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Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte ROGER M. BURGE

Appeal No. 1998-2667
Application 08/668,971

ON BRIEF

Before, OWENS, WALTZ and JEFFREY T. SMITH, Administrative
Patent Judges.

JEFFREY T. SMITH, Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

Appellant appeals the decision of the Primary Examiner rejecting claims 1-14 and 16-19, all the claims in the application. We have jurisdiction under 35 U.S.C. § 134.

BACKGROUND

The invention is drawn to a nixtamalization process and the product produced thereby. Nixtamalization is a process whereby whole or ground corn is treated with an alkali to

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provide a so-called masa flavor. The products are useful in a variety of products including breads, pastas, tortillas and chips. (Specification page 1).

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

Madrazo et al. 14, 1964 (Madrazo)	3,117,868	Jan.
Gonzalez et al. 1968 (Gonzalez)	3,369,908	Feb. 20,
Mendoza 1975	3,859,452	Jan. 7,
Heller 1994	5,332,594	Jul. 26,

Claims 11-14 stand rejected under 35 U.S.C. § 102 as being anticipated by GONZALEZ.

Claims 16-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of MADRAZO and MENDOZA.

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over HELLER.

OPINION

The rejection over Gonzalez

Claims 11-14 stand rejected under 35 U.S.C. § 102, as being anticipated by GONZALEZ. (Examiner's Answer, page 4). We affirm.

When addressing the rejection of claims 11-14 over the Gonzalez reference, appellant has not presented separate arguments for claims 12-14. Thus, claims 12-14, all of which depend from claim 11, will stand or fall with the patentability of claim 11. 37 CFR § 1.192(c)(7) (1995).

Claim 11 is drawn to a nixtamalized farinaceous composition having pronounced masa flavor comprising a farinaceous component containing ungelatinized corn starch and a pronounced masa flavor. Claim 11 is reproduced below:¹

11. A nixtamalized farinaceous composition having pronounced masa flavor comprising a farinaceous component containing ungelatinized corn starch and a pronounced masa flavor produced by the process of heating a superficially dry composition comprising farinaceous corn starch component, alkaline compound in a concentration of at least .2 parts by weight

¹ Claim 11 is reproduced as submitted in the amendment dated June 11, 1997, paper number 14. Although the examiner indicated that this amendment would be entered (see the Advisory Action dated July 9, 1997, paper number 16) this amendment was never physically entered. Upon the return of this application to the jurisdiction of the examiner, this clerical oversight should be corrected.

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per 100 parts by weight farinaceous component (d.s.b.) and water in a closed system to develop a pronounced masa flavor without pasting the starch component of the farinaceous component while maintaining the water content of the composition in the closed system at 2% to 20% by weight of the composition.

Gonzalez discloses a process for the production of nixtamalized corn meal useful for the production of tortillas. (Column 1, lines 23-25). Gonzalez discloses the importance of using processing conditions that prevent gelatinizing the starch because it would cause a loss in the product's flavor. (Column 4, lines 13-20 and 47-50). This disclosure indicates that the farinaceous component is ungelatinized.

Appellant argues that "[c]laims 11 to 14 are not anticipated by Gonzales et al. since appellant's products are ungelatinized whereas Gonzales et al. produce partially gelatinized products." (Brief, page 5, last paragraph). Claim 11 does not call for a completely ungelatinized product. Claim 11 is open to include both gelatinized and ungelatinized corn starch as is apparent from the use of the term "comprising" appearing on the second line of claim 11 reproduced above.² As acknowledged by appellant, Gonzalez

² "Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct

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describes products which contain at least a portion of ungelatinized corn starch. Thus, the compositions of Gonzalez which contain at least a portion of ungelatinized corn starch anticipate the subject matter of claim 11.

Appellant presented declarations on November 22, 1995 and June 2, 1997 to overcome the rejection of claims 11-14 over Gonzalez.

Roger Burge's declaration of November 22, 1995, is not supported by objective evidence. The declaration provides only the opinion of the declarant and does not indicate what evidence he considered in reaching his opinion. Thus, the declaration of November 22, 1995 is not persuasive.

Declarations unsupported by objective evidence are accorded little or no weight. In re Etter, 756 F.2d 852, 860, 225 USPQ 1, 6 (Fed. Cir. 1985).

The declaration of June 2, 1997 does not present evidence that the composition of Gonzalez contains at least partially ungelatinized corn starch. The experiment representative of Gonzalez' example 1 was not performed as described in the reference. For example, the cooking time of the reference was

within the scope of the claim. Genentech v. Chiron, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997).

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5 minutes at 94°C and then 30 minutes at 75°C. The declaration cooking time was 5 minutes at 90 to 95°C and then 45 minutes at 75°C. Further, the declaration provided no indication of the moisture content nor the pressure and temperature of the grounding process both of which were stated in example 1. For these reasons, the declaration is not probative. Declaration evidence must be considered, but will not be considered probative if it does not address the facts of record. In re Beattie, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992).

When the prior art appears to provide a product identical to the product claimed, the appellant has the burden to submit evidence commensurate in scope with the claims that the products are different. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Appellant has failed to direct us to evidence that the products of Gonzalez are different from the products of claim 11. We affirm the rejection of claims 11-14 under 35 U.S.C. § 102 as anticipated by Gonzalez.

The rejection over Madrazo and Mendoza

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Claims 16-19 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over the combination of MADRAZO and MENDOZA. (Examiner's Answer, page 6). We affirm.

Appellant stated in his brief that claims 16-19 are grouped together. (Brief page 4). When addressing the rejection of claims 16-19 over the combination of the Madrazo and Mendoza references, appellant has not presented separate arguments for claims 17-19. Thus, claims 17-19, all of which depend from claim 16, will stand or fall with the patentability of claim 16. 37 CFR § 1.192(c)(7) (1995).

Claim 16 is drawn to a process of forming a nixtamalized farinaceous composition having pronounced masa flavor. Claim 16 is reproduced below:³

16. The process of forming a nixtamalized farinaceous composition having pronounced masa flavor comprising heating a superficially dry composition comprising farinaceous corn starch component, alkaline compound in a concentration of at least .2 parts by weight per 100 parts by weight farinaceous component (d.s.b.) and water in a closed system to develop a pronounced masa flavor without pasting the starch component of the farinaceous component while maintaining the water content of the composition in the closed system at 2% to 20% by weight of the composition.

³ Claim 16 is reproduced as amended in the amendment dated June 11, 1997, paper number 14. See footnote 1.

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The examiner rejected claim 16 as obvious over the combined teachings of Madrazo and Mendoza. According to the examiner, Madrazo describes a process for nixtamalizing whole grains. Mendoza describes a process for nixtamalizing corn wherein the amount of alkaline solution varies dependent on the corn. Thus, it would have been obvious for one skilled in the art to determine the appropriate amount of alkaline solution through routine experimentation. (Examiner's Answer, page 6).

Madrazo example 5 describes a process for nixtamalizing corn in a closed vessel and adding calcium hydroxide in an amount of 0.6 (parts/100 parts of corn). Example 5 differs from claim 16 in that the amount of moisture described is 34%, which exceeds the claimed range of 2% to 20%. Madrazo discloses that the moisture content can vary within the range of 5 to 35%. (Column 4, lines 12-14). A rejection is proper when the difference between the claimed invention and the prior art is a minor difference in the range or value of a particular variable or when the ranges touch. In re Geisler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997). Overlapping ranges are prima facie obvious. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990); In

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re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA
1974).

It is noted that Madrazo does not describe the nixtamalized farinaceous composition as having a "pronounced masa flavor." However, the reaction conditions of Madrazo fall within the parameters set forth on page 4, lines 8 to 16 of appellant's specification. (See Madrazo, columns 3 and 4).

Appellant argues that Madrazo uses 35% water which is outside the critical range of 2% to 20%. (Brief, page 7). As stated above, Madrazo, at column 4, lines 12-14, discloses that the moisture content in the process can vary within the range of 5 to 35%. Consequently, one of ordinary skill in the art would have a reasonable basis for lowering the moisture of example 5 below 20%.

The declaration of June 2, 1997 does not present evidence that the process of Madrazo produces compositions containing at least partially ungelatinized corn starch. The experiment representative of Madrazo's example 5 was not performed as described in the reference. For example, the moisture content of example 5 was indicated to be 34% whereas the declaration maintained a moisture content of 11%. The declaration dried the nixtamalized corn at a temperature of 400°F for 20

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minutes. Example 5 does not include such drying conditions.
For these reasons, the declaration is not probative.

The rejection of claims 16-19 under 35 U.S.C. § 103(a),
as unpatentable over the combination of Madrazo and Mendoza is
affirmed.

The rejection over Heller

Claims 1-10 stand rejected under 35 U.S.C. § 103(a), as
being unpatentable over HELLER. (Examiner's Answer, page 5).
We reverse.

Claim 1 is reproduced below:

1. A food product comprising a major portion of an
under or non-nixtamalized farinaceous component
and a minor portion of a nixtamalized component
having pronounced masa flavor.

Upon careful review of the record including the
respective positions advanced by appellant and the examiner,
we find ourselves in agreement with appellant that the
examiner has
failed to carry the burden of establishing a **prima facie** case
of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24
USPQ2d

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1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). Accordingly, we will not sustain the examiner's rejection.

In particular, we note that the examiner has not adequately explained how and why one of ordinary skill in the art would have been led to increase the amount of non-nixtamalized farinaceous component and reduce the amount of nixtamalized component contained in the Heller composition. The examiner argues the amounts of the components are not patentably significant because one of ordinary skill in the art would have been motivated to vary the amounts of the components to adjust the taste, texture and flavor.

(Examiner's Answer, paragraph bridging pages 5 and 6).

Heller describes water-base bran snacks comprising 60% to 80%, by dry weight, masa, 20% to about 40% oat bran, and if desired, 5 to about 6% gluten flour. (Col 2 lines 24-27).

Generally the adjustment of amounts of components in compositions may be obvious. However, this does not address why one of ordinary skill in the art would have been motivated to adjust the amount of components in compositions which are outside Heller's scope of disclosure. That is, the examiner has not presented motivation for a person of ordinary skill in

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the art to modify Heller's composition by reducing the masa content below the non-nixtamalized farinaceous component content in Heller's composition. Further, the examiner has not indicated what effect the reducing the masa content below the non-nixtamalized farinaceous component content would have on the taste, texture

and flavor of the product. The rejection of claims 1-10 under 35 U.S.C. § 103(a) as unpatentable over Heller is reversed.

SUMMARY

The rejection of claims 11-14 under 35 U.S.C. § 102 as anticipated by Gonzalez is affirmed.

The rejection of claims 16-19 under 35 U.S.C. § 103(a) as unpatentable over the combination of Madrazo and Mendoza is affirmed.

The rejection of claims 1-10 under 35 U.S.C. § 103(a) as unpatentable over Heller is reversed.

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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).

AFFIRMED-IN-PART

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TERRY J. OWENS))
Administrative Patent Judge)	
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)	BOARD OF
)	PATENT
THOMAS A. WALTZ)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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