

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AIME MENASSA and HENRI CAUPIN

Appeal No. 94-2861
Application 08/013,537¹

HEARD: July 16, 1997

Before KIMLIN, JOHN D. SMITH and THIERSTEIN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judges.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-20, all the claims in the present application. Claims 1 and 3 are illustrative:

1. A composition of matter comprising (a) an animal foodstuff and (b) an effective foodstuff deodorizing amount of at least one alkyl or polyoxyalkylene ester of undecylenic acid.

¹ Application for patent filed January 28, 1993. According to appellants, this application is a continuation of Application 07/902,484, filed June 23, 1992; which is a continuation of Application 07/629,848, filed December 19, 1990, both abandoned.

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3. The composition of matter as defined by Claim 1, said deodorant (b) comprising a polyoxyethylene, polyoxypropylene or poly(oxyethylene)/(oxypropylene) ester of undecylenic acid.

In addition to the admitted prior art found in the present specification, the examiner relies upon the following references as evidence of obviousness:

Thomas E. Furia and Nicoló Bellanca (Furia), 2 Fenaroli's Handbook of Flavor Ingredients (2d ed., CRC Press, Inc., 1975)

Arctander, Steffen, II Perfume and Flavor Chemicals (1969)

Appellants' claimed invention is directed to a composition comprising an animal foodstuff and a deodorizing amount of at least one alkyl or polyoxyalkylene ester of undecylenic acid. According to appellants, the "undecylenic acid ester compounds have been found to mask the odor of objectional foodstuffs without producing an odor of their own" (page 3 of Brief).

Appellants submit at page 4 of the Brief that "only claims 3-4 and 14-15 is [sic: are] separately argued." Accordingly, claims 1, 2, 5-13 and 16-20 stand or fall together.

Appealed claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted state of the art in view of Arctander and Furia.

Upon careful consideration of the opposing arguments presented on appeal, as well as appellants' declaration evidence of nonobviousness, we will sustain the examiner's rejection of

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claims 1, 2, 5-13 and 16-20. However, the examiner's rejection of claims 3, 4, 14 and 15 is reversed.

We consider first the examiner's rejection of claim 1, with which claims 2, 5-13 and 16-20 stand or fall. Appellants' specification acknowledges that it was known in the art for feed manufacturers to solve the product odor problems by deodorization. Appellants' counsel at oral hearing also conceded that Furia evidences that it was known in the art to use compounds encompassed by the claimed alkyl esters of undecylenic acid as additives to foods, such as beverages, candy and baked goods, to impart a wine-like odor. Accordingly, since it was known in the art to add aromatic compounds to animal foodstuff for deodorization, we agree with the examiner that it would have been prima facie obvious for one of ordinary skill in the art to incorporate known aromatic compounds, such as the claimed alkyl esters of undecylenic acid, in an animal foodstuff as the deodorizing agent.

Appellants rely upon a Rule 1.132 Declaration as evidence of nonobviousness. According to appellants,

the declarants compared the deodorizing efficacy of three undecylenic acid esters of the present invention to equivalent esters of different carboxylic acids, specifically lauric, capric and caprylic, as well as to undecylenic acid *per se*. In all instances, the subject compounds provided for demonstrably better deodorizing

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activity than the comparative compounds. [Page 9 of Brief.]

However, we concur with the examiner that the declaration evidence is of little probative value since "[n]o explanation has been given for the selection of the various comparative compounds and the relevancy thereof" (page 5 of Answer). Appellants have not established that the comparative compounds are conventional deodorants for animal feedstock, nor does the declaration establish that the superiority of appellants' undecylenic acid esters vis-à-vis the comparative compounds would be unexpected to one of ordinary skill in the art. For all we know, one of ordinary skill in the art would expect the claimed compounds to provide substantially better deodorization of animal feed compositions than the compounds offered for comparison. Furthermore, although appellants state at page 3 of the Brief that "the aromatization of foodstuffs is undesirable because it causes additional expense to feed manufacturers," there is no objective evidence of record which demonstrates that use of the claimed compounds results in an economic savings as compared with conventional deodorants.

Moreover, since the claim language "animal foodstuff" is sufficiently broad to encompass food for humans, as well as human food that is also consumed by animals, we find that Furia, which

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discloses an alkyl ester of undecylenic acid as an additive for foodstuffs, describes the claimed subject matter within the meaning of 35 U.S.C. § 102. It is well settled that anticipation is the epitome of obviousness.

We will not sustain the examiner's rejection of claims 3, 4, 14 and 15, which define the deodorant as a polyoxyethylene, a polyoxypropylene or a poly(oxyethylene)/(oxypropylene) ester of undecylenic acid. The examiner has cited no prior art evidence that such polyoxyalkyl esters of undecylenic acid are known as odorants or flavorants for food compositions. In the absence of such prior art, the examiner has failed to provide factual support for the conclusion of obviousness. Accordingly, we are constrained to reverse the examiner's rejection of claims 3, 4, 14 and 15.

In conclusion, based on the foregoing, the examiner's rejection of claims 1, 2, 5-13 and 16-20 is affirmed. The examiner's rejection of claims 3, 4, 14 and 15 is reversed. The examiner's decision is affirmed-in-part.

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

EDWARD C. KIMLIN)

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Administrative Patent Judge)	
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Administrative Patent Judge)	APPEALS AND
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