

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK DERAUD and ADAM GAMBEL

Appeal 2007-3965
Application 09/954,491
Technology Center 1700

Decided: April 28, 2008

Before THOMAS A. WALTZ, ROMULO H. DELMENDO, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 1-29. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We AFFIRM.

Appellants state they invented a method of configuring “a slice of a pizza-type pie that minimizes spillage of the toppings and sauce” and “is

conducive to consumption by utilizing only one hand” (Specification, hereinafter “Spec.,” 2, ll. 18-23). Specifically, the method includes the separate steps of folding at least a partially baked pizza-type pie in both the transverse and lengthwise directions (Spec. 3, ll. 3-9).

Claims 1 and 14 on appeal read as follows:

1. A method of configuring a slice of a pizza-type pie, which is at least partially baked, the method comprising:

folding an end portion of the slice in a transverse direction; and

folding the slice in a lengthwise direction.

14. A method of configuring a slice of a pizza-type pie, which is at least partially baked, which method comprises:

folding an end portion of the slice in a transverse direction, wherein the end portion is substantially free of toppings and wherein the remainder of the slice has one or more toppings; and

folding the slice in a lengthwise direction.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Brad Appleton, *Pizza Inversion – a Pattern for Efficient Resource Consumption*, <http://www.www.enteract.com~bradapp/docs/pizza-inv.html> (Sep. 4, 2001, 4:43 PM; last modified Feb. 12, 1999)(available at <http://www.cmcrossroads.com/bradapp/docs/pizza-inv.html>).

Cooking A to Z, edited by Jane Horn, Cole Group, Inc. 447 (1997).

The Examiner rejected claims 1-29 under 35 U.S.C. § 103 as follows:

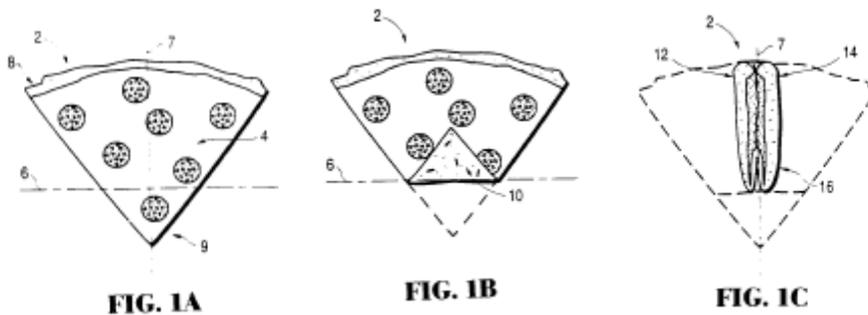
- I. claims 1-13 as unpatentable over Appleton (Examiner’s Answer mailed Jan. 22, 2007, hereinafter “Ans.,” 3-4); and
- II. claims 14-29 as unpatentable over the combined teachings of Appleton and *Cooking A to Z* (Ans. 4-5).

ISSUE

Have Appellants demonstrated reversible error in the Examiner's determination that the subject matter of the appealed claims would have been obvious to a person having ordinary skill in the art in view of the applied prior art?

FINDINGS OF FACT

1. Appellants' Figures 1A-1C are reproduced below:



2. Figures 1A-1C are said to illustrate one embodiment of the invention (Spec. 4, ll. 7-10).
3. Appellants' Specification, at page 6, lines 8-12, defines the term "toppings" as follows:

The toppings can include, but are not limited to, one or more of the following: cheese, such as mozzarella cheese, feta cheese, and goat cheese; vegetables/fruits, such as onions, tomatoes, mushrooms, bell peppers, onions, and pineapples; and meat/fish, such [as] sausage, pepperoni, ham, bacon, chicken, turkey and anchovies.

4. Appellants' Specification, at page 10, lines 11-16, defines the phrase "substantially free" as follows:

The term “substantially free,” as used herein, means that the referenced material is not added to the portion of the slice before baking. Accordingly, the term “substantially free” can encompass portions of a slice on which some of the toppings and sauce have migrated over during baking. Without wanting to be bound by any one theory, it is believed that a minority portion that is substantially free of toppings allows a better transverse fold.

5. Under a section captioned “Motivation” at page 1, Appleton describes a problem in consuming pizza quickly, as follows:

One of the more significant problems faced by software engineers revolves around the need for nutritional sustenance while maintaining personal productivity. The impossibly hectic schedules of most software development projects demands that developers spend more time developing software than satisfying their hunger...

Because efficiency and scheduling are *always* important concerns, developers frequently need to consume multiple slices of round pizza in a short period of time. The tomato sauce tends to be very hot, however, and the cheese on top of it adds to the problem by forming an insulating layer that locks in the heat. To make matters worse, cheese contains non-negligible levels of fat and, when melting, forms pockets of grease which can reach exceedingly high temperatures (a condition aggravated by fatty toppings like ground beef, pepperoni, and Italian sausage).

When trying to eat pizza quickly, the grease on the cheese and the hot tomato sauce

underneath can severely burn the roof of one's mouth...

The naive approach of waiting for the pizza to cool may at first seem reasonable. But the resultant increase in the latency-time between when the pizza arrives and when it has cooled enough for human consumption imposes an unacceptable performance penalty that impedes programmer productivity.

6. To address the need for consuming pizza quickly without burning one's mouth, Appleton discloses a method under a section captioned "Implementation" (p. 4), as follows:

2. *Singleton Slice*: If you have a single slice of pizza you can envision an imaginary line lengthwise down the center of the slice that divides it into two symmetrical halves. Fold one half of the slice over (and on top of) the other half. Another variation that works with a single slice (assuming you have a round pizza) is to fold the pointed end of the slice towards the crust end. You don't get full slice coverage this way but some have expressed a preference for this particular implementation.

7. Appleton establishes that the level of ordinary skill in the art is that of the consumer of the pizza.
8. A person having ordinary skill in the art (*i.e.*, a person who consumes pizza) would have known that a thinner pizza with relatively little or no toppings would be easier to fold than a thicker pizza with relatively more toppings.
9. The photograph at the top of page 447 of *Cooking A to Z* is reproduced below:



10. The photograph at the top of page 447 of Cooking A to Z shows a slice of pizza cut out from a round pizza in which fewer toppings are present towards the pointed end of the slice.
11. Appellants rely on the Declaration of Marc J. Halperin filed on October 12, 2006 pursuant to 37 C.F.R. § 1.132 (hereinafter “Halperin Declaration), which is appended to the Supplemental Appeal Brief filed on Nov. 1, 2006 (hereinafter “App. Br.”).
12. Halperin declares that he is the Culinary Director at the Center for Culinary Development in San Francisco, California, and that his “experience includes developing packaged foods, including pizza...” (¶2).
13. Halperin states that the inventors presented their ideas to commercialize the invention to the principals at the Center for Culinary Development (¶¶7-8).
14. Halperin declares that Appellants’ invention is “new and innovative” (¶8).
15. Halperin states (¶9):

[I]t had never occurred to me as a trained chef (and was not obvious to me) to first fold the pointed end of the slice towards the crust end and then fold one half of the folded slice of pizza over the other half. The combination of the two folds was new and not obvious to me. Further, I did not expect the combination of the two folds to produce a satisfactory result.

16. Halperin further declares: “In addition, I had never seen or been aware of a pizza, where one or more strategic portions of the pizza are free of cheese and toppings” (§10).

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 the subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

KSR reaffirms the analytical framework set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), which mandates that an objective obviousness analysis includes: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. *KSR*, 127 S. Ct. at 1734. Secondary considerations such as commercial success, long felt but unsolved needs, or failure of others “might be utilized to give light to the circumstances surrounding the origin

of the subject matter sought to be patented.” *Id.* (quoting *Graham*, 383 U.S. at 17-18).

ANALYSIS

In addressing each of the two grounds of rejection, Appellants argue the claims together. Accordingly, we confine our discussion of the two rejections to claims 1 and 14, respectively. 37 C.F.R. § 41.37(c)(1)(vii).

With respect to claim 1, Appellants’ principal argument is that Appleton “merely shows that it was known to eat pizza using either the half fold or the end fold” and that it not only “fail[s] to recognize the applicants’ problem to be solved, but it also fails to provide any explicit or implicit motivation or suggestion to combine the two folds on a single slice” (App. Br. 15). The Examiner, on the other hand, acknowledges that Appleton does not teach the combination of folding steps as recited in appealed claim 1 (Ans. 3). Nevertheless, the Examiner reasoned that “[i]t would have been obvious to one skilled in the [art] to combine folding of the end portion toward the crust and then folding one half over the other half if one want[s] a closed pocket to further ensure that the topping and sauce will not drip out easily.” (Ans. 3). According to the Examiner, “[b]oth foldings are known and to combine them when one wants a more closed in pocket would have been readily apparent to one skilled in the art” (Ans. 3-4).

We are in complete agreement with Examiner that the subject matter of appealed claim 1 would have been obvious within the meaning of 35 U.S.C. § 103(a). As acknowledged by Appellants, Appleton shows that it was known to fold a slice of pizza either transversally (*i.e.*, folding in the direction of the crust from the pointed end) or lengthwise (Fact 6). Because

Appleton desires a pizza slice that can be consumed quickly without burning the mouth (Fact 5), one of ordinary skill in the art would have found it obvious to use both known folding steps as described in Appleton with the reasonable expectation that the resulting pizza would be more compact in size and thus more quickly consumed.

We are not persuaded by the Halperin Declaration (Facts 11-15). Halperin emphasizes that the claimed invention is “new” (Fact 14). That, however, does not address the heart of the matter, which is obviousness. While Halperin avers that “[t]he combination of the two folds was new and not obvious to me” (Fact 15), he does not explain why a person having ordinary skill in the art would have so concluded in spite of Appleton’s disclosure. Also, while Halperin states that “I did not expect the combination of the two folds to produce a satisfactory result” (Fact 15), this conclusory statement is unsupported by any factual evidence or acceptable scientific reasoning. *See, e.g., In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997).

Appellants argue that Appleton “fails to teach applicants’ claimed invention because Appleton’s ‘Pizza Inversion’ disclosure sought to solve a different problem” (App. Br. 14). Even if Appleton addresses a different problem, this does not defeat the Examiner’s prima facie case of obviousness because any need or problem known in the field of endeavor at the time of the invention and addressed by the prior art can provide a reason for combining the elements in the manner claimed. *KSR*, 127 S. Ct. at 1742. *See also In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996) and *In re Dillon*, 919 F.2d 688, 693 (Fed. Cir. 1990)(*en banc*) (the motivation to combine the prior art references need not be identical to that of Applicants).

Appellants assert that “[n]ot only is the combination of the two folds counter-intuitive, the skilled artisan would expect traditionally flat pizza slice to be thickened and stiffened by one fold and to resist a second fold” (App. Br. 15). This position lacks merit because a person having ordinary skill in the art (*i.e.*, a person who consumes pizza) would have known that a thinner pizza with relatively little or no toppings would be easier to fold than a thicker pizza with relatively more toppings (Fact 8). Our determination on this matter is supported by the fact that appealed claim 1 also fails to limit the thickness or amount of toppings in any way.

With respect to appealed claim 14, Appellants contend that *Cooking A to Z* “shows a vegetable topping in the center of the pizza” (Facts 9-10) and, therefore, the Examiner did not make out a prima facie case of obviousness with respect to this claim requiring an end portion “substantially free of toppings.” (App. Br. 20). We disagree. Appellants’ Specification informs one skilled in the relevant art that the end portions are not entirely free of toppings and can include toppings that have migrated during cooking (Facts 3-4). While *Cooking A to Z* shows a pizza with some toppings at the end portions, Appellants have not demonstrated that the claimed “substantially free of toppings,” which does not exclude toppings that have migrated during cooking, distinguishes over the prior art pizza.

CONCLUSION

On this record, we determine that Appellants have failed to demonstrate any error in the Examiner’s conclusion that the subject matter of claims 1-13 would have been obvious over Appleton and that the subject

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matter of claims 14-29 would have been obvious over the combined teachings of Appleton and *Cooking A to Z*.

DECISION

The Examiner's decision to reject the appealed claims 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).

AFFIRMED

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