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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* JERRY WAYNE MARSHALL, DANIEL VERDIN CANTRELL,  
and SERBAN C. MOLDOVEANU

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Appeal 2018-001883  
Application 14/055,449  
Technology Center 1700

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Before JEFFREY T. SMITH, N. WHITNEY WILSON, 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(a) from the Examiner's Final Rejection of claims 1–27. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Independent claim 1 is generally illustrative of the subject matter on appeal and is reproduced below:

1. A smokeless tobacco pastille configured for insertion into the mouth of a user, the smokeless tobacco pastille comprising: (i) a tobacco material present in an amount of less than about 40 dry weight percent, based on the total dry weight of the pastille; (ii) at least one natural gum binder present in an amount of at least about 25 dry weight percent; and (iii) a plurality of sugar alcohols present in a total amount of at least

about 40 dry weight percent, the predominant component of the plurality of sugar alcohols being isomalt or erythritol, wherein the shape of the smokeless tobacco pastille is moldable in the oral cavity.

Appellant<sup>1</sup> (*see generally* App. Br.<sup>2</sup>) requests review of the following rejections from the Final Office Action:

I. Claims 1–3, 5–14, and 17–27 rejected under 35 U.S.C. § 102(a)(1) as anticipated by Cantrell (US 2012/0138074 A1, published June 7, 2012).

II. Claim 4 rejected under 35 U.S.C. § 103 as unpatentable over Cantrell and O’Connell (US 2012/0145170 A1, published June 14, 2012).

III. Claims 15 and 16 rejected under 35 U.S.C. § 103 as unpatentable over Cantrell and Liu (US 2004/0101543 A1, published May 27, 2004).

## OPINION

### *The Prior Art Rejections*

Appellant relies on the same line of arguments to address the rejection of claims 1–3, 5–14, and 17–27 (Rejection I) and separately rejected claim 4 (Rejection II). *See generally* App. Br. Appellant presents separate arguments for the rejection of claims 15 and 16 (Rejection III).

App. Br. 8–9. Accordingly, we select independent claim 1 as representative of the subject matter before us on appeal for Rejections I and II and decide the appeal as to claims 1–14 and 17–27 based on the arguments made by

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

<sup>2</sup> The Appeal Brief is not paginated. For the purposes of this opinion, we number the pages of the Appeal Brief beginning with the Title page as page 1.

Appellant in support of patentability of claim 1. We address claims 15 and 16 separately.

After review of the respective positions provided by Appellant and the Examiner, we affirm the Examiner's rejections of claims 1–27 under 35 U.S.C. §§ 102(a)(1) and 103 for the reasons presented by the Examiner. We add the following for emphasis.

*Claim 1*

Independent claim 1 is directed to a smokeless tobacco pastille configured for insertion into the mouth of a user comprising a plurality of sugar alcohols present in a total amount of at least about 40 dry weight percent, the predominant component of the plurality of sugar alcohols being isomalt or erythritol.

The Examiner finds Cantrell anticipates the claimed invention by describing a smokeless tobacco pastille comprising a sugar alcohol component in an amount that overlaps the claimed amount of at least about 40 dry weight percent. Final Act. 2; Cantrell ¶¶ 29, 40, and 43.

Appellant's principal argument is that, while Cantrell discloses that the filler (e.g., a sugar alcohol) will not exceed about 50% (Cantrell ¶ 40), Cantrell provides no examples that would guide one skilled in the art to a pastille having sugar alcohols present in a total amount of at least about 40 dry weight percent as claimed because all exemplified formulations have sugar alcohols at a concentration that is less than the claimed concentration. App. Br. 4–6.

We are unpersuaded. The Examiner must establish a prima facie case of anticipation under 35 U.S.C. § 102 by showing that all elements arranged

as specified in a claim are disclosed within the four corners of a reference, either expressly or inherently, in a manner enabling one skilled in the art to practice an embodiment of the claimed invention without undue experimentation. *Clear Value, Inc. v. Pearl River Polymers, Inc.*, 668 F.3d 1340, 1344 (Fed. Cir. 2012); *Sanofi-Synthelabo v. Apotex Inc.*, 550 F.3d 1075, 1083 (Fed. Cir. 2008). When the prior art discloses a range that overlaps a specified range, but no specific examples falling within the specified range are disclosed, a fact-dependent question arises as to whether the reference describes the claimed subject matter “with sufficient specificity to anticipate” the claim. *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999 (Fed. Cir. 2006). In *Atofina*, the court held that a reference's temperature range of 100–500 degrees C did not describe the specified range of 330–450 degrees C with sufficient specificity to anticipate the claim. *Atofina*, 441 F.3d. at 999; *see MPEP* § 2131.03 (Part II). However, as explained in *Clear Value*, the finding of a lack of anticipation in *Atofina* can be understood to be based on the criticality of the claimed temperature range to enable the process to operate effectively. *Clear Value*, 668 F.3d at 1344–45.

We are not persuaded of Examiner error based on Appellant’s contention that Cantrell does not describe the invention because it lacks of specific examples meeting the limitations of Appellant’s claims. The Examiner identifies particular teachings in Cantrell that are relied upon to reject Appellant's claims. Final Act. 2; Ans. 2 (citing Cantrell ¶ 40). The Examiner also notes that Cantrell’s teachings are not limited to what is disclosed in the examples. Ans. 2; *In re Mills*, 470 F.2d 649, 651 (CCPA 1972) (“All the disclosures in a reference must be evaluated, including

nonpreferred embodiments, . . . and a reference is not limited to the disclosure of specific working examples.”) (citations omitted). Moreover, while Appellant argues a relatively high level of sugar alcohols in the present invention surprisingly provides a pastille having desirable characteristics,<sup>3</sup> such as the presently claimed moldability (App. Br. 4 (citing to Spec. 15)), the portion of the Specification relied upon by Appellant to support such an allegation does not recite that the amount of sugar levels is critical for an effective pastille.

Thus, we find that the Examiner adequately explains why Cantrell’s disclosure of sugar alcohol levels (“will not exceed about 50 percent”) describes the specified range (“at least about 40 dry weight percent) with sufficient specificity to anticipate claim 1. A person of ordinary skill in the art following the teachings of Cantrell by forming a smokeless tobacco pastille comprising a sugar alcohol component such as in an amount of 49 percent (i.e. not exceeding about 50 percent) would have been practicing the invention as described by Cantrell and also infringing claim 1.

We are also unpersuaded by Appellant’s argument that none of the examples include erythritol as a dominant sugar alcohol component. App. Br. 6. Claim 1 recites the predominant component of the plurality of sugar alcohols to be *isomalt or erythritol*. As Appellant acknowledges, Cantrell’s Example 4 exemplifies isomalt as the predominant sugar alcohol component. *Id.* This disclosure is sufficient to meet the claimed limitation.

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<sup>3</sup> We understand Appellant’s contention to also be analogous to a contention that the claimed invention yields unexpected results. An Appellant, however, cannot overcome a rejection under 35 U.S.C. § 102 by showing unexpected results. *In re Malagari*, 499 F.2d 1297, 1302 (CCPA 1974).

Accordingly, we affirm the Examiner's rejection of claims 1–14 and 17–27 under 35 U.S.C. §§ 102(a)(1) and 103 for the reasons given by the Examiner and presented above.

*Claims 15 and 16*

We refer to the Examiner's Final Action for a statement of the rejection. Final Act. 6. Briefly, Liu, directed to a nicotine containing lozenge, was cited to supplement the teachings of Cantrell with regard to the ratios of sugar alcohols to meet the claimed limitation of at least two additional sugar alcohols being present in a dry weight ratio of at least about 3:1. Final Act. 26; Liu ¶ 26.

Appellant's argument for this rejection are premised on Liu teaching a lozenge product instead of a pastille product. App. Br. 8–9. According to Appellant, Liu's lozenge is different from Cantrell's pastille and, thus, the teachings of the cited art are not combinable absent impermissible hindsight. App. Br. 8–9.

We are unpersuaded for the reasons provided by the Examiner. Ans. 3. Moreover, Merriam-Webster defines lozenge as “a small usually sweetened and flavored medicated material that is designed to be held in the mouth for slow dissolution especially: one that contains a demulcent sore throat lozenges— called also *pastille*, *troche*.”<sup>4</sup> In view of this, Appellant's arguments are not persuasive of reversible error.

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<sup>4</sup> <https://www.merriam-webster.com/dictionary/lozenge> (last accessed October 31, 2018).

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Accordingly, we affirm the Examiner's rejection of claims 15 and 16 under 35 U.S.C. § 103 for the reasons given by the Examiner and presented above.

#### DECISION

The Examiner's prior art rejections of claims 1–27 under 35 under U.S.C. §§ 102(a)(1) and 103 are affirmed.

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)(iv).

AFFIRMED