

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW S. WHITEHOUSE,
JOHN H. WALKER AND
RICHARD J. CRAGGS

Appeal 2007-3150
Application 10/465,662
Technology Center 1700

Decided: January 4, 2008

Before CHUNG K. PAK, CATHERINE Q. TIMM, and JEFREY T. SMITH,
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, and 3-7. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

I. BACKGROUND

The invention relates to a 1 to 2.75 gram filled confectionary product. Claim 1 is illustrative of the subject matter on appeal:

1. A filled confectionery product having a weight from 1 to 2.75 g and comprising a shell-molded fat-containing confectionery material with a viscous confectionery filling.

Appellants request review of the rejections maintained under 35 U.S.C. § 103(a), i.e.: (1) the rejection of claims 1, 3, 6, and 7 over Appellants' Prior Art Admission (Specification 1:13-16) or British Patent 769,092 issued to S. A. Macchine Industria Dolciaria Carle & Montanari (published Feb. 27, 1957) (Macchine) in view of Bites Candies – Hershey's, hersheys.com/products/details/bites.asp (accessed Jan. 24, 2005); and (2) the rejection of claims 4 and 5 over the above references further in view of EP 0 775 448 A1 issued to Jury (published May 28, 1997).

With respect to the rejection of claims 1, 3, 6, and 7, Appellants argue the claims together with the exception of claim 7. Appellants do not separately argue the rejection of claims 4 and 5. We, therefore, select claims 1 and 7 as representative for deciding the issues on appeal.

II. DISCUSSION

The issues on appeal arising from the contentions of Appellants and the Examiner are: (1) Based on the totality of the evidence of record, would it have been obvious to one of ordinary skill in the art to make a filled confectionary product of the 1 to 2.75 g weight required by claim 1; and (2)

would it have been obvious to that ordinary artisan to package a plurality of the those filled confectionary products together as required by claim 7?

We answer both questions in the affirmative.

A preponderance of the evidence of record supports the following Findings of Facts (FF):

1. According to Appellants' Specification, "[b]ite-sized confectionery products usually have a weight of about 3-6g" and "[m]any chocolate-coated bite-sized confectionery products contain a center which contrasts with the chocolate in terms of taste and texture, e.g. caramel, fondant or praline and can be made on a shell molding line." (Specification 1:13-16).
2. Shell molding is a process of injecting chocolate into a mold, passing the mold through a cooling tunnel to set the outside of the chocolate, turning the mold upside down to drain the liquid chocolate from the center to leave a chocolate shell coating the mold cavities, turning the mold back over, filling the center of the chocolate shell with filling, applying a layer of chocolate over the top of the filling to form the bottom of the confectionery product, cooling, and demolding (Specification 1:16-24).
3. "When filling the shell, it is important that the center material does not melt the chocolate. There are few problems with fondants or fat-based fillings such as pralines, which can be relatively fluid at about 30°C, but one of the main difficulties with caramel is that it tends to stretch out in a tail that does not easily break under its own weight and gravity." This is known as "tailing" and it causes problems with dosing, product weight and shape, product aesthetics and quality,

- shelf-life, equipment hygiene, and equipment function (Specification 1:25 to 2:4).
4. Claim 1 encompasses filled confection products with “viscous confectionery filling.”
 5. “[T]he term ‘viscous’ for the viscous confectionery filling, means a filling which is pumpable at the time it is deposited. It may also be flowable or pourable and may be a liquid or a semi-liquid with a minimum viscosity of 0.05Pa.s at 30°C, i.e. the viscosity of cocoa butter at 30°C.” (Specification 3:13-16).
 6. According to the Specification, “viscous confectionery fillings” include “toffee, caramel, hydrocolloid, Turkish delight, coconut paste, yogurt, mousse, fondant, praline, marshmallow, nougat, peanut butter, truffle, marzipan, jelly or any mixture of two of more thereof.” (Specification 3:18-20).
 7. Macchine discloses that shell molding for the production of “chocolate tablets and small chocolate articles filled with creams or the like” was known in the art (Macchine, p. 1, ll. 9-19).
 8. The word “creams,” refers to fondants or similar confectionary fillings within the chocolate. (“Confectionery fillings” are “products such as fondants or cremes which may contain nuts, flavorings, or other ingredients and are used to fill sugar confectionery or bakery products,” Dictionary of Food Science and Technology (Compiled and edited by The International Food Information Service Dictionary 2005) available at knovel.com/knovel2/Toc.jsp?BookID=1404&VerticalID=0; *see also* “cream,” dictionary. com unabridged v 1.1 (accessed Dec. 19, 2007):

- “usually, creams, a soft-centered confection of fondant or fudge coated with chocolate.”).
9. Macchine does not disclose the weight of the “small chocolate articles,” nor does Macchine disclose any limitations on the weight of the “small chocolate articles” produced using the shell molding process.
 10. Hershey’s Bites are filled confectionary products having a viscous confectionery filling such as peanut butter covered in chocolate (Bites, pp. 1-2; Ans. 3).
 11. An individual Reese’s Peanut Butter Bite has a weight of about 2.5 g (Bites, serving size information; Ans. 3).
 12. Bites are marketed as “perfect for munching” (Bites, p. 1).
 13. Bites are not shell molded, they are made using a panning process (Br. 11; Ans. 4).
 14. Tailing was a known problem with a known solution at the time of the invention. For instance, there was known a method of cutting the tail with a pulse of steam or compressed air issued through the filling nozzle (Specification 2:5-9 citing GB 2,026,378).

“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 (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 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

“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.” *KSR*, 127 S. Ct. at 1740. In analyzing the question of obviousness it is proper to take into account the interrelated teachings of the prior art, the effects of demands known to the design community or present in the market place, and the background knowledge possessed by the ordinary artisan. *KSR*, 127 S. Ct. at 1740-41. Moreover, it is also proper to take into account the inferences and creative steps that a person of ordinary skill in the art would employ. *KSR*, 127 S. Ct. at 1741.

Applying the preceding legal principles to the Factual Findings in the record of this appeal, we determine that the Examiner has established a *prima facie* case of obviousness.

There is no question here that filled confectionary products weighing from about 3 to 6 g were known in the art, Appellants admit as much in the Specification (FF 1). There is also no question that shell molding was used to make small and bite-sized filled confectionaries (FF 1 and 7). The Examiner has also provided evidence that there was a market demand for filled confectionaries of sizes of, for instance, 2.5 g, the size of Hershey’s Bites (FF 10-12). As the prior art evidences a need for filled confectionaries

within the claimed size range, the question is: Was it within the capability of one of ordinary skill in the art to make shell molded confectionaries in the size range of 1 to 2.75 g? *See KSR*, 127 S. Ct. at 1740 (“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”).

As an initial matter, the evidence cited by the Examiner supports a finding that making shell molded confectioneries was within the capabilities of the ordinary confectionery manufacturer. Contrary to the contentions of Appellants (Br. 14), *Macchine* does not teach away from products in the 1 to 2.75 g weight range, *Macchine* is merely silent as to the weight of the “small chocolate filled articles.” Under the circumstances, it is presumed that adjustment of the size and weight would have been within the capabilities of those of ordinary skill in the art, there being any number of workable or optimal solutions, and it is well settled that where patentability is predicted on such a routinely varied parameter the burden is on the applicant to establish with objective evidence that the change is critical. *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990); *In re Aller*, 220 F.2d 454, 456 (CCPA 1955); *In re Troiel*, 274 F.2d 944 (CCPA 1960).

In the present case, Appellants have cited no *objective* evidence which establishes criticality. Rather, Appellants rely upon the opinion of one of the inventors, Whitehouse, that “the process and apparatus taught by *Macchine* would not be capable of producing the filled confectionary products having a weight from 1 to 2.75 g.” (Whitehouse Affidavit ¶ 6). We do not find this opinion to be persuasively supported such that the evidence of

nonobviousness outweighs the evidence of obviousness when all the evidence is considered together.

The opinion of Whitehouse is, at least in part, premised on the belief that “[a] typical confectionery cream is not a viscous confectionery filling,” (Whitehouse Affidavit ¶ 6). But this statement ignores the breath of the claim language. We determine that Appellants’ claim language, “viscous confectionery filling” encompasses “creams” as that word is used in Macchine. The word “cream” as used in the context of filled chocolates is understood to refer to fondants or similar confectionery fillings (FF 8), and, according to Appellants’ Specification, such fondants and similar confectionery fillings are “viscous confectionery fillings” as those words are used in claim 1 (FF 4-6).

It is because, according to the Whitehouse Affidavit, that Macchine does not deal with the problem of tailing, that Macchine would not be capable of producing 1 to 2.75 g confectionery products. But Appellants’ Specification indicates that there are few problems with viscous confectionery fillings such as fondants and pralines, rather, the tailing problem occurs with caramels (FF 3). There is no convincing evidence that tailing would have been a problem with the “creams,” i.e., fondants, of Macchine when using the apparatus to form 1 to 2.75 g filled chocolates. Appellants’ evidence is not commensurate in scope with the claims. *See In re Greenfield*, 571 F.2d 1185, 1189 (“[O]bjective evidence of non-obviousness must be commensurate in scope with the claims which the evidence is offered to support.”).

We also note that Appellants’ Specification indicates that tailing was a known problem with known solutions (FF 14). In an obviousness assess-

ment, skill is presumed on the part of the artisan, rather than the lack thereof. *In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985). The evidence as a whole indicates that those of ordinary skill in the art would understand how to modify the conventional shell molding process and apparatus, such as that taught by Macchine, to prevent tailing. The Whitehouse opinion does not adequately take into account the skill of the ordinary artisan.

After reviewing the totality of the evidence, we determine that the evidence of record supports the Examiner's determination that it would have been obvious to one of ordinary skill in the art to make a filled confectionery product of the 1 to 2.75 g weight required by claim 1.

With regard to claim 7, the issue is: Would it have been obvious to that ordinary artisan to package a plurality of the filled confectionery products together as required by claim 7?

We answer in the affirmative because the evidence (Bites) shows it is conventional to so package such products, and there is no convincing evidence that sticking due to the tailing problem would have existed for the "creams" of Macchine, or if tailing were a problem that those of ordinary skill in the art would not have overcome it using known methods and apparatus.

Upon further prosecution, the Examiner should consider a further rejection relying upon US 6,302,96 B1 issued Oct. 16, 2001 to Nelson et al., a patent describing the method and apparatus of depositing confectionery products used by Appellants (Specification 2:10-22). Nelson is prior art under 35 U.S.C. § 102(e), and Appellants have not yet removed Nelson as prior art, e.g., by satisfying 35 U.S.C. 103(c).

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III. CONCLUSION

Based on the totality of record, including due consideration of the Appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of 35 U.S.C. § 103.

IV. DECISION

We affirm the Examiner's decision rejecting the claims on appeal under 35 U.S.C. § 103.

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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