

1 The opinion in support of the decision being entered today was *not* written
2 for publication and is *not* binding precedent of the Board
3

4 UNITED STATES PATENT AND TRADEMARK OFFICE
5

6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
9

10
11 *Ex parte* DBC and XanGo
12

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14 Appeal 2007-1907
15 Reexamination Control No. 90/007,178¹
16 Patent 6,730,333 B1²
17 Technology Center 1600
18

19
20 Decided: August 24, 2007
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23 Before RICHARD E. SCHAFER³, MICHAEL P. TIERNEY, and JAMES
24 T. MOORE, *Administrative Patent Judges*.

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26 MOORE, *Administrative Patent Judge*.

27
28 DECISION ON APPEAL

29 A. Introduction

30 DBC and XanGo appeal under 35 U.S.C. §§ 134 and 306 from the
31 final rejection for obviousness over the prior art of claims 1-81, all the

¹ Filed August 20, 2004. The Real Party in Interest is identified as DBC, LLC (assignee) and XanGo, LLC (exclusive licensee).

² Issued May 4, 2004.

³ Judge Romulo H. Delmendo, who participated in the Oral Argument of this appeal, is unavailable to participate in this decision.

1 claims present in his reexamination application. We have jurisdiction under
2 35 U.S.C. § 6.

3 We AFFIRM.

4 B. Findings of Fact

5 The following findings of fact and any set out in the Discussion
6 section are supported by a preponderance of the evidence of record. Any
7 conclusions of law should be treated as such.

8 1. The 90/007,178 application ("application") is the vehicle for
9 reexamination of U.S. Patent 6,730,333 B1 (the application is cited as the
10 "333 patent").

11 2. The claimed subject matter relates to a fruit based beverage.

12 3. The real parties in interest are DBC and XanGo. (Br. at 1.)⁴

13 4. Litigation involving the '333 patent was filed, and is presently stayed,
14 in the United States District Court for the District of Utah, Case No.
15 2:04cv405. (Br. at 2).

16 5. The Appellants have withdrawn their appeal as to claims 29-43 (Br. at
17 3, fn. 2). Accordingly, the rejection as to claims 29-43 is summarily
18 AFFIRMED herein.

19 6. This decision addresses the rejection of claims 1-28 and 44-81.

20 7. Oral Argument was heard on this appeal on June 20, 2007, from 10:00
21 to 10:30 AM.

⁴ All references to the Appellants' Brief refer to the Appellants' Amended Appeal Brief, filed December 16, 2005.

1 8. Mr. Larry Jarvis, Registration Number 27,341 appeared for the
2 Appellants.

3 The Application Disclosure

4 9. According to the application, one of the objects of the invention is to
5 provide "nutraceutical compositions derived from the fruit of the *Garcinia*
6 *mangostana L.* plant, otherwise known as the mangosteen plant." (333
7 patent at 1: 7–9.)

8 10. The nutraceutical compositions are said to comprise a mixture of the
9 fruit and the pericarp of the mangosteen fruit. (1:11-12).

10 11. The nutraceutical compositions are said to contain xanthone
11 compounds (2:63).

12 12. In preparation, the entire mangosteen fruit is ground into a pulp, then
13 selected juice concentrates and water are added.

14 13. Nutraceutical is defined in the specification to include “any
15 compounds or chemicals that can provide dietary or health benefits when
16 consumed by humans or animals” (3:59-61).

17 The Application Claims

18 14. Claims 1, 5, and 15 are representative of the issues on appeal.

19 15. Claim 1 reads:

20 A nutraceutical beverage comprising:

21 pericarp from fruit of a *Garcinia mangostana L.* tree; and

22 a first juice from fruit of a *Garcinia mangostana L.* tree; and

1 at least one second juice selected from the group consisting of fruit
2 juice and vegetable juice.

3 16. Claim 5 reads:

4 The nutraceutical beverage of claim 4⁵, wherein said vegetable juice
5 is comprised of at least one of alfalfa juice, carrot juice, celery juice, green
6 barley juice, green lettuce juice, kale juice, parsley juice, spinach juice, and
7 tomato juice.

8 17. Claim 15 reads:

9 The nutraceutical beverage of claim 11⁶, wherein a percentage by
10 weight of said pericarp from fruit of a *Garcinia mangostana L.* tree and said
11 juice from fruit of a *Garcinia mangostana L.* tree is approximately 3% to
12 50% of a total weight of said pericarp from fruit of a *Garcinia mangostana*
13 *L.* tree, said juice from fruit of a *Garcinia mangostana L.* tree and said juice
14 from concentrate.

15 The Prior Art

16 18. The Examiner has relied upon the following references:

17 Nakatani, *Biochemical Pharmacology* 63, 2002, pp. 73-79

18 Caius, *The Medicinal and Poisonous Plants of India*, 1986, pp. 430-1

19 Yaacob, *Mangosteen Cultivation*, 1995

⁵ Claim 4 reads: The nutraceutical beverage of claim 1, wherein said at least one second juice comprises vegetable juice.

⁶ Claim 11 reads: The nutraceutical beverage of claim 1, wherein said second juice comprises juice from concentrate.

1 Kirtiker, Indian Medicinal Plants, 1999, pp. 261-262

2 Duke, CRC Handbook of Alternative Cash Crops, 1993, pp. 257-9
3 and 474-98.

4 JP 08208501⁷ Hirokazu August, 1996

5 JP 11043442⁸ Saneho February, 1999

6 JP 442

7 19. JP 442 describes a legionella bacteria disinfection agent and ingestible
8 compositions, e.g., drinks, that contain the disinfection agent. (‘442, p. 5, ¶¶
9 1, 12 and 31)..

10 20. JP 442 describes various plants, including mangosteen pericarp, as
11 being “used since ancient times as a food material, an herb tea or a natural
12 additive” (6 ¶ 8).

13 21. JP 442 describes food products for preventing *Legionella* bacteria
14 infection including at least 0.001% of additives including mangosteen
15 pericarp. (7, ¶12).

16 22. JP 442 describes a drink, in Example 6, which includes an extract of
17 mangosteen pericarp, orange juice, and water. (16, ¶31).

18

⁷ Citations are to the 7 page English language translation thereof.

⁸ Citations are to the 17 page English language translation thereof. The reexamination prosecution history contains at least three different English language translations of the ‘442 document. The translations differ in page length, 17 pages, 18 pages and 23 pages. For reasons of convenience, we cite solely to the 17 page English language translation.

1 JP 501

2 23. JP 501 describes the antibacterial effect of *Garcinia mangostana L.*
3 against *helicobacter pylori*. (2: 24-28).

4 24. JP 501 also states that *Garcinia mangostana L.* fruit peels have been
5 used in the past as a peptic folk medicine, an anti-infection drug and an anti-
6 diarrhea drug. (3:4-8).

7 25. JP 501 describes the extracting of the dried fruit peel, the dried fruit,
8 and dried seeds of *Garcinia mangostana L.* to obtain the anti bacterial drug
9 (3:15-27).

10 26. JP 501 describes the reconstitution of the extract into a drug and states
11 that the drug can take any suitable form for administration including as a
12 syrup, solution, or suspension with a carrier. (4: 13-15).

13 27. JP 501 describes, among other carriers, starch, sucrose, and lactose.
14 (4:17-18).

15 Duke

16 28. Duke describes that *Garcinia Mangostana L.* is “[c]ultivated for its
17 fruit, which has a flavor suggestive of strawberry and grape; said to be the
18 most delicious of all tropical fruits.” (257:2-3).

19 29. Duke describes that the rind of the fruit is used as folk medicine. It is
20 said to be an astringent and used for the treatment of catarrh, cystitis,
21 diarrhea, dysentery, eczema, fever, intestinal ailments, itch, and skin
22 ailments. (257:10-17).

23 30. Duke illustrates the mangosteen fruit as follows:



1

2

This is an illustration of Mangosteen Fruit (508(c))

3

Yaacob

4

31. Yaacob describes mangosteen fruits as “one of the finest flavoured
5 fruits in the world, outranking all other tropical fruits; the mangosteen has
6 therefore justly earned the popular title of ‘Queen of Fruits’” (5:19-22).

7

32. Yaacob states that the “popularity of the mangosteen is consistently
8 increasing” (5:23).

9

33. Yaacob describes that research has revealed that the mangosteen
10 pericarp contains valuable compounds used as medicines and anti bacterial
11 agents. (11:7-10).

12

34. The medicinal uses described by Yaacob include central nervous
13 system depressant, blood pressure elevator, anti-inflammatory, anti-
14 ulcerative, anti-diarrheal, astringent, anti-dysentery and healing skin
15 infections. (11:13-29)

16

35. Yaacob describes that the mangosteen is preserved in the form of
17 fruits immersed in sugar and water, and as flavored drinks, candy, jams,
18 juices, jelly, syrups, and canned fruit segments (12:13-26).

19

36. Yaacob describes the edible pulp or aril of the mangosteen fruit as
20 “juicy, subacid, exquisitely flavoured, and faintly aromatic” (20:25-26).

1 Kirtikar

2 37. Kirtikar describes that the bark and rind of *G. mangostana L.* have
3 astringent properties and the gum and resins have cathartic properties (p.
4 260, ll. 35-37).

5 38. Kirtikar also describes that the rind is used as an astringent medicine
6 for diarrhea and dysentery (p. 261, ll. 27-29).

7 Nakatani

8 39. Nakatani describes the use of mangosteen fruit hull as a medicinal
9 treatment for skin infections, wounds, and diarrhea. (p. 1, cols. 1-2).

10 Caius

11 40. Caius describes *Garcinia Mangostana L.* and that the rind of the fruit
12 is a “well-known astringent useful in the treatment of diarrhoea [sic] and
13 dysentery.” (p. 430, final paragraph).

14 Miscellaneous Findings

15 41. One of ordinary skill in the art at the time the invention was made
16 knew that fruit juices and vegetable juices could be blended and that they
17 could be blended for flavor purposes, e.g., V-8[®] and cranapple juice.

18 The Examiner’s Rejections Under 35 USC § 103

19 42. Claims 1-28 and 44-81 stand rejected under 35 USC § 103 as being
20 unpatentable as obvious over the combination of JP ‘442, JP ‘501, Duke,
21 Caius, Nakatani, Kirtikar, and Yaacob. (Answer, p. 5, ll. 1-3).

1 43. The Examiner has found that the combined references taught that the
2 pericarp from fruit of *Garcinia mangostana L.* was known for therapeutic
3 purposes but had an unpleasant taste. (Answer, p. 5, ll. 4-6).

4 44. The Examiner found that one of ordinary skill in the art would have
5 recognized that the good tasting fruit of mangosteen, in combination with
6 another fruit or vegetable juice, would mask a bitter tasting ingredient, such
7 as mangosteen rind (Answer, p. 6)..

8 45. The Examiner concluded that it would have been obvious to one of
9 ordinary skill in the art at the time the invention was made to combine the
10 mangosteen rind, which has known medicinal qualities, with the known
11 good tasting fruit of mangosteen and another fruit or vegetable juice to cover
12 up the bad taste of the rind. (Answer, p. 6, ll. 6-13).

13 The Appellants' Arguments on 35 USC § 103

14 46. The Appellants urges four specific grounds of error. (Br. p. 15, ll. 19-
15 20).

16 47. First, the Appellants urge that the Examiner has failed to show a
17 suggestion or motivation to combine the references, including disregarding a
18 negative teaching in the record. (Br. p. 15, ll. 21-24).

19 48. Second, the Appellants urge that the rejection is based on hindsight,
20 alleging the Examiner used the present invention as a template. (Br. p. 15, ll.
21 25-26).

22 49. Third, the Appellants urge that the rejection fails to show a reasonable
23 expectation of success in the prior invention. (Br. p. 16, ll. 1-2).

1 50. Fourth, the Appellants urge that the cited references do not teach or
2 suggest all of the claim limitations on appeal. (Br. p. 16, ll. 3-4).

3 The Appellants' Argument on Secondary Considerations

4 51. The Appellants urge that the Examiner failed to properly consider the
5 proffered evidence of commercial success. (Br., p. 25, ll. 9-10).

6 C. Discussion

7 Obviousness

8 A claimed invention is not patentable if the subject matter of the
9 claimed invention would have been obvious to a person having ordinary skill
10 in the art. 35 U.S.C. § 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct.
11 1727, 82 USPQ2d 1385 (2007); *Graham v. John Deere Co. of Kansas City*,
12 383 U.S. 1 (1966).

13 Facts relevant to a determination of obviousness include (1) the scope
14 and content of the prior art, (2) any differences between the claimed
15 invention and the prior art, (3) the level of skill in the art and (4) any
16 relevant objective evidence of obviousness or non-obviousness. *KSR*,
17 127 S. Ct. at 1734, 82 USPQ2d at 1389, *Graham*, 383 U.S. at 17-18.

18 A person having ordinary skill in the art uses known elements and
19 process steps for their intended purpose. *Anderson's-Black Rock, Inc. v.*
20 *Pavement Salvage Co.*, 396 U.S. 57, 90 S. Ct. 305, 163 USPQ 673 (1969)
21 (radiant-heat burner used for its intended purpose in combination with a
22 spreader and a tamper and screed); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273,
23 282, 96 S. Ct. 1532, 1537, 189 USPQ 449, 453 (1976) (the involved patent
24 simply arranges old elements with each performing the same function it had

1 been known to perform); *Dunbar v. Myers*, 4 Otto (94 U.S.) 187, 195 (1876)
2 (ordinary mechanics know how to use bolts, rivets and screws and it is
3 obvious that any one knowing how to use such devices would know how to
4 arranged a deflecting plate at one side of a circular saw which had such a
5 device properly arranged on the other side).

6 In analyzing the invention for obviousness, we look to the claim first.
7 Claim 1 of the instant reexamination proceeding calls for:

8 A nutraceutical beverage comprising:

9 pericarp from fruit of a *Garcinia mangostana L.* tree; and

10 a first juice from fruit of a *Garcinia mangostana L.* tree; and

11 at least one second juice selected from the group consisting of fruit
12 juice and vegetable juice.

13 We next turn to the prior art.

14 Of record in the rejection is JP '442, which discusses the known
15 medicinal qualities of pericarp. Of particular interest is Example 6, found on
16 page 16 of the translation, which describes a drink which includes orange
17 juice, water, and an extract of pericarp.

18 JP '442 describes health benefits of its composition; consequently it is
19 a nutraceutical according to the Appellant's definition in the Specification.
20 FF 12. Example 6 of JP '443 includes pericarp from fruit of a *Garcinia*
21 *mangostana L.* tree in the form of a medicinal extract. Example 6 also
22 includes orange juice, which is a juice selected from the group consisting of
23 fruit juice and vegetable juice.

1 Thus, the only difference between the single closest piece of prior art
2 of record and instant claim 1 is the addition of juice from fruit of a *Garcinia*
3 *mangostana L.* tree into the drink.

4 JP ‘442 also notes that “from the standpoint of ingesta palatability, the
5 addition of 5% or less [of extract] is particularly preferable.” (p. 7, last two
6 lines). One of ordinary skill in the art would also therefore recognize that JP
7 ‘442 teaches that the mangosteen rind had a taste problem which was
8 overcome by the addition of other components. One of ordinary skill in the
9 art would have realized that water and orange juice make up over 84% of the
10 beverage.⁹ One of ordinary skill in the art would recognize that juices can
11 be blended for flavor.

12 Duke describes that *Garcinia Mangostana L.* is “cultivated for its
13 fruit, which has a flavor suggestive of strawberry and grape; said to be the
14 most delicious of all tropical fruits.” (257:2-3). Yaacob describes
15 mangosteen fruits as “one of the finest flavored fruits in the world,
16 outranking all other tropical fruits; the mangosteen has therefore justly
17 earned the popular title of ‘Queen of Fruits’” (5:19-22).

18 We agree with the Examiner that these references provide ample
19 motivation to combine mangosteen juice, another fruit or vegetable juice,
20 and mangosteen pericarp in a beverage, to cover up the taste of the
21 mangosteen rind.

22 Specifically, the only difference between the prior art of record and
23 the claimed invention is the addition of a mangosteen juice to the

⁹ 54.46% water, 30.0% orange juice. (JP ‘442, 16, ll. 19-28).

1 nutraceutical mangosteen rind/orange juice beverage of the prior art.
2 Mangosteen fruit segments were known for their delicious taste and
3 Appellants' do not dispute the Examiner's finding that the blending of juices
4 for taste improvement was well known in the art.

5 Additionally, the blending of two known fruit juices to form a
6 beverage juice blend is prima facie obvious. *In re Kerkhoven*, 626F.2d 846,
7 850, 205 USPQ 1069, 1072 (CCPA 1980) (It is prima facie obvious to
8 combine two compositions each of which is taught by the prior art to be
9 useful for the same purpose, in order to form a third composition which is to
10 be used for the very same purpose.).

11 With this prior art background in place, we turn to the specific
12 arguments of the Appellants.

13 Suggestion or Motivation to Combine

14 The Appellants urge that the "Final Office Action" does not rely on
15 the prior art for a suggestion or motivation to combine the elements. (Br. p.
16 17, ll. 1-2). The Appellant urges that the Examiner did not provide
17 particular findings in the prior art that suggest or motivate the actual
18 combination being claimed. (*Id.*, ll. 21-22). The Appellant then quotes a
19 portion of that Final Office Action in support of its argument.

20 This argument is without merit. The portion of the final action of
21 April 21, 2005 quoted by the Appellant did not state the rejection as applied
22 in a previous December 6, 2004 Office Action. The quoted portion
23 addressed and responded to the arguments of counsel made in a March 7,
24 2005 response to the previous December 6, 2004 rejection. It concluded

1 with the statement that “Thus, the rejection is maintained and is proper”
2 (Final Action, April 21, 2005, p. 4, last line).

3 The text of the rejection as it stood is found in the Office Action dated
4 December 6, 2004 and the Examiner’s Answer.

5 In that rejection, the Examiner found pericarp from a fruit of *Garcinia*
6 *mangostana L.* (mangosteen) was known as well as the juice of mangosteen
7 and another juice. The Examiner specifically found that (1) Yaacob teaches
8 the use of mangosteen pericarp for various medicinal uses and that the fruit
9 was known to be preserved as a drink; (2) Kirtikar and Caius teach the
10 pericarp is used as an astringent; (3) JP ‘442 teaches combining the
11 mangosteen rind with fruits of other plants; (4) JP ‘501 teaches that pericarp
12 from mangosteen is used to treat various conditions; and (5) Duke teaches
13 mangosteen rind (pericarp) is known to be used as an astringent for various
14 ailments. (Office Action, December 6, 2004, pp. 2-3).

15 The Examiner then concluded it would have been obvious to one of
16 ordinary skill in the art at the time the invention was made to combine the
17 two or more ingredients which were known in the prior art to be useful for
18 the same purposes. (*Id.* p. 3).

19 The Appellant, on the other hand, urges that the quotation from the
20 Final Action is no more than conclusory statements and not evidence of
21 motivation or suggestion. (Br. p. 18, ll. 1-2).

22 We find that this argument ignores that the body of the rejection is
23 found elsewhere in the application prosecution history. This argument has
24 not challenged the substance of the findings and conclusion of the Examiner.

1 No persuasive contrary evidence is provided. Accordingly, we find no error
2 in the initial finding of obviousness based on this argument.

3 The “Teaching Away”

4 The Appellant next urges that the Examiner failed to consider the
5 prior art as a whole in that the prior art “teaches away from the combination
6 cobbled together by the Examiner” (Br. p. 18, ll. 7-9). The principal thrust
7 of this argument is that the rind tastes so bad one would not be led to
8 combine it with the fruit.

9 The Appellant quotes a portion of Yaacob:

10 The method of preparation is to cut carefully across the central
11 part of the woody layer, removing the thick skin without
12 touching the white aril. Care must be taken to prevent the
13 resins or tannins exuded from the cut pericarp coming into
14 contact with the fruit segments. When the segments of the aril
15 are exposed, they can be removed with a fork. The seeds are
16 also edible, after they have been boiled in water. (Br. p. 18, ll.
17 11-16).

18 The Appellant quotes a portion of Duke:

19 The juicy pulp (aril), surround [sic] and adhering to the seed, is
20 the edible part . . . Rind contains enough tannin for tanning
21 leather and is the source of a black dye. (Id. ll. 18-19).

22 The Appellant also urges that several references indicate that pericarp
23 is astringent, and concludes with the argument that the art teaches that the
24 pericarp should not be combined with the edible fruit of the mangosteen.
25 (Br. p. 19, ll. 1-10).

26 We agree with the Appellant that the evidence of record supports a
27 finding that the rind of the mangosteen fruit has a bad taste.

1 However, the “teaching away” that the Appellant is asserting is in the
2 specific context of fresh mangosteen fruit and ignores other known methods
3 of preparing the mangosteen fruit, and the known prior art methods of
4 overcoming the bad taste of the rind.

5 Appellants’ alleged teaching aware is nothing more than a recognition
6 that a person desiring solely the “delicious taste” of the mangosteen fruit
7 segments¹⁰ would keep the mangosteen’s pericarp portion separate from the
8 fruit segment. Yet, the record demonstrates that a person seeking the alleged
9 medicinal properties of the mangosteen pericarp would seek out the pericarp,
10 even though it is known to have a bitter taste.

11 Indeed, a person seeking the pericarp’s medicinal benefits, but at the
12 same time wishing to avoid its unpleasant taste, would attempt to mask the
13 flavor of the pericarp. As taught by the prior art, one of ordinary skill in the
14 art knows to mask a bitter tasting ingredient through the addition of a juice,
15 especially a fruit juice. As mangosteen juice is known as the “Queen of
16 Fruits” due to its great taste, one skilled in the art would have added the
17 mangotsteen juice to the prior art mangosteen rind/orange juice drink so as
18 to improve the taste of the prior art beverage.

19 However, the issue at hand does not most properly pertain to the
20 eating of fresh mangosteen in the jungles of Thailand or the Philippines.

¹⁰ The opening of the cited paragraph of Yaacob reads as follows:

Fresh Fruits

The mangosteen fruit is always best eaten as a fresh fruit. The method of preparation is to cut carefully(Yaacob, p. 14, ll. 4-11). Yaacob’s teaching, in perspective, is principally to the fresh fruit segments, not already known prepared drinks.

1 Rather, the closest prior art to the invention as claimed has already
2 recognized that the mangosteen rind has medicinal benefits and should be
3 included in a beverage with other juices for those medicinal benefits and
4 improved taste. (E.g. JP 442, Example 6). Indeed, the prior art has
5 recognized that the taste can be improved with water and orange juice. The
6 addition of mangosteen juice to the rind/juice known drink is taught by the
7 known desirability of the mangosteen fruit - the “Queen of Fruits” with a
8 great taste.

9 Finally, the multiple references teaching medicinal properties of the
10 mangosteen rind would have led one of ordinary skill in the art to include it
11 in the claimed composition - Duke, JP ‘442, JP ‘501, Yaacob, Caius,
12 Kirtiker, and others each teach at least one medicinal use for ingesting the
13 rind or an extract of the rind of the mangosteen fruit. What teaching there
14 may have been in the references regarding the bitter taste of the rind is more
15 than overcome by the teaching of benefits to be gained by the addition of the
16 rind to a drink. Furthermore, the argument lacks persuasive merit as the
17 closest prior art already has the rind in the beverage

18 Accordingly, we are unpersuaded by this contention.

19 “Official Notice”

20 The Appellant has urged that the Examiner has not cited to any
21 documentary evidence of motivation or a suggestion to combine, either in
22 the prior art or the general knowledge in the art. (Br. p. 19, last 2 lines). As
23 such, it is alleged that the Examiner must be taking “[o]fficial notice” of
24 those facts. (Br. p. 20, ll. 1-2). This argument is without persuasive merit.

1 It appears that this argument is based on the Appellants' quotation of
2 the same paragraph in the Final Rejection discussed above. As noted, that
3 paragraph was directed to addressing the Appellant's arguments and did not
4 restate the then pending rejection. The Appellants are either ignoring or are
5 not cognizant of the text of the rejection in the December 6, 2004 rejection.

6 We have found above that the rejection is based on facts of record in
7 this proceeding, supported by the evidence of the multiple cited references.
8 We see no instances of the Examiner taking "official notice" of facts
9 unsupported in the record.

10 Accordingly, this argument is unpersuasive as well.

11 Hindsight

12 The Appellant urges that the rejection is based on hindsight. More
13 specifically, the Appellant urges that the Examiner followed the suggestion
14 of the third-party requester and

15 [U]sed the '333 patent specification as a template to pick and
16 choose, from the many ingredients listed in the cited references,
17 certain ingredients, such as mangosteen pericarp, mangosteen
18 pulp, and other fruit or vegetable juices, and then combine them
19 together in accordance with the teaching of the '333 patent.
20 (Br. p. 23, ll. 1-4).

21 We also find this argument unpersuasive.

22 First, two of the three ingredients were known to be combined in a
23 beverage in Example 6 of JP '442.

24 Second, the only difference between the prior art and the claimed
25 invention of claim 1 was the addition of a known fruit juice with a known
26 superior taste, added for flavor. The references of record indicate that a

1 person of ordinary skill in the art, at a minimum, would have some practical
2 experience in formulating nutraceutical beverages for medicinal content and
3 flavor. (See, e.g. JP ‘442, example 6).

4 The art of record supports a finding of a teaching, suggestion, or
5 motivation to combine the references.

6 In particular, the record supports a finding that Appellants’ have done
7 no more than combine known elements in a known manner for the purpose
8 of achieving a predictable result, the formation of a fruit juice blend having
9 nutraceutical properties. KSR at 1739, 82 USQP2d at 1395.

10 Lack of a Reasonable Expectation of Success

11 The Appellant urges that it was known that the mangosteen pericarp
12 was bitter, tough, and astringent, and one of ordinary skill in the art would
13 have known to keep the pericarp separate from the fruit pulp. Accordingly,
14 it is urged that a person of ordinary skill in the art, being aware of these
15 teachings, would have no reasonable expectation of success of a
16 nutraceutical beverage containing mangosteen pericarp. (Br. p. 24, ll. 5-15).

17 As the evidence of record indicates that beverages had been prepared
18 in the prior art containing mangosteen pericarp (See, e.g. JP 442, example
19 6), and the Appellant has put forth no persuasive evidence to the contrary,
20 we find that this argument is without persuasive merit.

21 Failure to Show All the Claim Limitations

22 The Appellant urges that the Examiner “did not differentiate among
23 the 81 separate claims,” “failed to differentiate among the seven cited
24 references,” “failed to distinguish a primary reference and secondary

1 references,” and “failed to identify where each and every limitation of
2 claims 1-4, 6-14, 21-22, 44-47, 49, 50, 57-65, 73-74, and 78-80 was
3 allegedly disclosed in the prior art of record.” (Br. p. 25, ll. 8).

4 As to the argument relating to differentiating among the various
5 claims, we note that the Board of Patent Appeals and Interferences does not
6 sit in a supervisory capacity over the Patent Examining Corps. 37 CFR
7 §1.104(b) requires the Examiner’s Action to be complete as to all matters. If
8 the Action was not complete, a petition to the Director under 37 CFR
9 §1.181(a)(1) or (3) should have been made. No such petition appears in the
10 record. By proceeding to appeal, the Appellants as a litigation strategy have
11 chosen to forego this argument.

12 Furthermore, even were we to deem the issue properly before us, the
13 Appellant has not argued any of these multiple claims separately as required
14 by our rules. By separate argument, we mean specific argument relating to
15 why one of ordinary skill in the art would not have found a particular claim
16 or group of claims to be obvious. 37 CFR § 41.37(c)(vii) requires separate
17 argument of claims; merely pointing out what a claim recites is not separate
18 argument.

19 Additionally, “. . .the Board may select a single claim from the group
20 of claims that are argued together to decide the appeal with respect to the
21 group of claims that are argued together . . .” (*Id.*). We have selected claim
22 1; the Appellant has provided no meaningful argument or reasoning as to
23 why any of the other claims would have been separately patentable.
24 Accordingly, we need not reach the individual claims, as explained below.

1 Claims 2-5, 9-14, 21-22, 45-48, 50, 63-66, and 78-81 recite known
2 juices such as fruit juices, vegetable juices, or concentrates thereof. The
3 Appellant has not explained why each of which would not have been
4 obvious to use by one of ordinary skill in the art to be used in a beverage.

5 Claims 29-43 have been withdrawn from appeal and as such the
6 rejection is summarily affirmed.

7 Claims 6-8 recite known methods of preparing ingredients (whole
8 fruit, ground, or powdered). The Appellant has not put forth any meaningful
9 argument as to why each would not have been obvious to one of ordinary
10 skill in the art.

11 Claims 15-17 recite percentages by weight of fruit juice and pericarp;
12 claims 18-20 recite ratios of water to pericarp and juice; claims 23-25 recite
13 ratios of pericarp and first juice to the total weight; claims 26-28 recite ratios
14 of water to pericarp, first juice, and second juice; claims 51-53 recite a
15 percentage by weight of fruit pulp and pericarp; claims 54-56 recite a ratio
16 of water to fruit pulp, pericarp, and juice concentrate; claims 67-69 recite a
17 percentage by weight of ground fruit pulp and pericarp; claims 70-72 recite a
18 ratio of water to the remaining ingredients; and claims 75-77 recite a ratio of
19 water to liquid pericarp.

20 The Appellants have not put forth any meaningful argument as to why
21 these claims would not have been obvious.

22 Claim 49 recites flash pasteurizing the mixture of pericarp and juices.
23 The Appellants have not put forth any meaningful argument as to why this
24 claim would not have been obvious.

1 Claims 57-61 recite known nutraceutical delivery forms, namely
2 syrup, powdered drink mix, tablet, capsule, and beverage. The Appellants
3 have not put forth any meaningful argument as to why these claims would
4 not have been obvious.

5 Claims 44, 62, and 73 are independent method claims. Claim 44
6 recites “processing” of the claimed ingredients, “providing” another juice,
7 and “combining” into a mixture, claim 62 recites “grinding” the claimed
8 ingredients, “providing another juice, and combining into a mixture, and
9 claim 73 recites “grinding” pericarp, “providing” another juice; and mixing.
10 The Appellants have put forth no persuasive argument explaining why these
11 claims would not have been obvious to one of ordinary skill in the art at the
12 time the invention was made.

13 *Claim 73*

14 We observe that claim 73 appears to violate 37 CFR § 1.75(g),
15 requiring the least restrictive claim to be claim 1. Despite claim 73’s
16 placement towards the end of the claims, it has not escaped our attention that
17 claim 73 is undoubtedly a broad claim, requiring as ingredients only ground
18 whole mangosteen pericarp and a juice other than mangosteen juice, closely
19 mimicking Example 6 of JP ‘442. The Appellants have not explained why
20 this claim would not have been obvious to one of ordinary skill in the art at
21 the time the invention was made.

22 Finally, the Appellants' characterization of the references as "primary"
23 and "secondary" evidences a misunderstanding of the law. The question
24 before us is not determined by how the examiner has chosen to delineate the

1 references in his exposition of the rejection. Rather, the question to be
2 resolved under § 103 depends on what the prior art teaches or suggests and
3 whether what the prior art teaches or suggests would have rendered what is
4 claimed unpatentable. *In re Albrecht*, 579 F.2d 92, 94, 198 USPQ 208, 209,
5 210 (CCPA 1978); *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 267
6 (CCPA 1961)

7 We are therefore not persuaded by this argument.

8 The Secondary Considerations

9 The Appellant urges that the Examiner failed to consider its evidence
10 of non-obviousness. The Appellant alleges that XanGo™ juice sold
11 \$130,000.000 in gross sales in its first two years of business, and the
12 Examiner improperly failed to consider the information by applying an
13 erroneous nexus test.

14 In 1966, the Supreme Court in *Graham v. John Deere Co.*, 383 U.S.1,
15 148 USPQ 459 (1966) interpreted and applied section 103, stating:

16 Under 103, the scope and content of the prior art are to be
17 determined; differences between the prior art and the claims at
18 issue are to be ascertained; and the level of ordinary skill in the
19 pertinent art resolved. Against this background, the
20 obviousness or nonobviousness of the subject matter is
21 determined. Such secondary considerations as commercial
22 success, long felt but unsolved needs, failure of others, etc.,
23 might be utilized to give light to the circumstances surrounding
24 the origin of the subject matter sought to be patented. 383
25 U.S.1, 17-18, 148 USPQ 459, 467 (1966).

26

1 A nexus is required between the commercial success and the claimed
2 invention. *Ruiz v. A.B. Chance, Inc.* 234 F.3d 654 (Fed. Cir. 2000). This is
3 to ensure that the secondary considerations are really due to the claimed
4 invention, and not some other factor.

5 Objective evidence of nonobviousness including commercial success
6 must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791,
7 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of
8 thermoplastic foam "cups" used in vending machines was not commensurate
9 in scope with claims directed to thermoplastic foam "containers" broadly).

10 Additionally, commercial success must be the result of the claimed
11 and novel features. *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, [GET
12 PIN] 79 USPQ2d 1931, 1941-42 (Fed. Cir. 2006) (Evidence of commercial
13 success not credible where success was based on features that were not
14 new); *J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1571,
15 41 USPQ2d 1641, 1647 (Fed. Cir. 1997) (“[T]he asserted commercial
16 success of the product must be due to the merits of the claimed invention
17 beyond what was readily available in the prior art.”).

18 The difference between the prior art and the claimed composition is
19 the addition of mangosteen juice to a beverage containing mangosteen rind
20 and orange juice. Appellants’ evidence of commercial success must
21 demonstrate that the success was due to the novel feature of the claimed
22 invention, the addition of the mangosteen juice to a known mangosteen rind
23 nutraceutical beverage. As discussed below, it does not.

24
25

1 *Analysis of the Commercial Success*

2 We start with the commercial product, XanGo™. The only evidence
3 of record as to the contents of XanGo™ that we are directed to is the
4 Declaration of Mr. Bean, a patent attorney. According to the Declaration of
5 Mr. Bean:

6 4. I am also personally familiar with XanGo's nutraceutical
7 beverage product - XanGo™ Juice, sold under the trademark
8 XanGo™ and the related market. I have confirmed my understanding
9 of the XanGo™ Juice composition and production with XanGo's
10 employees and contractors. I have also confirmed my understanding
11 of the sales information and market position of XanGo™ Juice with
12 XanGo's employees and officers.

13

14 5. XanGo™ Juice is made from the whole fruit (both pericarp
15 and pulp) of a *Garcinia Mangostana L.* (Mangosteen) tree in
16 combination with juices from other vegetables, including other fruit
17 juices. Ingredients of XanGo™ Juice include reconstituted *Garcinia*
18 *mangostana* juice from whole fruit, apple juice concentrate, pear juice
19 concentrate, grape juice concentrate, pear puree, blueberry juice
20 concentrate, raspberry juice concentrate, strawberry juice concentrate,
21 cranberry juice concentrate, cherry juice concentrate, etc. *See Product*
22 *Label of XanGo™ Juice, attached as Exhibit B1.*”

1 An attached copy of a label of Xango containing a nutrition
2 information box contains the following information:

3

4 Supplement Facts
5 Serving Size: 1 fl. oz. (30 ml)
6 Serving [sic] per container: 25

7

8	Amount per 1 fl. oz. (30 ml)	% Daily Value*
9		
10	Calories 10	
11	Total Carbohydrate 3g	1%*
12	Sugars 2g	
13		
14	Proprietary Blend 30 ml	
15	Mangosteen (<i>Garcinia mangostana L</i>) Whole Fruit Juice	†
16	Apple Fruit Juice	†
17	Pear Fruit Puree	†
18	Blueberry Fruit Juice	†
19	Raspberry Fruit Juice	†
20	Strawberry Fruit Juice	†
21	Cranberry Fruit Juice	†
22	Cherry Fruit Juice	†

23

24 * Percent Daily Values are based on a 2,000 calorie diet

25 † Daily Value not established

26 Other Ingredients: citric acid, natural flavor, pectin, xanthan gum,
27 sodium benzoate.

28

29 First, we find that the testimony of Mr. Bean is of low persuasive
30 value in its form. Mr. Bean does not make clear how he has come by the
31 information of paragraph 5. We are presented with no evidence that Mr.
32 Bean did anything other than read a current product label, ask someone if it
33 was accurate, and then read those ingredients onto the claim, as discerned

1 from the last words of Paragraph 5 - “See Product Label of XanGo™
2 Juice, attached as Exhibit B1.”

3 Mr. Bean’s Declaration provides no persuasive evidence of any real
4 personal knowledge of the contents of XanGo™ for the relevant time frame
5 for claimed commercial success. For example, no chemical analyses,
6 product batch sheets, manufacturing records, sales records, or the like are
7 provided in support of any specific testimony that the commercially sold
8 XanGo™ product contains the listed ingredients in the time period 2002-
9 2004 accounting for the \$130,000,000 in sales. In sum, we do not find
10 paragraph 5 to be persuasive or credible.

11 Second, we are presented with no persuasive evidence that the
12 proffered product label accurately reflects the current content of XanGo™,
13 let alone its historic content over the time period for which commercial
14 success is claimed. We are provided with no testimony to assist in
15 interpreting this product label or information about the relative content of
16 any of the ingredients. The product label standing alone lacks any
17 persuasive evidence (e.g., testimony) linking it to the product and time
18 period of claimed commercial success.

19 For this reason alone, the Appellants’ showing of secondary
20 considerations in terms of commercial success fails.

21 However, we observe that the showing is deficient in additional ways.
22 It is not commensurate in scope with the claimed subject matter. All of the
23 ingredients listed in the Bean Declaration and product label are listed as
24 “fruit” juices. However, the claims, prosecuted by Mr. Bean, recite a second

1 juice selected from the group consisting of “fruit juice and vegetable juice.”
2 There is no persuasive evidence in the record of commercial success as to
3 the entire second category, vegetable juice. Each of the listed items on the
4 product appears as a “Fruit Juice” or “Fruit Puree.”

5 Mr. Bean’s Declaration does seem to say that XanGo™ is made from
6 mangosteen fruit “in combination with juices from other vegetables,
7 including other fruit juices.” (Paragraph 5, lines 2-3). If Mr. Bean is
8 equating fruit with vegetable, then a good number of the dependent patent
9 claims directed specifically to “fruit” or “vegetable” do not further limit the
10 claims from which they depend (See, e.g. Claims 2, 4, 30, and 32). If Mr.
11 Bean is stating that one of the listed ingredients is a vegetable (in the sense
12 used in the specification and claims), then either he, the product ingredient
13 list upon which he is relying, or instant claim 3 which he prosecuted is in
14 error in listing each ingredient as a “Fruit Juice.”

15 In other words, we find that Mr. Bean appears to be glossing over the
16 inconsistency and lack of evidence relating to the vegetable juice half of the
17 claim. As a consequence the probative value of his Declaration is
18 significantly diminished.

19 Counsel for XanGo relies heavily upon Mr. Bean’s statements, noting
20 that:

21
22 “Mr. Bean, a chemical engineer and patent attorney serving as
23 the corporate counsel of XanGo and the prosecuting attorney of
24 the ‘333 patent, declared, under oath, and from his own
25 personal knowledge of XanGo™ Juice, that the commercial
26 product:

27 * includes pulp and pericarp from mangosteen whole
28 fruit;

1 *includes juice from mangosteen fruit; and
2 *includes other fruit and vegetable juices, such as apple
3 fruit juice, pear fruit juice, grape fruit juice, and cranberry fruit
4 juice.” (Br. p. 28, l. 16 - p. 29, l. 2.)(emphasis added).
5

6 Again, we are not told how Mr. Bean acquired his personal
7 knowledge, or which of the juices in XanGo™ is a “vegetable” juice.

8 We then turn to the sales data. Even though a raw \$130,000,000.00 in
9 sales is an impressive figure for a two year period, there is no persuasive
10 evidence tying those sales to the claimed subject matter. Mr. Bean’s
11 Declaration lacks credibility and persuasive evidence of exactly what was
12 sold those two years. The sales data, if the content is as on the label, is also
13 not commensurate in scope with the claimed subject matter.

14 Even were those infirmities overcome, there is already evidence in the
15 record which indicates that the commercial sales may be due to other factors.
16 For example, Yaacob states that the “popularity of the mangosteen is
17 consistently increasing” (Yaacob, 5:23). It is said to be an extremely good
18 tasting juice. Duke calls it “the most delicious of all tropical fruits.” (257:2-
19 3). We are provided with no evidence comparing the growth in sales of
20 XanGo™ to the growth in sales of mangosteen juice in general.

21 The Appellants also urge that XanGo’s marketing efforts are “flat”
22 and “low” and generally less than 0.60% of product sales. (Br. p. 41, l. 1
23 and 4). However, XanGo, the parent company which sells XanGo™, also
24 appears to be a multilevel marketing company. In its evidentiary appendix
25 to the Brief, a sheet entitled “Xango Compensation” seems to indicate there
26 are levels of sales earning commissions of up to 30% - so called “PowerStart

1 “Double-Depth” sales. In its policies and procedures manual, XanGo is said
2 to be a “network marketing company.” (Page 1). How much of the
3 commercial success is due to aggressive network marketing in the form of
4 sales commissions and bonuses is unexplained by the Appellants.

5 In ex-parte proceedings before the Patent and Trademark Office, an
6 applicant must show that the claimed features were responsible for the
7 commercial success of an article if the evidence of nonobviousness is to be
8 accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40
9 USPQ2d 1685, 1690 (Fed. Cir. 1996). We are not requiring the Appellants
10 to prove the negative, but rather the Appellants must meet a minimum
11 burden of proving their case of commercial success, commensurateness, and
12 nexus with persuasive evidence of record sufficient to render the claims
13 unobvious. This the Appellants have not done.

14 The Appellants have not established with credible and persuasive
15 evidence what product was marketed and when. The Appellants have not
16 established that the product which was sold is commensurate in scope with
17 the scope of the claims for which protection is sought. Finally, the
18 Appellants have not persuaded us that the sales are a result of anything other
19 than network marketing, the increasing popularity of mangosteen, and
20 improved availability of the mangosteen fruit in general.

21 Accordingly, we find that the evidence of commercial success is
22 insufficient to persuade us of the unobviousness of the claimed subject
23 matter, which differs from the prior art only in the addition of a known,
24 tasty, mangosteen juice.

Appeal 2007-1907
Reexamination Control No. 90/007,178
Patent 6,730,333 B1

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