

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AHMED HUSSEIN

Appeal 2008-1519
Application 10/443,085
Technology Center 1700

Decided: June 30, 2008

Before BRADLEY R. GARRIS, CATHERINE Q. TIMM, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 19-35. We have jurisdiction under 35 U.S.C. § 6(b).

I. BACKGROUND

According to the Specification “[t]he invention is directed to a pourable dessert liquid product comprising a dairy or non-dairy protein source, fat, sweetener, stabilizer, emulsifier, and a flavoring agent.” (Spec. 1, ¶ 1.) This pourable dessert liquid product may be used to form dessert cakes (such as “Tres Leches” type cakes, sponge cakes soaked with a blend of three milks), ready-to-use nutritious beverages, and any food products where condensed and/or evaporated milk is called for (Spec. 1 ¶¶ 2-3 and 3, ¶ 1). Moreover, the liquid dessert product may be frozen (Spec. 1, ¶ 3 and 3, ¶ 2). The claims are directed to liquid dessert compositions (e.g. claim 19), a dessert product of cake and the liquid dessert composition (e.g. claim 20), a process of making liquid dessert compositions (e.g., claim 29), and a frozen dessert composition (e.g., claim 31). Claims 19, 20, 29, and 31 are illustrative of the products and process:

19. A ready-to-use liquid dessert composition comprising:

about 4 to 12 wt % of a protein source;
about 4 to 12 wt % fat;
about 10 to 25 wt % sweetener;
between 0.01 % and 1 wt % stabilizer; and
about 0.05 to 1 wt % emulsifier.

20. A dessert comprising cake and the liquid dessert composition of claim 19, wherein the weight ratio of the cake to the liquid dessert composition ranges from 1:1 to 1:2.5.

29. A process of making a ready-to-use liquid tres-leches dessert composition comprising:

forming a dry blend of protein, stabilizer, emulsifier and

optional dry sweetener;

preparing an aqueous solution of the dry blend with water
and optional liquid sweetener;

heating the aqueous solution; and
adding fat to the aqueous solution,
wherein the composition comprises:

about 2% to about 20% protein;
about 4 to about 12% fat;
about 10% to about 25% sweetener;
between 0.01 % and 1 wt % stabilizer; and
about 0.05 to about 1% emulsifier

31. A frozen dessert composition comprising:

about 8% protein;
about 8% fat;
about 19% sweetener;
about 0.03% stabilizer; and
about 0,3% emulsifier.

The Examiner maintains the following rejections:¹

- A. Claims 19-35 rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-3, 8, 12-15, 17, 18, 20, 21, 34, and 42 of US 6,569,485 B2 issued on May 27, 2003 to Hussein;
- B. Claims 33-35 rejected under 35 U.S.C. § 112, ¶ 1 for lack of written descriptive support;

¹ The Examiner has withdrawn the rejection of claims 33-35 under 35 U.S.C § 112, ¶ 1 for lack of enablement (Ans. 2).

- C. Claims 19, 21-23, and 33-35 under 35 U.S.C. § 102(b) as anticipated by Gilmore (US 4,208,444 issued Jun. 17, 1980 to Gilmore et al.);
- D. Claims 20, 24-28, 31, and 32 under 35 U.S.C. § 103(a) as unpatentable over Gilmore in view of Bundus (US 4,307,123 issued Dec. 22, 1981 to Bundus); and
- E. Claims 29 and 30 under 35 U.S.C. § 103(a) as unpatentable over Dell (US 4,451,492 issued May 29, 1984 to Dell et al.) in view of Bundus.

II. DISCUSSION

A. Obviousness-type Double Patenting

Appellant advances no arguments against the obviousness-type double patenting rejection (Br. 8-14; Reply Br. 3).² We, therefore, summarily affirm with respect to this rejection.

B. Written Descriptive Support

The Examiner finds that there is no written descriptive support for the language “wherein the composition produces an unstable foam when whipped” as recited in claim 33 (Ans. 5).

Appellant contends that there is inherent support in the description and in the examples of the Specification. In addition, Appellant relies upon the Perks Declaration as evidence that Examples 1 and 2 of the original Specification produce the required unstable foam when whipped (Br. 9).

The Examiner responds that “unstable” is a relative term undefined by Appellant, claims 33-35 do not preclude a whipping agent, but require a

² Citations to the Brief are to the corrected Appeal Brief filed May 1, 2007.

stabilizer, and it is unclear how the claimed composition can be unstable when whipped when, in fact, the claims require a stabilizer (Ans. 8).

The issue to be resolved is: has Appellant overcome the Examiner's finding of lack of written descriptive support by showing that the claimed property is inherently described in the examples of the original Specification?

We answer that question in the affirmative.

As a first matter, by pointing to the fact that the Specification did not disclose the unstable foaming limitation, the Examiner satisfied the initial burden of presenting evidence or reasons why those of ordinary skill in the art would not recognize in the disclosure a description of the invention defined by claims 33-35. *See In re Wertheim*, 541 F.2d 257, 263-64 (CCPA 1976) ("we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. By pointing to the fact that claim 1 reads on embodiments outside the scope of the description, the PTO has satisfied its burden."). Therefore, the burden shifted to Appellant to show written descriptive support. *Id.* at 264. Appellant may meet that burden by showing that what is claimed is inherently present in what was originally disclosed in the Specification. *Id.* at 264; *see also Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 1421-22 (Fed. Cir.1987) (parent application's lack of express disclosure of inherent "equiaxed microstructure" property did not deprive c-i-p's claims to a sintered ceramic body having said property of the benefit of parent's filing date).

Perks indicates that she reproduced Examples 1 and 2 of the Specification (Perks Dec. ¶¶ 4-5), whipped the resulting compositions for 15 minutes (Perks Dec. ¶ 8), and observed that “[n]either Example 1 nor Example 2 of the subject application produced a stable foam; they could not form peaks, as is characteristic of a stable foam. Whipping was continued to 20 minutes and still no peaks formed.” (Perks Dec. ¶ 9). There is no dispute that the Perks Declaration faithfully reproduces Examples 1 and 2 of the Specification (Ans. 8), rather the Examiner questions the meaning of “unstable” and questions how the composition can be unstable given the presence of a stabilizer in the composition. However, Appellant’s experimental evidence shows that, in fact, the stabilizer levels in Examples 1 and 2 are not great enough to allow the formation of peaks (Perks Dec. ¶ 9). Moreover, Appellant points out that those of ordinary skill in the art understood the meaning of “unstable foam” as incapable of forming peaks and, in fact, Gilmore, one of the references applied as prior art evidence of unpatentability, equates foam stability with “the ability to hold shape.” (Gilmore, col. 1, ll. 21-25). The totality of the evidence weighs in favor of a conclusion that the composition of Examples 1 and 2, when whipped, inherently produces an unstable foam.

Appellant has overcome the Examiner’s finding of lack of written descriptive support by showing that the claimed property is inherently described in the examples of the original Specification and the Examiner has not sufficiently rebutted the Appellant’s evidence of inherency.

We, therefore, do not sustain the rejection of claims 33-35 under 35 U.S.C. § 112, ¶ 1 for lack of written descriptive support.

C. Anticipation by Gilmore

The Examiner rejects claims 19, 21-23, and 33-35 as anticipated by Gilmore. Appellant separately argues two claim groupings: group (1) claims 19 and 21-23 and group (2) claims 33-35. We select one claim from each group to decide the issues on appeal. For the first group we select claim 19, for the second we select claim 33.

1. Group (1): Claims 19 and 21-23

Claim 19 is directed to a composition containing a protein source, fat, sweetener, stabilizer, and emulsifier in specific concentration ranges. The Examiner finds that Gilmore describes the claimed composition in column 2, lines 45-51. In this regard, the Examiner acknowledges that several of Gilmore's concentration ranges merely overlap the claimed concentration ranges (Ans. 5-6). Specifically, Gilmore's protein range, about 1-5%, merely overlaps the about 4-12% range of claim 19; Gilmore's stabilizer range, about 0.20-2.2%, merely overlaps the between 0.01-1% range of claim 19; and Gilmore's emulsifier range of about 0.1-1.2% merely overlaps with the about 0.05-1% range of claim 19.

Appellant contends that, in a case such as this, where multiple ranges merely overlap with the claimed ranges and none of the reference examples fall within the range of the claims, there can be no anticipation, citing *Atofina v. Great Lakes Chemical Corp.*, 441 F.3d 991, 999 (Fed. Cir. 2006) (Br. 11-12).

The Examiner responds that

Appellant's reliance on *Atofina*, to support appellant's contentions with respect to the 35 U.S.C. 102(b) rejection, is not convincing. Although the range of each of Gilmore et al's composition components merely overlap the range of each

component claimed by appellant, as appellant contends, such an overlap is sufficient to anticipate each of appellant's claimed ranges since any point disclosed in a prior art reference which is within a claimed range is sufficient to anticipate such a claimed range.

(Ans. 8).

The law of anticipation does not support the Examiner's position. In order to anticipate, a reference must identify something falling within the claimed subject matter with sufficient specificity to constitute a description thereof within the purview of § 102. *In re Schaumann*, 572 F.2d 312, 317 (CCPA 1978). A genus including an untold number of species does not anticipate a much smaller claimed species or sub-genus. *See In re Meyer*, 599 F.2d 1026, 1032 (CCPA 1979) (holding that the genus of "alkaline chlorine or bromine solution" of the reference did not "describe", within the meaning of § 102, the claimed species of alkali metal hypochlorite "since the genus would include an untold number of species.>"). Where a reference embraces a very limited number of compounds closely related to one another in structure, that reference provides a description of those compounds just as surely as if they were identified in the reference by name and, therefore, anticipates each of those compounds. *Schaumann*, 572 F.2d at 315. But in the case of numerical ranges of concentrations for an ingredient, there are an untold number of possible concentrations within the range, and in such a case the broader ranges and overlapping ranges may not "describe" a much narrower or overlapping claimed range. *See Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 1000 (Fed. Cir. 2006) (broader prior art temperature range of 100-500°C did not describe the narrower claimed range of 330-450°C "with sufficient specificity to anticipate" nor did the overlapping prior art oxygen to methylene chloride molar ratio of 0.001-1.0% describe

“with sufficient specificity” the claimed 0.1-5.0 % molar ratio). Moreover, the rejection here requires the selection of concentrations from multiple ranges that merely overlap. Such picking and choosing is not permitted in the context of anticipation. *See In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (picking and choosing amongst various possible suggested combinations may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.).

We determine that the Examiner failed to establish that Gilmore sufficiently specifically describes, within the meaning of § 102, a composition having the claimed ingredients in the ranges required by the claims.

2. Group (2): Claims 33-35

With respect to claim 33, this claim requires that the composition “produces an unstable foam when whipped.” The Perks Declaration shows that Gilmore produces a stable foam when whipped (Perks Dec. ¶ 10). Furthermore, Gilmore expressly teaches that the composition is “whippable” and produces a stable foam (Gilmore, title; col. 2, l. 31; Example 1).

We determine that the Examiner failed to establish that Gilmore sufficiently specifically describes, within the meaning of § 102, a composition having the claimed ingredients in the ranges required by claim 33 which produces an unstable foam when whipped.

3. Conclusion

We do not sustain the rejection of claims 19, 21-23, and 33-35 as anticipated by Gilmore.

D. Obviousness over Gilmore and Bundus

The Examiner rejects claims 20, 24-28, 31 and 32 under 35 U.S.C. § 103(a) as unpatentable over Gilmore in view of Bundus.

Appellant contends that “[n]one of the compositions of claims 19-28 and 31-35 are obvious over Gilmore” because one of ordinary skill in the art “would not be motivated to make the particular selections necessary to obtain the claimed invention for at least the reason that Gilmore is directed to a completely different type of composition with very different properties” than the claimed composition, and “Bundus fails to remedy the deficiencies of Gilmore for at least the reason that Bundus does not provide motivation to alter the special properties of Gilmore that make it fundamentally different from the claimed invention.” (Br. 13). We note that in support of Appellant’s position that the composition is “completely different” than the claimed composition, Appellant argues that “the claimed composition is a liquid dessert composition (claim 19) that produces an unstable foam when whipped (claim 33).”

As a first matter, we note that Appellant’s argument that the composition is completely different than the claimed composition focuses on a non-rejected limitation, i.e., the unstable foam formation limitation of claim 33. None of the rejected claims are limited to compositions which form unstable foams. The rejected claims, i.e., claims 20, 24-28, 31, and 32 are directed to liquid dessert compositions (claims 24, 26-28), a dessert

comprising cake and a liquid dessert composition (e.g., claims 20 and 25), and a frozen dessert (claims 31 and 32). Gilmore and Bundus are directed to dessert compositions having the same basic ingredients as claimed. While the Gilmore and Bundus compositions are whippable, none of the rejected claims exclude whippable compositions.

Further Appellant contends that

there would have been no motivation to "modify the amount of protein used in the composition in order to obtain a stable emulsion" because Gilmore's composition is already stable. In addition, there would have been no motivation to modify Gilmore by decreasing the amount of stabilizer because to do so would cause it to no longer be whippable, which would render it unsuitable for its intended purpose.

(Reply Br. 3).

This argument appears to be directed to the Examiner's rejection of claims 24 and 31. With respect to claims 24 and 31, the Examiner finds that Gilmore describes a composition with the claimed ingredients and that while Gilmore does not disclose the claimed concentrations of protein and stabilizer, it would have been obvious to modify the amount of protein to obtain a stable emulsion, this purpose being taught by Bundus, and it would have been obvious to modify the amount of stabilizer based on the fact that the amount of stabilizer can vary widely, as disclosed by Bundus (Ans. 6-7).

The issue to be resolved is: has Appellant shown that the Examiner reversibly erred in concluding that it would have been obvious to one of ordinary skill in the art to formulate a dessert composition with the claimed ingredients in amounts within the claimed ranges?

Gilmore teaches a whippable dessert topping composition including a water-dispersible or soluble protein (col. 4, ll. 23-24) and a stabilizing gum

(col. 3, ll. 58-59) as well as fats, sweeteners, and emulsifiers (col. 2, ll. 45-51). Gilmore does not specify the purpose of the protein. The function of the stabilizer is “to offer bodying and water binding properties to the combination, and also to significantly improve the ability of the composition to withstand freezing and thawing without adverse effects.” (Col. 4, ll. 3-7). In a preferred embodiment, the whippable topping composition contains about 1-5 % of the edible protein and about 0.20-2.2% stabilizer (col. 2, ll. 45-51).

Bundus teaches a dessert composition similar to that of Gilmore, i.e., it contains protein, fat (lipid material), stabilizer, sweetener, and optionally emulsifier (*compare* Bundus, col. 1, l. 66 to col. 2, l. 9 *and* col. 3, ll. 64-67 *with* Gilmore, col. 2, ll. 45-51) that is whippable and can be frozen (Bundus, col. 2, ll. 14-17). Bundus teaches that “[t]he protein is used in an amount sufficient when combined with the other ingredients of the composition to provide a stable emulsion. The amount of protein depends on the source and quality of the protein as well as the type of final product desired” and Bundus provides guidance on levels for different protein sources and desired products (Bundus, col. 2, ll. 49-63). Bundus also teaches that the amount of stabilizer “is that amount sufficient to prevent ice crystal growth without substantially affecting the taste and mouth feel of the final composition. Since some stabilizers are more effective than others, the amount used can vary widely. Exact amounts can be easily determined by one skilled in the art.” (Bundus, col. 4, ll. 29-44).

Based on the above guidance provided by Gilmore and Bundus, those of ordinary skill in the art would have understood that the concentration of protein and stabilizer in whippable, freezable dessert compositions is

dependent on the specific protein source and stabilizer compound selected as well as the properties desired in the end product. The evidence also suggests that optimal concentrations for such dessert compositions were obtained by experimentation which is routine and within the capabilities of those of ordinary skill in the art. *See KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007) (stating that “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”). Under the circumstances, the burden shifts to Appellant to show the result would have been unexpected to one of ordinary skill in the dessert formulation art. *See In re Aller*, 220 F.2d 454, 456 (CCPA 1955) (“[I]t is not inventive to discover the optimum or workable ranges by routine experimentation.”); *In re Boesch*, 617 F.2d 272, 276 (CCPA 1980) (a prima facie case of obviousness may be rebutted where the result of optimizing a result effective variable are unexpectedly good).

While the Examiner limited the rejection to claims 20, 24-28, 31, and 32, we note that Gilmore and Bundus also serve as evidence that the compositions of claims 19 and 21-23 would have been obtainable through routine experimentation as discussed above. This is particularly so since the references describe using the ingredients in ranges overlapping those of claim 19. We note that Gilmore suggests the use of non fat dry milk as required by claim 21 (col. 4, l. 27); the use of corn syrup and sucrose as sweeteners as required by claim 22 (col. 3, ll. 48-51); the use of palm kernel oil as the fat as required by claim 23 (col. 2, ll. 54-55).

Because we extend the rejection over Gilmore and Bundus to claims 19 and 21-23, we denominate our decision as involving a new ground of rejection against these claims under our authority pursuant to 37 C.F.R. § 41.50(b).

E. Obviousness over Dell and Bundus

The Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as unpatentable over Dell and Bundus.

Claims 29 and 30 are argued as a group (Br. 14). We select claim 29 to decide the issues on appeal.

Appellant contends that “Dell is directed to a completely different composition with very different properties” because Dell is directed to a frozen whipped topping and not a liquid (Br. 14). According to Appellant, “Dell would have to be modified by picking and choosing certain amounts of each ingredient broadly disclosed in Dell” but one would not be motivated to modify the compositions “in such a way that the properties sought by Dell would not be achieved.” (Br. 14). Bundus, according to Appellant, does not remedy the deficiencies of Dell (Br. 15).

The Examiner finds that Dell discloses a liquid dessert composition with the claimed ingredients and that Bundus teaches a similar composition (Ans. 7).

There is no dispute that the combination of Dell and Bundus suggests the method steps of claim 29. The issue on appeal arising from the contentions of Appellant and the Examiner is: has Appellant shown that the Examiner reversibly erred in finding that, given the disclosures of Dell and Bundus, those of ordinary skill in the art would have been capable of

formulating a liquid dessert composition having the claimed ingredients in the claimed concentration ranges?

We answer this question in the affirmative based on our analysis above regarding the abilities of those of ordinary skill in the art to perform routine experimentation to find the optimal concentrations of the protein, fat, sweetener, stabilizer and emulsifier based on the disclosure of Bundus. We also note that the composition of Dell is liquid at least before whipping if not after freezing.

Appellant has not shown that the Examiner reversibly erred in concluding that formulating the composition of claim 29 would have been within the capabilities of one of ordinary skill in the art.

III. CONCLUSION

In summary, we sustain the rejection of claims 19-35 under the judicially-created doctrine of obviousness-type double patenting; the rejection of claims 20, 24-28, 31, 32 under 35 U.S.C. § 103(a) over Gilmore in view of Bundus; and the rejection of claims 29 and 30 under 35 U.S.C. § 103(a) over Dell in view of Bundus.

We do not sustain the rejection of claims 33-35 under 35 U.S.C. § 112, ¶ 1 as lacking written descriptive support; nor do we sustain the rejection of claims 19, 21-23, and 33-35 under 35 U.S.C. § 102(b) as anticipated by Gilmore.

We enter a new ground of rejection of claims 19 and 21-23 under 35 U.S.C. § 103(a) as unpatentable over Gilmore in view of Bundus.

IV. DECISION

The decision of the Examiner is affirmed and a new ground of rejection entered.

V. TIME PERIOD FOR RESPONSE

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

Appeal 2008-1519
Application 10/443,085

If the Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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
NEW GROUND ENTERED 37 C.F.R. § 41.50(b)

tf/lis

KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON, DC 20005