

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CHEL W. LEW

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Appeal No. 1996-0249  
Application No. 08/076,709<sup>1</sup>

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ON BRIEF

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Before PAK, WARREN, and KRATZ, Administrative Patent Judges.  
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-13 and 20-23. Claims 14-19 and 24-26, which are all of the remaining pending claims in this application,

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<sup>1</sup> Application for patent filed June 15, 1993. According to appellant, this application is a continuation of Application No. 07/534,496, filed June 7, 1990, now abandoned; which is a continuation-in-part of Application No. 07/201,637, filed June 2, 1988, now abandoned.

have been indicated as allowable by the examiner (answer, page 1).

#### BACKGROUND

The appellant's invention relates to an edible encapsulated food product comprising (1) a core of a food enhancing additive and water insoluble material such as a fat that melts to release the additive in water at temperatures above about 90°F and (2) an outer shell including a material such as hydroxypropylcellulose which has a gelation temperature between about 90-160°F. An understanding of the invention can be derived from a reading of exemplary claims 1 and 12, which are reproduced below.

1. An edible microcapsule comprising an encapsulated food enhancing additive which comprises:

a) a core comprising: (i) at least one food enhancing additive; and (ii) a meltable core material that is insoluble in water but which melts and releases said at least one additive in water at temperatures above about 90°F; and

b) an outer shell completely surrounding said core, said outer shell comprising a shell forming material that has a thermal gelation temperature within the range from about 90°F to about 160°F.

12. A liquid-based food product comprising: (a) a comestible comprising a soup, stew, or sauce; and (b) edible microcapsules comprising an encapsulated food enhancing additive which comprises:

a) a core comprising: (i) at least one food enhancing additive selected from the group consisting of volatile and nonvolatile oils that add flavor and/or color, spices, and vitamins; and (ii) a meltable core material that is insoluble in water but which melts and releases said at least one additive in water at temperatures above about 90°F; and

b) an outer shell completely surrounding said core, said outer shell comprising a shell forming material selected from the group consisting of methylcellulose, hydroxypropylcellulose, hydroxypropylmethylcellulose, and mixtures thereof wherein said shell forming material has a thermal gelation temperature within the range from about 90°F to about 160°F.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Johnson et al. (Johnson)                      3,985,913                      Oct. 12,  
1976

A food technologist's guide to Methocel Premium Food Gums, Dow Chemical Company (the Dow brochure), 12/1989.<sup>2</sup>

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<sup>2</sup> Appellant does not dispute the availability of the relied upon teachings of this reference as prior art for the purposes of this appeal.

Claims 1-13 and 20-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of the Dow brochure.

According to appellant (brief, pages 2 and 3), two identified groups of claims<sup>3</sup> are urged to be separately patentable with an indication by appellant that claims 1-11 stand or fall together and claims 12, 13, 22, and 23 stand or fall together. We note that claims 20 and 21 have not been identified as belonging to either of these groups and no separate arguments specifically directed to claims 20 and 21 have been presented in the brief with a reasonable degree of specificity so as to warrant the separate consideration thereof with respect to the § 103 rejection. Accordingly, we consider the patentability of claims 20 and 21 to rise or fall with the patentability of claim 1 from which they ultimately depend. See 37 CFR § 1.192 (c)(7)(1995); *In re Nielson*, 816 F.2d 1567, 1570, 2 USPQ2d 1525, 1526-1527 (Fed. Cir. 1987). Accordingly, we have selected claim 1 as the representative claim from the grouping

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<sup>3</sup> The claims identified by appellant (brief, pages 2 and 3) as belonging to groups (b) and (d) have been indicated as allowable by the examiner as indicated above.

of claims 1-11, 20, and 21 and claim 12 as the representative claim from the grouping of claims 12, 13, 22, and 23 in considering the present appeal.

OPINION

We have carefully reviewed each of appellant's arguments for patentability. However, we concur with the examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 in view of the applied prior art. Accordingly, we will sustain the examiner's rejection.

We begin with a review of the applied prior art in relation to representative claim 1. Johnson discloses an encapsulated food additive including: (1) a core comprising a condiment (the food additive) that may be blended with a lipoidal material such as an edible fat that is normally solid at 95°F (column 2, line 49 through column 3, line 53, and the Example); and (2) a coating (outer shell) that comprises a material such as an edible resin, gum, wax, proteinaceous material, and/or sacchariferous material (column 3, line 54 through column 4, line 32). Johnson (column 6, lines 15-35) also teaches that:

The condiment-laden core is afforded a measure of: protection (by the dry coating thereon) against deterioration caused by exposure to the atmosphere; control for release of the condiment into a foodstuff or the like in which it is compounded, the surface coating dissolving to release the condiment at a desired, rather than at an accidental juncture; prevention of undesired interaction between condiment and its surrounding materials in a food, drug, or cosmetic; and prevention of the condiment coloring and/or flavoring ingredient to bleach, run, dilute or evaporate....

The amount of such protection is dependent upon the specific-coating material chosen, the coating thickness, and the completeness of the coating on the condiment core.

In light of the above and a fair reading of the full disclosure of Johnson, it is our view that Johnson prefers the use of a meltable lipoidal material in the core (columns 3 and 4, and the Example at columns 7 and 8) and teaches selecting the coating (shell) material from among those listed at columns 3 and 4, including the edible resins such as methylcellulose and hydroxypropylmethylcellulose, depending on the surrounding environment and the amount of protection desired to prevent interaction with surrounding food materials, dilution and evaporation of the coating. While Johnson illustrates the use of a shellac resin as the coating in the sole example

presented, we agree with the examiner that it would have been obvious to one of ordinary skill in the art to use the other disclosed resins of Johnson such as methylcellulose (column 4, lines 25-32), depending on the degree or type of protection desired. Methylcellulose would have been reasonably expected to have a gelation temperature as called for in the appealed claims as further explained by the Dow brochure (final rejection, page 3).

In view of the above, we find ourselves in agreement with the examiner that the applied prior art would have rendered the appealed claims *prima facie* obvious within the meaning of 35 U.S.C. § 103. Moreover, appellant's arguments in the brief are not convincing of any reversible error on the examiner's part in reaching an obviousness conclusion.

In particular, appellant urges that the teachings of Johnson would not lead one skilled in the art to the "claimed core and shell combination" (brief, page 4) and argues that the applied prior art is not concerned with the problems faced by the inventor regarding retort protection (brief, page 5).

We do not find these arguments convincing for the reasons set forth above. In our view, Johnson furnishes ample

motivation for one skilled in the art to follow the specific teachings of the patent in selecting a shell material including methylcellulose depending on the protection desired and surrounding foodstuffs. Moreover, we find that the methylcellulose would have been expected to possess a gelation temperature as claimed at herein as one of its properties as further explained by the teachings of the Dow brochure.

Given the above, we agree with the examiner that it would have been *prima facie* obvious to one of ordinary skill in the art to utilize a methylcellulose coating as the shell material for an edible core containing a meltable lipoidal material as claimed with a reasonable expectation of imparting the desired protective effect. One of ordinary skill in the art would have had a reasonable expectation that use of a coating of methylcellulose having the claimed gelation temperature would impart evaporation as well as retort protection. In any event, the motivation to use methylcellulose as a coating material need not be identical to that of appellant to establish a *prima facie* case of obviousness. See *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996). We also note that the conclusion of obviousness under 35 U.S.C. § 103

does not require absolute certainty, but only a reasonable expectation of success. *Merck & Co. Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 809, 10 USPQ2d 1843, 1847 (Fed. Cir. 1989); *In re O'Farrell*, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

With regard to the second grouping of claims, including representative claim 12, appellant further argues that the applied prior art does not suggest that the claimed product "will protect the encapsulated additive through commercial sterilization and storage yet release the additives upon reheating..." (brief, page 4). At the outset, we note that appellant has not furnished any convincing argument showing a patentable distinction between a sauce as called for in claim 12 and a topping as disclosed by Johnson (brief, page 3). Moreover, the mere fact that appellant urges a potential new advantage in using the encapsulated additive in commercially sterilized and stored food products does not alter the patentability of the product claims on appeal herein. In this regard, we note that appellant's arguments in the brief do not take the place of evidence in the record. See *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

In sum, we find that the examiner has properly utilized the teachings and suggestions within the prior art both as to what the references teach and also as to what they fairly would have suggested to one of ordinary skill in the art. *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979). Accordingly, we conclude that the examiner has met her burden of establishing that the claimed subject matter would have been *prima facie* obvious to one of ordinary skill in the art at the time the application was filed. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). Upon reconsideration in light of appellant's arguments, we find that the evidence of obviousness outweighs any arguments/evidence alleging nonobviousness that has been presented.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1-13 and 20-23 under 35 U.S.C. § 103 as being unpatentable over Johnson in view of the Dow brochure is affirmed.

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

AFFIRMED

CHUNG K. PAK	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES F. WARREN	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
PETER F. KRATZ	)	
Administrative Patent Judge	)	

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Appeal No. 1996-0249  
Application No. 08/076,709

Page 12

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APPEAL NO. 1996-0249 - JUDGE KRATZ  
APPLICATION NO. 08/076,709

APJ KRATZ

APJ PAK

APJ WARREN

DECISION: **AFFIRMED**

Prepared By: TINA

**DRAFT TYPED:** 14 Jun 00

**FINAL TYPED:**