

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ELDON ROTH

Appeal 2008-1998
Application 10/951,076
Technology Center 1700

Decided: November 20, 2008

Before BRADLEY R. GARRIS, KAREN M. HASTINGS, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant, pursuant to 37 C.F.R. § 41.52, has submitted a timely Request for Rehearing dated June 27, 2008 (hereafter the “Request”), requesting rehearing from, and modification of, the original Decision in this appeal dated April 28, 2008 (hereafter “Dec.”) where this merits panel affirmed the Examiner’s rejection of claims 1-4, 6-10, 12, and 14-22 under

35 U.S.C. § 103(a) as unpatentable over Roth in view of Townsend or Langen (Dec. 9-10).

Appellant contends that it appears that we made a “different” rationale for combining the references than the Examiner made in his Final Rejection, and further, that this “different” rationale is defective under the analysis required by *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). (Request 1-3). We disagree.

First, although Appellant did not ask us to redesignate our decision as a new ground of rejection, it is well established that there is no new ground of rejection when “[t]he basic thrust of the rejection” remains the same such that an appellant has been given a fair opportunity to react to the rejection. *In re Kronig*, 539 F.2d 1300, 1302-03 (CCPA 1976). Further, where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Kronig*, 539 F.2d at 1303 (reliance upon fewer references in affirming a rejection under 35 U.S.C. § 103 does not constitute a new ground of rejection).

The Decision explained in detail our rationale for agreeing with the Examiner that the combination of references established a *prima facie* case of obviousness. In particular, Roth describes it is desirable for the pH increasing fluid (e.g., gas) to be *absorbed into* the meat product. (See Dec. 6). As noted in the Decision, one way of ensuring the gaseous fluid to be absorbed into the meat product would have been to deliver the fluid into the interior of a meat product (*Id.*). Thus, the use of prior art injection needles known for forcing fluids into a meat product, as exemplified in each of

Townsend and Langen, to reach the interior surfaces of the meat product of Roth would have been *prima facie* obvious (Dec. 7).

Appellant contends that the Decision “relies upon an incomplete and inaccurate description” of the Townsend and Langen patents, since neither reference teaches using injection needles for ground meat. (Request 4-5). We have carefully reviewed our Decision and we do not agree that we relied upon “incomplete and inaccurate” descriptions as alleged by Appellant. (See, e.g., Dec. 5, first paragraph.)

Appellant contends that the use of injection needles to inject fluid into ground meat “seems to defy common sense” (Request 5). We disagree. Appellant’s contention that one would pour sauce into a bowl with the ground meat and then rearrange (mix) the ground meat pieces is not on point (*Id.*). The claimed invention deals with “forcing... pH modifying material into the interior” of a meat product via an injection conduit. Both Townsend and Langen exemplify the use of injection needles to add treatment material into the interior of meat products (Dec. 5). One of ordinary skill in the art would readily appreciate that “meat products” include ground meat products.

Appellant contends that we relied upon an “unsupported combination of components” because there is no evidence that a needle injection device as shown in Townsend or Langen is a known alternative to the injection port and pump arrangement of Roth (Request 6-7). We disagree. As the Supreme Court recently articulated, the question to be asked is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR*, 127 S. Ct. at 1740. Also, the Court held “that when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than

one would expect from such an arrangement, the combination is obvious.” *KSR*, 127 S. Ct. at 1740, quoting from *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976). It is undisputed that the injection needles of Townsend and Langen force treatment fluids into meat products. It is also undisputed that the injection port and pump arrangement of Roth force a treatment fluid into a meat product. Thus, the evidence of record establishes that these were known alternative mechanisms for applying fluids to a meat product.

Appellant’s contention that there was no apparent reason to combine the applied prior art is not persuasive (Request 7-8). Reasons to combine the applied prior art were set forth by the Examiner as well as in our Decision (Dec. 7, 8).

Finally, Appellant’s contention that we have overlooked evidence of long-felt need is not persuasive for the reasons discussed in our Decision (Dec. 8-9).

Appellant further states that the Examiner’s failure to address the objective evidence of “long-felt need” is an error that “warrants reversal of the rejections and remand” (Request 10-11). We do not agree.

It is well established that Appellant must establish that the art tried and failed to solve the problem. Appellant simply did not meet their burden of proof in this regard (Dec. 9).

The Board has broad discretion as to the weight to be accorded to evidence. *Velander v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) (stating that it is “within the discretion of the trier of fact to give each item of evidence such weight as it feels appropriate”). *See also, In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) (“attorney argument [is] not the kind of factual evidence that is required to rebut a prima facie case of obviousness”).

Therefore, Appellant's general statements that the Board "overlooked" evidence of "long-felt need" fails to persuade us of error on our part in concluding that a preponderance of the evidence favored the Examiner's obviousness determination (Decision 9). *See Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1364 (Fed. Cir. 2007) (explaining that as long as the Examiner establishes "a reasonable probability of success," "obviousness cannot be avoided simply by a showing of some degree of unpredictability in the art").

CONCLUSION

In conclusion, based on the foregoing, we have granted Appellant's request to the extent that we have reconsidered our decision, but we deny Appellant's request to make any change therein.

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).

REHEARING DENIED

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