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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL P. BASHOR, THOMAS J. FORT, and
JANET L. BOYLE

Appeal 2012-000570
Application 11/747,266
Technology Center 1700

Before CHARLES F. WARREN, LINDA M. GAUDETTE, and
GRACE KARAFFA OBERMANN, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision¹ finally rejecting claims 1-13, 16-18, 21, and 22 under 35 U.S.C. §103(a) over Scherwitz (US 4,379,176, issued Apr. 5, 1983) in view of Huang (US 6,565,909 B1, issued May 20, 2003), as evidenced by Paul (US 5,531,989, issued Jul. 2, 1996) and claims 14 and 15 under 35 U.S.C. §103(a) over the same references, further in view of Frippiat (US 2003/0068429 A1, published Apr. 10, 2003).² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Claim 1 is representative of the invention and is reproduced below from the Claims Appendix to the Appeal Brief:

1. A reduced-calorie icing composition comprising inulin, sugar, gum, water, and fat; wherein the reduced-calorie icing has about 3.7 calories/gram or less; wherein the sugar is pre-dissolved in the water prior to adding the inulin.

Appellants request reversal of the Examiner's decision to reject all appealed claims on the basis that the Examiner "failed to establish a *prima facie* case of obviousness with respect to each of independent claims 1, 18, 21, and 22 because there would have been no apparent reason or benefit to modify the Scherwitz et al. reference with the Huang et al. reference at the time of Applicants' invention." (App. Br. 10.) Appellants do not present separate arguments in support of patentability of any particular claim or claim grouping. (*See generally*, App. Br. 10-12.) Accordingly, we decide the appeal as to all claims on the basis of independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii) ("When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together

¹ Final Office Action mailed Dec. 17, 2010 ("Final")

² Appeal Brief filed Apr. 1, 2011 ("App. Br.")

to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone.”).

We turn now to the issue of whether the Examiner’s proposed motivation for modifying Scherwitz’s icing to include inulin is based on improper hindsight reasoning.

The Examiner finds Scherwitz discloses an icing composition comprising the same components recited in claim 1, with the exception of inulin. (Ans. 5.³) Scherwitz’s composition is said to “remain pliable and spreadable through freeze-thaw conditions, without becoming too runny at room temperature” (Scherwitz col. 2, ll. 32-34); the composition is not disclosed as being “reduced-calorie.” (Cf. Spec. 2:3-6 (“Although icings have been developed that can be used under broad temperature-ranges (see, e.g., [Scherwitz]), a reduced-calorie version of such icings is desirable.”).) Scherwitz discloses

[t]he icing formulation may be varied somewhat as long as it has a critical total fat content, sugar content and water content, with the total fat content itself being a mixture of liquid triglyceride oil and hydrogenated shortening, with the ratio of liquid oil to liquid oil plus shortening being within the range of from about 0.26 to 0.43:1.

(Scherwitz col. 2, ll. 34-40.)

For example, other typical ingredients may include corn syrup solids, salt, flavoring, surfactants, coloring, gums, and the like. These may be varied, as desired, within reasonable use levels.

Thus, the levels of these additional ingredients may vary considerably, almost at the formulator's will, without having any significant effect upon the overall icing attributes, providing that the critical parameters remain.

(*Id.* at col. 4, ll. 41-48.)

³ Examiner’s Answer mailed Jun. 22, 2011.

The Examiner determines it would have been obvious to one of ordinary skill in the art at the time of the invention to include inulin in Scherwitz's composition for added phase stability and fiber content, based on the teachings of Huang and Paul. (Ans. 6.) The Examiner determines that while Scherwitz and Huang do not specifically teach pre-dissolving sugar in water prior to adding the inulin, one of ordinary skill in the art would have expected that the teachings of the reference would result in a product having the same properties as the product of claim 1. (Ans. 7.) In this respect, the Examiner finds the record does not establish that the process limitation "wherein the sugar is pre-dissolved in the water prior to adding the inulin" in product-by-process claim 1 would not be expected to materially affect the properties of the claimed product. (Ans. 7, 12.)

Paul discloses inulin "is a frequent replacement for sugar in many foods," "has a moderately sweet taste, [and] is highly soluble." (Paul col. 6, ll. 13-15.) According to Paul, "inulin is a well known source of fiber which promotes gastrointestinal health" (Ans. 6 (citing Paul Abstract)), "has been an important food in Europe for many years and is currently being used as a source of dietary fiber, for replacing fat in the diet" (Paul col. 6, ll. 9-11).

Huang discloses the use of inulin in "a stable, low density, ready-to-spread frosting" (Huang col. 1, ll. 5-6, 46-50), i.e., "frostings that can be stored unopened for extended periods at room temperature with . . . minimal separation of the aqueous and shortening phases" (*id.* at col. 2, ll. 46-48). More specifically, Huang discloses the frosting is stabilized by an aqueous phase gel containing inulin rather than by manipulation of the shortening phase, e.g., by addition of palm oil hard stock. (*Id.* at col. 3, ll. 21-24.) According to Huang, the resulting frostings do not have the waxy texture or mouth feel (*id.* at ll. 24-25) typical of products containing palm oil hard stock (*id.* at col. 1, ll. 40-41).

Appellants argue one of ordinary skill in the art would not have been motivated to include inulin in Scherwitz's composition based on Huang because Scherwitz's composition is already said to be stable. (App. Br. 11.) Appellants also note that while Huang teaches inulin provides stability to whipped frostings, there is no teaching that inulin would provide such stability to a non-whipped frosting such as Scherwitz's. (*Id.*; *see also* Reply Br.⁴ 2-3.) Appellants further contend the ordinary artisan would not have been motivated to add inulin simply because it supports gastrointestinal health given the adverse impact inulin can have on icing viscosity and /or color. (App. Br. 11-12.) Appellants also contend that the limitation "wherein the sugar is pre-dissolved in the water prior to adding the inulin" in claim 1 distinguishes the claimed product over the prior art, pointing out that as disclosed at page 4, line 25 to page 5, line 1 of the Specification, "inulin may thicken an icing to an undue degree unless the sugar is pre-dissolved in water prior to adding the inulin." (Reply Br. 3-4,)

When a second reference identifies the benefits of adding a feature to the primary reference, an obviousness rejection is proper. *In re Thrift*, 298 F.3d 1357, 1365 (Fed. Cir. 2002); *see also KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) ("[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.").

We have considered Appellants' arguments, but are not persuaded that the Examiner failed to establish proper motivation to modify Scherwitz to include inulin. Paul discloses inulin "is a frequent replacement for sugar in many foods" (Paul col. 6, ll. 14-15) and Huang would have suggested that inulin may be

⁴ Reply Brief filed Aug. 22, 2011.

successfully incorporated into frostings as a replacement for shortenings which can negatively impact the organoleptic properties (Huang col. 3, ll. 24-25; *see also* Paul col. 6, ll. 9-11). *Cf. In re Mayne*, 104 F.3d 1339, 1340 (Fed. Cir. 1997) (noting the substitution of one known element for a known equivalent is *prima facie* obvious). Both references disclose the health benefits of inulin. Further, one of ordinary skill in the art would have had a reasonable expectation of success in adding inulin to Scherwitz's composition, since Scherwitz expressly states that additional ingredients may be added without having any significant effect upon the overall icing attributes, provided the sugar, fat and water content of the composition is maintained within certain critical parameters. We are not convinced the ordinary artisan would have been dissuaded from making the proposed modification based on the mere possibility of an adverse effect on the viscosity of Scherwitz's icing composition. (*See Spec.* 4:25-28.) Indeed, as the Examiner contends, Appellants have not established that the order of addition of the ingredients using Scherwitz's method would not result in a product that is encompassed by product-by-process claim 1. (Ans. 5, 12; Reply Br. 3-4.) *See, e.g., In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985) (“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.”).

For the reasons discussed above, we affirm the Examiner's decision to reject claims 1-18, 21 and 22.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED

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