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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MERRIE MARTIN

Appeal 2012-000477
Application 11/288,374
Technology Center 1700

Before ROMULO H. DELMENDO, MICHAEL P. COLAIANNI, and
GEORGE C. BEST, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*

DECISION ON APPEAL

The named inventor (hereinafter “the Appellant”)¹ seeks our review under 35 U.S.C. § 134(a) of a final rejection of claims 12-21. We have jurisdiction under 35 U.S.C. § 6(b). We affirm. However, we designate our affirmance as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) because our reasoning differs from the Examiner’s in certain respects.²

¹ The Appellant identifies the real party in interest as “Nestec S.A.” Appeal Brief filed March 11, 2011 (“App. Br.”) at 1.

² We heard oral arguments from the Appellant’s counsel on February 5, 2013. A written transcript will be entered into the record in due course.

STATEMENT OF THE CASE

The Appellant claims a method of providing a ready-to-bake dough bar. Representative claim 12 is reproduced below:

12. A method of providing a ready-to-bake dough bar having edges, a top, and a bottom in a pre-defined shape having an outer surface, which bar comprises first, second and third dough portions, which method comprises:

formulating the first, second and third dough portions to each differ in texture and appearance after the dough bar is baked, with the first dough portion formulated to have a first texture, wherein the first dough is sufficiently viscous to retain its pre-defined shape under ambient temperature before baking and while being transferred from a sealed storage package to a baking container having a shape, yet is sufficiently fluid to flow at baking temperatures to conform to the shape of the baking container; and with the second and third dough portions formulated to have second and third different textures after the dough is baked;

associating the dough portions together to form the bar, with the first dough forming a base layer, the second dough forming a second layer disposed over a portion of the base layer and retained on the first dough portion during and after baking to minimize or avoid burning or scorching of the first dough portion; and the third dough disposed around the sides of the second dough forming the edges of the bar to thus form a ready-to-bake parallelepiped-shaped dough product with the second dough portion hidden from view along the bar edges by the third dough portion until and unless the ready-to-bake dough bar is separated along an internal separation zone, which is an internal cross-section of the dough bar that extends from the top to the bottom of the dough bar;

transporting the dough bar to a remote location in the sealed storage package; and

providing instructions which comprise:

removing the ready-to-bake dough bar from the package;

directly placing the dough bar in a baking container without modifying its shape; and
baking the ready-to-bake dough bar.

App. Br. 12 (Claims App'x.).

The Examiner rejected claims 12-21 under 35 U.S.C. § 103(a) as unpatentable over Blaschke³ and Abdelrahman.⁴ Examiner's Answer entered May 12, 2011 ("Ans.") 3-9.

DISCUSSION

The Appellant argues claims 12 and 13 (Group A) separately from claims 14-21 (Group B). App. Br. 6. Accordingly, we select claims 12 and 14 as representative of the two groups, respectively, and confine our discussion to these selected claims. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The key issue in this appeal is whether the Appellant showed reversible error in the Examiner's conclusion that a person of ordinary skill in the art would have been prompted to modify Blaschke's method of providing a dough structure in view of Abdelrahman's teachings to arrive at a method encompassed by claim 12 or claim 14.

The Examiner found that Blaschke describes every limitation of the claims except the reference "do[es] not disclose the second layer is hidden from view along the edge, third dough portion surrounding the second dough portion, separating the layers and instruction for use." Ans. 4. The Examiner relied on Abdelrahman and concluded that "if the second dough layer contains filling or inclusion material and then it is desired to enclose

³ PCT International Publication WO 01/06858 A1 published February 1, 2011.

⁴ U.S. Patent 5,192,564 issued March 9, 1993.

the filling or inclusion so that it does not fall out or gives a surprising end effect, then it would have been obvious to enrobe the second dough layer for such purpose.” *Id.* at 5. Regarding the instructions, the Examiner asserted that “[i]t would have been obvious to include instruction for usage when the product is marketed so that consumers will know how to use the product.” *Id.*

With respect to claim 12, the Appellant argues that:

- 1) “Blaschke does not disclose . . . first, second, and third dough portions which each differ in texture and appearance after the dough bar is baked, with the first dough portion formulated to have a first texture, wherein the first dough is sufficiently viscous to retain its pre-defined shape under ambient temperature before baking while being transferred from a sealed storage package to a baking container having a shape, yet is sufficiently fluid to flow at baking temperatures to conform to the shape of the baking container. . .” (App. Br. 7);
- 2) “one of ordinary skill in the art would not be motivated to modify the teachings of Blaschke to formulate doughs with different baking properties” (*id.*);
- 3) “using vertically adjacent layers of different textures and compositions advantageously permits ‘the dough bar to better retain its structure by minimizing or preventing any materials from escaping the dough bar structure’” (*id.* (quoting Spec. 16, ll. 8-10));
- 4) “Blaschke does not teach or suggest ‘transporting the dough bar to a remote location in the sealed storage package’ with

instructions regarding how to bake the bar, as recited and claimed in claim 12” (*id.* at 8);

- 5) “Blaschke requires a consumer to either break the blocks by hand as for a chocolate bar or use a knife to cut along the grooves prior to baking” and “there is no motivation for one of ordinary skill in the art to modify the teachings of Blaschke to omit the grooves in the dough block” (*id.*);
- 6) the claimed invention differs from the prior art because “the first dough forms a base layer, the second dough is disposed over a portion of the base layer to minimize or avoid burning or scorching of the first dough portion during baking, and the third dough is disposed around the sides of the second dough forming the edges of the bar to protect the edges of the bar which are exposed” (*id.* at 8-9);
- 7) Abdelrahman does not disclose the steps of the claimed method (e.g., the transporting step) (*id.* at 9);
- 8) “neither Blaschke nor Abdelrahman discloses, teaches or suggests the benefits of the presently claimed method” (*id.* at 10);
- 9) the references do not disclose “an internal separation zone” (*id.*); and
- 10) “[a]s Blaschke does not disclose or suggest that different layers have different baking performance, there is no motivation for one of ordinary skill in the art to enrobe one dough with another” (*id.*).

With respect to claim 14, the Appellant argues that neither Blaschke nor Abdelrahman discloses or suggests “providing the dough portions in the form of a parallelepiped-shaped bar that is ready-to-bake and placed in the sealed storage package,” as recited in the claim. *Id.* at 8, 9.

We do not find any of the Appellant’s arguments persuasive to show reversible error in the Examiner’s rejection. *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011).

Blaschke teaches that traditional “[b]akery products such as brownie products are generally provided as dry mixes to which eggs, oil and water and other ingredients such as nuts or chocolate pieces are added, the product is appropriately mixed and then placed in a pan for baking.” P. 1, ll. 7-11. According to Blaschke, these traditional dry mix products take time to prepare the dough and require the use of different kitchen utensils. P. 1, ll. 11-13. As an improvement, Blaschke proposes a method of providing a consumer with a ready-for-baking dough product that requires only a minimum of manipulation by the consumer. P. 1, ll. 25-27. Specifically, Blaschke’s contribution to the art is said to be a ready-to-bake dough product provided in a form having grooves or score lines defining smaller individual pieces such that the pieces can be broken off and placed in a baking tin and baked. P. 1, ll. 28-36. Thus, a person of ordinary skill in the art would have drawn a reasonable inference from these disclosures that it was known prior to Blaschke’s disclosure that the entire dough may be baked without cutting the dough product into smaller pieces.

Blaschke teaches that the improved dough block may be of either parallelepipedal, cylindrical, or prismatic form. P. 3, ll. 27-31. In particular, Blaschke discloses that the improved dough block has at least two layers

(typically between 2 and 6 layers), which are “more specifically of different compositions” to impart different types of colors, flavor, shape, and/or texture. P. 8, ll. 13-21, 27-28, 31-33. Blaschke teaches an embodiment of a dough product having creamy, liquid, or solid filling (e.g., chocolate dough) inside a basic dough. P. 10, ll. 9-16. Blaschke states that the dough with the filling may be produced “by placing the filling in a first layer and then putting a second layer of dough *on the filling and first layer.*” P. 10, ll. 18-22 (emphasis added). Additionally, Blaschke teaches that the dough block “is wrapped conventionally, for example in a wrapping based on synthetic material or based on covered carton, so as to be protected from air and moisture prior to use.” P. 7, ll. 15-18. Blaschke explicitly teaches that the dough block “should be quite firm, but should nevertheless spread well during baking.” P. 4, ll. 30-34.

Abdelrahman describes baking a dough product with an inner dough layer enrobed by an outer dough layer without cutting the product into smaller pieces prior to baking. Col. 5, l. 40 to col. 6, l. 25.

Blaschke’s disclosure differs from the subject matter of claim 12 only in that Blaschke does not explicitly state that the “second layer of dough on the filling and first layer,” as described at page 10, lines 18-22, differs from the “first layer” and is “disposed around the sides” of the filling layer, as recited in claim 12.

As we found above, however, Blaschke teaches that the multiple dough layers can be formulated to have different compositions to impart different appearances and textures, yet provide a dough product that “should be quite firm, but should nevertheless spread well during baking.” P. 4, ll. 30-34; p. 8, ll. 13-21, 27-28, 31-33. Furthermore, Blaschke teaches that

the filling may be *inside* the basic dough. P. 10, ll. 9-16. Taken together with Abdelrahman's additional disclosure that enclosing a dough or filling layer within another dough is well known in the art, we conclude that a person of ordinary skill in the art would have been prompted to enclose Blaschke's filling layer (including the sides of the filling layer) with a dough layer that differs in composition from the first dough layer as a matter of design choice. These findings and conclusions directly contradict the Appellant's arguments 1), 2), 3) and 10).

We agree with the Examiner that "[i]t would have been obvious to include instruction[s] for usage [of Blaschke's commercial product] when the product is marketed so that consumers will know how to use the product." Ans. 5. Indeed, we find it unlikely that Blaschke's product, which is designed to be sold as a packaged commercial product, would not include instructions. Thus, the Appellant's argument 4) is unpersuasive.

The Appellant's argument 5) that Blaschke teaches breaking the dough product into smaller pieces along grooves or score lines fails. Claim 12 does not recite as positive steps removing the dough product and then baking the dough product without cutting it into smaller pieces. Rather, claim 12 is directed to a "method of providing a ready-to-bake dough bar," with only the instructions reciting the baking steps. Nor does claim 12 exclude groove lines or scores. Quite oppositely, the Appellant's own Specification states that grooves or score lines may be provided on the dough product to facilitate separation. Spec. 20, ll. 15-17. Here, the Appellant has failed to direct us to persuasive evidence that Blaschke's dough product with grooves or score lines could not be wholly baked without cutting the product into smaller pieces. Under these circumstances,

we give no patentable weight to the *content* of the Appellant's baking instructions. *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004).

Claim 14 also fails to positively recite the steps of removing dough product from the package and then directly baking the product without breaking the product into smaller pieces. Specifically, the claim recites the removing and baking steps in a *conditional* context of “*when fresh baked dough bars are desired*” (emphases added) and therefore also fails to patentably distinguish over the prior art. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997) (“It is the applicants’ burden to precisely define the invention, not the PTO’s.”).

Regarding the Appellant's argument 6), the Appellant has not directed us to any description in the Specification that would constitute a standard for determining whether the “second [dough] layer [is] disposed over a portion of the base layer . . . to *minimize* . . . burning or scorching of the first dough portion” (emphasis added) during baking, as required by claim 12. Absent any limitation as to variables such as the sizes of the dough product and/or individual dough layers, amount of heat used, positioning of the heat source relative to each of the layers, the baking time, or degree of acceptable burning or scorching, we interpret this limitation to encompass any amount of the second dough layer (filling layer) relative to the first dough layer.⁵

The Appellant's argument 7) attacking Abdelrahman individually is without merit for the reasons given by the Examiner at page 8 of the Answer. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986)

⁵ In the event of further prosecution, the Appellant and the Examiner should consider whether the claims comply with 35 U.S.C. § 112(b). *See, e.g., Seattle Box Co., Inc. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984).

(“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”).

The Appellant’s argument 8) concerning the alleged benefits of the claimed invention is also unpersuasive. First, an obviousness analysis is not constricted to one that “look[s] only to the problem the [Appellant] was trying to solve.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007). “The question is not whether the combination was obvious to the [Appellant] but whether the combination was obvious to a person with ordinary skill in the art.” *Id.* Second, the Appellant has offered no evidence to demonstrate that the alleged “benefits of the presently claimed method” (App. Br. 10) would have been considered truly unexpected by one of ordinary skill in the art.

With respect to argument 9) concerning “an internal separation zone,” claim 12 recites “with the second dough portion hidden from view along the bar edges by the third dough portion until and *unless* the ready-to-bake dough bar is separated along an internal separation zone, which is an internal cross-section of the dough bar that extends from the top to the bottom of the dough bar” (emphasis added). When baked without breaking and subsequently cut along a cross-section, it would reasonably appear that Blaschke’s modified dough product would also reveal an otherwise hidden filling layer as well as the other dough layers. The Appellant has offered no evidence to the contrary.

With respect to claim 14, Blaschke explicitly teaches parallelepiped dough products, as we discussed above. Therefore, the Appellant’s argument fails.

Because we have relied on facts and reasoning not raised by the Examiner, we designate our affirmance as including new grounds of rejection to preserve the Appellant's procedural safeguards. *In re Leithem*, 661 F.3d 1316, 1319 (Fed. Cir. 2011) ("Mere reliance on the same statutory basis and the same prior art references, alone, is insufficient to avoid making a new ground of rejection when the Board relies on new facts and rationales not previously raised to the applicant by the examiner.").

37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(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 the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

SUMMARY

The Examiner's rejection under 35 U.S.C. § 103(a) of claims 12-21 as unpatentable over Blaschke and Abdelrahman is affirmed.

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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
37 C.F.R. § 41.50(b)

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