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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GERALD OLEAN FOUNTAIN, PHILIP JAMES OXFORD, and
AMY LYNN PENNER

Appeal 2019-001529
Application 13/810,617
Technology Center 1700

Before CATHERINE Q. TIMM, JEFFREY T. SMITH, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

ROBERTSON, *Administrative Patent Judge*.

DECISION ON APPEAL¹

STATEMENT OF THE CASE

Appellant² appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–10, 29, and 30. (Appeal Br. 1.) We have jurisdiction pursuant to 35 U.S.C. § 6(b).

¹ This Decision includes citations to the following documents: Specification filed January 16, 2013 (“Spec.”); Final Office Action mailed March 20, 2018 (“Final Act.”); Appeal Brief filed August 21, 2018 (“Appeal Br.”); Examiner’s Answer mailed October 16, 2018 (“Ans.”); and Reply Brief filed November 26, 2018 (“Reply Br.”).

² We use the word “Appellant” to refer to “Applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Intercontinental Great Brands, LLC. (Appeal Br. 3.)

We AFFIRM-IN-PART, but denominate the rejection we affirm as involving a New Ground of Rejection.

THE INVENTION

Appellant states the invention relates to methods and devices for forming beverages or portions of beverages from powder and processes for forming the powders. (Spec. ¶ 2.)

Claims 1 and 29 are representative and reproduced below from the Claims Appendix to the Appeal Brief:

1. A method for forming a beverage for consumption by a consumer from a co-milled powdered composition, the method comprising:

co-milling together at least one powdered ingredient having a difficult to disperse portion thereof with about 2 to about 90 percent of one or more dispersion facilitator components to form a co-milled powdered composition with a particle size of about 100 to about 150 microns; and

combining the co-milled powdered composition with the particle size of about 100 to about 150 microns with a fluid to produce the beverage for consumption by the consumer with about 2 to about 16 percent solids from the co-milled powdered composition dispersed in the beverage for consumption by the consumer.

29. A method of preparing a co-milled powdered composition capable of preparing a beverage for consumption by a consumer, the method comprising:

introducing at least one powdered ingredient having a difficult to disperse portion and about 2 to about 90 percent of one or more dispersion facilitator components to a milling apparatus,

co-milling, in a sustained operation and at the same time, the at least one powdered ingredient and the one or more dispersion facilitator components to form the co-milled powdered composition with a particle size of about 100 to about 150 microns and being effective to produce the beverage for consumption by the consumer when the co-milled powdered composition with the particle size of about 100 to about 150 microns is contacted with water, the beverage for consumption by the consumer having about 2 to about 16 percent solids from the co-milled powdered composition dispersed therein.

(Appeal Br. (Claims Appendix) 23, 25.)

Claim 30 is also independent and recites a similar method to claim 1 where a co-milled powdered composition with the particle size of about 100 to about 150 microns is mixed with a fluid to produce a food product. (*Id.* at 25.)

REJECTIONS

1. The Examiner rejected claims 1–9, 29,³ and 30 under pre-AIA 35 U.S.C. § 103(a) as obvious over Einstman et al. (US 3,706,572, issued December 19, 1972 (hereinafter “Einstman”)), Richmond (US 3,227,558, issued January 4, 1966), and Atkinson et al. (US 6,207,203 B1, issued March 27, 2001 (hereinafter “Atkinson”)).

³ As Appellant points out, the Final Office Action does not include claim 29 in the rejection. (Appeal Br. 10, FN1; Final Act. 2–3.) Nevertheless, Appellant states that due to the similarity between claims 1 and 29, Appellant understands the rejection to also apply to claim 29. (*Id.*) Thus, we treat claim 29 as being subject to the rejection, as claim 29 is indicated as rejected in the Final Office Action. (*See* Final Act. Office Action Summary, box 7.)

2. The Examiner rejected claim 10 under pre-AIA 35 U.S.C. § 103(a) as obvious over Einstman, Richmond, Atkinson, and Halliday et al. (US 2004/0182250 A1, published September 23, 2004) (hereinafter “Halliday”).

(Final Act. 2–4.)

We select independent claims 1 and 29 for disposition of this appeal, which are representative of the subject matter claimed, and decide the appeal as to all grounds of rejection on the basis of the arguments presented for these claims (*see* Appeal Br. 17). 37 C.F.R. § 41.37(c)(1)(iv).

Rejection 1

ISSUE

The Examiner found, *inter alia*, Einstman discloses milling spray dried coffee (powder) with solids (corn syrup, oil) to produce a powder having an average particle size of 120 microns with substantially all particles between 90–150 microns. (Final Act. 2.) The Examiner found Einstman discloses feeding powder into an agglomerator, forming an agglomerate that would be a portion of a beverage, and that in view of Einstman’s disclosure of mixing powders to form beverages, it would have been obvious to mix the powder with a liquid to form a beverage. (*Id.* at 2–3.) The Examiner found Einstman does not disclose the amount to produce the beverage portion with about 2–16% solids and 2–90% of the dispersion facilitator being with the particle size, but determined that in view of the solid content for beverages disclosed in Richmond and Atkinson, it would have been obvious to have adjusted the liquid content and solids content of Einstman depending on the desired taste of the beverage. (*Id.* at 3.)

Appellant argues, *inter alia*, Einstman discloses the powder produced and sized to 100–150 microns is not the powdered product that is mixed with water to form the final drinkable beverage, but rather Einstman discloses the powdered product is fed further into an agglomerator to produce an agglomerated product having an average particle size of about 1400 microns, which is then combined with hot water to form a beverage. (Appeal Br. 16–17.)

Accordingly, the dispositive issues with respect to this rejection are:

Has Appellant identified a reversible error in the Examiner’s position that Einstman discloses “combining the co-milled powdered composition with the particle size of about 100 to about 150 microns with a fluid to produce the beverage for consumption by the consumer” as recited in claim 1?

Has Appellant identified a reversible error in the Examiner’s position that Einstman discloses a co-milled powdered composition “with a particle size of about 100 to about 150 microns,” which is “capable of preparing a beverage for consumption by a consumer” as recited in claim 29?

DISCUSSION

Claim 1

We agree with Appellant that Einstman fails to disclose combining the co-milled powdered composition with the particle size of about 100 to about 150 microns with a fluid to produce the beverage for consumption by the consumer. Einstman discloses blending 155 lbs. of spray-dried lightener solids with 45 lbs. spray dried soluble coffee, which is milled to form a powder with substantially all particles between about 90 microns and 150

microns. (Einstman, col. 4, l. 63 – col. 5, l. 7.) However, Einstman discloses the “co-ground mixture is then fed to an agglomerator at 400 lbs./hr.” (Einstman, col. 5, ll. 7–8.) Einstman discloses the agglomerator operates with a steam nozzle pressure of 24 p.s.i., an air rate of 2300 cu. ft./min., an air inlet temperature of 420° F and an air outlet temperature of 245° F.” (*Id.* at col. 5, ll. 8–12.) Einstman discloses the “resulting product” has a bulk density of about 0.210 g/cc and an average particle size of about 1400 microns, where two teaspoons of the “resulting product” are mixed with hot water to form a cup of coffee beverage. (*Id.* at col. 5, ll. 12–18.) Thus, we agree with Appellant that Einstman does not disclose mixing of the powder with substantially all particles between about 90 microns and 150 microns with water, as would be required to meet the method of claim 1, but rather discloses mixing an agglomerated particle with much larger particle size, 1400 microns, for example, with water to form a beverage. In this regard, we agree also with Appellant that the Examiner’s position that Einstman’s agglomerate “is still made up of a collection of particles having a size of 90-150 microns” (Ans. 3) is unsupported, particularly in view of Einstman’s disclosure discussed above of the pressure and temperature conditions in the agglomerator used to produce particles that average 1400 microns in size. (Reply Br. 2–5.)

Accordingly, we reverse the Examiner’s rejection of claim 1, and claims 2–9 dependent therefrom. In addition, because independent claim 30 similarly recites mixing a co-milled powdered composition with a particle size of about 100 to about 150 microns with water, we reverse the Examiner’s rejection of claim 30 as well.

Claim 29

Claim 29 stands on different footing than claim 1. Specifically, claim 29 recites a “method of preparing a co-milled powdered composition,” as opposed to a “method for forming a beverage” recited in claim 1. Claim 29 does not recite the co-milled powdered composition is mixed with water, but recites only that the composition is “capable of preparing beverage” and is “effective to produce the beverage for consumption.” As discussed above, Einstman discloses producing a powdered composition of combined coffee solids and lightener solids co-milled to produce a powdered composition having a particle size of about 90 microns to about 150 microns, a substantially identical process and composition as formed by Appellant’s method. Thus, the powdered composition produced in Einstman would have been expected to be “capable of preparing a beverage” and “effective to produce the beverage for consumption” as recited in claim 29. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (“[w]here, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.”).

Accordingly, we affirm the Examiner’s rejection of claim 29. However, because the Examiner did not address claim 29 specifically in the rejection, and because our rationale differs from the Examiner’s rationale, we designate our affirmance as a new ground of rejection.

Rejection 2

Regarding claim 10, which depends from claim 1, the addition of Halliday relied upon for the teaching of cartridges for use with a beverage brewing machines (Final Act. 4), fails to remedy the deficiencies of Einstman as discussed above. Accordingly, we reverse Rejection 2 as well.

DECISION

Claims Rejected	Basis	Affirmed	Reversed
1–9, 29, and 30	§ 103(a) Einstman, Richmond, and Atkinson	29	1–9 and 30
10	§ 103(a) Einstman, Richmond, Halliday, and Atkinson		10
Overall Outcome		29	1–10 and 30

FINALITY AND RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[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:

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(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. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

AFFIRMED-IN-PART; 37 C.F.R. 41.50(b)