

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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TOVE SKELBAEK and STEEN ANDERSEN

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Appeal No. 1998-2536  
Application No. 08/710,690

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ON BRIEF

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Before KIMLIN, OWENS and JEFFREY T. SMITH, *Administrative Patent Judges*.  
JEFFREY T. SMITH, *Administrative Patent Judge*.

***DECISION ON APPEAL***

Applicants appeal the decision of the Primary Examiner finally rejecting claims 1 to 6, 16 to 18, 25 and 26.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 134.

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<sup>1</sup> The subject matter of claims 22 to 24 has been indicated as allowable by the Examiner. The subject matter of claims 7 and 19 to 21 has been indicated as containing allowable subject matter. However, these claims depend upon a rejected claim and stand objected to. (Paper no. 22, p. 3.)

### ***BACKGROUND***

Appellants' invention relates to a microencapsulated oil or fat product. The microencapsulated product contains at least 10% by weight of at least one highly unsaturated fatty acid. The fat or oil is dispersed in a caseinate matrix material. In one embodiment, the microencapsulated product has an average diameter of less than or equal to 2Fm and is said to be stable for at least one year. The microencapsulated product can be used in foods such as infant formulas, health functional foods and pharmaceuticals. (Specification, p. 4a.) Claims 1, 16 and 17, which are representative of the claimed invention, appear below:

1. A dried microencapsulated oil or fat product, comprising at least one oil or fat is dispersed in the matrix material as particles or drops having an average diameter of less than or equal to 2Fm, the oil or fat containing at least 10% by weight of highly unsaturated fatty acid, the level of free fatty acids being below 5.0% by weight, and the matrix material consisting of caseinate, said microencapsulated oil or fat product being stable for at least one year.

16. An edible fat product for incorporation into a dry or wet formula suitable for feeding infants, said product comprising a dried microencapsulated oil or fat product wherein the oil or fat contains at least 10% by weight of highly unsaturated fatty acids which is dispersed in a matrix material comprising caseinate.

17. A pharmaceutical composition comprising a dried microencapsulated oil or fat product wherein the oil or fat contains at

least 10% by weight of highly unsaturated fatty acids which is dispersed in a matrix material comprising caseinate, and a pharmaceutically acceptable carrier.

***CITED PRIOR ART***

As evidence of unpatentability, the Examiner relies on the following reference:

Janda et al. (Janda)	WO92/05708	Apr. 16, 1992
(Published PCT application)		

The Examiner rejected claims 1 to 6, 16 to 18, 25 and 26 under 35 U.S.C. § 103(a) as obvious over Janda.<sup>2</sup> (Answer, p. 3.)

We reverse the aforementioned rejection. We need to address only the independent claims, i.e., claims 1, 16 and 17.

The Appellants' claims 1, 16 and 17 all require the oil or fat, that is dispersed in the matrix material, to contain at least 10% by weight of highly unsaturated fatty

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<sup>2</sup> The Appellants, in the Brief, have inadvertently referred to the Janda reference as US 5,013,569. (Brief, p. 2.) The Examiner in both the Final Rejection and the Answer has rejected the claims over the WO92/05708 Janda document. The Appellants have not indicated, by filing a Reply Brief, the Examiner was in error. Therefore, we will address the rejection as presented by the Examiner.

acid, and caseinate to be the matrix material. According to the specification, page 8, highly unsaturated fatty acids refers to “nutritionally valuable fatty acids having at least 18 carbon atoms and having at least 3 double bonds.” Claim 1 also requires the oil or fat to have an average diameter of less than or equal to 2Fm and the level of free fatty acids to be below 5.0% by weight. Claim 17 requires the matrix material to also contain a pharmaceutically acceptable carrier.

Janda describes a microencapsulation process wherein a liquid or solid material is dispersed in a protein coating. Janda discloses the microcapsules may range in size from submicron in diameter to several millimeters. (Page 1.) Various oils are disclosed to be suitable for use as the core material. (Page 4.) Caseinate is disclosed to be suitable for use as the coating material. (Page 7.) Janda discloses the microencapsulation product is suitable for use in the food industry and in pharmaceuticals. (Page 1.) Janda does not disclose the core material contains at least 10% by weight of highly unsaturated fatty acid as required by claims 1, 16 and 17. Janda also does not disclose that the fat or oil core material has an average diameter of less than or equal to 2Fm or that the level of free fatty acids is below 5.0% by weight as required by claim 1.

To remedy the deficiencies in Janda, the Examiner asserts it would have been obvious to “substitute the unsaturated fatty acids from marine oil for the oils of the reference because these oils are seen to be nutrient type oils.” (Answer, p. 4.) The Examiner also urges that the selection of a particular oil is an “obvious matter of choice”. (Answer, p. 5.) The Examiner has not directed us to the portion of Janda which discloses marine oils are “nutrient type oils.” Further, the Examiner has not identified “marine oils” as highly unsaturated fatty acids having at least 18 carbon atoms and having at least 3 double bonds.

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The Examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

The Examiner has not provided the required explanation as to how the applied prior art itself would have fairly suggested, to one of ordinary skill in the art, to form

the microencapsulated products of Janda wherein the core material contains at least 10% by weight of highly unsaturated fatty acid.

Accordingly, we conclude that the Examiner has not carried the burden of establishing a *prima facie* case of obviousness for the inclusion of at least 10% by weight of highly unsaturated fatty acid in the matrix material as recited in the Appellants' claims 1, 16 and 17. Hence, we reverse the rejection of claims 1 to 6, 16 to 18, 25 and 26.

***DECISION***

The rejection of claims 1 to 6, 16 to 18, 25 and 26 under 35 U.S.C. § 103(a) as obvious over Janda is reversed.

**REVERSED**

EDWARD C. KIMLIN  
*Administrative Patent Judge*

TERRY J. OWENS  
*Administrative Patent Judge*

JEFFREY T. SMITH  
*Administrative Patent Judge*

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