

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HYUNG W. KIM, DHARAM V. VADEHRA, and ELAINE R. WEDRAL

Appeal No. 2001-1002
Application No. 08/709,963

ON BRIEF

Before GARRIS, WARREN, and WALTZ, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-6, 9-17, 19 and 21-23. These are all of the claims remaining in the application.

The subject matter on appeal relates to a browning composition and to a process for treating a food product having a dough crust with the browning composition. The composition comprises an emulsion of a caramel-colored colorant and a thickening agent in a weight ratio of between 5:100 and 100:100 and wherein the amount of the thickening agent is at least 2.5

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percent by weight of the composition. This appealed subject matter is adequately represented by independent claim 17 which reads as follows:

17. A browning composition in the form of an emulsion comprising a thickening agent, and a caramel-colored colorant, wherein the caramel-colored colorant and thickening agent are present at a weight ratio of between 5:100 and 100:100, and the amount of thickening agent is at least 2.5 percent by weight of the composition.

The references relied upon by the examiner as evidence of obviousness are:

Anderson et al. (Anderson)	5,139,800	Aug. 18, 1992
Hsu et al. (Hsu)	5,196,219	Mar. 23, 1993

Owen, Food Chemistry, pp. 630-31 (New York, Marcel Dekker, Inc., 1985) (hereinafter referred to as the Food Chemistry reference).

Claims 4 and 21-23 are rejected under the first paragraph of 35 U.S.C. § 112 as containing subject matter which was not described in the originally filed specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the now claimed invention at the time the application was filed.

All of the claims on appeal are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Hsu and the Food Chemistry reference.

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We refer to the brief and reply brief and to the answer for a thorough exposition of the contrary viewpoints expressed by the appellants and by the examiner concerning the above noted rejections.

OPINION

We will sustain the examiner's Section 112 rejection but not her Section 103 rejection. Our reasons follow.

Concerning the Section 112 rejection, the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

When applied to the factual circumstances of record, this test reveals that the originally filed disclosure of the subject application would not reasonably convey to an artisan that the appellants had possession on the application filing date of the now claimed subject matter defined by claims 4 and 21-23 wherein the thickening agent starch is defined as "non-pregelatinized."

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In support of their opposing view, the appellants present the following argument on pages 11 and 12 of the brief:

Applicants respectfully submit that STALEY MIRA THIK 468, the modified starch used in Examples 1-3 of the application, is a non-pregelatinized starch. Moreover, the submitted literature on STALEY MIRA THIK 468 does indeed indicate it is a non-pregelatinized starch. For example, page 2, second paragraph, of the submitted literature states that "MIRA-THIK starches provide . . . and less syneresis than is found in typical pregelatinized starch." Similarly, on page 3, paragraph 4, it is stated that "MIRA-THIK 468 . . . significantly out performs pregelatinized starches." Based on these statements one of ordinary skill in the art, reading this literature, would readily understand that MIRA-THIK 468 is not a pregelatinized starch, *i.e.*, it is a non-pregelatinized starch.

On page 11 of the answer, the examiner advances two fundamental reasons for regarding this argument as unpersuasive. First, the file record is unclear as to whether the STALEY MIRA THIK 468 starch which was used in specification examples 1-3 possesses the same characteristics as the STALEY MIRA THIK 468 starch which is described in the undated MIRA THIK literature reference supplied by the appellants. Second, the statements in this literature reference which the appellants interpret as connoting a starch that is non-pregelatinized could also be interpreted as connoting a starch that is pre-gelatinized. The

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examiner's reasoning has merit. Moreover, it is significant that the appellants have submitted no rebuttal to this reasoning in their reply brief.

Under these circumstances, we will adopt the examiner's reasoning as our own and concomitantly will sustain her Section 112, first paragraph, rejection of claims 4 and 21-23.

Regarding the Section 103 rejection, the appellants and the examiner agree that all of the appealed claims distinguish over Anderson by requiring the thickening agent to be present in an amount of at least 2.5 percent by weight of the composition. In the browning composition of Anderson, the thickening or viscosifying agent is "present at a concentration of from about 0.01 to about 1 percent by weight, preferably at from about 0.05 to about 0.4 percent by weight" (column 2, lines 41-43).

Regarding this claim feature, the examiner expresses her obviousness conclusion in the following manner on page 5 of the answer:

While it is recognized that Anderson et al[.] do not disclose the amount of thickening agent as claimed and might be teaching away from increasing the amount by disclosing that it is preferable to use less than the broad range disclosed, the claimed amount is not deemed to be patentable in absence of showing of unexpected results. It is well known in the art to add thickening agent to increase or decrease the viscosity of a composition; therefore, it would have been obvious to one skilled in the art to use more or

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less of the thickening agent depending on the viscosity desired. This is a result-effective variable that can readily be determined by one skilled in the art depending on the viscosity wanted for the composition.

According to the appellants, the examiner has provided no evidence in support of her conclusion that the here claimed thickening agent amount or concentration would have been obvious to an artisan with ordinary skill. Indeed, the appellants argue that Anderson's concentration disclosure, especially his disclosure of concentration preference, teaches away from increasing patentee's thickening or viscosifying agent concentration to at least 2.5 percent as here claimed. Further, the appellants argue that evidence of record including the Kim declaration under 37 CFR § 1.132, filed February 11, 2000, militates against the examiner's obviousness conclusion.

As correctly indicated by the appellants, the examiner has provided no evidence that thickening agent amounts or concentrations of the type under consideration were known in prior art browning compositions prior to the appellants' invention. Rather, the examiner's conclusion of obviousness is based solely on the proposition that the concentration of thickening agent in a browning composition "is a result-effective variable that can readily be determined by one skilled in the art

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depending on the viscosity wanted for the composition.” Id. To the examiner’s credit, it is generally considered that it would have been obvious for an artisan with ordinary skill to develop workable or even optimum ranges for parameters or variables which are known in the prior art as being result-effective. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980); In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

However, whether an obviousness conclusion is appropriate depends upon what the prior art discloses with respect to the parameter in question. In re Sebek, 465 F.2d 904, 906-07, 175 USPQ 93, 95 (CCPA 1972). For example, where the prior art discloses a range of values and suggests that workable or optimum values should be sought within that range, a parameter value outside the range might not have been obvious. Id.

Here, the lowest thickening agent amount claimed by the appellants is two and a half times higher than the highest thickening or viscosifying agent concentration disclosed by Anderson. Moreover, patentee’s preferred (i.e., optimum) concentrations are far below his highest concentration and thus do indeed teach away from the here claimed range as urged by the appellants. These circumstances support a determination that the examiner’s rationale in concluding obviousness is deficient.

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This determination is reinforced by the Kim declaration since it provides testimonial evidence by one with skill in the art (i.e., the declarant Kim who is one of the inventors of the here claimed subject matter) in relation to what the concentration disclosure of Anderson would have suggested to an artisan with ordinary skill.

In light of the foregoing, it is our ultimate determination that the record before us on this appeal does not support the examiner's conclusion of obviousness regarding the thickening agent amounts required by the appealed claims. Therefore, we will not sustain the examiner's Section 103 rejection of all appealed claims as being unpatentable over Anderson in view of Hsu and the Food Chemistry reference.

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

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

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES F. WARREN)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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BRG:hh

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