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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for 13/907,283 filed 05/31/2013 by Daniel Verdin Cantrell.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIEL VERDIN CANTRELL, JOSHUA D. MORTON,
STEVEN D. HUME, BARRY BRATCHER, ROBERT FRANK BOUTIN,
THOMAS HINKEMEYER, and THADDEUS J. JACKSON

Appeal 2018-001851
Application 13/907,283
Technology Center 1700

Before GEORGE C. BEST, JENNIFER R. GUPTA, and
MERRELL C. CASHION, JR., *Administrative Patent Judges*.

CASHION, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from a final rejection of
claims 45–57. We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

Claim 45 is illustrative of the subject matter on appeal and is reproduced below:

45. A smokeless tobacco composition configured for insertion into the mouth of a user, the smokeless tobacco composition comprising:

at least about 2 dry weight percent of tobacco material in the form of an aqueous tobacco extract, based on the total weight of the composition;

at least about 30 dry weight percent of a sugar alcohol;

at least about 40 dry weight percent of a natural gum binder component;

at least about 2 dry weight percent of a humectant; and

at least about 2 dry weight percent of a salt,

the composition being in the form of a pastille.

Appellant¹ requests review of the following rejections in the Examiner's Final Office Action (*see generally* Br.):

I. Claims 45, 49–54, and 57 rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Dam (US 5,525,351, issued June 11, 1996) and Sprecker (US 4,206,092, issued June 3, 1980).

II. Claims 46–48 and 56 rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Dam, Sprecker, and Latimer (*Pyrolysis vs. Actual Smoking Conditions: Conversion of Glucose, Fructose, and Cellulose to B[a]P*, 1325 (1966)).

III. Claims 55 rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Dam, Sprecker, and Strickland (US 2005/0244521 A1, published November 3, 2005).

¹ R. J. Reynolds Tobacco Company is the Applicant/Appellant and is also identified as the real party in interest. Br. 1.

Appellant also requests that the provisional rejection of claims 45–57 on the ground of nonstatutory double patenting as unpatentable over claims 1–13 and 15–17 of copending Application No. 12/957,821 be held in abeyance until the claims of both applications are in condition for allowance so that they can then consider any need for a terminal disclaimer. Br. 15.

The provisional rejection is now *de facto* based upon U.S. Patent No. 9,775,376, thereby making the rejection non-provisional. In view of this, we note that the scope of the claims of copending Application No. 12/957,821 may have changed from the scope of the claims as addressed by the Examiner during its prosecution. Thus, we decline to reach the merits of the Examiner’s provisional obviousness-type double patenting rejection. *Ex parte Jerg*, 2012 WL 1375142 at *3 (BPAI 2012) (informative) (“Panels have the flexibility to reach or not reach provisional obviousness-type double-patenting rejections.”) (citing *Ex parte Moncla*, 95 USPQ2d 1884 (BPAI 2010) (precedential)). We refer the matter to the Examiner to ascertain the appropriateness of maintaining this rejection.

OPINION

Prior Art Rejections

Appellant relies on the same line of arguments to address the rejection of claims 45, 49–54, and 57 (Rejection I) and separately rejected claims 46–48 and 56 (Rejection II). *See generally* Br. Appellant presents separate arguments for the rejection of claim 55 (Rejection III). *Id.* at 14–15. Accordingly, we select independent claim 45 as representative of the subject matter before us on appeal for Rejections I and II and decide the appeal as to

claims 45–54, 56, and 57 based on the arguments made by Appellant in support of patentability of claim 45. We address claim 55 separately.

After review of the respective positions provided by Appellant and the Examiner, we affirm the Examiner’s prior art rejections of claims 45–57 for the reasons presented by the Examiner.

Claim 45

The Examiner finds, and Appellant does not dispute, that Dam discloses a smokeless tobacco composition configured for insertion into the mouth of a user that differs from the claimed invention in that Dam does not disclose the use of salt as a stabilizing ingredient. Final Act. 2–3; Br. 3–5. The Examiner relies on Sprecker for the teaching of salt (sodium chloride) for use in tobacco products. Final Act. 3. The Examiner concludes that it would have been obvious for one skilled in the art to use salt as a stabilizing ingredient in Dam’s smokeless tobacco product in view of Sprecker’s teaching. *Id.*

Appellant argues Sprecker is directed to providing natural flavoring ingredients in smoking tobacco by adding it to smoking tobacco material directly, to the filter, or to the paper wrapper of a smoking article. Br. 5; Sprecker col. 6, ll. 36–40; col. 15, ll. 1–5. According to Appellant, Sprecker does not teach or suggest a smokeless tobacco product in the context of a stimulant unit as disclosed in the Dam reference. Br. 6. Thus, Appellant asserts that, absent impermissible hindsight, one of skill in the art would not turn to Sprecker’s disclosure for a particular ingredient (salt) of a fundamentally different composition (smoking tobacco) for inclusion in Dam’s composition (smokeless tobacco). *Id.* at 5. Appellant also contends that one of skill in the art would have no motivation to use or reasonable

expectation of using Sprecker's sodium chloride in Dam's smokeless tobacco product because both references are directed to significantly different types of products. *Id.* at 5, 10.

We are unpersuaded of reversible error. It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in the art would have reasonably been expected to draw therefrom. *See In re Fritch*, 972 F.2d 1260, 1264–65 (Fed. Cir. 1992).

As noted by the Examiner, Sprecker defines the term “tobacco” as “any composition intended for human consumption, by smoking or otherwise, whether composed of tobacco plant parts or substitute materials or both.” Ans. 8; Sprecker col. 15, ll. 61–65. Therefore, one skilled in the art would have inferred from this disclosure that Sprecker's tobacco products are not limited to smoking tobacco products.

With respect to the use of sodium chloride, Sprecker discloses a number of additional stabilizing compounds, such as ascorbic acid, citric acid and butylated hydroxylated toluene, which are also used as stabilizing compounds for Dam's smokeless tobacco products. Sprecker col. 9, ll. 62–68; Dam col. 8, ll. 60–67. Therefore, one skilled in the art would have had a reasonable expectation that the simple substitution of Sprecker's sodium chloride for Dam's disclosed stabilizing additives would have predictably resulted in an adequate smokeless tobacco product. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416–417 (2007) (“the simple substitution of one known element for another” generally will be obvious unless the substitution or the application of the known technique would have been beyond the level of

ordinary skill in the art, or the results of the substitution would not have been predictable by one of ordinary skill in the art.)

Thus, Appellant has not adequately explained why one skilled in the art would not have expected Sprecker's additives, such as the sodium chloride stabilizing compound, to be suitable for Dam's smokeless tobacco product.

Appellant argues that the cited art does not lead one skilled in the art to incorporate the components of the claimed smokeless tobacco composition in the recited amounts. Br. 11.

We are unpersuaded by this argument because it does not identify error in the Examiner's reasons for finding that the amounts for these components are result-effective variables that can be optimized by one skilled in the art through routine experimentation for a product having a desired taste, texture, and shelf-life.

Accordingly, we affirm the Examiner's prior art rejections of claims 45–54, 56, and 57 for the reasons presented by the Examiner and given above.

Claim 55

We affirm.

Claim 55 requires a smokeless tobacco composition that comprises a particulate tobacco material having an average particle size of less than about 50 microns.

The Examiner turns to Strickland's disclosure of tobacco powder with average particle size less than 80 microns, a particle size range that includes the recited average particle size of less than about 50 microns. Final Act. 5; Ans. 10; Strickland ¶ 52. The Examiner concludes that a prima facie case of

obviousness exists wherein the claimed ranges overlap or lie inside ranges disclosed by the prior art. Final Act. 5; Ans. 10.

Appellant argues Strickland reference does not disclose a particulate tobacco material having an average particle size of less than about 50 microns. Br. 14. According to Appellant, while Strickland notes a starting material designated as “Tobacco Powder (average particle size < 80 μm)” within one example, one of skill in the art would not understand this single reference to encompass, much more broadly than intended, tobacco powder with an average particle size anywhere below 80 μm , including the recited average particle size of less than about 50 microns. Br. 14–15.

We are unpersuaded by these arguments because they do not address the Examiner’s reasoning. Dam recognizes that it is known to make smokeless tobacco products from comminuted tobacco or tobacco dust/powder. Dam col. 1, ll. 47–48; col. 20, l. 20; col. 23, l. 37. Strickland discloses that the tobacco can be granulated. Strickland ¶ 14. Strickland further discloses that the tobacco useful in compositions can have “[e]xemplary average sizes are in the range of 1 to 1000 μm , e.g., about 800, 500, 250, 100, 80, 75, 50, 25, 20, 15, 10, 8, 6, 5, 3, 2, or 1 μm or less, preferably 80 μm or less.” *Id.* ¶ 23. Thus, contrary to Appellant’s assertion (Br. 15), the prior art suggests that particle size range for tobacco particles is a result-effective variable. Therefore, Appellant has not shown error in the Examiner’s determination of obviousness.

Accordingly, we affirm the Examiner’s prior art rejection of claim 55 for the reasons presented by the Examiner and given above.

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Application 13/907,283

ORDER

The Examiner's prior art rejections of claims 45–57 under 35 U.S.C. § 103(a) are affirmed.

We do not reach the provisional obviousness-type double patenting rejection of claims 45–57.

TIME PERIOD

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