

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOO H. SONG, CHRISTAFOR E. SUNDSTROM,
DAVID W. RECORD, DONALD J. TOWNSEND,
KEVIN B. BRODERICK, and PHILIP G. SCHNELL

Appeal No. 1998-0419
Application No. 08/526,534

ON BRIEF¹

Before WARREN, TIMM, and DELMENDO, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 20, which are all of the claims pending in the above-identified application. We affirm in part.

¹ A hearing was originally scheduled for 1:00 PM, October 23, 2001, but the appellants ultimately waived the hearing on October 22, 2001. (Papers 20-22.)

The subject matter on appeal relates to a method of continuously manufacturing a chewing gum (claims 1-4, 6-10, 12-17, 19, and 20) and to a chewing gum product (claims 5, 11, and 18). Further details of this appealed subject matter are recited in illustrative claims 1, 5, 6, 12, 19, and 20 reproduced below:

1. A method of continuously manufacturing a chewing gum without requiring separate manufacture of a chewing gum base comprising the steps of:
adding chewing gum ingredients to a high efficiency continuous mixer, at least one of the ingredients is added to the high efficiency continuous mixer through a feed port of the high efficiency mixer that is not adjacent to a conveyor element.

5. A chewing gum product manufactured according to the method of Claim 1.

6. A method of continuously manufacturing a chewing gum without requiring separate manufacture of a chewing gum base comprising the step of adding chewing gum ingredients to a high efficiency continuous mixer that includes mixing elements and at least one feed port that includes adjacent thereto a mixing element.

12. A method of continuously manufacturing chewing gum without requiring separate manufacture of a chewing gum base, comprising the steps of:
a) adding at least an elastomer and filler into a high efficiency continuous mixer, and mixing the elastomer and filler together in the continuous mixer;
b) adding a [sic] least one ingredient selected from the group consisting of fats, oils, waxes and elastomer plasticizers into the continuous mixer and mixing said ingredient with the elastomer and filler in the continuous mixer;
c) adding at least one sweetener and at least

one flavor into the continuous mixer, and mixing said sweetener and flavor with the remaining ingredients to form a chewing gum product; and

d) wherein at least one of the ingredients is added through a feed port that is located adjacent to a mixing element.

19. A method of continuously manufacturing chewing gum without requiring separate manufacture of a chewing gum base, comprising the steps of:

a) adding at least an elastomer and filler into a high efficiency continuous mixer that includes a screw and having mixing and conveyor elements and has at least one feed port that is not adjacent to a conveyor element;

b) adding at least one sweetener and at least one flavoring agent into the elastomer and filler in the continuous mixer;

c) subjecting at least the sweetener, flavoring agent, elastomer and filler to distributive mixing in the continuous mixer, to form a chewing gum product; and

d) continuously discharging the chewing gum product from the mixer.

20. A method of continuously manufacturing chewing gum without requiring separate manufacture of a chewing gum base, comprising the steps of:

a) adding at least an elastomer and filler into a mixer that includes mixing and conveyor elements, and mixing the elastomer and filler together;

b) adding at least one ingredient selected from the group consisting of fats, oils, waxes and elastomer plasticizers into the mixer, and mixing said at least one ingredient with the elastomer and filler using blades and pins;

c) adding at least one sweetener and at least one flavor into the mixer, and mixing said sweetener and flavor with the remaining ingredients to form a chewing gum product; and

d) wherein one of the ingredients is added to the mixer through a port that is not located adjacent a conveyor element.

The examiner relies on the following prior art reference as evidence of unpatentability:

Song et al.	5,486,366	Jan. 23, 1996
(Song)		(filed Oct. 14, 1993)

Claims 1 through 13, 16, and 18-20 on appeal stand rejected under 35 U.S.C. § 102(e) as anticipated by Song. (Examiner's answer, pages 4-5.) Separately, claims 14, 15, and 17 on appeal stand rejected under 35 U.S.C. § 103 as unpatentable over Song. (Examiner's answer, pages 5-6.)²

We cannot uphold the 35 U.S.C. § 102(e) rejection of claims 1 through 4, 6 through 10, 12, 13, 16, 19, and 20 as anticipated by Song and the 35 U.S.C. § 103 rejection of claims 14, 15, and 17 as unpatentable over Song. We affirm, however, the rejection under 35 U.S.C. § 102(e) of product-by-process claims 5, 11, and 18 as anticipated by Song.

We start with the claim language. Gechter v. Davidson, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). It is true that in proceedings before

² The provisional rejection under the judicially created doctrine of obviousness-type double patenting rejection of claims 1, 5, 19, and 20 as unpatentable over claims 1, 5, 6, 10, 11, and 13 of copending application 08/527,018 (final Office action, paper 8, pp. 2-3) has been withdrawn. (Advisory action of June 13, 1997, paper 12.)

the U.S. Patent and Trademark Office (PTO) claims must be interpreted by giving words their broadest reasonable meanings in their ordinary usage, taking into account the written description found in the specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). But conversely, the interpretation of the claim language must be "reasonable in light of the totality of the written description." In re Baker Hughes Inc., 215 F.3d 1297, 1303, 55 USPQ2d 1149, 1153 (Fed. Cir. 2000).

In the present case, we find that the specification enlightens one skilled in the relevant art to the fact that the methods recited in appealed claims 1, 6, 12, 19, and 20, the only independent claims on appeal, necessarily require the manufacture of a chewing gum product in a single mixer. (Specification, page 3, lines 3-9; page 7, lines 7-10; page 8, lines 30-34; page 18, lines 21-23; page 35, lines 24-30.) Nothing in the specification would have indicated to one skilled in the relevant art that the invention encompassed methods in which the chewing gum base discharged from a mixer is further mixed with other chewing gum ingredients to form a chewing gum product.

Having construed the claim language, we now consider the examiner's rejections. The examiner's position is as follows:

It should be noted that although Song et al. directs the teachings to the manufacture of gum base, Song et al. also teaches that once the gum base has been produced, the output of the produced gum base can used [sic, can be used] to supply a continuous chewing gum production line.

(Examiner's answer, page 4.)

Although the examiner is correct in stating that Song teaches the production of chewing gum using the gum base output of the continuous mixer (column 2, line 49 to column 3, line 11; column 4, lines 23-25), such a method for producing chewing gum using multiple mixing devices is not encompassed by the appealed claims as we have discussed above. Accordingly, we reverse the examiner's 35 U.S.C. § 102 rejection of method claims 1 through 4, 6 through 10, 12, 13, 16, 19, and 20 as anticipated by Song. Concerning the 35 U.S.C. § 103 rejection of claims 14, 15, and 17, this rejection is also not tenable because the modification of Song's method to include the recited L/D ratios would not result in a method encompassed by the appealed claims.

The examiner's rejection under 35 U.S.C. § 102 of product-by-process claims 5, 11, and 18 stand on different footing.³ The examiner held:

As to claims 5, 11 and 18, these claims are product-by-process [claims] and as such the patentability is based on the product itself, even though the claims are limited and defined by the process. Therefore, unless proven otherwise, the instant products are not different from that produced in the reference to Song et al. regardless [of] the method of production.

(Examiner's answer, page 5.)

We agree with the examiner's analysis. Our reviewing court has held that if a product recited in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a process that is different from the process recited in the claims. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

In In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977), the predecessor of our reviewing court explained as follows:

³ The appeal brief does not include a statement that claims 5, 11, and 18 are separately patentable from each other. Nor is there any argument supporting the separate consideration of these claims. We therefore limit our discussion as to the rejection of these product-by-process claims to claim 5. See 37 CFR § 1.192(c)(7)(1997).

Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product...Whether the rejection is based on "inherency" under 35 USC 102, on "prima facie obviousness" under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. [Citations and footnotes omitted.]

Applying these principles, we share the examiner's view that there is substantial evidence to support a prima facie case of anticipation, which has not been adequately rebutted by the appellants. As we noted above, Song teaches chewing gum products made directly from the chewing gum base exiting the continuous mixer. Further, Song teaches that chewing gum typically contains a water-soluble bulk portion and water-insoluble flavoring agents in addition to the gum base. (Column 5, lines 9-15.) These chewing gum ingredients described in Song are identical or substantially identical to the chewing gum ingredients described in the present specification. (Page 15, lines 31-34.) Although Song's teaching is directed to chewing gum made by a process using more than one mixer, the end product would appear to be the same as that recited in appealed claim 5 because the same ingredients are used.

Appeal No. 1998-0419
Application No. 08/526,534

For these reasons and those set forth in the answer, we affirm the examiner's rejection under 35 U.S.C. § 102(e) of appealed claims 5, 11, and 18 as anticipated by Song.

In summary, we reverse the 35 U.S.C. § 102(e) rejection of claims 1 through 4, 6 through 10, 12, 13, 16, 19, and 20 as anticipated by Song. We also reverse the 35 U.S.C. § 103 rejection of claims 14, 15, and 17 as unpatentable over Song. We affirm, however, the rejection under 35 U.S.C. § 102(e) of product-by-process claims 5, 11, and 18 as anticipated by Song.

The decision of the examiner is affirmed in part.

Appeal No. 1998-0419
Application No. 08/526,534

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

CHARLES F. WARREN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CATHERINE TIMM)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
)	
ROMULO H. DELMENDO)	
Administrative Patent Judge)	

rhd/vsh

Appeal No. 1998-0419
Application No. 08/526,534

BELL BOYD & LLOYD LLC
PO BOX 1135
CHICAGO IL 60690-1135