

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not binding precedent of the Board.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 BENJAMIN H. NELSON and TRACY WOODY

Appeal 2007-1896
Application 10/223,864
Technology Center 1700

Decided: August 20, 2007

Before BRADLEY R. GARRIS, PETER F. KRATZ, 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 1-6, 10, 12, 14, 15, 17, and 18. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

I. BACKGROUND

The invention relates to a method for preparing raw shellfish such as oysters. The method reduces the amount of bacterial and viral contamination in the shellfish. The method involves steps of heating, freezing, and glazing. Claim 1 is illustrative of the subject matter on appeal:

1. A new and improved method for reducing the amount of a potentially harmful bacteria and viruses in at least one raw and unseasoned oyster, the method comprising the steps of heating the oyster to a temperature up to 168 degrees Fahrenheit (75 degrees Centigrade), the at least one oyster being heated for a sufficient time to destroy the potentially harmful bacteria and viruses;

freezing the at least one oyster, the freezing to thereby reduce decomposition of the oyster and preventing growth of the potentially harmful bacteria and viruses; and

glazing the oyster, wherein the glazing step is accomplished by an injection of water during the freezing that substantially encases the oyster in ice after freezing.

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

Tanigawa (as translated)	JP 59-135860 A	Aug. 4, 1984
Wilson	US 6,143,343	Nov. 7, 2000

Ruth Hertzberg et al. (hereafter “Hertzberg”), *Putting Food By* 278-85 (2d ed., Bantam Books 1973)

George J. Banwart (hereafter “Banwart”), *Basic Food Microbiology* at 103-106, 347-350, 414, and 418-425 (abr. ed., AVI Pub. Co. 1981)

On appeal, the Examiner maintains a rejection of all the claims, i.e., claims 1-6, 10, 12, 14, 15, 17, and 18, under 35 U.S.C. § 103(a) as

unpatentable over Tanigawa in view of Hertzberg or Wilson as further evidenced by Banwart.¹

II. DISCUSSION

A. Issues

In reviewing the rejection, we consider the dispositive issues arising from the contentions in the Corrected Appeal Brief filed September 8, 2006 (Brief), the Examiner's Answer filed November 3, 2006, and the Reply Brief filed January 3, 2007.

Appellants' main contention is that Tanigawa describes cooking and seasoning oysters whereas, in the claimed process, the oysters are raw and unseasoned, the oysters heated only to destroy bacteria and viruses.

Appellants also contend that there is no reason to combine the teachings of the references.

The issues arising from the contentions of Appellants and the Examiner are:

1. Does Tanigawa suggest heating oysters as claimed?
2. Does Tanigawa suggest a method for reducing pathogens in a raw and unseasoned oyster? And,
3. Have Appellants shown that the evidence does not sufficiently support the Examiner's finding of a reason to combine the teachings of the references?

B. Findings of Fact

¹ A rejection of claim 10 under 35 U.S.C. § 103(a) over other prior art was withdrawn (Answer 3).

The following Findings of Fact (FF) are supported by a preponderance of the evidence:

1. Tanigawa describes a process of preserving oysters. The intention is to preserve the oyster “without losing a flavor of raw oyster.” (Tanigawa, p. 3, ll. 2-3).
2. In one embodiment, the oysters are preserved through heating and quick-freezing. Heating serves to dehydrate, sterilize, and prevent deterioration. Quick-freezing serves to preserve the oysters for use in seasons other than the harvesting season. The oysters are not immersed in seasoning until later; after a defrosting step. (Tanigawa, para. bridging pp. 5 and 6.)
3. Tanigawa’s heating step does not involve cooking the oyster. Tanigawa does not refer to the heating step as a cooking step. Instead, as stated by Tanigawa, “this steaming or boiling must be done carefully [so] not to ruin a unique flavor of oyster. So, the steaming or boiling process is slightly adjusted depending upon the amount of oyster and outdoor temperature but it is generally heated at 70-100°C.” (Tanigawa, para. bridging pp. 3 and 4.)
4. The disclosed heating temperature range of Tanigawa overlaps the temperature range of claim 1 (up to 75°C) and touches the range of claim 10 (up to 70°C). Tanigawa’s heating duration (2-60 minutes) includes the range of claim 10 (4-12 minutes) and also includes shorter time periods.

5. The end-product oyster is described as “having the same flavor and taste as those of raw oyster” and as useful “for frying or cooking in a pot with vegetable.” (Tanigawa, p. 6, last para.)
6. Tanigawa does not disclose glazing the oyster.
7. Hertzberg describes ice glazing as a method of forming a thin coat of ice which keeps air away, thus saving the flavor (p. 279, “Glazing with Ice”).
8. Hertzberg also counsels freezing oysters within hours of the time they leave the sea because they are very perishable. They should be frozen raw because cooked oysters toughen in the freezer (Hertzberg, p. 283-84 “Freezing Oysters, Clams, Mussels and Scallops”).
9. Wilson describes a process of freezing oysters including an ice glazing step. The layer of ice serves to preserve the raw product’s original taste during cold storage (Wilson, Abstract). Particularly, ice glazing prevents freezer burn (Wilson, col. 4, ll. 44-50).
10. Banwart describes a number of heating and freezing techniques for preserving food. Banwart discloses that “[s]ometimes, relatively mild heat treatments are used in conjunction with other processes, such as refrigeration, freezing, drying or acidification.” (Banwart, p. 418, “Heat”).

C. 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). The question of obviousness 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, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *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.”)

“[T]o reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness.” *In re Kahn*, 441 F.3d 977, 985-86, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (emphasis omitted). “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.” *Id.* (emphasis omitted).

D. Analysis

We first turn to the question of whether Tanigawa suggests heating oysters as claimed. We answer this question in the affirmative.

As a first matter, we cannot agree with Appellants that one of ordinary skill in this art would read Tanigawa as teaching heating to cook the oysters. Tanigawa desires to retain the raw character of the oyster, not to cook it (FF 1 and 3). That the heating step is not a cooking step is further evidenced by the last paragraph of the reference which suggests cooking the oysters in a

pot with vegetable (FF 5). One does not cook what is already cooked, one reheats. Moreover, it was known in the art that cooked oysters do not freeze well (FF 8).

Appellants point out that the maximum temperature of the claims (75°C for claim 1 and 70°C for claim 10) is lower than that of Tanigawa. But this is not a meaningful distinction given that the temperature range exemplified by Tanigawa overlaps or touches the claimed range. Tanigawa heats to destroy pathogens and dehydrate the oyster (FF 2). Tanigawa provides some guidelines on heating temperatures and times sufficient to accomplish the required heating further noting that temperatures outside those ranges may need adjusting (FF 4). Those of ordinary skill in the art would have had a reasonable expectation of success of accomplishing the desired pathogen destruction and dehydration at the claimed ranges.

With regard to the second issue, we determine that Tanigawa describes a process of heating and freezing raw and unseasoned oysters as required by claims 1 and 10. As explained above, the product of Tanigawa's process is a raw oyster. What is frozen is an unseasoned oyster, only after defrosting the oyster is it seasoned (FF 2). Claims 1 and 10 do not exclude a further method of seasoning the oyster at some point in time after defrosting.

With regard to the third issue, we determine that Appellants have not overcome the Examiner's finding of a reason to combine the teachings of the references. "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397). The references relied upon by the Examiner evidence a problem known in the art

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(e.g., air causing a reduction in flavor and freezer burn) and a known solution (glazing) (FF 7 and 9). Appellants have not provided any evidence showing that their application of glazing is anything more than a predictable use of what was known in the art.

III. CONCLUSION

We determine that Tanigawa suggests heating oysters as claimed and that Appellants have not shown that the Examiner's finding of a reason to combine the teachings of the references was not supported by the evidence.

IV. DECISION

The decision of the Examiner is affirmed.

V. 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

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The Matthews Firm
2000 Bering Dr.
Suite 700
Houston, TX 77057