

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN F. GILGEN

Appeal No. 1996-0876
Application 08/123,144¹

ON BRIEF

Before CAROFF, HANLON and ELLIS, ***Administrative Patent Judges***.

ELLIS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's second rejection² of claims 1 through 24, all the claims remaining in the application.

¹Application for patent filed September 17, 1993.

² We have jurisdiction to consider this appeal since the appellant's claims have been "twice rejected" within the context of 35 U.S.C. § 134, even though the rejection appealed from was not designated by the examiner as being final.

Claims 1, 17 and 19³ are illustrative of the subject matter on appeal and read as follows:

1. A method for treating a food product for increased shelf life, said method comprising the steps of:

providing a predetermined quantity of a food product for treatment;

mixing an anti-oxidant substance with a heated liquid to form a treatment solution;

soaking the food product in said treatment solution until the food product has absorbed a predetermined amount of said treatment solution;

removing the food product from said treatment solution;

providing a predetermined amount of a coating material;

placing the food product and said coating material in a pressure vessel;

reducing the pressure inside said pressure vessel to a predetermined pressure value which is less than one atmosphere;

mixing the food product and said coating mixture at said reduced pressure value until the food product has retained a predetermined amount of said coating material on a surface thereof;

increasing the pressure in said pressure vessel to a pressure value of approximately one atmosphere;

injecting a predetermined quantity of nitrogen gas into said pressure vessel substantially to replace the air therein; and

removing the coated food product from said pressure vessel.

17. A method of treating pecans for increased shelf life comprising the steps of:

³ Claim 19 is representative of claims 18 through 24 which relate to nut products rather than a process.

providing a predetermined amount of pecans;

mixing a predetermined amount of an anti-oxidant substance substance [sic] and a predetermined amount of edible oil to form a treatment solution;

placing said pecans and said treatment solution into a pressure vessel;

reducing the pressure in said pressure vessel to a predetermined pressure value that is less than one atmosphere;

mixing said pecans and said treatment solution at said reduced pressure value;

increasing the pressure inside the pressure vessel to a pressure value of approximately one atmosphere;

removing said treated pecans from said pressure vessel.

19. An edible nut product according to claim 11 wherein the step of providing a predetermined quantity of edible nuts includes providing a predetermined quantity of pecans.

The references relied upon by the examiner are:⁴

Mamahit	4,206,246	June 3, 1980
Hoover	4,647,463	Mar. 3, 1987
Kotani et al. (Kotani)	5,208,058	May 4, 1993
Zook et al. (Zook)	5,240,726	Aug. 31, 1993

The claims stand rejected as follows:⁵

⁴ We point out that in the Answer, the examiner does not list any prior art as being relied upon for the rejection of the claims. Answer, p. 2. We find this to be clear error on the part of the examiner. However, in order to advance prosecution of the case, we have nevertheless considered the references cited in the grounds of the rejection since (i) they are of record in the Office action (Paper No. 8) of January 4, 1995, and (ii) we are remanding the application to the examiner for other reasons. See Section II of this Decision, *infra*.

⁵ The examiner's statements of the rejections are set forth on p. 3 of the Answer. However, the grounds for the rejections are set forth in Paper No. 8.

I. Claims 1 through 6, 8 through 14, 16 through 22 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hoover, Mamahit, Zook and Kotani.

II. Claims 7, 15 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hoover, Mamahit, Zook and Kotani in view of Hawley.

We **reverse** both Rejections I and II, and **remand** the application to the examiner for further consideration of the patentability of claims 17 through 24. Our reasons follow.

I.

The appellant's invention is directed to a method of treating food products which is said to increase their usable shelf life. Specification, p. 1. In particular, the invention involves "a method for treating nuts in a vacuum to remove substantially all the oxygen therefrom while leaving the nut meat in a flavorful, edible condition. ... The treated nuts may then be stored, roasted, baked, or otherwise processed for packaging and shipping." *Id.*

The examiner has premised his initial conclusion of obviousness on the teachings of (i) Hoover, a patent which is said to disclose coating nuts with a warm aqueous solution comprising oil and antioxidants; (ii) Mamahit, a patent which is said to disclose the coating of food material by soaking; (iii) Zook, a patent which is said to disclose that "it is well known to spray nuts and therefore coat by mixing same while under vacuum followed by a return to atmospheric pressure"; and (iv) Kotani, a patent which is said to disclose "treating nuts with an inert gas in a pressure vessel to retard oxidation." **Paper No. 8**, pp. 2-4. The examiner concludes that it would have been obvious to one having ordinary skill in the art

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“... to have coated said nuts via soaking same as an art recognized alternative manner for coating same [*Id.*, p. 3]... to have employed ... [a] vacuum when mixing said nuts and coating material to provide more extensive coating of said nuts [*Id.*] ... to have employed an oxygen-free or low oxygen environment during processing of foods (e.g. mixing nuts with coating) to prevent oxidation and, therefore, increase the shelf-life of same” [*Id.*, p. 4].

We find the examiner’s arguments unpersuasive.

It is well established that the examiner has the initial burden under § 103 to establish a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). It is the examiner’s responsibility to show that some objective teaching or suggestion in the applied prior art, or knowledge generally available [in the art] would have led one of ordinary skill in the art to combine the references to arrive at the claimed invention. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 745 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). Here, we find that the examiner has failed to provide any reasons based on the applied prior art, or otherwise, as to why it would have been obvious to one of ordinary skill in the art to subject an antioxidant-coated food product to vacuum treatment in a pressure vessel, to return the pressure in said pressure vessel to one atmosphere, and to inject nitrogen gas into said pressure vessel to replace the air. The examiner urges that such suggestions come from the Kotani disclosure that (i) “the prior art treatment of foods, in general, with

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nitrogen as well as carbon dioxide as a means of retarding or preventing oxidation of said foods,” and (ii) the use of nitrogen described in Example 4 of the patent provides some prevention of oxidation. Paper No. 8, p. 4.

As to the prior art methods to which the examiner alludes, it is not clear to us as to which portion of the patent he is relying on. We point out that it is not the responsibility of this tribunal to examine the case in the first instance and to formulate a rejection based on the references provided. Moreover, even if we assume, *arguendo*, which we do not, that the examiner is referring to the teachings of Kotani [col. 1, lines 14-18] that

General methods to retard or prevent oxidation of foods are an addition of antioxidant *or* a substitution of air in pouches with inactive gases, for instance nitrogen or carbon dioxide *or* an addition of oxygen absorbing agents into pouches. As for nuts, an addition of antioxidants is not so effective. ... [emphases added]

we do not find that these teachings would have suggested the claimed method to persons having ordinary skill in this art. That is, the quoted passage describes the use of nitrogen packets as an alternative to an antioxidant, and makes no mention of prior treatment with a vacuum. Absent a fact-based explanation from the examiner, we do not find that from these teachings of Kotani it would have been obvious to one of ordinary skill in the art to treat a food product (1) *with an antioxidant* (since Kotani expressly states that antioxidants are not so effective), *and* (2) *with a vacuum*, followed by an increase in pressure to one atmosphere *and* replacement of the air in the pressure chamber *with nitrogen*.

With respect to the examiner’s second point, we acknowledge that Kotani discloses

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a method of treating nuts with compressed carbon dioxide so as to make them oxidation resistant. Kotani, Example 4. However, we point out that the nuts treated with compressed nitrogen gas showed **no effect** on oxidation resistance. See Example 4 and the results in col. 5, lines 1-11. Thus, it is not clear to us, and no reasons have been provided by the examiner, as to why these teachings would have rendered the claimed method obvious to one of ordinary skill in the art.

On this record, the only place where we find a suggestion to treat a food product with an antioxidant under vacuum, to increase the pressure to one atmosphere and to replace the air in the pressure chamber with nitrogen, is in the appellant's specification. Thus, we find that the examiner has relied on impermissible hindsight in making his determination of obviousness. ***In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps"); ***Interconnect Planning Corp. v. Feil***, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); ***W.L. Gore & Assocs. v. Garlock, Inc.***, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher").

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Turning to the rejection of claims 7, 15, and 23 in further view of Hawley, since we do not find that the examiner has met his initial burden of establishing a *prima facie* case of obviousness of the basic method of treating a food product over the primary and secondary references applied in Rejection I, it reasonably follows that we do not find that a dictionary which merely defines tocopherol, overcomes the deficiencies of the primary rejection.

Accordingly, Rejections I and II are reversed.

II.

Upon review of the record before us, we have determined that some of the issues, as presented, are not ripe for appeal. Accordingly, we remand the application to the examiner for several reasons.

First, we direct attention to the examiner's rejection of claim 17. In view of its brevity, we reproduce said rejection in its entirety. It reads as follows:

As for claim 17, it would have been further obvious to have coated said nuts with the first coating while under reduced pressure for the reasons set forth above with respect to Reznik [Paper No. 8, p. 5].

However, the Reznik reference was not included in the examiner's statement of the rejection set forth on p. 2 of Paper No. 8. See also, pp. 3-4 of this Decision. Nor do we find a discussion of said Reznik reference anywhere in Paper No. 8. Consequently, the examiner has left both the appellant⁶ and this merits panel "up in the air" as to what factual

⁶ In response to the examiner's rejection of claim 17, the appellant states:

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basis there may be for his conclusion of obviousness. Since the appellant has not been properly advised of, and therefore, has not had a fair opportunity to respond to, the examiner's rejection, the application is remanded to the examiner for correction and clarification.

Second, it is not clear from the examiner's statement of the rejection that he has properly considered the breadth of claim 17. Upon return of this application, the examiner should review the claim and consider whether it would have been obvious to one of ordinary skill in the art to apply an antioxidant and oil solution to nuts, such as pecans, in view of the teachings of Hoover with respect to the coating of nuts with an antioxidant and oil (col. 3, lines 12-18 and lines 53-63) and the teachings of Zook that additives can be infused into nuts by any conventional means such as differential pressure; i.e., using a vacuum. Zook, col. 15, line 47- col. 16, line 3. The examiner is reminded that a conclusion of obviousness must be based on facts, and not on unsupported generalities. *In re Freed*, 425 F.2d 785, 788, 165 USPQ 570, 572 (CCPA 1970); *In re Warner* 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). Thus, the examiner should clearly set forth, on the record, his findings of fact and his reasons for concluding that the claimed invention would have been obvious to one of ordinary skill in the art.

It should be noted here that the Resnick patent is not cited in this Official Action, but was cited against the aforesaid claim in the first Official Action, namely, Paper No. 6, a ground of rejection which was not continued to the second Official Action [Brief, p. 9].

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As to claims 18 through 24, we point out that these claims are directed to the nuts produced by the appellant's process of food treatment. Thus, the nuts of claims 18 through 24 are defined in a product-by-process format. ***In re Thorpe***, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). When claims are presented in this manner, it is the patentability of the product which must be established. Thus, upon the return of this application, the examiner should determine whether there are any characteristics which distinguish the claimed products from the nuts described by the prior art. That is, if there are no substantial differences between the claimed nuts and those described in the prior art, the examiner should consider whether the prior art products anticipate, or render obvious, the inventions described in claims 18 through 24. ***In re Best***, 562 F.2d 1252, 1255, 195 USPQ 430, 433-334 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product").

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It is apparent that claims 17 through 24 have not been fully considered by the examiner. Accordingly, in view of the aforementioned errors, we remand this application to the examiner to address these problems.

This application, by virtue of its "special" status, requires an immediate action.

Manual of Patent Examining Procedure (M.P.E.P.) § 708.01(d)(7th ed., July 1998).

REVERSED AND REMANDED

Marc L. Caroff)
Administrative Patent Judge)
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Aдриene Lepiane Hanlon) BOARD OF PATENT
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