

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VICTOR V. GUDAS,
MICHAEL A. REEED,
PHILIP G. SCHNELL,
HENRY T. TYRPIN,
MICHAEL J. GREENBERG
and FRED R. WOLF

Appeal 2007-4149
Application 10/280,688
Technology Center 1700

Decided: May 22, 2008

Before EDWARD C. KIMLIN, JEFFREY T. SMITH, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This is an appeal from the final rejection of claims 1-27 and 30-34.

Claim 1 is illustrative:

1. A method of producing a chewing gum product containing a physically-modified bitterness inhibitor in order to control the release rate of the bitterness inhibitor comprising the steps of:

- a) mixing a quantity of a bitterness inhibitor with a modifying agent in such a way so as to produce said physically-modified bitterness inhibitor, the bitterness inhibitor being selected from the group consisting of glucono delta lactone; sodium gluconate, potassium gluconate; neodiosmin; cyclotetradecenones, sclareolide; natural soy flavor; N-sulfomethyl-N-arylureas; sodium, potassium and ammonium salts of ferulic acid and caffeic acid; 2, 4-dihydroxyl benzoic acid; ferulic acid; sodium ascorbate; sodium acetate; sodium glycinate; calcium glycerolphosphate; sodium glycerolphosphate and mixtures thereof;
- b) adding a quantity of the physically-modified bitterness inhibitor and a bitter medicament to a chewing gum formulation to provide a bitterness inhibitor level in the chewing gum formulation of from about 0.5% to about 8.0%.

As evidence of obviousness, the Examiner relies upon asserted admitted prior art and the references cited at page 3 of the Answer.

Appellants' claimed invention is directed to method of producing a chewing gum comprising a bitter substance, such as a medicament, and a bitterness inhibitor selected from the Markush group recited in independent claims 1 and 18.¹ The bitterness inhibitor is modified to control its release rate in the chewing gum.

The appealed claims stand rejected under 35 U.S.C. § 103(a) as follows:

- (a) claims 1-22, 26, 27, and 32 over Patel in view Cherukuri,
- (b) claims 1-22, 26, 27, and 32 over Patel in view of Suzuki;

¹ Independent claims 24 and 25 do not recite any particular bitterness inhibitor.

(c) claims 23-25, 30, and 31 over Patel in view of Cherukuri or Suzuki in view of Yatka, and

(d) claims 33 and 34 over Patel in view of Cherukuri or Suzuki.

Patel, the "primary" reference in all the rejections under 35 U.S.C. § 103(a), discloses chewing gum comprising encapsulated salts as a bitterness inhibitor for mint type favors that are also contained in the chewing gum. As recognized by the Examiner, Patel does not disclose any of the specifically claimed bitterness inhibitors. To make up for this deficiency in Patel, the Examiner cites page 2 of Appellants' Specification for an asserted admission that many of the claimed bitterness inhibitors were well known in the art (*see* Ans. 4, first two complete sentences). The Examiner draws the legal conclusion that it would have been obvious for one with ordinary skill in the art to substitute one of the presently claimed, admittedly well known bitterness inhibitors for the encapsulated salts of Patel.

Appellants, in their Reply Brief, expressly state that they "do not admit on page 2 that any bitterness inhibitors are 'well known'" (Reply Br., sentence bridging pages 2-3). Appellants go on to state that "[p]age 2 merely points out some ideas disclosed in previously published patents where certain items were suggested as useful to reduce bitterness of other compounds in specific applications" (Reply Br., 3, first para.). Appellants further state that "[c]ertainly Applicants make no admission that any of the items are well known bitterness inhibitors" (*id.*).

In the face of Appellants' express repudiation of any admitted prior art asserted by the Examiner, and the Examiner's reliance on this assertion as essential to his conclusion of obviousness, the present appeal is not ripe for

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our decision. Significantly, the Examiner did not respond to this argument of Appellants which does not appear in the principal Brief. The Examiner only noted and entered the Reply Brief.

Accordingly, this application is remanded to the Examiner so that he may include in the statement of the § 103 rejections the specific prior art cited at page 2 of Appellants' Specification that is relied upon as evidence of the obviousness of adding the specifically claimed bitterness inhibitors in the chewing gum of Patel. The Examiner should consider prior art that teaches any of the claimed compounds as bitterness inhibitors, while also considering whether any of the claimed compounds were known to be bitterness inhibitors for medicaments or similar materials. Again, we must emphasize that not all the claims on appeal recite specific bitterness inhibitors (see claims 24 and 25).

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this remand by the Board.

This application, by virtue of its Aspecial@ status, requires ***immediate*** action by the examiner. *See MPEP ' 708.01(d).* The Board of Patent Appeals and Interferences ***must*** be informed promptly of any action affecting the appeal in this case, including reopening of prosecution, allowance and/or abandonment of the application.

REMANDED

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