

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 SHIROH OHASHI, GERALD J. SHELSON,  
ARTHUR L. MOIRANO and WALTER L. DRINKWATER

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Appeal No. 95-2971  
Application No. 07/742,260<sup>1</sup>

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ON BRIEF

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Before WINTERS, WILLIAM F. SMITH, and ROBINSON, Administrative Patent Judges.  
ROBINSON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-13, which are all of the claims pending in the case. Independent claims 1 and 11 are illustrative of the subject matter on appeal and are reproduced below:

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<sup>1</sup> Application for patent, filed August 8, 1991.

1. Clarified konjac characterized in that it comprises glucomannan derived from konjac which is substantially free of insoluble impurities; has a nitrogen content of about 0.60 wt % or less; and readily dissolves in water to form a sol or gel having an aqueous sol turbidity potential of less than 20 turbidity units as measured at 1.0 w/v % concentration using the Formazin Turbidity Standard.

11. A method for production of the clarified konjac of claim 1 characterized by the steps of:

[a] preparing an aqueous sol of crude konjac comprising insoluble impurities and glucomannan;

[b] contacting the crude konjac sol with an extraction salt selected from one or more of dicalcium phosphate, calcium phosphate, magnesium phosphate, and aluminum sulfate in an amount effective to extract the insoluble impurities by precipitation;

[c] precipitating and removing the insoluble impurities;

[d] forming a glucomannan coagulate by treating the remaining aqueous sol with isopropyl alcohol present in an amount sufficient to coagulate substantially all glucomannan therein; and

[e] removing and drying the glucomannan coagulate to recover the clarified glucomannan.

The references relied upon by the examiner are:

Shimizu et al. (Shimizu)	3,767,424	Oct. 23, 1973
Sugiyama et al. (Sugiyama)	3,856,945	Dec. 24, 1974
Fuller et al. (Fuller)	3,608,068	Sept. 21, 1971
Yamada et al. (Yamada)	4,036,655	July 19, 1977
Gaffar et al. (Gaffar)	4,183,914	Jan. 15, 1980
Koyama et al. (Koyama)	4,460,730	July 17, 1984
Hara (Hara I) (Japanese Patent)	58-165,758	Sept. 30, 1983
Hara (Hara II) (Japanese Patent)	59-227,267	Dec. 20, 1984
Fukuda (Japanese Patent)	H2-231,044	Sept. 13, 1990

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### **GROUND OF REJECTION**

Claims 1-10 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Hara I, Hara II, Sugiyama, Shimizu, Gaffar, Fuller, Yamada, Koyama and Fukuda.

Claims 11-13 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Hara I, Hara II, Sugiyama, Shimizu, Gaffar, Fuller, Yamada, and Koyama.

We reverse both rejections and enter a new ground of rejection under 35 U.S.C. § 103 (37 CFR § 1.196(b))

### **BACKGROUND**

At page 3 of the specification, appellants describe the invention as relating to a clarified konjac and a method of preparing clarified konjac, wherein the clarified konjac is substantially free of insoluble impurities, has a reduced nitrogen content and has a reduced aqueous sol turbidity potential.

## **DISCUSSION**

### The rejections under 35 U.S.C. § 103

#### **Claims 1-10:**

Claims 1-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hara I, Hara II, Sugiyama, in view of Shimizu, Gaffar, Fuller, Yamada, Koyama and in further view of Fukuda.

The examiner has relied upon 9 references, including 4 newly cited in the Examiner's Answer (Answer), in setting forth the basis for this rejection. The examiner briefly describes the disclosure of each reference (Answer, pages 4-9) and then concludes at page 10 of the Answer:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to produce the claimed glucomannan derived from konjac, since Fukuda shows that such a clarified konjac having a nitrogen content of about 0.60 wt % or less is well known in the art and since the process steps disclosed by Hara (JP 58-165758 and JP 59-227267), Sugiyama et al, Shimizu et al, Gaffar et al, Fuller et al, Yamada et al and Koyama et al references suggest a konjac product in which the insoluble impurities were removed and a konjac product which has an aqueous sol turbidity potential within the scope of that which is claimed by the Appellants.

The examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On the record before us, we find that the examiner has failed to provide sufficient explanation to establish a prima facie case of unpatentability of the claimed subject matter.

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The examiner has relied upon Fukuda stating (Answer, page 9):

Fukuda discloses a konjac mannan purified to a degree so that the nitrogenous component originating in the konjac tuber is not more than 0.2%.

However, at page 1, last paragraph of the translation, Fukuda describes the konjac of the reference as being "resistant to melting by heat and dissolution in hot water." (Emphasis added). In addition, Fukuda makes no mention of the presence or absence of insoluble impurities. This compares to claim 1 which calls for a clarified konjac "substantially free of insoluble impurities" and "readily dissolves in water." The examiner relies on the remaining references as disclosing processes of preparation of konjac products which the examiner concludes would have the characteristics of the claimed product. However, the examiner has pointed to no product, in any of the cited references, which would reasonably appear to correspond to the konjac of the claims.

We conclude that the examiner has failed to establish a prima facie case of unpatentability of the clarified konjac claimed. Where the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). We therefore reverse the rejection of claims 1-10 under 35 U.S.C. § 103.

**Claims 11-13:**

Claims 11-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hara (I), Hara (II) and Sugiyama in view of Shimizu, Gaffar, Fuller, Yamada and Koyama.

A patentability determination must begin with the scope of the claims being ascertained. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert denied, 481 U.S. 1052 (1987). ("Analysis begins with a key legal question--what is the invention claimed?"). In similar fashion, the court stated in In re Wilder, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970), "[t]he first inquiry must be into exactly what the claims define." The examiner's rejection of these claims is fatally defective since it does not properly account for and establish the obviousness of the subject matter as a whole.

Claim 11 requires, in pertinent part, the contacting of the crude konjac sol with an extraction salt selected from one or more of dicalcium phosphate, calcium phosphate, magnesium phosphate and aluminum sulfate prior to precipitation and removal of insoluble impurities, formation of a coagulate by treating the resulting sol with isopropyl alcohol and the removal and drying of the coagulate. The examiner points to no reference which discloses the contacting of a crude konjac sol with one of the extraction salts of claim 11. The examiner's reliance on newly cited Fuller, Yamada, Gaffar, and Koyama to equate the claim designated phosphate and sulfate salts with the inorganic salts of Hara I and Hara II is misplaced. These references relate to processes and products which are unrelated to the purification or treatment of konjac and are of no value in establishing the equivalency of

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such materials in the claimed process. The only disclosure, in any of the cited references, relating to the addition of alcohols to konjac is found in Shimizu. However, that disclosure relates to the use of alcohols in a crude konjac comminuting process and does not suggest the addition of the alcohol to a konjac sol to cause the coagulation of glucomannan in a process intended to result in clarified konjac. On the record before us, we find that the examiner has failed to establish that the claimed method for the production of clarified konjac would have been prima facie unpatentable over the references relied upon. We therefore reverse the rejection of claims 11-13 under 35 U.S.C. § 103.

New ground of rejection

Claims 1 - 10 are rejected under 35 U.S.C. § 103 as unpatentable over Sugiyama.

Sugiyama discloses a process (col. 3, Example 1) wherein a colloidal solution of konjac in water is filtered through a nylon filter cloth and then a glass filter with suction to remove insoluble materials. The filtrate is then dialyzed against distilled water. The resulting solution is lyophilized to yield a "Purely white, cotton-like konjac mannan" disclosed to have only a trace of nitrogen. Table 1 (col. 3) indicates that the resulting konjac mannan is water soluble and gelable. This konjac mannan would reasonably appear to meet the claim limitations of claim 1 as well as claims 4-6 directed to an aqueous sol and claims 7-9 directed to an aqueous gel. The only characteristics not explicitly disclosed by Sugiyama are the functional limitations regarding turbidity (claim 1) and viscosity (claim 10).

We recognize that the claimed clarified konjac is prepared by a process which differs from that disclosed by Sugiyama. However, it is established law that the patentability of a product does not depend on its method of production. If the product is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 965-66 (Fed. Cir. 1985). Where, as here, the claimed and prior art products are identical or substantially identical, the PTO can require an applicant to show that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977) and In re Swinehart, 439 F.2d 210, 212, 169 USPQ 226, 228-29 (CCPA 1971).

We are mindful of the comparison, at page 17 of appellants' specification, which compares the product of the claimed invention with a product resulting from a process disclosed in U.S. Patent 3,928,322, which is similar to that of the Sugiyama patent herein relied on; the results of which are summarized in Table II, at page 19 of the specification. However, we do not find this comparison sufficient to distinguish the product disclosed by Sugiyama from the claimed product, because it is not a side-by-side comparison with the product resulting from Example 1 of Sugiyama, the closest prior art. The comparison of the specification relates to a product and process disclosed in a different U.S. patent. Further, we note that the filtration steps of the compared process differs from the that of Example 1 of Sugiyama. Compare steps 2 and 3 at page 17 of the specification with the filtration steps of Sugiyama at col. 3, lines 25-28. This difference could readily explain any observed difference in the amount of insoluble materials detected.

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We therefore conclude that the disclosure and teachings of Sugiyama are sufficient to have established a prima facie case of unpatentability of the subject matter of claims 1 - 10.

#### **SUMMARY:**

The examiner's decision to reject claims 1-13 as being unpatentable under 35 U.S.C. § 103 is reversed. A new ground of rejection is entered pursuant to 37 CFR 1.196(b) under 35 U.S.C. § 103 over Sugiyama.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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**SUMMARY**

We reverse the examiner's rejection of claims 1-13 under 35 U.S.C. § 103 and enter a new ground of rejection under 35 U.S.C. § 103.

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

REVERSED, 37 CFR 1.196(b)

SHERMAN D. WINTERS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
WILLIAM F. SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
DOUGLAS W. ROBINSON	)	
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