

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WANDA KIISKILA

Appeal 2008-1722
Application 10/416,589
Technology Center 1600

Decided: March 14, 2008

Before DONALD E. ADAMS, ERIC GRIMES, and LORA M. GREEN,
Administrative Patent Judges.

ADAMS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-18, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

INTRODUCTION

The claims are directed to an orally ingestible baked radiopaque product (claims 1 and 2), a cookie (claims 3-5), a method for testing a

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patient for dysphagia (claims 6-10), a method for making an orally ingestible baked radiopaque product (claims 11-15) and a dough (claims 16-18).

Claims 3, 6, 11, and 16 are illustrative:

3. A cookie comprising: a) fat, b) sweetener[,] c) moisturizer, d) x-ray contrast agent, e) flour and f) optionally flavoring agent, wherein the x-ray contrast agent is interspersed throughout the product.

6. A method for testing a patient for dysphagia, which comprises, subjecting said patient to MBS studies utilizing an ingestible baked radiopaque product having a dry food texture comprising: a) fat, b) sweetener, c) moisturizing agent, d) x-ray contrast agent, e) flour and f) optionally flavoring agent, wherein the x-ray contrast agent is interspersed throughout the product.

11. A method for making an orally ingestible baked radiopaque product having a dry food texture which comprises (1) mixing a) fat, b) sweetener, c) moisturizing agent, d) x-ray contrast agent, e) flour and f) optionally flavoring agent to prepare dough (2) forming the dough into a shape adapted for oral ingestion and (3) baking the shaped dough.

16. Dough comprising: a) fat, b) sweetener, c) moisturizing agent, d) x-ray contrast agent, e) flour and f) optionally flavoring agent.

The Examiner relies on the following prior art references to show unpatentability:

Helen M. Robertson et al. (Robertson), *A Strategy for Providing Food to the Patient with Neurologically Based Dysphagia*, 54(4) J. Can. Dietetic Assoc., 198-201 (1993).

(Better Homes and Gardens) *Homemade Cookies*, 8 and 66 (Mary Jo Plutt 4th ed., Better Homes and Gardens, Books 1989).

The rejection as presented by the Examiner is as follows:

Claims 1-18 stand rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Robertson and Better Homes and Gardens.

We affirm.

DISCUSSION

Findings of Fact (FF):

Robertson:

1. teaches “dysphagia” is a “difficulty swallowing resulting from neurological injury or disease” (Robertson 198: Abstract);
2. teaches “the use of test substances [including a firm dry cookie dipped in barium solution] for videofluoroscopy examination of dyphagia patients” (Robertson 199: col. 2, l. 33 through 200: col. 1, l. 32; Ans. 3);
3. teaches a “new system [wherein] the barium-dipped cookie has been replaced by a small tea biscuit made with barium in the flour” (Robertson 200: col. 1, ll. 20-21; Ans. 3);
4. teaches that “[b]arium acts as a contrast medium in all test substances” (Robertson 199: col. 2, ll. 45-46; Ans. 3)
5. teaches “[k]its . . . consist[ing] of a *barium biscuit* and four envelopes to produce four mini-puddings” (Robertson 200: col. 1, ll. 34-38 (emphasis added); Ans. 3);
6. teaches flour containing barium, but does not teach the other components of the tea biscuit (cookie) (Ans. 4).

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Better Homes and Garden:

7. teaches a cookie recipe comprising margarine or butter, flour, sugar, eggs, flavoring, and baking soda or powder (Better Homes and Garden 8 and 66; Ans. 4);
8. teaches a method of making cookies that comprises mixing ingredients, shaping the resulting dough, placing the shaped dough on a cookie sheet, and baking (Better Homes and Garden 8 and 66; Ans. 4).

Claim 3:

Appellant has grouped claims 1-5 together (App. Br. 12). Therefore, these claims will stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii).

Accordingly, we limit our discussion to representative claim 3.

Claim 3 is drawn to a cookie comprising:

- a) fat,
- b) sweetener,
- c) moisturizer,
- d) x-ray contrast agent,
- e) flour, and
- f) optionally flavoring agent.

In addition, claim 3 requires that the x-ray contrast agent is interspersed throughout the product.

Robertson teaches a cookie made from a flour comprising barium, an x-ray contrast agent (FF 3 & 4). Robertson does not teach the other ingredients of the cookie (FF 6). Appellant does not dispute, and therefore concedes, that Better Homes and Gardens teaches a cookie made from ingredients comprising a fat, sweetener, moisturizer, flour, and a flavoring

agent. According to the Examiner, it would have been *prima facie* obvious to use Robertson's barium enriched flour along with the other ingredients of a basic cookie recipe as taught by Better Homes and Gardens to make Robertson's barium enriched cookie (Ans. 4).

Appellant disagrees. According to Appellant Robertson "fails to teach a recitation . . . that 'the x-ray contrast agent is interspersed throughout the product'" (App. Br. 7). We disagree. Robertson teaches "a small tea biscuit made with barium in the flour" (FF 3). The use of barium enriched flour in the preparation of the biscuit will result in a biscuit or cookie with the barium, the x-ray contrast agent, interspersed throughout the product.

We also disagree with Appellant's assertion that "Robertson reveals that the biscuit is 'shaken' in a covered cup with water and starch . . . resulting [in a] liquid slurry" (App. Br. 7-8; Reply Br. 2). This is inaccurate. Robertson teaches "[k]its . . . consist[ing] of a *barium biscuit* and four envelopes to produce four mini-puddings" (FF 5). It is the contents of the envelopes, not the biscuit, that is mixed with water to produce a pudding, or in Appellant's words - "a slurry" (Robertson 200: col. 1, ll. 38-44). Accordingly, we are not persuaded by Appellant's argument.

Likewise, we are not persuaded by Appellant's unsupported assertion that "Robertson actually teaches that a liquid slurry containing barium sulfate is preferred over a dry baked product 'made with barium in the flour'" (App. Br. 8; Reply Br. 3). As discussed above, Robertson teaches a kit comprising a biscuit, a dry baked product, made with barium flour and a number of envelopes to make a pudding. According to Robertson, the prior art "cookie dipped in barium solution to simulate a crumbly texture used in 'the modified cookie swallow' frequently simulated a thick paste contrast

instead. A true crumbly food containing barium was necessary to this test” (Robertson 200: col. 1, ll. 16-19). Therefore, Robertson developed a “new system” wherein the prior art “barium-dipped cookie has been replaced by a small tea biscuit made with barium in the flour” (Robertson 200: col. 1, ll. 20-22; FF 3) to produce a “true crumbly food containing barium [which] was necessary for this test” (Robertson 200: col. 1, ll. 16-19). Accordingly, we disagree with Appellant’s unsupported assertion that upon reading Robertson, a person of ordinary skill in this art “would be motivated to modify that baked good and form a liquid slurry” (App. Br. 8; Reply Br. 3). We are also not persuaded by Appellant’s unsupported assertion that “[a]lthough Robertson includes dry products, i.e. a ‘barium biscuit’ in the test kits, those biscuits are transformed into flowable liquid or semi-liquid testing samples prior to their intended use” (App. Br. 15-16).

We recognize Appellant’s citation of Robertson, page 200, column 1, lines 36-44 in support of the assertion that Robertson teaches “administering ‘mini-puddings’ which are prepared by combining the barium-containing tea biscuits with ‘cold water swelling starch’ to achieve the desired viscosity”” (Reply Br. 5). We disagree, however, with Appellant’s interpretation of Robertson. According to Roberston, each *envelope* in the kit “consists of barium sulfate sufficient to show up during the videofluoroscopy exam, a flavoring crystal to improve the taste of the mixture, and enough cold water swelling starch to produce the desired viscosity when mixed as directed” (Robertson 200: col. 1, ll. 39-44). There is no teaching in this portion of Robertson to add the cookie, which is also included in the kit, to the ingredients of the envelopes. To the contrary, the ingredients of the envelopes are used to produce “mini-puddings” containing enough barium

sulfate to show up during the videofluoroscopy exam (Roberston 200: col. 1, ll. 36-41). If Robertson's cookie, which already contains the barium contrast agent, is to be added to the contents of the envelopes, why then would the envelopes also contain barium sulfate? Conversely, if the envelopes contain barium sulfate, why add the barium-containing cookie to them? Appellant does not resolve those questions. Instead, Appellant is satisfied in asserting that the cookie is added to the contents of the envelopes. Appellant does not, however, direct our attention to a teaching in Robertson that supports this assertion. In contrast, however, we note that Robertson expressly states that a "true crumbly food containing barium [(the cookie)] was necessary to this test" (Robertson 200: col. 1, ll. 16-19). For the foregoing reasons we are not persuaded by Appellant's unsupported assertion.

We are not persuaded by Appellant's assertion that the only explanation provided by the Examiner to combine Robertson with Better Homes and Gardens is that "it would have been obvious" (App. Br. 10). Robertson teaches a cookie made from barium enriched flour (FF 3-5). No doubt Robertson does not teach other components, known to those of ordinary skill in the art, that are used in making a cookie (FF 6). Better Homes and Gardens teaches ingredients found in cookies (FF 7). We find no evidence on this record to suggest that a person preparing a cookie as taught in Robertson, would not include ingredients typically found in cookies as taught by Better Homes and Gardens. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007). Accordingly, we are not persuaded by Appellant's assertion that the combination of Robertson and Better Homes

and Gardens “is a classic example of prohibited hindsight reconstruction” (App. Br. 11). To the contrary, a person of ordinary skill in this art setting out to prepare a cookie would reasonably look to known cookie recipes to find the ingredients typically included in a cookie. It is proper to “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *See KSR*, 127 S. Ct. at 1741. *See also id.* at 1742 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

On reflection, we affirm the rejection of claim 3 under 35 U.S.C § 103(a) as unpatentable over the combination of Robertson and Better Homes and Gardens. Claims 1, 2, 4, and 5 fall together with claim 3.

Claim 6:

Appellant has grouped claims 6-10 together (App. Br. 12). Therefore, these claims will stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, we limit our discussion to representative claim 6.

Claim 6 is drawn to a method for testing a patient for dysphagia. Robertson is directed to a method for testing a patient for dysphagia (FF 1-5). The method of claim 6 comprises subjecting a patient to Modified Barium Swallow (MBS¹) studies utilizing an ingestible baked radiopaque product having a dry food texture. Robertson teaches a method for testing a patient for dysphagia comprising subjecting a patient to MBS studies utilizing an ingestible baked radiopaque product having a dry food texture (FF 1-5; Robertson 200: col. 1, ll. 16-22). Claim 6 requires that the ingestible baked radiopaque product comprises a) fat, b) sweetener, c)

¹ See Spec. 1: ¶ 0003.

moisturizing agent, d) x-ray contrast agent, e) flour[,] and f) optionally flavoring agent, wherein the x-ray contrast agent is interspersed throughout the product. As discussed under the header “*Claim 3*” the combination of Robertson and Better Homes and Gardens teaches an ingestible baked radiopaque product comprising these ingredients. Accordingly, we find no error in the Examiner’s conclusion that claim 6 would have been *prima facie* obvious in view of the combination of Robertson and Better Homes and Gardens (Ans. 4-5).

Appellant asserts that claim 6 requires the cookie to have a dry food texture (App. Br. 12). According to Appellant, “Robertson teaches entirely opposite from this by teaching that the ‘small tea biscuit’ be transformed into a liquid slurry” (*id.*). For the reasons provided under the header “*Claim 3*” above, we disagree with Appellant’s assertion that Robertson’s method is limited to the use of a “pudding” or in Appellant’s words “a liquid slurry” (*id.*). Robertson teaches a method and a kit for use in a method of testing a patient for dysphagia. Robertson’s kit comprises ingredients to prepare a pudding *and* a cookie that would have a dry food texture (FF 5; Robertson 200: col. 1, ll. 38-44). According to Robertson, “[a] true crumbly food containing barium was necessary to this test” (Robertson 200: col. 1, ll. 16-19). Accordingly, we are not persuaded by Appellant’s argument.

On reflection, we affirm the rejection of claim 6 under 35 U.S.C § 103(a) as unpatentable over the combination of Robertson and Better Homes and Gardens. Claims 7-10 fall together with claim 6.

Claim 11:

Appellant has grouped claims 11-15 together (App. Br. 12). Therefore, these claims will stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, we limit our discussion to representative claim 11.

Claim 11 is drawn to a method for making an orally ingestible baked radiopaque product having a dry food texture which comprises (1) mixing a) fat, b) sweetener, c) moisturizing agent, d) x-ray contrast agent, e) flour[,] and f) optionally flavoring agent to prepare dough (2) forming the dough into a shape adapted for oral ingestion and (3) baking the shaped dough.

As discussed above under the header “*Claim 3*” Robertson teaches a cookie having these recited ingredients. To arrive at Robertson’s cookie, a person of ordinary skill in the art would have mixed the ingredients together to prepare a dough, formed the dough into a shape adapted for oral ingestion, and baked the shaped dough as taught by Better Homes and Gardens (FF 8). For these reasons, as well as the reasons set forth above, we are not persuaded by Appellant’s assertion that the “combination of ingredients is not taught in the prior art [and] . . . there is no suggestion in the Robertson or *Better Homes and Garden[s]* recipes to combine them” (App. Br. 13).

On reflection, we affirm the rejection of claim 11 under 35 U.S.C. § 103(a) as unpatentable over the combination of Robertson and Better Homes and Gardens. Claims 12-15 fall together with claim 11.

Claim 16:

Appellant has grouped claims 16-18 together (App. Br. 12). Therefore, these claims will stand or fall together. 37 C.F.R.

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§ 41.37(c)(1)(vii). Accordingly, we limit our discussion to representative claim 16.

Claim 16 is drawn to a dough comprising: a) fat, b) sweetener, c) moisturizing agent, d) x-ray contrast agent, e) flour[,] and f) optionally flavoring agent. As discussed above under the header “*Claim 3*” Robertson teaches a cookie having these recited ingredients. To arrive at Robertson’s cookie, a person of ordinary skill in the art would have prepared a dough as taught by Better Homes and Gardens (FF 8). For these reasons, as well as the reasons set forth above, we are not persuaded by Appellant’s assertion that the “combination of ingredients is not taught in the prior art [and] . . . there is no suggestion in the Robertson or *Better Homes and Garden[s]* recipes to combine them” (App. Br. 13).

On reflection, we affirm the rejection of claim 16 under 35 U.S.C § 103(a) as unpatentable over the combination of Robertson and Better Homes and Gardens. Claims 17-18 fall together with claim 16.

CONCLUSION

In summary, we affirm the rejection of record.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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RANKIN, HILL & CLARK LLP
38210 GIEEN AVENUE
WILLOUGHBY OH 44094-7808