

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL KALMBACH

Appeal No. 95-0715
Application 07/936,942¹

HEARD: September 18, 1997

Before JOHN D. SMITH, WARREN and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. ' 134 from the decision of the examiner refusing to allow claims 1 through 3,5, 6 and 17 through 21 as amended subsequent to the final rejection, which are all of the claims in the application.² Claims 1 and 17³ are illustrative of the claims on appeal:

¹ Application for patent filed August 28, 1992.

² We have entered the amendment after final rejection of February 14, 1994 (Paper No. 9). We note that this amendment had not been previously entered even though entry upon the filing of an appeal was indicated in the advisory action of March 17, 1994 (Paper No. 10) as stated by appellant in his

1. A method of feeding nutrients to animals comprising:

forming granules comprising 1 to 70% by weight of said nutrients;

establishing the size of said granules at from 1/64 inch to 32/64 inch;

combining and suspending said granules with a feed composition said feed composition having an average particle size and wherein the size of said granules is approximately the same as the average particle size of said feed composition whereby said granules remain suspended in said feed.

17. A method of feeding nutrients to animals comprising:

forming granules comprising 1 to 70% by weight nutrients, 1-30% crude protein, 1-15% by weight crude fat, 1-15% by weight crude fiber, and establishing the size of said granules at from 1/64th inch to 32/64th inch;

combining and suspending from about .25 to about 7.5% of said granules with a feed composition based on the total weight of said granules and said feed composition, said feed composition having an average particle size and wherein the size of said granules is approximately the same as the average particle size of said feed composition whereby said granules remain suspended in said feed.

The appealed claims as represented by claims 1 and 17 are drawn to methods of feeding nutrients to animals wherein a granule comprising the nutrient has an average particle size that is approximately the same as the average particle size of the feed composition with which it is mixed such that the granules remain suspended in said feed. According to appellant, this similarity in average particle size between the nutrient granule and the feed composition causes the

brief (page 1) and acknowledged by the examiner in the answer (page 1).

³ We observe that appealed claim 21, the other independent claim of record, is at least a substantial duplicate of appealed claim 3. In the event that these claims are held to be allowable, see MPEP ' 706.03(K), Duplicate Claims (6th ed., Rev. 2, July 1996).

nutrient granule to remain suspended in the feed composition (specification, e.g., page 2).

The reference relied on by the examiner is:

Autant et al. (Autant)	4,876,097	Oct. 24, 1989
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We have relied on Duchstein and further cite Kalmbach:⁴

Duchstein	4,310,552	Jan. 12, 1982
Kalmbach	5,629,038	May 13, 1997

The patent to appellant was called to our attention by counsel at oral hearing. This patent issued from application 08/444,834, filed May 18, 1995, which according to appellant is a continuation of application 08/077,018, filed Jun. 15, 1993, now abandoned, which is a division of the present application. Patent claims 1 through 6, which are all of the claims, are drawn to products which are used in the methods claimed in the appealed claims of the present application. We have reviewed the patent and find that upon citation of Duchstein, the record in the present application is materially different from the record in the application maturing into the patent. Accordingly, the claims of this patent do not constitute binding precedent in the case before us as to whether these intermediates are nonobvious. *In re Riddle*, 438 F.2d 618, 169 USPQ 45 (CCPA 1971); *see also In re Willis*, 455 F.2d 1060, 1062-63, 172 USPQ 667, 669 (CCPA 1972); *compare In re Ochiai*, 71 F.3d 1565, 1567-70, 37 USPQ2d 1127, 1129-1131 (Fed. Cir. 1995).

The examiner has rejected claims 1 through 3, 5, 6 and 17 through 21 on appeal under 35 U.S.C. ' 103 as being

⁴ We have made Duchstein and Kalmbach of record (PTO-892) and provide a copy of Duchstein for appellant's convenience.

unpatentable over Autant.⁵ Because we agree with the examiner's stated rejection and take notice of knowledge in the prior art as evinced by Duchstein in doing so, we denominate our affirmance of the examiner's rejection as a new ground of rejection under 37 CFR ' 1.196(b). Under the provisions of this same rule, we also enter a new ground of rejection of appealed claims 1 through 3, 5, 6 and 21 under 35 U.S.C. ' 102(b) as being anticipated by, and under 35 U.S.C. ' 103 as being obvious over Duchstein. *See, e.g., In re Spada*, 911 F.2d 705, 708 n.2, 15 USPQ2d 1655, 1657 n.2 (Fed. Cir. 1990).

Rather than reiterate the respective positions advanced by the examiner and appellant, we refer to the examiner's answer and to appellant's brief for a complete exposition thereof.

Opinion

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the examiner that the method as claimed in appealed claim 1 through 3, 5, 6 and 17 through 21 would have been obvious as a whole over Autant in its entirety to one of ordinary skill in this art at the time the claimed invention was made in view of the knowledge in the art at that time as evinced by Duchstein.

The examiner contends that the appealed claims do not limit the size of the animal feed nor its density and thus the method of the appealed claims do not distinguish over Autant which discloses the concept of providing a mixture of granules and animal feed. However, we note that as a matter of claim

⁵ The examiner did not maintain on appeal the rejections based on 35 U.S.C. 112, first and second paragraphs, set forth in the final rejection.

construction, the appealed claims clearly specify that the nutrient granule has an average particle size that is approximately the same as the average particle size of the feed composition with which it is mixed such that the granules remain suspended in said feed.

In comparing the claimed invention with the teachings of Autant, we observe that the reference discloses that nutrient and therapeutic substances for ruminants may be coated with the disclosed coating compositions and can be prepared as pellets in the form of microcapsules which are mixed with animal feed (col. 5). Autant teaches that the pellets may be formed by conventional techniques and that

[t]he size of the pellets will depend on the use which is to be made of them, and will be determined, more especially, according to the animal for which they are intended,

which size is in the range of 0.1 to 5 mm (cols. 5-6, particularly col. 6, lines 7-12). We are of the view that this disclosure would have reasonably suggested to one of ordinary skill in the animal husbandry arts that the size of the pellets should be adjusted within the size range taught in the reference with respect to the animal to be fed which, of course, would include consideration of the feed normally provided to such an animal. Thus, the matter of adjusting the size of the pellets with respect to the animal to be fed would have been a matter of routine experimentation within the teachings of the reference by one of ordinary skill in this art at the time the claimed invention was made. It is well settled that in considering the effect of a reference, we must consider the specific teachings thereof and the inferences one of ordinary skill in this art would reasonably have been expected to draw therefrom. *In re Fritch*, 972 F.2d 1260,

1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). And, in doing so, we must presume skill on the part of those of ordinary skill in this art. *In re Sovich*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Indeed, it has long been well known in the animal husbandry arts that the feed for a ruminant or other livestock conventionally comprises digestible meal which is derived from, *inter alia*, corn, grains and soybeans, that have been processed into said meal by milling, which process reduces the kernel and the husk to small particles. It also has long been well known in these arts to augment the meal with whole grains as well as feed supplements for various purposes, such as nutrients and therapeutics, which whole grains and feed supplements are of relatively larger size than the small particles of the meal. It is further well known that such augmented meal will separate according to size in view of the difference in particles sizes. While this separation based on particle size difference may be of little consequence where the meal and the whole grain or feed supplements are mixed prior to distribution and rationed individually or in a trough, it will not work satisfactorily as premix used in a bulk feeder.

Indeed, Duchstein demonstrates that a feed mixture for pigs, hogs and swine comprising digestible grains and/or soy meal (col. 2, lines 12-15) which when mixed with feed supplements of greater than 5 mm result in problems

associated with separation of the components of the feed mixture [and] the problems of handling and manufacturing the animal feed because of the increase in volume resulting from the use of the additive.

Col. 1, lines 13-31, particularly lines 25-31. Thus, Duchstein teaches that in order to overcome these problems, an indigestible, porous perlite particle or granule, charged with physiologically or medicinally effective substances, which has a particle size of up to 5 mm should be added to the meal at a size that

corresponds to the particle size range of the meal of the usual finished swine fodder [i.e., especially grain and soy meal (including bran meal)] to which it is added so that the composition will contain 10 to 50 volume % of the blown perlite particles.

Col. 2, lines 10-41. Duchstein further teaches that

A surprising advantage of the use of perlite in accordance with the present invention, in the finished swine fodder, is that there is little influence of the additive, even when used in large volume proportions, on the bulk weight apparently because the fine-grained fraction of perlite fills the rough and broken surface of the digestible fodder components, especially grit and bran and/or soy meal while, conversely, the foamed meal components of the digestible portion fill the open pores of the perlite.

In other words after intensively mixing and blending of the digestible and indigestible components of the fodder, the composition has a relatively low volume and hence the composition can be handled easily with conventional machinery and techniques. [Col. 2, lines 42-56.]

We are of the view that Duchstein would have clearly suggested to one of ordinary skill in this art that using meal and food supplement granules of similar particle size confers a number of benefits without regard to the particular animal for which the feed is prepared. Indeed, grain and soy meal (including bran meal) constitute a basic feed for other livestock, including ruminants. We note in this respect that the feed supplement granules of Autant are disclosed to be in

the same range of up to 5 mm in particle size as the feed supplement granules of Duchstein.

Thus, the combination of Autant and the knowledge in the art as evinced by Duchstein taken as a whole would clearly have motivated one of ordinary skill in this art to utilize the food supplement granules of Autant in the same or similar particle size as the particle size of the feed with which it is to be mixed for a particular animal in order to avoid separation of the components of the mixed feed and to facilitate the ease of handling the mixed feed with conventional machinery and techniques. See, e.g., *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)("[T]he test [for obviousness] is what the combined references would have suggested to those of ordinary skill in the art.").

Accordingly, the claimed method of feeding nutrients to animals would have been *prima facie* obvious as a whole over Autant combined with Duchstein as a whole to one of ordinary skill in this art at the time the claimed invention was made, in the absence of persuasive argument and evidence to the contrary. We have carefully considered the elements of all of the appealed claims and the arguments set forth in appellant's brief in restating this ground of rejection. With respect to the appealed claims, we point out that in addition to teaching adjusting the particle size of the food supplement granule to the same or similar particle size of the meal for the particular animal, Autant and Duchstein also provide evidence that the adjustment of the contents of the granule with respect to its density relative to the meal, the amount of granules to be combined with the meal and the nutritional

and/or medicinal content of the granules were also within the ordinary skill in this art.

Furthermore, we cannot agree with appellant (brief, e.g., page 4) that Autant would not have reasonably suggested at col. 56, lines 7-10, thereof (see supra p. 5) to size the feed supplement granule to the particle size of the feed for the intended animal especially in view of the teaching of Duchstein that it was known in the art that similarity in particle size between the meal particles and the feed supplement granules avoided separation. While the main focus of Autant may have been on the content and preparation of the particle, that does not detract from the other clear teachings of the reference. See generally *In re Mills*, 470 F.2d 649, 651, 176 USPQ 196, 198 (CCPA 1972). Indeed, contrary to appellant's contentions (brief, page 5), we observe that the coated granules of Autant as well as the perlite granules of Duchstein clearly satisfy the requirements of the granules in the appealed claims. It is clear from appellant's specification as it would be interpreted by one of ordinary skill in this art that the "granules" are formed in conventional manner from concentrations of nutrients in combination with a carrier (e.g., page 2) wherein the carrier may be "any of a large number of digestible or nondigestible edible and GRAS (generally recognized as safe) ingredients" (page 4). Thus, as a matter of claim construction, we are of the view that the term "granules" as it is used in the appealed claims must be given its ordinary meaning as we find no other meaning intended by appellant. See, e.g., *York products, Inc. v. Central Tractor Farm & Family Center and Custom Form Manufacturing, Inc.*, 99 F.3d 1568, 1572-73, 40

USPQ2d 1619, 1622 (Fed. Cir. 1996), and cases cited therein (a claim term will be given its ordinary meaning unless appellant discloses a novel use of that term); *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent prosecution the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art.").

We further find that appellant's contention that the level of ordinary skill in the animal husbandry arts is "relatively low" with respect to "feeding animals" (page 5) is clearly without merit. Indeed, the high level of ordinary skill in the art of feeding livestock sustains a considerable segment of our food supply. As we set forth above, we will presume skill on the part of those of ordinary skill in this important art area. *Sovich*, supra.

We have also carefully considered appellant's allegations of commercial success and long-felt need (brief, pages 6-7). We agree with the criticism made of Mr. Kalmbach's declaration of commercial success in the advisory action of March 7, 1994, that "it is not apparent that [the commercial success] is directly derived from the invention as claimed" (emphasis in original). It is well settled that "[a] nexus must be established between the merits of the claimed invention and the evidence of commercial success before that issue becomes relevant to the issue of obviousness." *Vandenberg v. Dairy Equip. Co.*, 740 F.2d 1560, 1566-67, 224 USPQ 195, 198-99 (Fed. Cir. 1984). Indeed, the fact that, in this case, appellant's

customers selected a granule size based on the animal to be fed and the conventional feed for that animal demonstrates no more than the ordinary skill in the art as seen from Autant and Duchstein as we set forth above in considering the merits of the presently claimed invention. Appellant's allegation of long-felt need is clearly without merit as it is based entirely on speculation and not on any objective evidence in the record.

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new grounds of rejection. Claims 1 through 3, 5, 6 and 21 on appeal are rejected under 35 U.S.C. ' 102(b) as being anticipated by, and under 35 U.S.C. ' 103 as being obvious over Duchstein. We have set forth the teachings of this reference above. With respect to appealed claim 1, the perlite granule of Duchstein is "formed" in conventional manner, charged with at least 1% by weight of physiological substances, can have a grain size of 5 mm which is larger than 1/64 inch and is mixed with meal at a size corresponding to the particle size range of the meal so that it will not separate from the meal. With respect to appealed claim 2, the charged perlite granules of Duchstein would have a density equal to +/- 30% of the density of said feed composition and with respect to duplicate appealed claims 3 and 21 (see supra note 3), the charged perlite granules of Duchstein would be present at least at 10 volume percent of the feed composition and thus be present at least at .25% by weight. And finally, with respect to appealed claims 5 and 6, the perlite granules would possess a nutrient charge that would comprise at least 4% by weight of nutrient ingredients which are trace elements and/or vitamins.

Accordingly, it reasonably appears to us from consideration of the teachings of Duchstein that the nutrient charged perlite granules of an average particle size which avoids separation when mixed with meal for feeding animals as disclosed therein are identical or substantially identical to the nutrient charged granules of the same or similar size for the same purpose as encompassed by appealed claims 1 through 3, 5, 6 and 21. Thus, the burden falls upon appellant to establish by objective evidence that the claimed invention patentably distinguishes over this reference, whether the rejection is considered to be based on 35 U.S.C. ' 102 or 35 U.S.C. ' 103. See *Spada*, 911 F.2d at 708-09, 15 USPQ2d at 1657-58; *In re Best*, 562 F.2d 1252, 1255-56, 195 USPQ 430, 433-34 (CCPA 1977).

In summary, we denominate our affirmance of the examiner's rejection of appealed claims 1 through 3, 5, 6 and 17 through 21 under 35 U.S.C. ' 103 as being unpatentable over Autant as a new ground of rejection under 37 CFR ' 1.196(b) because we rely on Duchstein in sustaining this rejection. We have set forth a new ground of rejection of appealed claims 1 through 3, 5, 6 and 21 under 35 U.S.C. ' 102(b) as being anticipated by, and under 35 U.S.C. ' 103 as being obvious over Duchstein under the provisions of 37 CFR ' 1.196(b).

The examiner's decision is affirmed.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof. 37 CFR ' 1.197.

With respect to the new rejection under 37 CFR ' 1.196(b), should appellant elect the *alternate* option under that rule to prosecute further before the Primary Examiner by

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way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, 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.

If 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 us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR ' 1.136(a).

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Affirmed

37 CFR ' 1.196(b)

JOHN D. SMITH)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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