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Mars, Inc. c/o Mars Petcare Theresa Shearin 2013 Ovation Parkway Franklin, TN 37067			KIM, BRYAN	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW IAN ELLIOTT, ANDREW JAMES NEWTON,
PETER SEBASTIAN SLUSARCZYK, JONATHAN CHRISTOPHER,
VINOD GUMUDAVELLI, and JUSTIN NGUYEN

Appeal 2018-009212
Application 14/118,510
Technology Center 1700

Before DONNA M. PRAISS, CHRISTOPHER C. KENNEDY, and
JEFFREY R. SNAY, *Administrative Patent Judges*.

SNAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1, 4, 5, 8–11, 14–19, and 21–27. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies Mars, Incorporated as the real party in interest. Appeal Br. 2.

BACKGROUND

The invention relates to edible animal chews. Claim 1 reads:

1. An edible animal chew having a longitudinal axis, wherein the edible animal chew comprises:
 - (i) an outer wall extending in the direction of said longitudinal axis, wherein the animal chew is elongate in shape;
 - (ii) an internal support structure comprising inner walls and at least three struts, wherein each of the at least three struts contacts an inner surface of said outer wall wherein the inner walls and struts extend in the direction of said longitudinal axis and define a plurality of channels that extend in the direction of said longitudinal axis; and
 - (iii) wherein said edible animal chew comprises a degree of starch gelatinization greater than 30% on a total starch basis.

Appeal Br. 15 (Claims Appendix).

Independent claims 21 and 25 similarly recite an edible animal chew having an internal support structure comprising inner walls and struts. Each remaining claim on appeal depends from claim 1 or 21.

REJECTIONS

- I. Claims 1, 4, 5, 8, 14–19, 24, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Nie (US 2004/0086616 A1; pat. pub. May 6, 2004), Koo (2011/0290197 A1; pat. pub. Dec. 1, 2011), Heyman (US 2,784,097; iss. March 5, 1957), and Tintle (Des. 374,753; iss. Oct. 22, 1996).
- II. Claims 9–11 and 25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Nie, Koo, Heyman, Tintle, and Gokturk (D448,138 S; iss. Sept. 25, 2001).
- III. Claims 21–23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bunke (US 2009/0202700 A1; pat. pub. Aug. 13, 2009), Koo, Heyman, Tintle, Garcia Martinez (US 2008/0003270 A1; pat. pub. Jan. 3, 2008), and Cupp (US 2003/0021872 A1; pat. pub. Jan. 30, 2003).

OPINION

Each independent claim on appeal recites, *inter alia*, an edible animal chew having “an internal support structure comprising inner walls and at least three struts.” With regard to independent claims 1 and 25, the Examiner finds Nie discloses an extruded animal chew and Koo provides a reason to include internal air holes. Non-Final Act. 3. The Examiner finds Heyman, Tintle, and Gokturk teach edible food products, such as ice cream cones and pasta, that include internal walls and struts. *Id.* at 3–4. In light of the foregoing disclosures, the Examiner determines it would have been obvious to provide Nie’s extruded animal chew with internal walls and struts “as a manufacturing choice for the design of the pet chew.” *Id.* at 4. With

regard to independent claim 21, the Examiner substitutes Bunke for Nie as teaching an edible chew, and again relies on Heyman and Tintle to support a determination that the claimed internal support structure would have resulted from an obvious choice of manufacturing design. *Id.* at 7–8.² Generally, the Examiner states “the Office’s position is that the structure of appellant’s claimed invention is a matter [of] shape/design choice.” Ans. 10.

Appellant argues “there is no teaching or suggestion in any of Heyman, Tintle or Gokturk that it would be desirable to provide the support structures disclosed therein in a dog chew.” Appeal Br. 12. We agree.

Design choice may serve as a basis for obviousness where alternative elements or configurations in the prior art perform the same function as the claimed aspects with no unexpected results. *See In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975) (finding that the use of the claimed feature “would be an obvious matter of design choice” when it “solves no stated problem” and “presents no novel or unexpected result” over the disclosed alternatives). In the context of a rejection based on design choice, the relevant issue is whether the alleged differences between the claimed invention and the prior art “result in a difference in function or give unexpected results.” *See In re Rice*, 341 F.2d 309, 314 (CCPA 1965); *see also Gardner*, 725 F.2d 1338, 1349 (Fed. Cir. 1984) (holding that, where the only difference between the prior art and claims was recitation of relative dimensions of the claimed device and a device having the claimed dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from prior art device).

² The Examiner does not rely on Garcia Martinez or Cupp for evidence concerning an internal support structure. *See Non-Final Act.* 7, 9.

Here, the recited internal support structure is said to provide certain functions, including increased chewing time and reduced calorie content. Spec. 5. Thus, the Specification presents at least some evidence that the recited structure solves a stated problem. *See id.* at 2 (“It has been found that an internal support structure within the edible chew provides longer lasting time per gram of product.”). Conversely, the Examiner does not identify evidence or reasoning adequate to support a determination that the difference between a chew having no internal structure (Nie, Bunke) and the claimed chew having specified internal walls and struts would have been an obvious design choice.

Appellant has identified reversible error in the Examiner’s conclusory finding that differences between the internal structure of the claimed invention and that of the prior art would have been an obvious design choice. Accordingly, the rejections are not sustained.

CONCLUSION

The Examiner’s decision rejecting claims 1, 4, 5, 8–11, 14–19, and 21–27 is reversed.

DECISION SUMMARY

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 4, 5, 8, 14–19, 24, 26, 27	103(a)	Nie, Koo, Heyman, Tintle		1, 4, 5, 8, 14–19, 24, 26, 27
9–11, 25	103(a)	Nie, Koo, Heyman, Tintle, Gokturk		9–11, 25
21–23	103(a)	Bunke, Koo, Heyman, Tintle, Garcia Martinez, Cupp		21–23
Overall outcome				1, 4, 5, 8– 11, 14–19, 21–27

REVERSED