

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD DWYER HISERODT, THUMPLASSERIL V. JOHN,
JIDE ADEDEJI, and MARKUS A. ECKERT

Appeal 2008-2050
Application 11/268,224
Technology Center 1600

Decided: June 30, 2008

Before, TONI R. SCHEINER, DEMETRA J. MILLS, and
LORA M. GREEN, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b).

The following claim is representative.

1. A food-based consumer product comprising monomenthyl succinate as a natural flavor ingredient.

Cited Reference

Mane 5,843,466 Dec. 1, 1998

Grounds of Rejection

1. Claims 1-5, 7-10, 12 and 14-17, stand rejected under 35 U.S.C. 102(b) as being anticipated by Mane.
2. Claims 1, 4-7, 9-12, and 15-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mane.

DISCUSSION

Background

“Monomenthyl succinate (MMS), also known as butanedioic acid monomenthyl ester, is a flavor compound utilized for its cooling effects in oral health care products and chewing gum.... Currently, MMS is synthetically produced for commercial use. However, MMS can not be marketed as nature identical since its presence in natural sources has not been demonstrated. This limits the marketing of MMS-containing products in some countries. Therefore it would be desirable to find a natural source of MMS.” (Spec. 1.)

“[T]he present invention is a plant extract composition containing monomenthyl succinate that is useful as a coolant. The plant extract is preferably isolated from a plant of the genus *Lycium* or *Mentha*, most preferably, *Lycium barbarum* or *Mentha piperita*.” (Spec. 1.)

1. Claims 1-5, 7-10, 12, and 14-17 stand rejected under 35 U.S.C. 102(b) as being anticipated by Mane. We select claim 1 as representative of

the rejection before us since Appellants have not separately argued the claims. 37 C.F.R. 41.37(c)(1)(vii).

The Examiner finds that

Mane teaches various products that contain monomenthyl succinate. Specifically, the reference teaches incorporating this compound into products such as medicaments such as antacids and laxatives, chewing gums, solid foods, liquid beverages, cosmetics, toiletries, oral care products, nasal care products, lotions, oils, ointments, and perfumes. The compound is added from 0.001 to 1.0% by total weight of the product (see column 3, line 50 - column 4, lines 58).

The reference also does not specifically teach that the monomenthyl succinate is a “natural product” or is extracted from a plant source. However, the reference compound is structurally identical to the claimed “natural” compound. Thus, the claimed compound is not considered to be patentably distinct from the reference compound.

(Ans. 3.)

The standard under § 102 is one of strict identity. “Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.” *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997). “Every element of the claimed invention must be literally present, arranged as in the claim.” *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). We find no error in the Examiner’s prima facie case of anticipation.

“[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 708, (Fed. Cir. 1990). Where the prior art, as here, anticipates or renders obvious the claimed invention, the burden then falls on an Appellants to rebut that prima

facie case. Such rebuttal or argument can consist of any other argument or presentation of evidence that is pertinent. *In re Dillon*, 919 F.2d 688, 692-93, (Fed. Cir. 1990).

Appellants argue that:

Applicants teach monomethyl succinate as it is found in nature, wherein upon purification it may contain trace amounts of other similar compounds which are soluble in the same solvent.

(Br. 7.)

Appellant further argues that

the specification as filed provides factual evidence that refutes the Examiner's conclusions regarding the identical nature of synthetic versus natural monomethyl succinate. The LC/MS/MS chromatographs show in Figure 1 of the specification as filed are evidence. As is evident in Figure 1A, a preparation of synthetic monomethyl succinate is homogeneous to monomethyl succinate. In contrast, a monomethyl succinate preparation obtained from a plant source, a natural source, is less than homogeneous with respect to monomethyl succinate (see Figure 1C). It is well-established that the degree of purity of a compound can render it patentable over the same compound in an unpurified state, even if both materials share the same utility. See, e.g., *In re Bergstrom*, 427 F.2d 1394, 1401, 166 USPQ 256, 262 (CCPA 1970).

(Br. 8-9.)

We are not persuaded by Appellants' argument. First, Appellants' evidence is not commensurate in scope with the pending claim 1. Compare, *In re Lindner*, 457 F.2d 506, 508 (CCPA 1972) ("objective evidence ... must be commensurate in scope with the claims."). In the present case,

while Appellants' argument might be relevant to a claim to an extract of monomethyl succinate, Appellants do not claim an extract from a specific plant having the gas chromatograph (GC) profile of Figure 1. Appellants chose to claim natural monomethyl succinate, a compound. An inherent property of a compound, such as origin from a natural source, does not distinguish a claimed invention from the prior art. See *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997); *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) ("The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from the prior art, can not impart patentability to claims to the known composition.").

Appellants have not shown a difference between the synthetic monomethyl succinate and the claimed natural monomethyl succinate compound. We conclude that the preponderance of the evidence supports the Examiner's position, and the rejection is affirmed. See, e.g., *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

2. Claims 1, 4-7, 9-12, and 15-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mane. We select claim 1 as representative of the rejection before us since Appellants have not separately argued the claims. 37 C.F.R. 41.37(c)(1)(vii).

Mane is discussed above. Anticipation being the epitome of obviousness, we affirm the rejection of the claims under 35 U.S.C. § 103 as being obvious over Mane. See *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982). The obviousness rejection is affirmed.

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SUMMARY

The anticipation and obviousness rejections are 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).

AFFIRMED

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