

Appeal No. 1996-3469  
Application No. 08/268,708

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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(2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS D. LEE,  
and ROBERT W. WOOD

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Appeal No. 1996-3469  
Application No. 08/268,708

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ON BRIEF

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Before WINTERS, OWENS, and LORIN, Administrative Patent Judges.

LORIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. ' 134 from the final rejection of claims 1, 2, 4-6, 8-12, and 14-20, all the claims pending in the application. On consideration of the record, we reverse the rejections.

Representative Claims

1. A bottled non-carbonated, sugar-free, fruit-flavored beverage comprising fruit flavor, aspartame, citric acid and citrate buffer salt wherein the beverage has a pH of from 3.2 to 3.6, a weight ratio of the citric acid to the citrate buffer salt of 2.7-3.5:1 and a sour taste which is equivalent to fruit-flavored beverages having a pH of about 2.9, and wherein the sweetness of the beverage is provided by aspartame alone or by aspartame for a majority of the sweetness in combination with the other intensive sweeteners selected from the group consisting of alitame, acesulfame-K, saccharin, sucralose and combinations thereof.

9. A method of raising the pH of a non-carbonated, sugar-free, citric acid-containing and citrate buffer salt-containing fruit-flavored, bottled beverage wherein the sweetness of the beverage is provided by aspartame alone or by aspartame for a majority of the sweetness in combination with the other intensive sweeteners selected from the group consisting of alitame, acesulfame-K, saccharin, sucralose and combinations thereof, from below 3.0 to above 3.2 without lowering the sour taste of the beverage comprising the steps of adjusting the level of citric acid, increasing the level of citrate buffer salt, and decreasing the weight ratio of citric acid to citrate buffer salt to 2.7-3.5:1.

The references relied upon by the examiner are:

Sakai et al. (Sakai)	4,770,889	Sep. 13, 1988
Wakabayashi et al. (Wakabayashi)	4,849,238	Jul. 18, 1989
Sabatura	4,876,106	Oct. 24, 1989

The rejections are:

Claims 1, 2, 4-6, 8-12, and 14-20 are rejected under 35 U.S.C. ' 112, first paragraph, as the specification does not contain a written description of the claimed invention.

Claims 1, 2, 4-6, 8-12, and 14-20 are rejected under 35 U.S.C. ' 103 as being unpatentable over Sakai and Wakabayashi in view of Sabatura.

Decision

In rendering our decision, we have considered the following:

The entire specification and record in 08/268,708;  
Final Rejection (paper no. 9, mailed July, 26 1995);  
Brief (paper no. 15, filed March 25, 1996); and,  
Examiner's Answer (paper no. 16, mailed May 8, 1996).

Claims 1, 2, 4-6, 8-12, and 14-20 are rejected under 35 U.S.C. ' 112, first paragraph, as the specification does not contain a written description of the claimed invention.

The term "non-carbonated" was newly added to claims 1 and 9 by an amendment (paper no. 7, filed May 19, 1995) filed after the first Office action (paper no. 5, mailed December 30, 1994). Because the examiner could not find "verbatim basis" (Examiner's Answer, p. 3) for this term in the original disclosure, a rejection under 35 U.S.C. ' 112, first paragraph, was applied.<sup>1</sup> We reverse the rejection for two reasons.

First, the examiner applies the wrong legal standard. A specification need not have "verbatim basis" of the terms in the claims. "The claimed subject matter need not be described *in haec verba* to satisfy the description requirement," In re Herschler, 591 F.2d 693, 701, 200 USPQ 711, 717 (CCPA 1979).

Second, the term "non-carbonated" is implicitly disclosed for the reasons stated by appellants in their brief (p. 2). The specification (page 1, lines 12-21) contrasts "Carbonated soft drink manufacturers who enjoy a relatively quick distribution . . ." and "beverage products where the distribution and use cycle may extend to a period of several months . . ." The clear implication is that "beverage products" are other than "carbonated soft drinks." Since this can only mean non-carbonated beverages, the claimed invention has written descriptive support.

Claims 1, 2, 4-6, 8-12, and 14-20 are rejected under 35 U.S.C. ' 103 as being unpatentable over Sakai and Wakabayashi in view of Sabatura.

We feel compelled to point out the following defects in examiner's position:

First, examiner states that "the claim now requires a non-carbonated beverage [but that it] is not given weight as it is considered new matter." Examiner's Answer, p. 4. Simply because a limitation in a claim may not comply with the written description requirement of 35 U.S.C. ' 112 does not mean examiner can ignore the

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limitation with regard to obviousness under 35 U.S.C. '

103. In fact, it must be considered.

Even though the above quoted expressions are held by us to introduce new matter into the claims, nevertheless, they cannot be ignored, but rather, must be considered and given weight when evaluating the claims so limited with regard to obviousness over the art. See In re Miller, 58 CCPA 1182, 441 F.2d 689, 169 USPQ 597 (1971) and In re Wilson, 57 CCPA 1029, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970).

Ex parte Pearson, 230 USPQ 711, 712. See also Ex parte Grasselli, 231 USPQ 393, 394.

Second, examiner uses the wrong standard for determining obviousness. The standard is as follows:

Under ' 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined.

Graham v. John Deere, 148 USPQ 459, 467 (US 1966).

Instead, examiner makes a number of unsupported statements to the effect that claimed features are "obvious" or contain "nothing . . . non-obvious." From this follows the determination that it would have been "obvious" to use them. This is an example:

Features variously recited in the different claims are considered obvious features or

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control limitations well within the determination of one with the ordinary skill in the art. Therefore, it would have been obvious to use such known features in the composition and process of the combined reference.

The relevant inquiring is whether the claimed subject matter would have been obvious over the prior art to one with ordinary skill. For a large number of claimed features, no prior art is relied upon.

Third, "[i]t is elementary that the claimed invention must be considered as a whole in deciding the question of obviousness," In re De Blauwe, 736 F.2d 699, 706, 222 USPQ 191, 196 (Fed. Cir. 1984). Examiner's position never comes to grip with the invention as a whole. It is presented as though every feature of the claim is independent from each other. According to the examiner, all the claimed features are known or obvious for one reason or another. But the

question is not whether any single feature is obvious over the prior art but whether it, in combination with all the other features claimed, is obvious over the prior art to one of ordinary skill.

Lastly, examiner states that Appellants argue that they have shown commercial success. In fact, they filed a declaration (paper no. 8, filed May 19, 1995).

Examiner never mentions the declaration, let alone treats the substance of it. Instead of reevaluating the prima facie case of obviousness in light of the declaration, examiner dismisses<sup>1</sup> it. This is improper. As emphasized by the court in Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1549, 220 USPQ 193, 199 (Fed. Cir. 1983):

It is inappropriate and injudicious to disregard any admissible evidence in any judicial proceeding. Hence, all relevant evidence on the obviousness issue must be considered before a conclusion is reached. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

Evidence under 37 CFR ' 1.132 must be considered and, as mandated by the court in In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788<sup>2</sup> (Fed. Cir. 1984) and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147<sup>3</sup> (CCPA

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<sup>1</sup> A"The product may be commercially successful, but can still contain obvious subject matter which it would have been within the skill of the ordinary worker to vary to achieve the claimed product.@ Examiner's Answer, p. 8.

<sup>2</sup> AIf rebuttal evidence of adequate weight is produced, the holding of prima facie obviousness, being but a legal inference from previously uncontradicted evidence, is dissipated. Regardless of whether the prima facie case would have been characterized as strong or weak, the examiner must consider all of the evidence anew.@

<sup>3</sup> AFacts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself. Though the tribunal must begin anew, a final finding of obviousness may of course be reached, but such finding will rest upon evaluation of all facts in evidence, uninfluenced by any earlier conclusion reached by an earlier board upon a different record.@

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1976), the prima facie case must be considered anew in view of this evidence.

Now turning to the merits of the rejection.

The claims call for a non-carbonated beverage containing aspartame, citric acid and citrate buffer salt wherein the beverage has a pH of 3.2 to 3.6 and a weight ratio of the citric acid to the citrate buffer salt of 2.7-3.5:1 and a sour taste which is equivalent to fruit-flavored beverages having a pH of about 2.9. These are the salient but not all the features required by the claims. But even these are not disclosed.

The examiner has the initial burden of establishing a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). That has not been done here.

Neither the claimed pH of 3.2 to 3.6 nor the claimed weight ratio of the citric acid to the citrate buffer salt of 2.7-3.5:1 are taught. Nevertheless, Examiner rests on the fact that Sakai and Wakabayashi teach carbonated drinks containing citric acid and a citrate buffer and that "Sabatura discloses variations in the citric-citrate ratios . . . for fruit flavor beverage mixes" (Examiner's Answer, p. 4). Sabatura teaches a dry mix. All three references teach aspartame.

Based on this, examiner concludes that

to vary ratios as claimed in each of Sakai et al. or Wakabayashi et al. would have only involved only the ordinary skill of one in the art. Appellants are doing no more than varying the conventional citric-citrate ratio of beverage preparations for the expected consequence of the mixture.

Examiner's Answer, p. 4. Moreover, the "claimed pH would appear to be within the scope of the applied references" and "it would have been obvious that different ratios of acids to buffers are required if a product is more or less acid."

We are not persuaded that the two references to carbonated drinks with citric acid and citrate buffer and the third reference to a dry mix, in which the citric acid and citrate acid buffer ration can be adjusted, would lead one of ordinary skill to select the particularly claimed weight ratio of the citric acid to the citrate buffer salt of 2.7-3.5:1 with a pH of 3.2-3.5 as to a non-carbonated beverage. If anything, based on the combined references, it would have been

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obvious to adjust the weight ratio of the citric acid to the citrate buffer salt for carbonated beverages, not non-carbonated ones.

Even so, there is no suggestion to select the ratio claimed. This ratio, as appellants have argued, allows for the production of an acidic, fruit-flavored aspartame containing non-carbonated beverage with both aspartame stability and a sour taste equivalent to a similar beverage having a pH of about 2.9. Considering what the references do not teach and that no good reason has been given why one of ordinary skill reading the prior art references would select the particular citric acid to the citrate buffer salt ratio that is claimed for the acidic aspartame-containing

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non-carbonated sour-tasting fruit-flavored beverage that is claimed, we necessarily come to the conclusion that examiner has failed to make out a prima facie case of obviousness. We therefore reverse the rejection.

REVERSED

SHERMAN D. WINTERS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
TERRY J. OWENS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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HUBERT C. LORIN	)	
Administrative Patent Judge	)	

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The rejection is one of "new matter" in the claims. In accordance with 37 CFR ' 1.11 (see also MPEP ' 608.04), where the new matter has been entered into the claims, the claims are rejected under 35 U.S.C. ' 112, first paragraph, as the specification does not contain a written description of the claimed invention. See also MPEP ' 706.03(c).