

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte STEPHAN PODUBRIN, ACHIM ANSMANN,  
ROLF KAWA and RICHARD RIDINGER

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Appeal No. 2002-0523  
Application No. 09/117,918

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ON BRIEF

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Before WINTERS, SCHEINER and MILLS, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 7-10, 13, 16-19, 22, 25 and 26, which are all of the claims pending in this application.

Claim 7 is illustrative of the claims on appeal and reads as follows:

7. A process for making di-/triglyceride mixtures comprising:  
(a) providing a vegetable oil having an iodine value of from 0.5 to 50; and  
(b) partially transesterifying the vegetable oil by reacting it with a transesterifying component selected from the group consisting of a mixture of glycerol and a fatty acid corresponding to formula I:

$R^1COOH$  (I)

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wherein R<sup>1</sup>CO is an acyl group having from 6 to 10 carbon atoms, a mixture of glycerol and a methyl ester of the fatty acid of formula I, and triglycerides derived from the fatty acid of formula I in a molar ratio of vegetable oil to transesterifying component of 1:(2.5 to 3.5) so that the di-/triglyceride mixture has a ratio of diglycerides to triglycerides of from 1:3 to 1:6, a monoglyceride content of less than 5% by weight, and a cloud point below +6°C.

The prior art references relied upon by the examiner are:

Menz	3,658,555	Apr. 25, 1972
Barsky	GB 820,270	Sept. 16, 1959

#### Grounds of Rejection

Claims 7-10, 13, 16-19, 22, 25 and 26 stand rejected under 35 U.S.C. § 103(a) as obvious over Barsky in view of Menz.

We reverse this rejection.

#### DISCUSSION

In reaching our decision in this appeal, we have given consideration to the appellants' specification and claims, to the applied references, and to the respective positions articulated by the appellants and the examiner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the noted rejections, we make reference to the examiner's Answer for the examiner's reasoning in support of the rejection, and to the appellants' Brief for the appellants' arguments thereagainst. As a consequence of our review, we make the determinations which follow.

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35 U.S.C. § 103

Claims 7-10, 13, 16-19, 22, 25 and 26 stand rejected under 35 U.S.C. § 103(a) as obvious over Barsky in view of Menz.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). It is well-established that the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The examiner relies on Barsky for the disclosure of “a process of producing a modified glyceride oil by reacting a vegetable oil with a triglyceride of one or more fatty acids having 6-12 carbon atoms...” Answer, page 3. The examiner concludes that the “composition that is suitable for medicinals and foodstuffs would also be suitable for cosmetics.” Id. According to the examiner, Barsky does not teach “the ratio of diglycerides to triglycerides, the amount of monoglycerides, the cloud point, the molar ratio of vegetable oil, fatty acid and glycerol combination or a cosmetic composition.” Id.

In turn, the examiner relies on Menz for the disclosure that it is desirable to have a mixture of triglycerides and diglycerides for use in foodstuffs, cosmetics and pharmaceuticals that contain substantially no monoglycerides. Answer, page 4.

According to the examiner, “[i]t is within the skill of the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect.” Id. “Therefore, the amounts of components in the product and molar ratio of reactants are not considered critical to the invention absent evidence of unexpected results.” Id. The examiner also argues that “setting forth an intended use for, or an inherent property in, an otherwise old composition do not differentiate the claimed composition from those of the prior art.” Id.

The examiner concludes (Answer, page 4):

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to prepare a glyceride mixture using the esterification process taught by Barsky comprising a mixture of diglycerides and triglycerides with substantially no monoglycerides as taught by Menz with a reasonable expectation of obtaining a modified glyceride oil with a wide range of fusibility that is not brittle.

Appellants respond, arguing that “neither reference teaches nor suggests the combination of a vegetable oil with any of the three claimed transesterifying components, including the triglyceride itself, in the claimed molar ratio, which is clearly a claim limitation of the present invention, a combination of these references fails to render the claimed invention prima facie obvious.” Brief, page 3. The appellants also argue the examiner has failed to present basis in fact/or technical reasoning to support a theory of inherency. Brief, page 4.

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We agree with appellants, that the examiner has failed to present sufficient evidence to support a prima facie case of obviousness. Generally, "the discovery of an optimum value of a variable in a known process is normally obvious." In re Antonie, 559 F.2d 618, 619, 195 USPQ 6, 8 (CCPA 1977). In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) (citing In re Antonie with approval). The key to this rule is that the burden remains with the examiner to show that variable in question is "known to be result effective." In re Antonie 559 F.2d at 621, 195 USPQ at 9. Exceptions to this rule have been found in cases where the results of optimizing a variable, which was known to be result effective, were unexpectedly good. In re Waymouth, 499 F.2d 1273, 1276, 182 USPQ 290, 293 (CCPA 1974). Another exception is the case in which the parameter optimized was not recognized to be a result-effective variable. See In re Antonie, 559 F.2d 618, 619, 195 USPQ 6, 8 (CCPA 1977).

The examiner has argued that "it is within the skill of the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect." The examiner, however, has failed to provide evidence that both the optimal parameters or ratios claimed, and how to achieve the desired cosmetic or pharmaceutical beneficial effect were known in the art, or were known to be result effective variables. For example, the examiner has not indicated how the optimal parameters for preparing an oil which can be used for margarine or an edible food relate to parameters necessary to obtain desired cosmetic or pharmaceutical benefit.

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See claims 25 and 26. In our view, the examiner has pointed to no evidence in the prior art to support the position that the molar ratio of vegetable oil to transesterifying component of 1:(2.5 to 3.5) and the di-/triglyceride mixture of a ratio of diglycerides to triglycerides of from 1:3 to 1:6 are result effective variables. While we acknowledge that Menz, column 3, lines 1-8 does describe a range of amounts of diglyceride to triglyceride, we do not find that the examiner's analysis and evidence fully comes to grips with establishing either the molar ratio of vegetable oil to transesterifying component of 1:(2.5 to 3.5) and the di-/triglyceride mixture of a ratio of diglycerides to triglycerides of from 1:3 to 1:6, or identifying why one of ordinary skill in the art would find it obvious to manipulate the ranges of components described in Menz (relating to a food composition) to obtain desired cosmetic or pharmaceutical properties. Therefore, the examiner's conclusory statement that it is within the skill of the art to select optimal parameters, such as amounts of ingredients, improperly shifts the burden to appellants to show the amounts of components in the claimed process and ultimate product such as the molar ratio of reactants are unexpected and considered critical to the invention.

In addition, patent examiners, in relying on what they assert to be general knowledge in the art to negate patentability on the ground of obviousness, must articulate that knowledge and place it of record, since examiners are presumed to act from the viewpoint of a person of ordinary skill in the art in finding relevant facts, assessing the significance of prior art, and making the ultimate determination of the obviousness issue. Failure to do so is not consistent with either effective administrative

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procedure or effective judicial review, examiners cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which they rely. See In re Lee, 277 F.3d 1338, 1343-1344, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002). Thus, it is improper to rely on the “common knowledge and common sense” of a person of ordinary skill in art to find an invention obvious over a combination of prior art references, since the factual question of motivation to select and combine references is material to patentability, and cannot be resolved on subjective belief and unknown authority. In re Lee, 277 F.3d 1338, 1343-1344, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002). In other words, the examiner must provide evidence that the claimed parameters or variables are known in the prior art to be result effective variables.

In view of the above, the rejection of the claims for obviousness over Barsky in view of Menz is reversed.

#### CONCLUSION

We reverse the rejection of claims 7-10, 13, 16-19, 22, 25 and 26 under 35 U.S.C. § 103(a) as obvious over Barsky in view of Menz.

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

REVERSED

SHERMAN D. WINTERS  
Administrative Patent Judge

TONI R. SCHEINER  
Administrative Patent Judge

DEMETRA J. MILLS  
Administrative Patent Judge

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