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UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT TRIAL AND APPEAL BOARD

Ex parte NESTEC S.A.
(Application 11/720,254)

Appeal 2011-013350
from Technology Center 1700
Bhaskar Mukhopadhyay, Examiner

HEARD: 15 January 2013

Before RICHARD TORCZON, MICHAEL P. COLAIANNI and
GRACE KARAFFA OBERMANN, *Administrative Patent Judges*.

TORCZON, *Administrative Patent Judge*.

DECISION ON APPEAL

The appellant (Nestec) seeks relief from the final rejection of claims 1-12.
We AFFIRM.

OPINION

BACKGROUND

Nestec discloses "edible containers for foodstuffs and to a process for
preparing them."¹ Claims 1 and 9 (containers) and 10 (method of making) are

¹ Spec. 1:5-6. "Spec." means the amended specification filed 25 May 2007.

independent. The contested limitations are common to all three independent claims excepted as noted. Claim 1 defines the invention as follows:²

An open-ended edible container for foodstuffs comprising cereals and/or fruits in a sheet *consisting essentially of an inner surface of the container having a very lightly patterned surface comprising a network of lines that raise [sic, are raised] over the inner surface or grooves that are depressed under the inner surface, and an outer surface having a smooth texture with embedded flakes.*

"Consisting essentially of" requires the sheet to have the inner surface and outer surface stated, but is also open to the inclusion of an unstated structure or material provided it would not fundamentally change the character of the sheet.³ Nestec has not pointed to an express definition of "sheet" delimiting its fundamental character. Significantly, "consisting essentially of" introduces surfaces, not the internal structure of the sheet. Consequently, this transitional phrase does not limit the internal structure of the sheet as long as the result remains sheet-like.

The overall container (that is, apart from the sheet) uses "comprising" as the transition, which means that the container is open to the inclusion of another structure or material,⁴ including additional layers. Claim 10 (the method claim) does not include the "consisting essentially of" transition and its "comprising" transition refers to the steps of the method, which permits the addition of other layers.

² Br. 30 (Claims Apx.). All claim language comes from the claims appendix in Nestec's brief. Indenting has been added, consistent with 37 C.F.R. § 1.75(i), and emphasis has been added for contested language.

³ *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948). This phrase is more common in composition claims, rather than apparatus claims.

⁴ *Id.*

The specification defines "very lightly patterned" to mean:⁵

that the network of lines which [are raised] over the inner surface of the container or of grooves which are depressed under the said surface is very light in order to allow for uniformly applying of a protective fat-based coating onto the surface.

The definition does not provide additional structural detail, but indicates a functional requirement that the very light pattern permit uniform application of a fat-based coating to the pattern. For example, it does not explain how the pattern contributes to uniformity (as opposed to, for example, improved adhesion). It is not even clear from the definition whether "very lightly" refers to the height, the density or some other aspect of the pattern.

Even assuming that "very lightly" means "having little height", the functional definition does not appear to imply any structural limitation since fat-based coatings may be very thin (e.g., highly unsaturated fats (oils)) or very thick (e.g., highly saturated fats (shortenings)). Indeed, the definition does not even require the uniform coating, it only requires that the pattern allow for a uniformly applied coating. Moreover, "uniformly" could refer to completeness of coverage or to smoothness of the resulting coat. The plain language of the claim and the definition do not require any of these interpretations; hence, it is most appropriate to interpret "very lightly patterned" broadly to include all of these possibilities. The lines and grooves are listed with the word "or", which means broadly that lines alone, grooves alone or both together would meet the limitation.

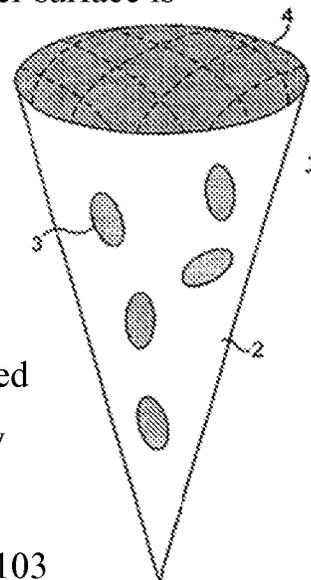
Nestec has not pointed us to a special definition in the specification or in the art "smooth texture" so we accord the term its ordinary meaning.⁶ The phrase "having a smooth texture", however, refers to the outer surface itself, not to the

⁵ Spec. 4:24-30.

⁶ *In re Am. Acad. of Sci. Tech Center*, 367 F.3d 1359, 1365-66 (Fed. Cir. 2004).

internal properties of a material forming the surface. The claim language is ambiguous in that it is not clear whether the smoothness of the outer surface is affected by the embedded flakes because the "with" clause appears after the outer surface is defined to have a smooth texture.

Nestec Figure 1 (right) is a perspective view of one embodiment of the invention.⁷ The figure shows a wafer 1 rolled into a cone with a smooth exterior surface 2 having embedded sliced almonds 3 and with a lightly patterned internal surface 4 uniformly coated with chocolate as a moisture barrier.⁸



The examiner maintains a set of rejections under 35 U.S.C. 103 using the combinations⁹ shown in the following table:

Claims	Prior art patents
1 & 5	Ferrero ¹⁰ and Denaro ¹¹
2 & 3	<ul style="list-style-type: none"> ⌘ Ferrero, Denaro & Frediani¹² or ⌘ Denaro, Frediani, Der Beek¹³ & Swiss¹⁴ or ⌘ Denaro, Frediani & Rosso¹⁵
1, 4, 5 & 8	Der Beek, Swiss & Denaro
1, 5 & 9	Rosso and Denaro
6	⌘ Rosso, Denaro & DeStephen ¹⁶ or

⁷ Amdt. to Spec. (9 October 2009).

⁸ Spec. 9:29-33.

⁹ Ans. 5-7.

¹⁰ P. Ferrero, *Food product comprising a wafer shell and a creamy filling with a caramel core and process for producing the same*, U.S. Pat. 6,103,279 (2000).

¹¹ J. Denaro, *Edible container for ice cream*, U.S. Pat. 1,637,556 (1927).

¹² N. Frediani, *Confection*, U.S. Pat. U.S. Pat. 2,167,353 (1939).

¹³ D.V. Der Beek, *Edible cone and apparatus and method for making same*, U.S. Pat. 5,336,511 (1994).

¹⁴ S.R. Swiss, *Edible product and package therefor*, U.S. Pat. 2,077,595 (1937).

¹⁵ R. Rosso, *Food product with a filling and a method of producing it*, U.S. Pat. 6,024,995 (2000).

	¶ Ferrero, Denaro & DeStephen
7	Rosso, Denaro & Huang ¹⁷
10	Der Beek, Denaro & Ito ¹⁸
11 & 12	Der Beek, Denaro, Ito & Goldstein ¹⁹

FACTS AND FINDINGS

[1] Ferrero discloses a structure for a food product with a shell and a creamy filling.²⁰

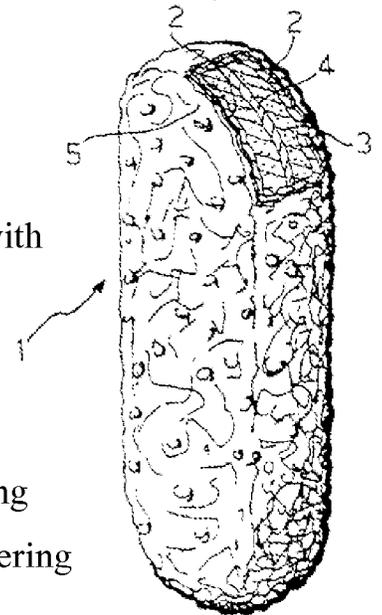
[2] Ferrero Figure 4 (right) is a perspective view of an embodiment with a portion removed.²¹

[3] The product **1** has a casing of two wafer half shells **2, 2** with a coating layer **5**, a core **4** and a filling **3**.²²

[4] The coating layer **5** may be chocolate.²³

[5] The coating layer **5** is preferably two coatings: a bottom coating with chopped hazelnuts incorporated and a top coating without hazelnuts that seals the first coating, completely covering any exposed nuts.²⁴

[6] The examiner found that the outer coating of chocolate is smooth.²⁵



¹⁶ S. DeStephen, C. Budwig & E. Best, *Chocolate or compound coating with unique texture*, US 6,251,448 B1 (2001).

¹⁷ V.T. Huang et al., *Food product with enhanced crispiness*, US 6,824,799 B1 (2004).

¹⁸ S. Ito, *Method of producing an edible container*, U.S. Pat. 5,298,273 (1994).

¹⁹ W.J. Goldstein, *Conical food article and process for making same*, U.S. Pat. 5,626,897 (1997).

²⁰ Ferrero 1:12-14.

²¹ *Id.* 2:43-44.

²² *Id.* 3:15-38.

²³ *Id.* 3:26-27.

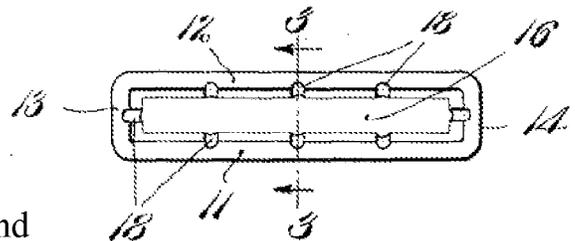
²⁴ *Id.* 3:27-36.

It is not entirely clear if the examiner means that chocolate coatings can be smooth or if the chocolate forms a smooth contrast to the nuts or if the use of chocolate is in itself sufficient for a surface to be smooth. If the examiner means that the outer coating of Ferrero's preferred embodiment including the chopped nuts, as illustrated in Figure 4, provides "an outer surface having a smooth texture with embedded flakes", a person having ordinary skill in the art would likely not agree. While the *consistency* of chocolate in itself may be smooth, a person having ordinary skill in the art would not understand Ferrero's outer *surface* with the embedded nuts to have a smooth texture or consistency.

We note that smooth chocolate coatings are common in confectionery. A person having ordinary skill in the art would understand at least Ferrero's chocolate-only coating to at least suggest a smooth outer surface. While Ferrero illustrates an embodiment with a rough outer coating with nuts, a rough coating is not an essential feature of Ferrero's disclosure. It would be within the skill of the art to make the chocolate-nut coating itself smooth by adjusting the shape and size of the nuts or by thickening the second chocolate coating.

[7] Denaro discloses edible containers for ice cream and other fillers for use in lieu of conventional cones and sandwiches.²⁶

[8] Denaro Figure 2 (right) provides a top plan view of an embodiment.²⁷



[9] Denaro's container has front **11**, rear **12** and side **13**, **14** walls, an open top end **16** and grooves **18** in the walls.²⁸

²⁵ Final Rej.

²⁶ Denaro 1:1-16.

²⁷ *Id.* 1:29.

²⁸ *Id.* 1:39-58.

We note that the outer walls of Denaro's container appear to be smooth in Figure 2 and in Figure 3 (not shown), while Figure 1 (not shown) partially shows unlabeled apparently decorative patterning on one wall.

We find that a person having ordinary skill in the art would have known that decorative patterning is optional.

[10] Denaro's grooves **18** facilitate the introduction of the filling into the container by permitting an outlet for air that would otherwise be trapped.²⁹

We find the grooves would provide a similar advantage if a relatively thick, fat-based coating were applied to the inner surface because the grooves would allow egress of air that would otherwise be trapped under the coating and create disuniformity (e.g., bubbles) in the fat-based coating.

[11] Rosso teaches a food product with a shell formed of two distinct materials, a soft filling within the shell and an outer coating, and a method to produce them.³⁰

[12] Rosso contemplates two half-shells with varying compositions and characteristics, joined at their open ends to encase a soft filling.³¹

[13] The half-shell may be a moldable food such as chocolate (optionally with added ingredients, including hazelnuts) or a wafer with high sugar content.³²

[14] For example, the half-shells may be a chocolate hemisphere and a wafer basin with a flat bottom.³³

[15] The product may optionally have additional fillings or outer coverings.³⁴

²⁹ *Id.* 1:58-62.

³⁰ Rosso 1:6-9.

³¹ *Id.* 1:46-50.

³² *Id.* 1:50-55.

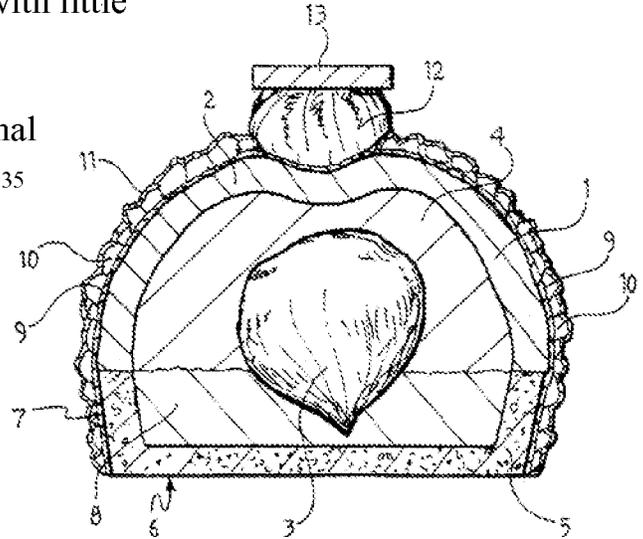
³³ *Id.* 1:57-60.

³⁴ *Id.* 1:65-67.

We find that Rosso suggests a person having ordinary skill in the art would have been comfortable adding structures and materials inside and outside a container, as well as within a moldable shell, with little additional guidance.

[16] Rosso Figure 12 (right) is a cross sectional view of an embodiment of Rosso's product.³⁵

[17] The embodiment is a praline with a chocolate half-shell 1 and a wafer half-shell 5, multiple fillings 3, 4, 8 and various coatings and decorations 9-13.³⁶



We note that while the combined half-shells create a closed container, each half-shell is itself an open-ended container. With the two half-shells joined, the container shell has a cereal (in the wafer) and, optionally, embedded hazelnuts (in the chocolate), but is no longer open-ended.

[18] The product may optionally have an outer coating of particulate matter or the particulate matter may be incorporated between successive layers of the outer coating.³⁷

[19] The particulate coating may be achieved by sprinkling the particulate matter, such as chopped hazelnuts or grated coconut, onto a chocolate coating before the coating has set.³⁸

[20] The examiner finds that Rosso does not teach inner surface patterning.³⁹

[21] Der Beek discloses an edible cone adapted to contain edible contents.⁴⁰

³⁵ *Id.* 3:1-3.

³⁶ *Id.* 4:66-5:5.

³⁷ *Id.* 2:1-5.

³⁸ *Id.* 4:32-46.

³⁹ Final Rej. 9.

[22] Der Beek acknowledges that the art, including apparatus and methods for making edible cones, is long-established.⁴¹

[23] The cone may edible particulates (including herbs and granulated onion) embedded on the outer surface.⁴²

[24] The cone may comprise cereal materials.⁴³

[25] Der Beek Figure 4 (right) is perspective view of a cone with an open end and a portion of the exterior surface removed.⁴⁴

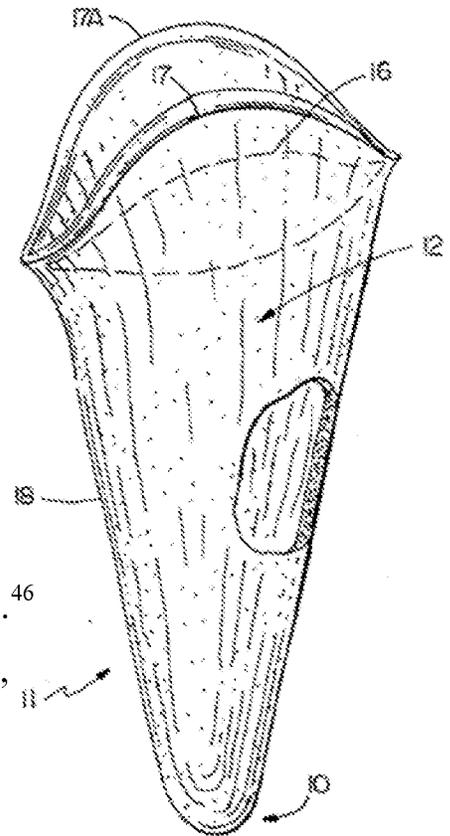
[26] Der Beek's preferred embodiment is a savory (as opposed to sweet) product, with a double-shelled or pita-like body portion **11**.⁴⁵

[27] The examiner finds that Der Beek does not teach a smooth outer surface or patterning on the inner surface.⁴⁶

[28] Ito relates to a method of producing a shallow dish-, cup- or cone-shaped edible container for frozen confections and similar food products.⁴⁷

[29] The container is made from a farinaceous (cereal-based) batter.⁴⁸

[30] Ito discloses steps for creating a farinaceous cone.⁴⁹



⁴⁰ Der Beek 2:3-4.

⁴¹ *Id.* 1:6-8.

⁴² *Id.* 2:36-37; 7:6-21.

⁴³ *Id.* 2:41-47; 5:5-8.

⁴⁴ *Id.* 5:28-29.

⁴⁵ *Id.* 6:39-68.

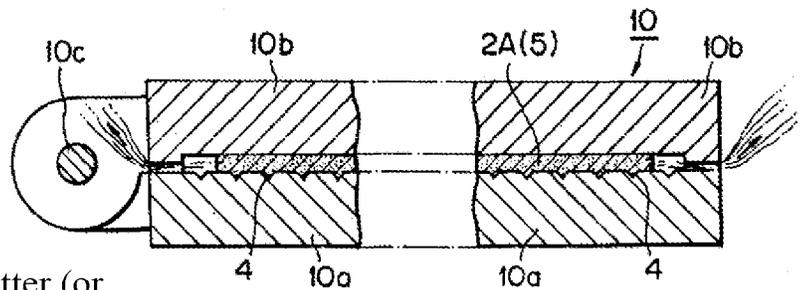
⁴⁶ Final Rej. 5.

⁴⁷ Ito 1:58-62.

⁴⁸ *Id.* 2:61-66.

⁴⁹ *Id.* 4:1-6:14.

[31] Ito Figure 3A (right) is a cross-sectional view showing a baking apparatus.⁵⁰



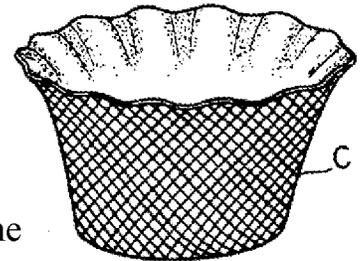
[32] A heating plate **10** has heating platens **10a**, **10b** with batter (or molded sheet **5**) sandwiched between them.⁵¹

[33] The heating plate **10** may have a grid pattern **4**.⁵²

Figure 3A shows a shallow grid on only the bottom platen, while the top platen is flat.

[34] The molded sheet **5** may be subsequently shaped into an edible container **C** before a final baking step.⁵³

[35] Ito Figure 10 (right) shows the final cup with the patterning on the outer surface.



Given the focus of the issues on appeal, the details of the remaining references are not necessary to the disposition of this case.⁵⁴

ANALYSIS

A claim that is narrowly and specifically drawn must nevertheless meet the requirements for patentability.⁵⁵ Nestec contends that the combined art does not teach or suggest the narrow and specific limitations of the sheet: that the sheet consist essentially of a very lightly patterned inner surface and a smooth outer surface with embedded flakes. The examiner contends that the contested

⁵⁰ *Id.* 2:31-33.

⁵¹ *Id.* 4:1-15.

⁵² *Id.* 6:30-36.

⁵³ *Id.* 7:39-50.

⁵⁴ *Cf. In re Gorman*, 933 F.2d 982, 985 (Fed. Cir. 1991) (focusing on key references in a thirteen reference rejection).

⁵⁵ *Id.*, 933 F.2d at 987.

limitations are known elements used for known purposes in a predictable manner. Much of Nestec's position comes down to claim interpretation. The words of the claim are not as narrow as Nestec contends.

Consisting essentially of

The transitional phrase "consisting essentially of" is narrowing, but only to the extent that additional elements must not materially change the invention. Nestec has not pointed to authority that "consisting essentially of" means the sheet is a single, homogenous piece. Indeed, the actual limitation refers to the *surfaces* of the sheet. Something must be between the surfaces. It is not clear how an additional element in between the surfaces is necessarily inconsistent with a sheet. For example, adding a second, incompletely mixed batter to achieve a marbled effect would not materially change the nature of the sheet. Similarly, it is not apparent why a sheet must have only a single layer. Nestec has not pointed us to a controlling definition of sheet in the specification or in the art that excludes a multilayer sheet.

Moreover, the "comprising" transition permits additional "non-sheet" layers, such as additional chocolate coatings inside or outside the sheet. These other sheet-like structures would not be considered the container, but if inside the container would be part of the foodstuff being contained. This is particularly important for claim 10, a method of making the container, which does not use the "consisting essentially of" transition, but does use "comprising the steps of", which would permit a step adding a smoothing layer to the container.

In any case, the references discussed above provide numerous examples of homogenous cereal-based cones with smooth or patterned surfaces, on both the inner and outer surfaces, for both functional and non-functional reasons.

Consequently, even with the narrow interpretation Nestec advocates, the sheet is well within the ordinary options known to the art.

Very lightly patterned

Nestec has not provided us with satisfactory guidance on what this term means. Even the functional restriction in the specification (allowing uniform application of a fat-based coating) is unhelpful because it does not imply any specific dimension, density or structure. Nestec has not pointed us to any customary meaning of this phrase. Nestec has not pointed us to any dimensions or specific patterns in the claims against which "very lightly" might be evaluated. To the extent the references can be said to inform the meaning of "very lightly patterned", all of the prior art patterns appear to be smaller in depth compared to the other dimensions of the containers. Some (like Ito) show dense patterns, while others (like Denaro) show sparse patterns.

Denaro teaches grooves sufficient for air to escape the container if it is filled with a pre-shaped filling. The examiner explained how this teaching would be functional relevant to filling Nestec's container. Denaro's functional teaching would also be applicable uniformly applying a fat-based coating if the coating were thick enough to trap air. The grooves do not need to be any deeper than necessary to permit air to pass.

Nestec urges that Denaro's grooves are much larger than Nestec's grooves,⁵⁶ but does not provide evidence to support this attorney argument. Given the lack of guidance from Nestec, we cannot conclude that the examiner prejudicially erred in reading Denaro as showing very light grooves within the meaning of the claims.

⁵⁶ Reply 3.

Having a smooth texture

To the extent that the examiner contends that "smooth texture" means the consistency of the material forming the outer surface, such an interpretation is not reasonable in view of the plain language of the claim: the antecedent of "having a smooth texture" is the outer surface, not the material forming the outer surface. In its reply, however, Nestec argues that there is a "contrast in texture between a smooth surface and a textured, embedded piece of almond",⁵⁷ which seems to support the examiner's contention that "smooth texture" means the consistency of the sheet. At the least, Nestec's statement supports an interpretation that the embedded flakes need not contribute to the smoothness of the outer surface; rather, the flakes can be embedded in contrast to the otherwise smooth surface.

The examiner also urges, however, that the claim is open to a multilayer sheet, which could include a smoothing layer such as chocolate, in which flakes may be embedded partially or fully. Even without a multilayer sheet, those in the art knew that containers could contain other ingredients. For example, in Rosso, the chocolate half of the shell optionally included hazelnuts apart from any additional coatings.

Obviousness

The examiner did not prejudicially err in concluding that the claims would have been obvious. The various contested elements widely recur in the prior art for essentially the same purposes for which Nestec employs them.⁵⁸ The only arguable departure is the claimed "very light patterning", which is shown in Denaro for a different but still relevant purpose.

⁵⁷ Reply 5.

⁵⁸ Cf. *Gorman*, 933 F.2d at 987, citing *Graham v. John Deere & Co.*, 383 U.S. 1, 17 (1966).

The combined disclosures of Ferrero and Denaro teach or suggest the contested features of independent claim 1. Denaro teaches a container with an outer surface that may be smooth or decoratively patterned (or smooth in places and patterned in other places). Denaro teaches an edible open-ended container with inner surface grooves capable of allowing uniform application of a fat-based coating. Ferrero teaches a wafer shell, first coating with flakes and a second coating completely covering the flakes. While Ferrero does not teach that the second coating would be smooth, a person having ordinary skill in the art would appreciate that a smooth coating was an option.

The combined disclosures of Rosso and Denaro similarly teach or suggest the contested features of independent claims 1 and 9. Rosso teaches a wafer shell joined to a chocolate shell that optionally includes hazelnuts. Rosso also teaches additional outer coatings that may include particulates like coconut flakes. Rosso thus suggests incorporation of particulates into a shell (albeit the teaching is for the chocolate moiety, not the wafer moiety) or as an added coating. Denaro teaches internal grooves on a container as discussed above.

For claim 10, Der Beek teaches an edible cone (exemplified by a savory cone with embedded savory particulates). Ito teaches apparatus and methods for making conventional wafer cones or cups, including patterning on only one surface. Denaro teaches internal grooves. Der Beek's preferred embodiment is pita-like, which would be difficult to combine with the teachings of Denaro and Ito, but the teachings and suggestions of Der Beek are not limited to that embodiment.

The dependent claims are rejected as having been obvious from various combinations of these and other references, but Nestec has relied on the limitations already discussed in challenging these rejections as well.⁵⁹

HOLDING

Nestec has not demonstrated prejudicial error in the final rejection of claims 1-12. Accordingly, rejection of the claims is—

AFFIRMED

For the appellant: AARON MARROW, K & L Gates LLP, of Chicago, Illinois, on the telephonic argument. ROBERT M. BARRETT, K & L Gates LLP, of Chicago, Illinois, on the brief.

tc

⁵⁹ *In re Dance*, 160 F.3d 1339, 1340 n.2 (Fed. Cir. 1998).