

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALLAN A. TORNEY, LIISA MOONEY and
PETER SLUSARCZYK¹

Appeal 2008-3666
Application 10/122,832
Technology Center 1600

Decided: November 6, 2008

Before RICHARD E. SCHAFER, SALLY G. LANE, and
JAMES T. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

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STATEMENT OF CASE

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The Appellants appeal under 35 U.S.C. § 134 (2002) from a final
rejection of claims 27-29, 32-45, 48-50, 113-116 and 118-133.² We have
jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ The real party in interest is MARS, Inc. (App. Br. 3).

² Claims 1-26, 30, 31, 46, 47, 51-112 and 117 have been canceled. (App. Br. 4).

1 The subject matter of the Appellants' claims is a liquid composition
2 for delivering a pharmaceutical or for supplementing the nutritional content
3 of food.

4 Claims 27 and 113 are the only independent claims in the application.

5 Claim 27 is illustrative and reads as follows:

6 27. A microbiologically stable aqueous composition for
7 delivering a pharmaceutical comprising on a dry matter basis,
8 from about 15 to about 80% by weight of a hydrolyzed protein
9 component, from about 20 to about 85% by weight of a
10 humectant, from about 1 to about 50% by weight of a lipid
11 component, and a therapeutically effective amount of the
12 pharmaceutical or medicament, wherein the composition is a
13 liquid concentrate or a colloidal suspension.

14
15

THE EVIDENCE

16 The Examiner relies upon the following as evidence in support of the
17 rejections:

18	Bone	US 4,006,266	Feb. 01, 1977
19	Davis	US 4,070,488	Jan. 24, 1978
20	Paluch	US 6,117,477	Sep. 12, 2000
21	Ballevre et al.	US 6,355,612	Mar. 12, 2002

1 THE REJECTION

2 The following rejection is before us for review:³

3 Claims 27-29, 32-45, 48-50, 113-116 and 118-133 stand rejected
4 under 35 U.S.C. § 103(a) over the combination of Paluch (US 6,117,477),
5 Balleve (US 6,355,612), Davis (US 4,070,488) and Bone (US 4,006,266).

6 We AFFIRM the rejections of claims 27-29, 32-45, 48-50, 113-116,
7 and 118-133.

8 ISSUES

9 Have the Appellants established that the Examiner erred in
10 determining that it would have been obvious to one of ordinary skill in the
11 art at the time the invention was made to combine protein, humectant, lipid,
12 and a pharmaceutical or medicament in an aqueous liquid form?

13 FINDINGS OF FACT

14 The record supports the following findings of fact by a preponderance
15 of the evidence.

16 1. The Appellants' specification describes that "microbiologically
17 stable" means "that the ready-to-use composition does not require
18 processing, i.e., sterilization or pasteurization." (Specification p. 12).

19 2. The Appellants' specification further describes that "[t]he
20 humectant ingredient aids in the microbiological stability of the
21 composition." (Id. p. 13).

³ The final rejection of claims 27-29, 32-45, 48-50, 113-116 and 118-133 under 35 U.S.C. § 112, second paragraph has been withdrawn by the Examiner. (See Ans. 2-3).

1 3. The Appellants' specification notes that the humectant can be
2 "sugar, a polyhydroxyl alcohol or a mixture of a sugar and a polyhydroxyl
3 alcohol." (Id., p. 8, ¶ 26).

4 4. Paluch describes a shelf-stable, dry multicomponent animal food
5 product having improved palatability and can function as a delivery system
6 for nutritional and/or pharmaceutical ingredients. (Paluch 2:63-3:1).

7 5. Paluch describes that its product includes protein, a humectant, a
8 lipid component, and optionally, pharmaceutical compounds. (3:4-14; 6:44-
9 53).

10 6. Paluch discloses an example in which the protein is a hydrolyzed
11 protein comprising 47 wt% of the composition. (Id. 12:17).

12 7. Paluch describes including lipids advantageously in an amount of
13 10-60 wt%, and more advantageously in an amount of 20-50 wt%. (Id.
14 6:33-38).

15 8. Paluch describes that semi-moist edible products are known in the
16 art and are made by adding a water based soft component to a dry
17 component, wherein the water based component is stabilized using a variety
18 of gelling agents, sugars, salts, glycols, and/or by using heat. (Id. 1:12-16).

19 9. Paluch describes adding linoleic acid, the functional ingredient in
20 sunflower or safflower oil, into the lipid based center filling material (Id.
21 7:20-30).

22 10. Paluch describes that "such safety procedures as are required to
23 produce a suitable pet or animal food product are also well known in the art
24 and are followed in practicing the present invention." (9:4-7).

1 11. Paluch describes that conventional products use water to increase
2 the palatability of dry pet food thereby creating semi-moist pet food
3 products. (Id. 2:43-49).

4 12. Paluch primarily differs from the claimed invention in that Paluch
5 does not describe a liquid or suspended composition and does not describe
6 the amount of humectant.

7 13. Davis describes a highly stable aqueous solution useful as a
8 nutritive composition for humans and/or animals which can be prepared in
9 liquid or dry form. (Davis Claim 1; Abstract; 2:9-12).

10 14. Davis also describes that the composition comprises gelatin which
11 acts to stabilize the composition and provides a rich source of essential
12 amino acids. (Id. 2:30-37).

13 15. Bone describes a process for making a dry pet food including
14 protein, lipid and humectant agents. (Bone 4:24-27; 5:13-15).

15 16. Bone describes that the quantity of sugar, proteinaceous adhesive,
16 animal protein source, vegetable protein source, fat and
17 plasticizing/humectant agent added to the composition is considered to be
18 within the skill of the art. (Id. 4:26-29)

19 17. Specifically, Bone describes that for plasticizing/humectant
20 agents the typical quantity added is in a range of 5-20 percent. (4:30-34).

21 18. Bone also describes using a quantitative range of humectant agent
22 from 5 to about 10 wt% of the soft component. (5:18-21).

23 19. Balleve describes a protein containing composition for pets and
24 humans and that the protein material used in the invention may be “any
25 material comprising proteins.” (Id. 2:56-57).

1 *Commc'ns Research, Inc. v. Vitalink Commc'ns Corp.*, 55 F.3d 615, 620
2 (Fed. Cir. 1995) (emphasis in original).

3 In this instance, we find that the claim preamble is limiting to the
4 claim. First, it provides context for the elements of the claim and antecedent
5 basis for the term “pharmaceutical.” Second, the Appellants have argued the
6 preamble limitations as if it intended them to be limiting. On balance, we
7 conclude that the preamble limitations should limit the scope of the claim.

8 We turn to the specific preamble limitation of interest. The claim
9 recites that the composition must be “microbiologically stable.” The
10 Appellants have defined this term in the specification as not requiring
11 processing, i.e., sterilization or pasteurization. (FF1) However, the
12 limitation does not recite any specific length of time or conditions.
13 The mechanism for obtaining microbiological stability is described by the
14 Appellants as being through the addition of a humectant, such as sugar.
15 (FF2, FF3).

16 With this background in place, we turn to the Examiner’s initial
17 findings and conclusion relating to obviousness.

18 *The Examiner’s Findings*

19 The Examiner found that Paluch describes a multicomponent
20 composition that may be used to deliver a pharmaceutical, comprising a
21 hydrolyzed protein, a humectant and lipid. (Final Rejection, Aug. 29, 2006,
22 p. 4-5). Specifically, Paluch describes an example in which the hydrolyzed
23 protein comprises 47 wt % of the composition. (Paluch 11:15-20, Table 2).
24 Additionally, Paluch describes including lipids advantageously in an amount

1 of 10-60 wt %, and more advantageously in an amount of 20-50 wt %. (Id.
2 at 6:33-38).

3 According to the Examiner, Paluch describes that conventional forms
4 of animal food products are water-based and typically stabilized using
5 gelling agents, sugars, salts, glycols and/or heat. (Final Rejection, Aug. 29,
6 2006, p. 4-5).

7 The Examiner found that Paluch does not describe that its
8 composition is entirely in an aqueous (“liquid”) form, and does not teach
9 using specific amounts of humectant. (Id. at 5).

10 However, the Examiner found that Davis describes a multicomponent
11 composition in the form of a highly stable aqueous solution useful as a
12 nutritive supplement. (Id.). The Examiner also found that Davis describes
13 that the composition comprises gelatin, which stabilizes the composition.
14 (Id.).

15 Additionally, the Examiner found that Bone describes a
16 multicomponent composition comprising protein, fat and a humectant,
17 selected from glycerol and/or sucrose, in a quantity of 20%. (Id. at 5-6).

18 The Examiner also found that Ballevre teaches that hydrolyzed
19 protein is useful in pet food because it is in a form which is slow to digest.
20 (Id. at 5).

21 According to the Examiner, it would have been obvious to a person of
22 ordinary skill in the art at the time of the invention to prepare a
23 multicomponent composition comprising hydrolyzed protein, a humectant
24 and lipid, as described by Paluch, as a highly stable aqueous solution, as
25 described by Davis. (Id. 6). The Examiner also determined that it would

1 have been obvious to the skilled artisan at the time of the invention to
2 incorporate the humectant described by Paluch in the amount taught by
3 Bone. (Id.).

4 *The Appellants' Assertions*

5 The Appellants assert that the Examiner's rejection of claims 27, 29,
6 32-38, 42-44, 113-116, 118-121, 125-127, 129, & 130 "is facially
7 insufficient for not accounting for all limitations of the claims." (App. Br.
8 18).

9 Specifically, the Appellants first challenge Paluch, asserting that
10 Paluch does not disclose "a microbiologically stable aqueous composition ...
11 wherein the composition is a liquid concentrate or a colloidal suspension."
12 (App. Br. 13) (citation omitted). According to the Appellants, the Examiner
13 erroneously "attempt[ed] to characterize Paluch as disclosing a composition
14 meeting this limitation" (App. Br. 7-8)(citing Final Rejection, Aug. 29,
15 2006, pp. 4-5).

16 This argument not persuasive. The Examiner specifically relied upon
17 Paluch for the teaching that a multicomponent composition comprising a
18 hydrolyzed protein, a humectant and lipid may be used to deliver a
19 pharmaceutical. (Final Rejection, Aug. 29, 2006, p. 4-5). According to the
20 Appellants' specification, "microbiologically stable" means "that the ready-
21 to-use composition does not require processing, i.e., sterilization or
22 pasteurization." (Specification p. 12). Such stability is "aided" by the
23 addition of a humectant.

24 Moreover, it is the combination of references which, along with the
25 knowledge of the person of ordinary skill in the art, which render the

1 claimed invention obvious. Davis also describes preparing a highly stable
2 aqueous solution prepared in a liquid form. (FF-13). Davis further
3 describes that the composition comprises gelatin which acts to stabilize the
4 composition. (FF-14). Davis does not describe that the liquid preparation
5 requires processing such as sterilization or pasteurization. Consequently,
6 Davis also describes a microbiologically stable aqueous composition
7 wherein the composition is a liquid concentrate, as claimed.

8 The Examiner expressly found that Paluch differs from the claimed
9 invention in that “an aqueous form [is] not disclosed.” (See Final Rejection,
10 Aug. 29, 2006, pp. 5). Davis describes the aqueous, stabilized, form. The
11 Examiner additionally referenced Paluch’s teaching that conventional forms
12 are water-based compositions and typically use of gelling agents, sugars and
13 glycols to stabilize these compositions to evidence the knowledge of a
14 skilled artisan at the time of the invention. (Id. pp. 4-5).

15 The Appellants next asserts that Paluch teaches away from a water-
16 based compositions. (App. Br. pp. 8, 12). The Appellants quote text from
17 Paluch, which states, in part, “The prior art products are not able to function
18 as a delivery system for various nutritional, functional, or pharmaceutical
19 additive ingredients because the prior art requires significant heat processes
20 and/or acidic conditions for stability.” (Id. p. 8)(citing Paluch 4:19-25).

21 This argument is also unpersuasive. “A reference may be said to
22 teach away when a person of ordinary skill, upon reading the reference,
23 would be discouraged from following the path set out in the reference, or
24 would be led in a direction divergent from the path that was taken by the
25 applicant.” *In re Gurley* 27 F.3d 551, 553 (Fed. Cir. 1994).

1 Paluch does not discourage preparing an aqueous composition that is
2 stabilized with a humectant or gelatin. Rather, Paluch discourages preparing
3 compositions requiring “significant heat processing and/or acidic conditions
4 for stability.” (Paluch 4:19-25). Paluch, therefore, describes a semi-moist
5 composition that does not require such processing for stability.

6 Additionally, Davis describes an aqueous composition that does not require
7 such processing. Thus, a skilled artisan at the time of the invention who
8 read Paluch and Davis would have understood that a microbiologically
9 stable aqueous composition, as claimed, was useful for delivering nutritional
10 ingredients.

11 Consequently, we find that the Appellants have not established that
12 the Examiner erred in relying upon Paluch, in combination, to reject the
13 claims.

14 The Appellants additionally challenge the Examiner’s reliance on
15 Davis. In particular, the Appellants assert that the Examiner erred in relying
16 upon Davis as disclosing “a microbiologically stable aqueous composition.”
17 (App. Br. 10). The Appellants assert that Davis instead “relates to
18 stabilizing vitamin C in the presence of iron,” which, according to the
19 Appellants, “has nothing whatsoever to do with ‘a microbiologically stable
20 aqueous composition.’” (Id. p. 11). The Appellants also assert that Davis is
21 not directed to a microbiologically stable aqueous composition because
22 Davis “achieves long term stability by freeze drying the aqueous
23 composition to a powder.” (Id. p. 16).

24 This argument is also unpersuasive. Davis teaches “a highly stable
25 aqueous solution” useful as a nutritive liquid composition for humans and/or

1 animals. (Davis Claim 1; Abstract; 2:9-12). Davis also expressly describes
2 that the composition comprises gelatin which, in addition to providing a rich
3 source of essential amino acids, also “acts to stabilize *the composition*.” (Id.
4 2:30-37)(emphasis added). As with the claimed invention, Davis discloses a
5 “ready-to-use composition [that] does not require processing, i.e.,
6 sterilization or pasteurization,” as the composition is stabilized by the
7 presence of gelatin. (Specification p. 12). The appellants have put forth no
8 persuasive evidence that Davis is not microbiologically stable.

9 The Appellants suggestion that Davis teaches the use of freeze drying
10 to stabilize the liquid form of the invention is not entirely correct. Davis
11 describes the highly stable aqueous composition of the invention “may be
12 prepared and marketed in either *liquid* or dry granular form.” (Davis
13 Abstract)(emphasis added). (Davis 3:15-31, Claims 7,8).

14 Therefore, we do not find error on the part of the Examiner and the
15 Appellants have not established otherwise.

16 The Appellants also assert that the Examiner erred by citing “Davis as
17 disclosing use of gelatin in an amount of 20% for the compositions therein.”
18 (App. Br. 10)(citing Final Rejection, Aug. 29, 2006, p. 6). The Appellants
19 do not dispute that Davis discloses the use of gelatin, nor that the use of
20 gelatin in foods was known in the art. (See App. Br. 10). Rather, the
21 Appellants assert that Davis does not disclose using gelatin “in an amount of
22 20%.” (App. Br. 10).

23 This argument is not persuasive. The Examiner found that “Davis
24 disclose[s] compositions having gelatin as an ingredient of a
25 multicomponent composition.” (Final Rejection, Aug. 29, 2006, p. 5). The

1 Examiner Examiner further described the combination of references as
2 including “a gelatin and humectant form in an amount of 20% as disclosed
3 by Davis and Bone...” (Id. p. 6). The amount of 20% relates to Bone’s
4 disclosure of the humectant. (See Bone 4:26-34)(describing quantity of
5 plasticizing/humectant agents in a range of 5-20 percent). Consequently, we
6 are not persuaded of error on the part of the Examiner.

7 The Appellants next challenge the Examiner’s reliance on Bone.
8 Specifically, the Appellants assert that the Examiner erred in finding that
9 Bone discloses the use of a humectant in an amount of 20%. (App. Br. 11,
10 Reply Br. 8). According to the Appellants, Bone only describes using a
11 humectant agent, such as glycerol, in “ranges from 5 to 10 percent by weight
12 of the soft component” (Reply Br. 8-9) (citing Bone 5:13-26), and not in the
13 claimed range “of from about 20 to about 85% by weight,” (Reply Br. 9;
14 claim 27). The Appellants also assert that Bone uses the humectant for
15 “softening the ‘soft dry component’ of Bone” and not “to help form a
16 microbiologically stable aqueous composition” as in the claimed
17 compositions. (App. Br. 17).

18 These arguments are not persuasive. While Bone describes that the
19 quantitative range of plasticizing/humectant agent used ranges from 5 to
20 about 10 wt% of the soft component (Bone 5:18-21); Bone also describes
21 that it may be necessary to increase the level of plasticizing/humectant agent
22 added to the composition. (Id. 6:49-53). Bone additionally describes that
23 the quantity of plasticizing agent added to the composition is considered to
24 be within the skill of the art and that such quantity typically is in a range of
25 5-20 percent. (Id. 4:26-34). It is well settled that a reference is good for

1 everything it teaches. *See In re Azorlosa*, 241 F.2d 939, 941 (CCPA 1957)
2 (it is proper for the court and necessarily, the board, to consider everything
3 that a reference discloses). Consequently, the Appellants' have not
4 established that the Examiner erred in finding that Bone describes using a
5 plasticizing/humectant in an amount of 20%.

6 The Appellants assert that Bone uses the humectant for a purpose
7 different than their own, to soften. (App. Br. 17). Both the primary
8 reference, Paluch, and Bone incorporate a humectant in the disclosed
9 compositions. "The fact that appellant has recognized another advantage
10 which would flow naturally from following the suggestion of the prior art
11 cannot be the basis for patentability when the differences would otherwise
12 be obvious." *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Int.
13 1985), *aff'd. mem.*, 795 F.2d 1017 (Fed. Cir. 1986).

14 Even though the instant rejection is not based on anticipation, we
15 observe that the principle of inherency is equally applicable to a rejection
16 based on obviousness. *See In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980);
17 *In re Best*, 562 F.2d 1252, 1254 (CCPA 1977) (Affirming rejections over a
18 combination of references under 35 U.S.C. § 103 where an allegedly
19 distinguishing claim limitation was apparently inherent in one of the
20 references).

21 To the extent that adding propylened glycol as the humectant in
22 Appellants' composition would aid in microbiologically stabilizing it
23 (Specification p. 13), Appellants have not directed us to evidence
24 demonstrating that Bone's propylened glycol humectant (Bone 5:25-26)
25 would not also stabilize the solution.

1 The Appellants also challenge the use of Bone in combination by
2 asserting that “Bone specifically teaches against converting dry pet foods
3 into anything that could be argued to be an aqueous liquid concentrate or
4 colloidal suspension.” (App. Br. 17). This argument misses the point.

5 The Examiner relied on Bone for teaching the amount of humectant to
6 use in the composition of Paluch. Bone does not teach away from using a
7 humectant in an aqueous composition that is a liquid concentrate or a
8 colloidal suspension. Rather, Bone describes that “in many cases, the hard
9 abrasive nature [of a dry pet food] is desired for teeth cleaning
10 characteristics in addition to the nutrition and ease of storage.” (Bone 1:37-
11 39). Bone describes that dry food, however, has palatability problems that
12 make it difficult to feed to a pet. (Id. 1:39-41). Then, Bone explains that
13 adding water improves palatability of the dry food, but softens the food
14 causing “the loss of some-- if not all-- teeth cleaning attributes.” (Id. 1:42-
15 47).

16 Thus, Bone describes that the addition of water to cure palatability is
17 “not suitable” in cases where the pet food is desired only for teeth cleaning.
18 This description does not constitute a teaching away from the claimed
19 invention, which is not directed to teeth cleaning attributes. Indeed, it is
20 well known that pet owners have been adding water to solid pet food for pet
21 enjoyment for many years. (E.G. “Gravy Train” U.S. Trademark Reg. No.
22 695774, April 5, 1960). Consequently, we are not persuaded of error.

23 The Appellants also challenge the Examiner’s finding that Balleve
24 discloses the use of hydrolyzed protein in pet foods. (App. Br. 9, 16). The
25 Appellants assert that Balleve is unrelated to such use and instead teaches

1 that “[i]n vitro enzyme digestion of native and microparticle incorporated
2 proteins shows a reduced relative enzymatic digestion rate.” (Id. at 9)
3 (emphasis in original). Additionally, the Appellants assert that the Examiner
4 erred in finding that because Balleve suggests a microbiologically stable
5 composition because the hydrolyzed protein is slow to digest. (Id.).

6 This argument is misplaced. The primary reference, Paluch, disclosed
7 a composition comprising a hydrolyzed protein, as claimed. (See App. Br.
8 13, Appellants acknowledge Paluch teaches this limitation). Additionally, as
9 discussed supra, Davis describes preparing an aqueous composition in a
10 liquid form that is microbiologically stable, as claimed and defined in the
11 specification.

12 Consequently, we do not find that the Appellants have established that
13 the Examiner’s rejection of claims 27, 29, 32-38, 42-44, 113-116, 118-121,
14 125-127, 129, & 130 “is facially insufficient for not accounting for all
15 limitations of the claims.” (App. Br. 18). Each of the claim limitations are
16 set forth in the combination of Paluch, Davis and Bone.

17 The Appellants also assert that the Examiner’s reliance on the
18 combination of Paluch, Davis and Bone represents “an overt hindsight
19 reconstruction.” (See, e.g., App. Br. 9, 16, 18).

20 This argument is also unpersuasive. The Appellants are claiming a
21 liquid or suspended food supplement containing a pharmaceutical, each
22 component of which was known in the art for its intended function. As the
23 Examiner determined, it would have been obvious to a person of ordinary
24 skill in the art at the time of the invention to prepare a multicomponent
25 composition comprising hydrolyzed protein, a humectant and lipid, as

1 described by Paluch, as a more palatable aqueous liquid that is also stable, as
2 described by Davis. (*See* Final Rejection, Aug. 29, 2008, pp. 6-10). The
3 Examiner also determined that it would have been obvious to the skilled
4 artisan at the time of the invention to incorporate the humectant described by
5 Paluch in the amount taught by Bone. (*Id.*). The Appellant has put forth no
6 persuasive contrary evidence.

7 Moreover, as the Court explained in *In re McLaughlin*, 443 F.2d
8 1392, 1395 (CCPA 1971), “Any judgment on obviousness is in a sense
9 necessarily a reconstruction based upon hindsight reasoning” The Court
10 further clarified that such a reconstruction is proper if it relies on ordinary
11 skill at the time of the invention and not on knowledge gained solely from
12 the applicant’s disclosure. *Id.* As discussed, *supra*, the cited combinations
13 of references disclose each of the limitations of claims 27, 29, 32-38, 42-44,
14 113-116, 118-121, 125-127, 129, & 130 and the rejection does not rely on
15 information gleaned only from Appellants’ disclosure. It would have been
16 obvious to one of ordinary skill in the art at the time of the invention to
17 combine the references to make the claimed invention.

18 II. Claim 28

19 Claim 28 reads as follows:

20 28. The composition of claim 27, wherein the pharmaceutical
21 is water soluble.

22
23 The Appellants assert that the additional limitation of claim 28 renders
24 the claim patentable. (App. Br. 19).

25 This argument is unpersuasive as the Appellants have neither
26 established nor asserted that it would have been beyond the skill of an

1 ordinarily skilled artisan at the time of the invention to add a water soluble
2 pharmaceutical component to an “aqueous composition for delivering a
3 pharmaceutical,” as claimed. The question of obviousness cannot be
4 approached on the basis that an artisan having ordinary skill would have
5 known only what was read in the references, because such artisan must be
6 presumed to know something about the art apart from what the references
7 disclose. *See In re Jacoby*, 309 F.2d 513, 516 (CCPA 1962).

8 Further, a conclusion of obviousness may be made from common
9 knowledge and common sense of the person of ordinary skill in the art
10 without any specific hint or suggestion in a particular reference. *See In re*
11 *Bozek*, 416 F.2d 1385, 1390 (CCPA 1969). Indeed, the law presumes skill
12 on the part of the artisan rather than the converse. *See In re Sovish*, 769 F.2d
13 738, 743 (Fed. Cir. 1985). We find that it was within the skill of the art at
14 the time of the invention to add a water soluble pharmaceutical to an
15 aqueous solution. (FF-20). It was well known to dissolve water-soluble
16 pharmaceuticals in water.

17 We additionally note that the Appellants have put forth no persuasive
18 evidence that water soluble pharmaceuticals would have been unobvious to
19 the skilled artisan. Accordingly, this argument fails.

20 III. Claims 39-41 and 122-124

21 Claim 39 reads as follows:

22 39. The composition of claim 38, wherein the mixture
23 comprises the sugar and the polyhydroxyl alcohol in a ratio of
24 about 1:1.
25

1 Claim 38 reads as follows:

2 38. The composition of claim 27, wherein the humectant
3 comprises a mixture of a sugar and a polyhydroxyl alcohol.

4
5 The Appellants assert that claims 39-41 and 122-124 “are drawn to
6 specific ratios of sugar and polyhydroxyl alcohol within the humectant
7 component of the claimed compositions.” (App. Br. 19). The Appellants
8 assert that the additional limitations of claims 39-41 and 122-124 render the
9 claims patentable. (Id.).

10 Paluch describes that semi-moist edible products are known in the art
11 and are made by adding a water based soft component to a dry component,
12 wherein the water based component is stabilized using a variety of gelling
13 agents, sugars, salts, glycols, and/or by using heat. Both agents were known
14 in the art and are being used by the Appellants for their known functions.
15 Where general conditions of the appealed claim (i.e. using two known ones
16 or a 1:1 ratio of known ones) are disclosed in the prior art, it is not
17 unobvious to discover optimum or workable ranges by routine
18 experimentation, and the Appellants have the burden of proving any
19 criticality. *In re Boesch*, 617 F.2d 272, 276 (CCPA 1980); *In re Aller*, 220
20 F.2d 454, 456 (CCPA 1955).

21 We therefore are unpersuaded by this contention.

22 IV. Claims 45 and 128

23 Claim 45 reads as follows:

24 45. The composition of claim 44, wherein the vegetable oil is
25 coconut oil, corn oil, cotton seed oil, olive oil, safflower oil,
26 sunflower oil, soybean oil or a combination thereof.

27

1 Claim 44 reads as follows:

2 44. The composition claim 27, wherein the lipid component
3 is provided as a vegetable oil.

4
5 The Appellants assert that the Examiner's rejection of claims 45 and
6 128 "is a hindsight driven conclusion without substantive basis." (App. Br.
7 19). Specifically, the Appellants assert Paluch teaches addition of the pure
8 active ingredient (linoleic acid) from sunflower oil for coat enhancement,
9 not sunflower oil itself." (Id. p. 20).

10 We disagree with the Appellants. Paluch describes that "the
11 functional ingredient in sunflower or safflower oil, linoleic acid, can be
12 mixed into the lipid based center filling material [of the composition].
13 (Paluch 7:20-22). Thus, adding the the linoleic acid in the form of the oils
14 would have been obvious to a skilled artisan at the time of the invention, e.g.
15 for coat enhancement (I.). Consequently, we are not persuaded of error.

16 V. Claim 48

17 Claim 48 reads as follows:

18 48. The composition of claim 27, wherein the composition
19 has a pH in the range of about 4.0 to about 8.0.

20 Additional Findings of Fact

21 The Appellants assert that claims 48-50 and 131 "are drawn to
22 specific ranges of pH for the claims compositions." (App. Br. 20). The
23 Appellants assert that the Examiner erred in determining that claims 48-50
24 and 131 are obvious in view of Paluch. In particular, the Appellants
25 challenge the Examiner's finding that Paluch discloses that the desired pH of
26 the composition is between about 1.0 to about 5.0. According to the

1 Appellants, Paluch's disclosure of pH relates only to safe conditions when
2 using a digest. (Id.) (citing Paluch 9:1-10).

3 This argument is not persuasive. Prior to stating that "safe digest
4 conditions are also well known, such as maintaining a pH between about 1.0
5 to about 5.0" (Paluch 9:9-10), Paluch similarly describes that "such safety
6 procedures as are required to produce a suitable pet or animal food product
7 are also well known in the art and are followed in practicing the present
8 invention." (9:4-7). Therefore, Paluch describes that the person having
9 ordinary skill in the art at the time of the invention would understand the
10 required pH range for using a digest and for producing a safe and suitable
11 pet or animal product. The Appellants have put forth no persuasive evidence
12 ot the contrary.

13 Consequently, we do not find that the Appellants have established that
14 the Examiner erred in rejecting dependent claims 48-50 and 131 over the
15 combined prior art, and specifically the disclosure of Paluch and the
16 ordinary skill in the art at the time of the invention.

17 VI. Claims 132 and 133

18 Claim 132 reads as follows:

19 132. The composition of claim 27, wherein the amount of
20 hydrolyzed protein component is equal to the amount of water.

21
22 Claim 133 recites the same limitation as claim 132.

23 The Appellants assert that the additional limitation of claims 132 and
24 133 render the claims patentable. (App. Br. 21).

25 We disagree.

1 The ingredients in the Appellants' claims are all being used for
2 known functions. It is not inventive to discover optimum or workable
3 ranges by routine experimentation, and Appellants have the burden of
4 proving any criticality. *In re Boesch*, 617 F.2d 272, 276 (CCPA
5 1980); *In re Aller*, 220 F.2d 454, 456 (CCPA 1955). The Appellants
6 have not put forth persuasive evidence of the criticality of this equal
7 measure of water and protein. Consequently, we are not persuaded of
8 error.

