 (2001).

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(a) as anticipated by Morris; and claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as anticipated by Cameron.

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997);

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accord *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). However, anticipation by a prior art reference does not require that the reference recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

Claims 1 and 4 are argued as a group. We select claim 1 as the representative claim on which we shall decide this appeal.

The issue presented for review with respect to these rejections is: Do the Morris and Cameron references each have a disclosure that anticipates the claimed subject matter? We answer this question in the affirmative.

The Rejection over Morris.

The Examiner finds that Morris discloses a canola protein isolate, suitable for use in food composition, having a protein content in excess of 100 wt% as determined by Kjeldahl nitrogen N x 6.25 (Answer 3). Morris discloses that the canola protein isolate is suitable for a variety of food compositions (see unnumbered page 4).

Appellant has not disputed the Examiner's factual findings. Appellant acknowledges that Morris describes a canola protein isolate having a protein content of 100 wt% as determined by Kjeldahl nitrogen x 6.25 that is suitable for various food product compositions (Br. 4). However, Appellant

contends that Morris provides insufficient details as to the manner of preparation of the canola protein isolate and therefore does not provide enablement of the preparation of the canola protein isolate (Br. 4-5).

Appellant's contention is not persuasive. Appellant has not provided evidence to establish the descriptions of Morris could not enable a person of ordinary skill in the art to make the describe canola protein isolate. The Examiner, recognizes that the Morris reference discloses the method of making a protein isolate which is the subject of a patent to the Assignee of the present application (Answer 4). Appellant has failed to present evidence that the patent referenced in the Morris disclosure would not have enabled a person of ordinary skill in the art to practice the Morris invention.

The Rejection over Cameron.

The Examiner finds that Cameron discloses a substantially undenatured canola protein isolate having a protein content of 106 wt% as determined by Kjeldahl nitrogen $N \times 6.25$ (Answer 3). Cameron discloses the canola protein isolate is suitable for a variety of food compositions (Cameron, col. 1, ll. 26-29).

Appellant acknowledges that Cameron describes a canola protein isolate having a protein content of 106 wt% as determined by Kjeldahl nitrogen $\times 6.25$ (Br. 5). Appellant acknowledges that Cameron discloses that the protein isolate is suitable for use in various food compositions (*Id.*).

However, Appellant contends that Cameron does not provide specific examples demonstrating any utility for the protein isolate (Br. 5-6).

A reference is not limited to the descriptions of the preferred disclosure or the disclosure of the examples; all its portions must be considered for what they disclose to one of ordinary skill in the art. A person of ordinary skill in the art would recognize that canola protein isolates are used in food product compositions.¹

Appellant contends that Cameron does not suggest that the protein isolate has functional properties such as those specified in the claimed invention. Appellant's contention is not persuasive. The claimed invention is directed to a food composition that comprises a canola protein isolate. Cameron discloses to a person of ordinary skill in the art food product compositions that incorporate canola protein isolate. The identification of the functional properties of the protein isolate is of no patentable moment. That is, a person of ordinary skill in the art forming a food product composition comprising the canola protein isolate described in Cameron would have been practicing the claimed invention. *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1366, 52 USPQ2d 1303, 1307 (Fed. Cir. 1999) (“Where, as here, the result is a necessary consequence of what was deliberately intended, it is of no import that the article’s authors did not appreciate the results.”).

¹The prior art, Morris and Cameron, as well as the prior art discussed in the Background of the Invention portion of the Specification establish canola protein isolates are routinely incorporated into food product compositions.

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Decision

The decision of the Examiner rejecting claims 1 and 4 under 35 U.S.C. §102 as anticipated by Morris and Cameron individually is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

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