

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN D. BAILEY, II

Appeal No. 1996-4109
Application 08/123,557

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and ADAMS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3, 5-15 and 18-20, which are all the claims pending in the application.

Claims 1, 14, 15 and 18 are illustrative of the subject matter on appeal and are reproduced below:

1. A psyllium containing baked snack bar which comprises, per snack bar:
 - from about 5.7% to about 20% by weight psyllium;
 - from about 10% to about 20% by weight shortening;
 - up to about 20% by weight sweetener;
 - from about 50% to about 80% by weight grain product, and;
 - from about 2% to about 20% by weight moisture.

14. The snack bar of claim 1, prepared by:
 - (a) blending said shortening and said psyllium to form a first mixture;
 - (b) combining said sweetener and said grain product with an amount of water sufficient to form a moistened, second mixture;
 - (c) combining said first and second mixture to form an uncooked snack bar product, and
 - (d) baking said uncooked snack bar product.

15. Process for preparing a psyllium containing snack bar, comprising:
 - (i) mixing psyllium and shortening to form a first mixture,
 - (ii) mixing a sweetener and a grain product with water to form a moistened second mixture,
 - (iii) combining said first and second mixture to form a third mixture, and
 - (iv) baking said third mixture to form a snack bar, wherein said third mixture comprises, on a weight percent basis:
 - (i) from about 1% to about 20% psyllium;
 - (ii) from about 5% to about 20% shortening;
 - (iii) up to about 20% sweetener;
 - (iv) from about 50% to about 70% grain product, and;
 - (v) from about 10% to about 40% water.

18. Dry mix useful for preparing a psyllium containing snack bar, comprising:
 - (i) from about 1% to about 20% by weight psyllium;
 - (ii) up to about 20% by weight of a dry sweetener; and
 - (iii) from about 50% to about 80% by weight of a grain product.

The references relied upon by the examiner are:

Wullschleger et al. (Wullschleger I)	5,227,248	July 13, 1993
Wullschleger et al. (Wullschleger II)	5,223,298	June 29, 1993
Pflaumer et al. (Pflaumer)	5,095,008	Mar. 10, 1992
Colliopoulos	5,009,916	Apr. 23, 1991

GROUND OF REJECTION

Claims 1-3, 5-15 and 18-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Wullschleger I and Wullschleger II alone, or in combination with, Pflaumer and Colliopoulos.

We reverse.

DISCUSSION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, and to the respective positions articulated by the appellant and the examiner. We make reference to the Examiner's Answer (Paper No. 19, mailed April 5, 1996), and the Supplemental Examiner's Answer (Paper No. 21, mailed June 11, 1996) for the examiner's reasoning in support of the rejection. We further reference appellant's Brief (Paper No. 18, received November 13, 1995), and appellant's Reply Brief (Paper No.20, received April 19, 1996) for the appellant's arguments in favor of patentability.

Obviousness is a legal conclusion based on the underlying facts. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (CCPA 1966); Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750 (Fed. Cir. 1991); Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1595-97 (Fed. Cir. 1987), cert. denied, 481 U.S. 1052 (1987). In creating his prima facie case of obviousness the examiner recognizes the differences between the claimed invention and Wullschleger¹.

Specifically, the examiner states (Answer, page 4)

Although there is a difference in the amount of grain product in the Wullschleger et al. example as compared to the appellants' snack bar, the claimed food products of Wullschleger et al. in '248 are readable on having about 25-90% of one or more cereal brans and about 6-19% psyllium.

The examiner maintains his position "because, in the absence of any unexpected benefits of the appellant's snack bar, the appellant's snack bars require only minor modifications in amounts of ingredients routinely used in the art and which have been suggested for modification by Wullschleger et al." See (Answer, page 5).

Appellant presents four groupings of claims. The claims within each group stand or fall together. The following discussion addresses appellant's four groups in order.

¹ The examiner states (Answer, page 4) "[t]he examiner's primary references against claims ... are the patents of Wullschleger et al. (#5,227,248 and #5,223,298) which have almost identical specifications." Thereafter the examiner discusses Wullschleger in reference to both patents. Appellant states (Brief, page 5) "the two Wullschleger patents will be treated as one, because their specifications are identical."

Claims 1-3, 5-13, 19 and 20:

In response to the examiner's rejection, appellant argues (Brief, page 5) that "[I]n example 10 [of Wullschleger], the unbaked cookie dough contained 13% shortening, 18% sugar, and additional ingredients, including 9% water. No information is given as to the final composition of the baked product." Appellant emphasizes (Brief, page 6) the significance of baking when comparing the claimed invention to the prior art relied upon, "baking drives off moisture, the final, baked product in Wullschleger will clearly weigh less than the unbaked material, and the percentages will change." Appellant notes (Brief, page 6) that since the prior art sugar content is already at 18%, it is not unreasonable to assume that once baked the sugar content of the prior art will exceed 20%. The examiner did not respond to appellant's argument that baking will drive off moisture and thereby change the percentages of each ingredient in the baked snack bar.

Appellant further argues (Brief, page 6) that the Wullschleger references teach the use of about 33.8% grain product, in contrast to the claims which specifically require about 50% by weight grain product. Appellant then argues (Brief, page 6) that there is no motivation, or suggestion, in the prior art to

change the percentage of grain product in the snack bar. To emphasize this point, appellant notes (Brief, page 7) that Pflaumer, “suggests lowering this value [regarding grain content], rather than increasing it by 50%.” In addition, appellant distinguishes Colliopoulos (Brief, bridging paragraph, pages 7-8) from the claimed invention, pointing out that “column 4 [of Colliopoulos], show, very low amounts of grain products and, more to the point, show absolutely no shortening.”

Initially we remind the examiner that, a conclusion of prima facie obviousness, of course, does not end a patentability determination under 35 U.S.C. § 103. As stated in In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986):

If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

In this case, appellant raised several arguments rebutting the examiner’s prima facie case of obviousness. In response, the examiner maintains (Answer, page 5) that only minor modifications of the prior art references are required to obtain the claimed snack bar. However, it is well-established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion or motivation to lead an inventor to combine those references. Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). On these facts, we find

that the only reason or suggestion to modify the references to arrive at the present invention comes from appellant's specification.

Accordingly, we reverse the examiner's rejection of claims 1-3, 5-13, 19 and 20 under 35 U.S.C. § 103.

Claim 14:

Appellant argues that the prior art teachings (Brief, pages 8-10) suggest that using the claimed process limitations would result in a distinct snack bar, specifically, one that would not be palatable. These same arguments are later incorporated (Brief, page 10) into appellant's arguments regarding claim 15.

Claim 14 is drawn to a snack bar of claim 1. Appellant recognizes (Brief, page 8) that "for examination purposes, the claimed product, rather than the recited process steps, are considered." Therefore, for the reasons given in the discussion of claims 1-3, 5-13, 19 and 20 above, we find that the only reason or suggestion to modify the references to arrive at the present invention comes from appellant's specification. However, we note that the process limitations of claim 14, discussed infra with regard to claim 15, further detract from the examiner's prima facie case of obviousness.

Accordingly, we reverse the examiner's rejection of claim 14 under 35 U.S.C. § 103.

Claim 15:

Appellant states (Brief, page 10) “[m]ost of the arguments pertinent to claim 14 ... supra, are also pertinent here.” We note that claim 15 requires mixing psyllium and shortening, and then adding inter alia water. With regard to the combination of psyllium and water, appellant points out (Brief, bridging paragraph, pages 8-9) that “the prior art suggests that one must be careful about water and psyllium ... [i]ndeed, Wullschleger et al., solves this problem ... by precooking the psyllium [or using] ... precooked psyllium nuggets.” Appellant notes (Brief, page 9) the teaching away from the claimed invention in the Pflaumer reference “incorporating psyllium into a cookie involves more than just mixing the desired amount of psyllium into a conventional cookie composition. If psyllium is added this way, the psyllium will hydrate and result in a less than palatable cookie.” Appellant further notes (Brief, page 10) that the Colliopoulos recipe at column 6 and examples 1-4 contain no moisture. Appellant emphasizes (Brief, page 10) that “to go contrary to what is expressly taught, and still produce a palatable product – as applicant did – clearly is contrary to the art.”

We remind the examiner again that, if the applicant comes forward with reasonable rebuttal ... the entire merits of the matter are to be reweighed. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

In this case, appellant raised several arguments rebutting the examiner's prima facie case of obviousness. In response, the examiner states (Answer, page 6) "[o]ne of ordinary skill in the art would be able to determine the appropriate method of handling the ingredients involved to make the desired final form of the product." This is exactly what appellant argues will not happen. Unlike appellant's argument, the examiner fails to support his opinion with a reference to the prior art. We are left to weigh the examiner's unsupported conjecture against appellant's fact based conclusions drawn from a reasoned analysis of the prior art. What is missing in the examiner's prima facie case is a reason, suggestion or motivation to lead an inventor to combine those references. Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). On these facts, we find that the only reason or suggestion to modify the references to arrive at the present invention comes from appellant's specification.

Accordingly, we reverse the examiner's rejection of claim 15 under 35 U.S.C. § 103.

Claim 18:

Claim 18 is drawn to a dry mix comprising specified weight percentages of psyllium, sweetener and grain product. Appellant argues (Brief, page 11) that "Wullschleger only teaches a recipe where water is included ... [and] the amount of grain product present is well below what is claimed." Appellant further states (Brief, page 11) that "[m]odification of Wullschleger is certainly not suggested because ...

Pflaumer actually suggests lowering the amount of grain product even further ...
[and] Colliopoulos does not remedy these failings.”

In response to appellant’s arguments the examiner states (Answer, page 6) that “[t]he cereal mixes of WULLSCHLEGER et al. could be contemplated to be dry mixes, but pre-mix forms of food products are routine in the art as is exemplified by the fiber bars and fiber drink mixes of COLLIPOULOS” [emphasis added]. The examiner fails to identify where in the combination of references one can find a reason, suggestion or motivation to lead an inventor to combine those references. Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

On these facts, we find that the only reason or suggestion to modify the references to arrive at the present invention comes from appellant’s specification.

Accordingly, we reverse the examiner’s rejection of claim 18 under 35 U.S.C. § 103.

Having determined that the examiner has not established a prima facie case of obviousness, we find it unnecessary to discuss the Bailey Declaration (executed February 2, 1995), or the Wullschleger Declaration (executed February 3, 1995) relied on by appellant to rebut any such prima facie case.

SUMMARY

The rejection of claims 1-3, 5-15 and 18-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Wullschleger I and Wullschleger II alone, or in combination with, Pflaumer and Colliopoulos is reversed.

REVERSED

SHERMAN D. WINTERS)
Administrative Patent Judge)
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)
) BOARD OF PATENT
WILLIAM F. SMITH)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
DONALD E. ADAMS)
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