

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY D. SEARS

Appeal No. 94-4461
Application 07/996,797¹

ON BRIEF

Before WINTERS, CAROFF, and WILLIAM F. SMITH, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

¹ Application for patent filed December 24, 1992. According to appellant, this application is a continuation-in-part of Application 07/771,402, filed October 2, 1991, now abandoned; which is a continuation-in-part of Application 07/539,385, filed June 18, 1990, now Patent No. 5,059,622, issued October 22, 1991; which is a division of Application 07/400,288, filed August 29, 1989, now abandoned; which is a continuation-in-part of Application 07/251,139, filed September 28, 1988, now abandoned.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 18-33, all the claims in the application.

Claims 18, 19, 24 and 28 are illustrative of the subject matter on appeal and read as follows:

18. A method for the reduction of hyperinsulinemia in a person by the control of insulin and glucagon levels, which method comprises:

a) providing for the oral introduction into the person of a therapeutic, effective amount of a solid food product having a total calorie value, which solid food product comprises:

i) a protein source of high biological value having about 20 to 40% of total calorie value;

ii) a carbohydrate source composed primarily of a low glycemic index having about 30 to 50% of total calorie value;

iii) a fat source having about 20 to 40% of total calorie value wherein the fat source comprises a combination of activated Omega 6 essential fatty acids and activated Omega 3 essential fatty acids in a ratio of Omega 3 acids to Omega 6 acids of greater than 2:1; and

iv) the protein source to carbohydrate source ratio greater than 0.4:1, but less than 1:1, to control the insulin and glucagon levels of the person.

19. The method of claim 18 which includes incorporating all or a portion of the fat source in a separate form for the introduction with the solid food product.

24. The method of claim 18 which includes providing for the oral ingestion by the person of the fat source in an emulsion, microencapsulated or capsule form.

28. A solid food nutritional composition adapted for oral administration to a person to reduce hyperinsulinemia, which composition comprises:

a) a protein source of high biological value having about 20 to 40% of total calorie value;

b) a carbohydrate source composed primarily of a low glycemic index having about 30 to 50% of total calorie value;

c) a fat source having about 20 to 40% of total calorie value wherein the fat source comprises a combination of activated Omega 3 essential fatty acids and activated Omega 6 essential fatty acids in a ratio of Omega 3 acids to Omega 6 acids of greater than 2:1; and

d) the protein source to carbohydrate source greater than 0.4:1, but less than 1:1, to control the insulin and glucagon levels of the person.

The references relied upon by the examiner are:

Stewart et al. (Stewart)	4,826,877	May 2, 1989
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Merck Manual, 14th Edition, pages 388-89 (1982).

Claims 18-33 stand rejected under 35 U.S.C. § 103 as unpatentable over Stewart in view of the Merck Manual. We reverse. In addition, we raise other issues for the examiner to consider upon return of the application.

DISCUSSION

The claims on appeal require the presence or use of a solid food product which comprises a protein source, a carbohydrate source, and a fat source. Each of these sources are defined in terms of the percent of the total calorie value of the solid food

product as well as in terms of ratios of either protein source to carbohydrate source or a ratio of Omega 3 acids to Omega 6 acids.

Stewart describes a pharmaceutical and dietetic composition which comprises a mixture of Omega 3 acids and Omega 6 acids. At best, Stewart describes at column 5, lines 46-54, that the fatty acid composition of that reference can be incorporated in “a dietary margarine or other foodstuffs.” There is no explicit disclosure in Stewart that the fatty acid composition of that reference should be incorporated in foodstuffs having a protein and carbohydrate content. Thus, Stewart would not have suggested to one of ordinary skill in the art to prepare a foodstuff as required by the claims on appeal.

The examiner attempts to rectify this deficiency of Stewart by repeatedly chanting the mantra of “obvious to the skilled artisan.” See, e.g., pages 4-5 of the Examiner’s Answer. However, it is well settled that a conclusion of obviousness must be based upon facts, not generalities. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968); In re Freed, 425 F.2d 785, 788, 165 USPQ 570, 572 (CCPA 1970).

The examiner’s rejection is reversed.

OTHER ISSUES

1. Proper dependent claims

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Claim 18 requires a solid food product that contains a protein source, a carbohydrate source, and a fat source. Claim 19 which depends from claim 18 requires that all or a portion of the fat source be provided in a separate form. As seen from claim 24, that separate form could be an emulsion, microcapsule, or capsule.

Claims 19 and 24 appear to be improper dependent claims since they do not serve to further limit independent claim 18. Rather, they require that an element of claim 18 be eliminated. This is improper.

Upon return of the application, appellant and the examiner should review all the claims pending and make sure they are in proper form.

2. Effective filing date of claims on appeal

This application is stated to be a continuation-in-part of Application 07/771,402 filed October 2, 1991. That application is stated to be a continuation-in-part of Application 07/539,385, filed June 18, 1990, issued as Patent No. 5,059,622 on October 22, 1991 ('622 Patent).

It does not appear that the examiner has determined whether any of the claims on appeal are entitled to the effective filing date of the immediate parent application 07/771,402. If any claim pending in this application is not entitled to the benefit of the earlier filing date under 35 U.S.C. § 120, the '622 patent would be available as prior art

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under 35 U.S.C. § 102(b) since it issued more than one year prior to the filing date of this application, December 24, 1992.

Upon return of the application, the examiner should determine the effective filing date of each claim pending in this application. If any claim pending in the application is not entitled to the benefit of the earlier filing date of parent application 07/771,402, the examiner should determine whether that claim is patentable over the prior art, including the '622 patent.

3. Proper search

As seen from the claims on appeal, the subject matter under review pertains to solid foodstuffs. From the "SEARCHED" section of the administrative file, it does not appear that the examiner has searched class 426 which is directed to foodstuffs. As set forth above, one embodiment of the present invention would be to administer a solid foodstuff which comprises only protein and carbohydrates in a specified ratio in conjunction with a separate formulation containing the required fatty acids.

As a second matter, it does not appear from the "SEARCH NOTES" portion of the administrative file jacket that the examiner has searched the available electronic data bases. Given the technical subject matter under review in this application, the examiner should consider whether a complete search should include accessing the electronic data bases.

4. Claim language

Upon return of the application, the examiner should clarify the following claim language.

The claims require “a carbohydrate source composed primarily of a low glycemic index.” According to the specification at page 11, it is the carbohydrate which has a glycemic index, rather than the carbohydrate being “composed” of a glycemic index. Should the claims require “a carbohydrate source having a low glycemic index?”

The claims also require that the protein have a “high biological value.” It is not clear where the specification of this application defines this phrase.

The decision of the examiner is reversed.

REVERSED

SHERMAN D. WINTERS)
Administrative Patent Judge)
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MARC L. CAROFF) BOARD OF PATENT

