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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/853,656	09/11/2007	Catherine Dorothea MAUREL	81455-6460	3406
108145	7590	02/26/2013	EXAMINER	
Winston & Strawn I.P. 1700 K Street, N.W. Washington, DC 20006			DEES, NIKKI H	
			ART UNIT	PAPER NUMBER
			1791	
			NOTIFICATION DATE	DELIVERY MODE
			02/26/2013	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CATHERINE DOROTHEA MAUREL,  
ANH LE, JEROME BARRA, and CHRISTIAN STARKEMANN

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Appeal 2011-010497  
Application 11/853,656  
Technology Center 1700

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Before BRADLEY R. GARRIS, BEVERLY A. FRANKLIN, and  
GRACE KARAFFA OBERMANN *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek relief pursuant to 35 U.S.C. § 134 from the following final rejections entered under 35 U.S.C. § 103(a): Claims 1, 2, 7-9, and 11 over Yoshida (English translation of JP 60-075427, pub. April 27, 1985); and claims 12-22 over Yoshida in view of Robinson (*Encyclopedia of Food Microbiology* (2000 Ed., R.K. Academic Press, San Diego, CA pp. 1710; 1729-1736; 1769-1774)).<sup>1</sup> We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

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<sup>1</sup> In an advisory action mailed February 1, 2011, the Examiner indicates that an amendment filed January 10, 2011, overcomes a rejection of claim 15 under 35 U.S.C. § 112, second paragraph, which should be withdrawn in the event of further prosecution. *See* App. Br. 2; Ans. 4; Reply Br. 1.

Appellants argue a first claim group directed to a composition comprising a hot component (i.e., eugenol), a cooling component (i.e., menthol), a bitter component (i.e., sequesterpenic lactone, humulone, or lupulone), and an acid component (i.e., lactic acid). App. Br. 7-11; *see* claims 1, 2, 7-9, and 11-17. Appellants argue a second claim group directed to a composition consisting essentially of these four components and an additional fifth component (i.e., alcohol). App. Br. 10-13; *see* claims 18-22.

Appellants raise the same arguments for the first and second claim groups, pointing out that the first group comprises four components whereas the second group consists essentially of five components. App. Br. 7-13; *compare* claim 1 to claim 18. Our analysis of claim 18 is dispositive of all issues raised in this appeal. Claim 18 reads as follows:

18. A flavor, perfume or skin sensation composition consisting essentially of a first component selected from the group consisting of piperine, pelargonyl vanillyl amide, vanillyl butyl amide, vanillin butyl ether, eugenol, gingerol, polygodial, shogoal, galangal acetate, capsaicin (N-(4-hydroxy-3-methoxybenzyl)-8-methylnonanamide and/or (6E)N-(4-hydroxy-3-methoxybenzyl)-8-methyl-6-nonenamide), capsaicin analogs and mixtures thereof, a second component selected from the group consisting of menthol, menthyl succinate, menthyl lactate, p-menthane-3,8-diol, 8-p-menthen-3-ol, 3-(3'-P-menthanyloxy)-1,2-propanediol, menthone glycerol ketal, 2-(1-methylpropyl)-I-cyclohexanone, N-ethyl-3-Pmenthanecarboxamide, aspartic acid, N-(4-hydroxy-3-methoxybenzyl)nonanamide, 5-[5-(1,3-benzodioxol-5-yl)-I-(1-piperidinyl)-2,4-pentadien-1-one, 6-isopropyl-3,9-dimethyl-1,4-dioxaspiro [4.5] decan-2-one, 2-isopropyl-1-N,2,3-trimethylbutanamide, and, 7-isopropyl-1,4,10-dimethyl-tricyclo[4.4.0.0(1,5)]decan-4-ol, 3-menthyl-3,6-dioxahexanoate, 3-menthylmethoxyacetate, 3-menthyl-3,6,9-trioxadecanoate, 3-menthyl-(2-hydroxyethoxy)acetate, menthyl-11-hydroxy-3,6,9-trioxadecanoate, 3S,5R,6S,9R)-6-isopropyl-3,9-dimethyl-1,4-dioxaspiro[4.5]decan-2-one, (3S,5S,6S,9R)-6-isopropyl-3,9-dimethyl-1,4-dioxaspiro[4.5]decan-2-one, 2,3

-dihydroxypropyl 1 (1 R,2 S,S R)-2-isopropyl 1-S -methylcyclohexanecarboxylate,(3 S,SR,6S,9R)-6-isopropyl-3,9-dimethyl-1,4-dioxaspiro[4.5]decan-2-one, (3 S,SS,6S,9R)-6-isopropyl-3,9-dimethyl-1,4-dioxaspiro[4.5]decan-2-one, (1R,2S,SR)-N-(tert-butyl)-2-isopropyl-1-methylcyclohexanecarboxamide and mixtures thereof, a third component selected from the group consisting of triterpenes, glucosides of monoterpenes, sesquiterpenic lactones, humulone, lupulone, flavonones, quinines, and mixtures thereof, a fourth component selected from the group consisting of citric acid, acetic acid, succinic acid, pyruvic acid, lactic acid, propionic acid, malonic acid, oxalic acid, HCl, H<sub>3</sub>P<sub>0</sub>4 and H<sub>2</sub>S<sub>0</sub>4 and a fifth component of an alcohol, aldehyde, ketal, ester, ether or sulfur compound.

There is agreement that Yoshida discloses a flavor composition comprising eugenol, menthol, and ethanol, which respectively constitute first, second, and fifth components according to claim 18. Ans. 5 (citing Yoshida, Example 1); App. Br. 7. The Examiner finds that Yoshida further discloses the optional inclusion of a bitter component, namely, sesquiterpene lactones (artemisia) or humulone and lupulone (hops), which are identified as suitable third components in claim 18. Ans. 5 (citing Yoshida 5:12, 16).

Appellants disagree, arguing that “no disclosure in Yoshida would motivate a skilled artisan to select artemisia and hops from a listing of over 153 different components that are mentioned as optional additional components in Yoshida.” App. Br. 7; *see* Reply Br. 1 (Examiner picks and chooses “from within large laundry lists of compounds” in Yoshida). In Appellants’ view, a skilled artisan would “need to conduct significant testing of many different possible combinations of components” disclosed in Yoshida in order “to stumble across the” claimed invention. App. Br. 9.

Appellants’ argument is unconvincing because, although it may be insufficient to constitute a description within the meaning of 35 U.S.C.

§ 102, “picking and choosing [from a prior art disclosure] may be entirely proper” in the context of an obviousness rejection under 35 U.S.C. § 103. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972). For example, in *Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 806-807 (Fed. Cir. 1989), our reviewing court concluded that a diuretic combination of amiloride and hydrochlorothiazide would have been obvious in view of prior art that disclosed 1200 combinations, one of which was the claimed combination.

In our opinion, *Merck* is controlling here. The fact that Yoshida “discloses a multitude of effective combinations does not render any particular formulation less obvious.” *Id.* at 807. “This is especially true because the claimed composition is used for the identical purpose taught by” Yoshida, namely, as a flavor composition. *Id.* (citations omitted); *compare* claim 18 (directed to “[a] flavor, perfume or skin composition”) to Yoshida, Title, Claims 1-2 (directed to a flavor composition).

Appellants point out that “Yoshida does not mention or even suggest anything about the ability of artemisia and hops to impart a bitter flavor or any desirability or need to do so.” App. Br. 7. Yoshida’s silence as to the bitter nature of artemisia and hops does not detract from the reference’s express disclosure that these compounds are suitable additives for a flavor composition that includes eugenol, menthol, and ethanol, thus comprising the first, second, third, and fifth components of the composition specified in claim 18. *See* Ans. 5 (citing Yoshida 5:13, 15 and Example 1).

Regarding the fourth specified component, the Examiner concedes that Yoshida does not disclose any of the particular acids specified in claim 18, but finds that the reference does disclose the addition of sorbic

acid, which “is known to be a common food preservative.” *Id.* at 6; *see* Yoshida 7:17 (disclosing optional addition of sorbic acid). The Examiner relies on Robinson to show that sorbic acid, as disclosed in Yoshida, and lactic acid, identified as a suitable acid component in claim 18, were known “organic acids for use as preservatives in foodstuffs.” *Id.* Appellants come forward with no evidence establishing error in that finding. App. Br. 10 (discussing acid component); Reply Br. 1 (“the Examiner asserts that acid preservatives are generally known in the art . . . this is true”). On the contrary, Appellants assert that “Yoshida is satisfied with the use of the well known preservative sorbic acid” and, on that basis, question “what motivation is there to change to a different acid?” Reply Br. 2.

Where two known alternatives are recognized as interchangeable for a desired function, an express suggestion to substitute one for the other is not needed to render a substitution obvious. *In re Fout*, 675 F.2d 297, 301 (CCPA 1982); *In re Siebentritt*, 372 F.2d 566, 568 (CCPA 1967). The Examiner thus shows that it would have been *prima facie* obvious to substitute one known food preservative (lactic acid) for another (sorbic acid) in Yoshida’s flavor composition. Ans. 6. On this record, the Examiner establishes a *prima facie* case that claim 18 is unpatentable over Yoshida.

A question remains whether Appellants come forward with evidence of unexpected results sufficient to rebut that *prima facie* case. In this regard, Appellants advance taste test results “established with a panel of at least 15 tasters” purporting to show “that by preparing a composition comprising at least a hot component, a cooling component, and a bitter component, a clear hot and/or warming sensation was provided, which is devoid of oily off-

notes and further undesired characteristics.” *Id.* (quotation omitted); *see, e.g.*, Spec. 2:17-20; 3:19-24; 12:23-15:18. A preponderance of evidence, however, supports the Examiner’s observation that Appellants’ comparative data is limited to “compositions comprising a single hot component” and, therefore, is not commensurate in scope with the closest prior art. Ans. 8; *see* Spec. 13:6-8 (inventive composition is “compared to a single ingredient like a capsicum oleoresin”); Spec. 14:11-12 (comparing inventive composition to “candies comprising capsicum oleoresin”); Spec. 15:13 and Table 1 (comparing inventive composition to cinnamon tablet). On this record, the evidence of unexpected results is insufficient to rebut the prima facie case of obviousness because no showing is made that Yoshida’s composition “does not function as the claimed composition.” Ans. 10; *see In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991) (evidence of unexpected results is persuasive only where the results are “shown to be unexpected compared with the closest prior art”) (citation omitted).

We have considered Appellants’ other arguments but none warrant reversal of the Examiner’s rejection. For the reasons stated above and in the Answer, we affirm the decision of the Examiner.

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

AFFIRMED

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