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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte EARL L. JOHNSON

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Appeal No. 1997-2565  
Application 08/382,588

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ON BRIEF

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Before DOWNEY, WILLIAM F. SMITH and HANLON, Administrative Patent Judges.

DOWNEY, Administrative Patent Judge.

DECISION ON APPEAL

This decision is an appeal under 35 USC § 134 from the final rejection of claims 1-12, all the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A beverage for human consumption consisting essentially of about 40% to 60% by volume of orange juice made from concentrate, about 40% to 60% by volume of tomato juice made from concentrate, 60 to 1,200 milligrams of ascorbic acid per liter of the beverage, and sufficient food additive preservative substances to prevent spoilage of the beverage after it has been sterilize[d] while in seal[ed] sterile containers.

The references relied upon by the examiner are:

Tarr, Y. V., "The Tomato Book", Random House, Inc., NY, pp. 142-143 (March 1977).

Nagy et al., "Citrus Science and Technology", Vol. 2, Avi Publishing Co., Westport, CN, p. 246 (1977).

Hawley, G., "The Condensed Chemical Dictionary", 10<sup>th</sup> ed., Van Norstrand Reinhold Co., NY, p. 854 (1984).

Claims 1-12 stand rejected under 35 USC § 103(a). As evidence of obviousness, the examiner relies on Tarr, Nagy, and Hawley. We reverse the rejection and institute new grounds of rejection under 37 CFR § 1.196(b).

#### DISCUSSION

##### The claims

Our analysis begins with the claims at issue. Claims 1-5 and 12 are directed to a beverage, claims 6 and 7 to a frozen concentrate, and claims 8-11 to a method of producing a beverage. All of the claims involve "a beverage suitable for human

consumption” consisting essentially of roughly equal amounts of orange juice from concentrate and tomato juice from concentrate.<sup>1</sup> The independent claims are 1, 4, 6, 8, and 12. Claims 1, 4, and 6 require 60-1,200 mg/L of ascorbic acid (Vitamin C) and require “sufficient food additive preservative substance to prevent spoilage”.<sup>2</sup> Claim 8 involves a method which consists essentially of mixing approximately equal portions of orange juice concentrate and tomato juice concentrate with water in the amount of approximately three times the amount of the concentrates, without the ascorbic acid or preservative required in the other independent claims. Claim 12 also requires “sufficient food preservative to prevent spoilage”<sup>3</sup> but not ascorbic acid (Vitamin C).

#### The prior art

Tarr is cited for its description of a beverage based on the combination of orange and tomato juices. The relevant portion of Tarr is the following recipe from p. 143:

#### MINTED TOMORANGE-ADE

YIELD: 1 QUART

2 Cups tomato juice

½ Cup granulated sugar

2 Cups mint leaves

2 Cups orange juice

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<sup>1</sup> The amounts of each are about 40-60 vol.% (claim 1), about 40-60% (claim 4), about equal ... by volume (claim 6), approximately equal (claim 8), or about/approximately 50 vol.% (claims 3 and 12).

<sup>2</sup> Claim 1 requires that the food preservative be sufficient “to prevent spoilage of the beverage after it has been sterilized while in sealed sterile containers”, whereas claim 6 requires the food preservative be sufficient “to prevent spoilage of the mixture while shipped, marketed and stored in a frozen condition.” Claims 4 and 6 require “about” 60-1,200 mg/L of ascorbic acid.

<sup>3</sup> Claim 12 requires that the food preservative be sufficient “to prevent spoilage of the beverage after it has been sterilized while in sealed sterile containers”

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½ Cup lime juice  
Club soda

Directions: In a medium-size saucepan, bring tomato juice to a boil, then add sugar and mint leaves. Remove from heat and allow mixture to cool. Stir in orange and lime juices. Divide among ice-filled highball glasses and add soda to fill.

Both Nagy and Hawley are cited for their teachings concerning food preservatives.

Nagy shows that sodium benzoate is a known preservative for citrus juices, including orange juices. Hawley teaches that potassium sorbate is used as “[b]acteriostat and preservative in meats, sausage casings, wines, etc.”

The rejection and issues on appeal

The Examiner rejected claims 1-12 under 35 USC § 103 as being unpatentable over Tarr in view of Nagy and Hawley. The Examiner states at p. 4-6 of her Answer mailed February 19, 1997 that Tarr teaches a composition with equal parts of tomato juice and orange juice but notes that Tarr does not teach the use of juice concentrate, ascorbic acid, and preservative substances. Nevertheless, the Examiner finds that juices of differing concentrations are extremely well known and that nothing “new” is seen in the addition of ascorbic acid (Vitamin C). Since Nagy and Hawley purportedly show that the preservatives claimed are well known, the examiner holds that the particular amounts of these additives required by the claims are within the skill of the ordinary worker.

The examiner concludes at p. 4 of her February 19, 1997 Answer:

(I)t would have been obvious to one of ordinary skill in the art at the time the

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invention was made to use the known ingredients as disclosed above in the composition and process of Tarr to make a shelf stable product.... As in In re Levin, the ingredients are used for their known functions, and nothing new or unexpected is seen in varying the amounts of ingredients.

The examiner elaborates at p. 5 of the same Answer:

Attention is invited to In re Levin, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F. (2d) 974, 5 U.S.P.Q 267; In re Mason et al., 33 C.C.P.A (Patents) 1144, 156 F. (2d) 189, 70 U.S.P.Q 221.

The examiner further acknowledges at p.6 of her Answer that the independent claims are further limited by "consisting essentially of" language but maintains that "even by limiting the particular ingredients, the claims are seen to be a recipe as in In re Levin, and no coaction of ingredients is seen to make a new product."

The appellant raises two arguments. First, the Examiner improperly applied In re Levin as

a per se rule. Second, the Tarr reference does not teach or suggest the presently claimed invention because the reference also teaches the addition of two cups of boiled mint leaves and ½ cup of sugar. The examiner responds to the first argument at p. 7 of (parenthetical added):

Appellant argues that the Examiner is applying a rule in using In re Levin, but does not say just how (his) situation is different than that cited in In re Levin. It is not seen that a “rule” has been applied, but a court decision, that has not been overturned.

The examiner responds to the second argument at the pg. 6 (parenthetical added):

Appellant argues that the cited reference to “Minted Tomorange-ade” does not show [his] exact recipe. However, it does show the basic concept of combining in equal amounts, tomato juice and orange juice. The additional ingredients only add flavor, i.e., mint, and lime, and most likely the mixture will be much thinner than that claimed, otherwise the claims and the cited recipe are seen to be very similar and the use of less water would only give the expected result of a more concentrated thicker product.

### Opinion

We reverse the examiner on both grounds. The decision of In re Levin, 178 F.2d 945, 948, 84 USPQ 232, 234 (CCPA 1949), provides no basis for the application of a per se rule. In our view, Tarr, either alone or in combination with other prior art, does not teach or suggest a beverage consisting essentially of the claimed components.

In effect, the examiner has labeled the claimed invention as a recipe and then extracted a per se rule from Levin that recipes are not patentable. The court made it clear

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in In re Ochiai, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) that there are no per se rules when determining obviousness under 35 U.S.C. § 103. As stated in Ochiai, 71 F.3d at 1572, 37 USPQ2d at 1133:

The use of per se rules, while undoubtedly less laborious than a searching comparison of the claimed invention-including all its limitations-with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. Per se rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)] and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any per se rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract per se rules from decisions that disavow precisely such extraction.

To paraphrase the court in Ochiai, at 71 F.3d at 1570, 37 USPQ2d at 1132, there are not [Levin] obviousness rejections . . . but rather only section 103 obviousness rejections.

In order to properly determine whether the subject matter of a claim as a whole

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would have been obvious, an examiner's office action must explicitly address the Graham v. John Deere Co., *supra*, criteria for prima facie obviousness in the office action.<sup>4</sup> Those criteria cannot be circumvented by resort to a per se rule. In addition, care must be exercised in citing caselaw predating Graham v. John Deere Co., *supra*, on the issue of obviousness. While In re Levin, *supra* contains language about recipes, there also was evidence in that case "that the cited patents showed it was old in the making of butter substitute compositions to use edible acids, gums, starch, and egg yolk, and to use them together in the customary way and for the same purpose as they were used by appellant." See In re Levin, *supra*. The point remains that Graham v. John Deere Co., *supra*, and its progeny are controlling on the requirements for establishing a *prima facie* case of obviousness. As set forth in In re Cofer, 354 F.2d 664, 667, 148 USPQ 268, 271 (C.C.P.A. 1966):

Necessarily, it is facts appearing in the record, rather than prior decisions in and of themselves, which must support the legal conclusion of obviousness under 35 U.S.C. 103. Merely stating that a compound or composition is obvious, without adequate factual support, is not sufficient.

With respect to the prior art rejection, this appeal raises a question as to the scope of a claim in regard to the expression "consisting essentially of". The transitional phrase "consisting essentially of" in a composition claim leaves the scope of the claim open to the inclusion of unspecified ingredients which do not materially affect the basic and novel

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<sup>4</sup> See MPEP, 7<sup>th</sup> ed. (July 1998), ' 706.02(j).

characteristics of a claimed composition. See In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 895, 896 (CCPA 1963).<sup>5</sup> We therefore need to determine the “basic and novel characteristics” of the claimed invention. In so doing, the claims should be analyzed to determine their plain meaning in light of the specification. See In re Marosi, 710 F.2d 799, 803, 218 USPQ 289, 291-293 (C.A.F.C. 1983). In the instant case, the beverage is described as having a “distinctive taste” with “novel flavor and taste characteristics” (p. 1, para. 1) without added sugar or other flavoring (p. 2, para. 1). The appellant indicates that the beverage is to be distinguished from other commercially available products which are combinations of high fructose, corn syrup, artificial flavorings, and water, with only minimum amounts of fruit and vegetable juices in their pure form (p. 1, para. 2, through p. 3, para. 1). As explained by the appellant in the paragraph bridging pp. 3 and 4 of his Reply Brief, the “beverage, as claimed, is essentially limited to orange juice and tomato juice made from concentrates and has a mild, but pleasant and distinct taste.”<sup>6</sup> In our view, when the claims on appeal are read in light of the specification, the phrase “consisting essentially of” in the present claims excludes the sugar and mint leaves taught by Tarr.

The examiner has not provided any teaching or suggestion in the prior art to omit

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<sup>5</sup> See also, PPG Industries Inc. v. Guardian Industries Corp., 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-1354 (C.A.F.C. 1998), wherein the Federal Circuit noted that by using the term “consisting essentially of” the claim drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention.

<sup>6</sup> At least some of the claims also provide for one or more of ascorbic acid, preservatives, soda water, and mineral water.

the sugar and mint leaves from the Tarr reference. As the appellant correctly notes, the Tarr process has no intermediate step in which only tomato juice and orange juice are present without the sugar or mint leaves. Sugar and mint also are strong flavorings, and no suggestion is seen in Tarr for removing those flavorings. To the contrary, Tarr designated her drink as “**Minted** Tomorange-Ade” (emphasis added). None of the other prior art of record, either alone or in combination, suggests a beverage consisting essentially of tomato and orange juices from concentrates. Only through impermissible hindsight, therefore, would one skilled in the art have chosen the tomato and orange juices taught by Tarr, while at the same time excluding the sugar and mint leaves also taught by that reference, to arrive at the invention consisting essentially of the components presently claimed.

NEW GROUND OF REJECTION UNDER 37 CFR 1.196(B)

Pursuant to the provisions of 37 CFR 1.196(b), we make the following new grounds of rejection.

Claims 2, 4, 5, 7, and 8 are rejected under 35 USC 112, second paragraph, as being indefinite.

Claims 2 and 5 are unclear as to whether the percentages of sodium benzoate and

potassium sorbate are by weight or by volume with respect to the beverage or the preservative. In light of the specification at p. 5, lines 7-10, and at p. 6, lines 1-6, it appears that appellant intended the claims to read as if -- , by weight of the beverage, -- was inserted after “comprises”.<sup>7</sup> Clarification is needed.

Claims 4 and 8 are unclear as to whether the percentages and portions, respectively, are by volume or by weight. Again, clarification is needed.

Claim 7 recites a “frozen concentrate accordance with claim 6, further comprising in combination a bottle ...”, but it is unclear what physical relationship the bottle of claim 7 has to the composition of claim 6. Claim 7 may be construed as requiring the combination of the frozen concentrate of claim 6 and the bottle as part of a kit. See p. 4, para. 2, of the specification. Alternatively, Claim 7 may be construed as simply requiring the presence of the frozen concentrate and bottle in the same store in an unassociated manner. Clarification is needed on this point as well.

### CONCLUSION

The rejection of claims 1-12 is reversed.

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<sup>7</sup> No issue under 35 U.S.C. ' 112, second paragraph, is seen for the use of the term “comprising” in claims 2 and 5, even though they depend from claims 1 and 4, respectively, which have the “consisting essentially of” language. Claims 2 and 5 further limit the invention by providing that the preservative – not the beverage – comprises the recited amounts of sodium benzoate and potassium sorbate. The beverage still consists *essentially* of the components recited in the independent claims.

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This opinion further contains new grounds of rejection pursuant to 37 CFR ' 1.196(b) (amended effective December 1, 1997, by final rule notice, 62 FR 53131, October 10, 1997), which "shall not be considered final for purposes of judicial review." Rule 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<sup>8</sup> as to the rejection claim:

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.

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

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)

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<sup>8</sup> See 37 CFR ' 1.197(c).

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MARY F. DOWNEY )  
Administrative Patent Judge )

WILLIAM F. SMITH )  
Administrative Patent Judge )

ADRIENE LEPIANE HANLON )  
Administrative Patent Judge )

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