

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARGARET E. DONOVAN

Appeal No. 1997-2014
Application No. 07/959,995¹

ON BRIEF

Before JOHN D. SMITH, GARRIS and KRATZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 through 20 which are all of the claims in the application.

The subject matter on appeal relates to a no fat, no cholesterol cake, to a dry premix for making such a cake and

¹ Application for patent filed October 13, 1992.

Appeal No. 1997-2014
Application No. 07/959,995

California Prune Board, "Utilization of Dried Plums in Reduced-Fat/Cholesterol-Free Bakery Products," Research Report, dated 1992.

Claims 1 through 11 and 13 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dobbin in view of Fahlen and Matz.

Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over the California Prune Board reference.

According to the appellant (e.g., see page 2 of the Brief and page 2 of the Reply Brief), the claims on appeal are grouped separately as follows:

- (1) claims 1, 4, 5;
- (2) claims 2, 3, 8-12;
- (3) claims 6, 7; and
- (4) claims 13-20.

We refer to the several Briefs and Answers of record for a complete exposition of the opposing viewpoints expressed by the appellant and the examiner concerning the above noted rejections.

OPINION

Appeal No. 1997-2014
Application No. 07/959,995

For the reasons which follow, we will sustain the § 103 rejection of claims 1 through 11 and 13 through 19 as being unpatentable over Dobbin in view of Fahlen and Matz but not the § 103 rejection of claims 1 through 20 as being unpatentable over the California Prune Board reference.

Concerning this last mentioned reference, the appellant and the examiner disagree as to whether the reference, vis à vis its publication date, has been established on this record as prior art against the here claimed invention². Even assuming that the California Prune Board reference constitutes prior art with respect to the appealed claims, however, it is clear to us that the examiner's rejection based on this references cannot be sustained. This is because the

² We here clarify and emphasize that the disclosure relied upon by the examiner in support of her rejection of claims 1 through 20 constitutes the "oat bran muffins" teachings in the California Prune Board reference which bears the date "2/92" on the last page thereof. The examiner's referrals to other documents such as the California Prune Board reference which bears the date "1/91" and a Washington Post article are not relevant to the obviousness issues raised by this rejection. It follows that we have not considered these other documents in assessing the propriety of the rejection in question.

Appeal No. 1997-2014
Application No. 07/959,995

reference disclosure concerning "oat bran muffins", which the examiner relies upon as support for her obviousness conclusion, quite plainly would not have suggested the here claimed invention.

More specifically, the aforementioned disclosure relates to a muffin product having a fat content many times higher than the maximum allowed by independent claims 1 and 8. Moreover, the examiner's position that it would have been obvious to lower the fat content of this product so as to be within the here claimed range simply is not supported by the requisite teaching/ suggestion and reasonable expectation of success. In re O'Farrell, 853 F.2d 894, 903-904, 7 USPQ2d 1673, 1680-1681 (Fed. Cir. 1988). Similarly, the California Prune Board reference contains no teaching or suggestion of a dry premix having the ingredients and proportions defined by appealed independent claim 6.

In light of these evidentiary deficiencies, we cannot sustain the examiner's § 103 rejection of claims 1 through 20 as being unpatentable over the California Prune Board reference.

Appeal No. 1997-2014
Application No. 07/959,995

On the other hand, it is appropriate that we sustain the examiner's § 103 rejection of claims 1 through 11 and 13 through 19 as being unpatentable over Dobbin in view of Fahlen and Matz.

Notwithstanding the appellant's arguments to the contrary, it is our opinion that Fahlen would have suggested to one with an ordinary level of skill in the art substituting a fruit material such as fruit paste for the oil used in Dobbin's "Applesauce Cake" recipe based upon a reasonable expectation of success. This suggestion and expectation of success would have arisen from Fahlen's teaching of desirably and successfully replacing fat with fruit paste in a bread product (e.g., see lines 17 through 23 and 26 through 38 in column 1). While we appreciate the appellant's point that such products are distinct from cake products of the type under consideration, an artisan with ordinary skill would have considered the benefits associated by Fahlen with this replacement (e.g., a more healthy food product while maintaining flavor and processability) as being applicable to cake products of the type taught by Dobbin.

Further, the leavening reaction between fruit acid and baking soda, which is recited in appealed independent claims 1 and 8, would have been suggested and expected to the artisan in view of the Matz disclosure (e.g., see the first and second paragraphs on page 102, the paragraph bridging pages 102 and 103, the first full paragraph on page 103 and the first and second paragraphs on page 105)³. As support for her nonobviousness position, appellant argues that Matz teaches that acidic fruit products are undesirable. From our perspective, however, Matz simply teaches that premature and nonuniform leavening reactions between baking soda and acidic food ingredients such as fruit juices are undesirable (again see the first two paragraphs on page 105). Clearly, the Matz teaching as a whole would not have dissuaded the artisan from using fruit products in the manner under consideration.

³ Concerning the matter of leavening, the appellant argues that Dobbin relies upon heat, soda and salt to produce a leavening reaction, rather than a fruit acid component and baking soda as here claimed, and that the applesauce of Dobbin's recipe is not believed to contain sufficient acid to effect the here claimed reaction. On the record before us, however, this argument is without evidentiary support of any kind and thus must be regarded as purely speculative.

Appeal No. 1997-2014
Application No. 07/959,995

We also agree with the examiner that it would have been obvious for an artisan to modify the applesauce cake recipe of Dobbin so as to utilize flour, sugar and baking soda proportions (e.g., see appealed claims 2, 3, 8-12) within the ranges here claimed and concomitantly to eliminate salt (see appealed claims 13-19) from this recipe motivated by a desire and reasonable expectation of success in relation to obtaining a flavorful and healthy food product. As for the dry premix feature of independent claim 6 and the claims which depend therefrom, it would have been obvious for the artisan to combine the dry ingredients of Dobbin's applesauce cake recipe as a dry premix, thereby obtaining the handling and processing advantages associated with a dry premix, in view of, for example, Matz's teaching of dry premixes as well known in the prior art (e.g., see the first paragraph on page 105).

In light of the foregoing, it is our determination that the Dobbin, Fahlen and Matz references establish a prima facie case of obviousness with respect to appealed claims 1 through 11 and 13 through 19. As support for her nonobviousness position, the appellant proffers several affidavits which praise the taste of cake samples given to the affiants by the

Appeal No. 1997-2014
Application No. 07/959,995

appellant. Clearly, however, these cake samples were limited to specific ingredients and proportions and thus much more narrow in scope than the appealed claims. Indeed, in the appellant's submission "What was Learned from the baking experiments" (referred to in the paragraph bridging pages 16 and 17 of the Brief), it is stated (apparently by the appellant) "you must have a high acidic fruit that employs LOTS of flavor in the cake and in chunk form, this is what differentiates my cakes from all the rest" (see the last sentence of this submission). Significantly, none of the appealed claims are limited to high acidic fruit in chunk form. It follows that the affidavit evidence of nonobviousness, even when viewed in its most favorable light, is considerably more narrow in scope than the here claimed subject matter and accordingly that this evidence is not sufficient to rebut the prima facie case of obviousness established by the Dobbin, Fahlen and Matz references. In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979).

In addition, it is questionable whether the flavorful taste referred to in these affidavits would have been unexpected to one with an ordinary skill in the art. This is

Appeal No. 1997-2014
Application No. 07/959,995

because Fahlen explicitly teaches that replacing fat with a fruit product (i.e., fruit paste) yields an acceptable food product. Although the food product of Fahlen is bread, an artisan with ordinary skill would have expected similar acceptable results in the context of a cake food product as discussed previously.

Under these circumstances, it is our ultimate conclusion that all the evidence of record, on balance, weighs most heavily in favor of an obviousness conclusion. We shall, therefore, sustain the examiner's § 103 rejection of claims 1 through 11 and 13 through 19 as being unpatentable over Dobbin in view of Fahlen and Matz.

The decision of the examiner is affirmed-in-part.

Appeal No. 1997-2014
Application No. 07/959,995

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

AFFIRMED-IN-PART

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

bae

Appeal No. 1997-2014
Application No. 07/959,995

Robert E. Purcell
Reilly & Purcell
1120 Lincoln Street
Suite 1500
Denver, CO 80203