

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT M. COVINGTON, JR. and ERNIE H. UNGER

Appeal No. 95-2823
Application No. 08/078,383¹

ON BRIEF

Before WINTERS, METZ and GARRIS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 7 and 10, which are all of the claims remaining in the application. The examiner added a new ground of rejection of claim 10 under 35 U.S.C. § 112, fourth paragraph (Answer,

¹ Application for patent filed June 17, 1993.

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page 5), giving appellants two months from the mailing date of the Examiner's Answer to reply to the new ground (Answer, page 6). Appellants did not reply to the new ground of rejection within that period and, accordingly, the appeal with respect to claim 10 is dismissed. This leaves claims 1 through 7 for our consideration.

The claimed invention relates to a shortening comprising a partially hydrogenated plastic canola having three essential properties: (1) a maximum saturated fatty acid content of about 11.7%; (2) a maximum polyunsaturated fatty acid content ($C_{18:2}+C_{18:3}$) of about 3.4%; and (3) a maximum iodine value of about 83.6. As stated in the Appeal Brief, paragraph bridging pages 5 and 6, appellants are able to achieve a shortening having the claimed properties because of their starting oil IMC 01. This oil is derived from a particular Brassica napus plant line, a Spring canola variety, developed by mutagenesis. See the instant specification, page 3, last paragraph, for a further description of appellants' starting oil. Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A shortening comprising a partially hydrogenated plastic canola having a maximum saturated fatty acid content

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of about 11.7%, a maximum polyunsaturated fatty acid content ($C_{18:2}+C_{18:3}$) of about 3.4%, and a maximum iodine value of about 83.6.

The references relied on by the examiner are:

J. D. Bansal et al. (Bansal), "Effect of Hydrogenation on the Chemical Composition of Canola Oil," 47 Journal of Food Science 1338-44 (1982)

Unichema International (Unichema), Hydrogenation of Canola Oil, Pricat 9920 (1992)

The issue presented for review is whether the examiner erred in rejecting claims 1 through 7 under 35 U.S.C. § 103 as unpatentable over "Unichema alone or in view of Bansal" (Answer, page 3). For the reasons set forth below, we reverse the examiner's prior art rejections.

DISCUSSION

Independent claim 1 requires that the shortening have a maximum polyunsaturated fatty acid content ($C_{18:2}+C_{18:3}$) of about 3.4%. Acknowledging that Unichema does not disclose "the particular extent of unsaturation" recited in claim 1, nevertheless, the examiner relies on Bansal, Figure 7, to reach that feature. See the Examiner's Answer, page 4, lines 7 through 12; and page 5, section (11) entitled "Response to argument," lines 4 through 9 thereunder. This being the case, we summarily reverse the rejection of claims 1 through 7 under

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35 U.S.C. § 103 as unpatentable over Unichema alone. The Examiner's Answer is internally inconsistent in (1) stating a prior art rejection based on Unichema alone; (2) acknowledging that Unichema falls short with respect to an essential claim limitation relating to the polyunsaturated fatty acid content; and (3) relying on Figure 7 of Bansal to cure the noted deficiency of Unichema. Manifestly, the rejection of claims 1 through 7 under 35 U.S.C. § 103 over Unichema alone is untenable. This rejection is reversed.

Considering now the rejection of claims 1 through 7 under 35 U.S.C. § 103 over Unichema "in view of" Bansal, we have carefully reviewed these references in their entireties including Bansal, Figure 7. We have also reviewed the Examiner's Answer and the explanation of the rejection therein. In our judgment, the examiner does not establish how a person having ordinary skill in the art, armed with the disclosures of Unichema and Bansal, would have arrived at the specifically defined shortening in independent claim 1 comprising a partially hydrogenated plastic canola having (1) a maximum saturated fatty acid content of about 11.7%; (2) a

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maximum polyunsaturated fatty acid content ($C_{18:2}+C_{18:3}$) of about 3.4%; and (3) a maximum iodine value of about 83.6.

We emphasize that, during hydrogenation of a canola oil, the saturated fatty acid content increases, the polyunsaturated fatty acid content decreases, and the iodine value decreases. Unichema and Bansal disclose hydrogenating canola oils. Each reference discloses numerous hydrogenation runs, and each reports the saturated fatty acid content, the polyunsaturated fatty acid content, and the iodine value in products resulting from those runs. The examiner does not, however, point to any portion or portions of Unichema or Bansal, including Figure 7 of Bansal, which would have led a person having ordinary skill in the art to the claimed shortening having the specifically recited combination of saturated fatty acid content, polyunsaturated fatty acid content and iodine value. Again, during hydrogenation, saturated fatty acid content increases as polyunsaturated fatty acid content decreases and iodine value decreases. On this record, appellants and appellants alone describe the preparation of a shortening where the saturated fatty acid content, the polyunsaturated fatty acid content, and the

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iodine value are interrelated according to the specific terms of claim 1. Appellants are able to achieve a shortening having the claimed properties because of their starting oil IMC 01. See the Appeal Brief, paragraph bridging pages 5 and 6 and see the instant specification, page 3, last paragraph.

The references relied on by the examiner contain copious disclosure relating to partially hydrogenated canola oils. The examiner, however, has not established that those references would have led a person having ordinary skill in the art to the shortening products defined in independent claim 1. The rejection of claims 1 through 7 under 35 U.S.C. § 103 as unpatentable over Unichema "in view of" Bansal is reversed.

CONCLUSION

For the reasons set forth in the body of this opinion, we do not sustain the rejection of claims 1 through 7 under 35 U.S.C. § 103 as unpatentable over Unichema alone, or Unichema "in view of" Bansal. Accordingly, the examiner's decision rejecting those claims is reversed. The appeal with respect to claim 10 is dismissed.

REVERSED

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Administrative Patent Judge)	
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ANDREW H. METZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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