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Harness Dickey (Troy) P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			BEKKER, KELLY JO	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KLAUS KUHN

Appeal 2019-002416
Application 14/761,171
Technology Center 1700

Before GEORGE C. BEST, CHRISTOPHER C. KENNEDY, and
JULIA HEANEY, *Administrative Patent Judges*.

BEST, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 17–27, 35, and 37–39 of Application 14/761,171. Final Act. (May 7, 2018). We have jurisdiction under 35 U.S.C. § 6.

For the reasons set forth below, we *affirm*.

¹ We use the word “Appellant” to refer to “Applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Südzucker Aktiengesellschaft Mannheim/Ochsenfurt, as the real party in interest. Appeal Br. 3.

I. BACKGROUND

The '171 Application describes a jelly confectionary such as a gummy bear. Spec. 1. The jelly confectionary is said to be non-cariogenic, non-laxative, reduced-calorie, and to have a low glycemic index. *Id.* In particular, the jelly confectionary is produced by replacing the sucrose in prior art jelly confectionaries with isomaltulose. *Id.* at 3.

Claim 17 is representative of the '171 Application's claims and is reproduced below from the Claims Appendix of the Appeal Brief.

17. A jelly confectionary comprising:
- (a) a sugar, the sugar being isomaltulose;
 - (b) at least one gelling agent; and
 - (c) water,

wherein the sugar in the jelly confectionary is 30 to 50 wt.-% based on a total weight of the jelly confectionary, wherein the jelly confectionary contains no sugar alcohol or polyols, and wherein the jelly confectionary has a turbidity of 100 to 250 nephelometric turbidity units (NTU) measured at a frequency^[2] of 578 nm.

Appeal Br. 18 (Claims App.).

² 578 nm is a wavelength, not a frequency. If prosecution of the '171 Application continues, Appellant should consider correcting this error. This error also appears in claim 38 and in the Specification on at least pages 3, 8, 11, and 13.

II. REJECTIONS

On appeal, the Examiner maintains the following rejections:

1. Claims 17, 18, 23–27, and 35 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gyeong³ and Lees & Jackson.⁴ Final Act. 2–5.
2. Claims 19 and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gyeong, Lees & Jackson, and Applicant’s Admitted Prior Art (AAPA). Final Act. 5–6.
3. Claims 21, 22, and 37 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gyeong, Lees & Jackson, and Francisca.⁵ Final Act. 6–7.
4. Claims 38 and 39 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gyeong, Lees & Jackson, AAPA, and Francisca. Final Act. 7–10.
5. Claims 17–21, 23, 26, 27, 35, and 38 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Koivistoinen⁶ and Lees & Jackson. Final Act. 10–13.
6. Claims 22, 24, and 25 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Koivistoinen, Lees & Jackson, and Francisca. Final Act. 13–14.

³ KR 100432039 B1, published July 16, 2004. We rely upon the machine translation that was made of record in the prosecution of the ’171 Application on December 26, 2017.

⁴ R. Lees & E.B. Jackson, *Sugar Confectionery and Chocolate Manufacture*, 247, 249, Thomson Litho Ltd, publishers (1973).

⁵ US 2010/0104722 A1, published April 29, 2010.

⁶ WO 2008/071797 A1, published June 19, 2008.

7. Claims 37 and 39 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Koivistoinen, Lees & Jackson, Francisca, and AAPA. Final Act. 14–15.

III. DISCUSSION

Appellant argues that independent claims 17 and 38 are patentable over the cited prior art. Appeal Br. 10–16. Appellant does not present separate arguments for the patentability of any of the rejected dependent claims. *Id.*

We address each of Appellant’s arguments in turn.

A. *The Examiner Did Not Err by Selecting Isomaltulose from Lists of Sugars Provided by Gyeong and Koivistoinen*

The Examiner rejected claim 17 as unpatentable over the combination of Gyeong and Lees & Jackson and rejected claim 38 as unpatentable over the combination of Gyeong, Lees & Jackson, AAPA, and Francisca. Final Act. 2, 7. In doing so, the Examiner found that Gyeong describes a jelly confectionary comprising 0.1 to 35% of one or more sugars selected from a group of eight sugars that includes isomaltulose. *Id.* at 2.

Similarly, the Examiner rejected claims 17 and 38 as unpatentable over the combination of Koivistoinen and Lees & Jackson. *Id.* at 10. In reaching this conclusion, the Examiner found that Koivistoinen describes a jelly confectionary comprising 25 to 75% of one or more bulk sweeteners selected from the group of 18 sweeteners including isomaltulose. *Id.* at 10–11.

Appellant argues that each of the rejections of claims 17 and 38 should be reversed because the Examiner has not provided an adequate reason to select isomaltulose from the list of sucrose substitutes set forth in

Gyeong or Koivistoinen. Appeal Br. 11–13. Appellant further argues that the Board’s decision in *Ex parte Tatarka*, appeal 2014-007414, 2016 WL 1239173 (PTAB March 28, 2016), supports its argument. Appeal Br. 12–13. In *Tatarka*, we reversed an obviousness rejection because the Examiner did not provide any specific rationale for why a person having ordinary skill in the art would have “plucked” a particular elastomer from the many possibilities suggested in the prior art. *Tatarka*, 2016 WL 1239173 at*2.

We are not persuaded by Appellant’s argument.

First, *Tatarka* is not controlling precedent. The Federal Circuit has explained that the fact that a reference “discloses a multitude of effective combinations does not render any particular formulation less obvious.” *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989). *See also In re Corkill*, 771 F.2d 1496, 1500 (Fed. Cir. 1985) (obviousness rejection of claims affirmed in light of prior art teaching that “hydrated zeolites will work” in detergent formulations, even though “the inventors selected the zeolites of the claims from among ‘thousands’ of compounds”); *In re Susi*, 440 F.2d 442, 445 (CCPA 1971) (obviousness rejection affirmed where the disclosure of the prior art was “huge, but it undeniably include[d] at least some of the compounds recited in appellant’s generic claims and [was] of a class of chemicals to be used for the same purpose as appellant’s additives”).

Second, *Tatarka* is distinguishable from the facts of this appeal. According to Appellant, there are 255 possible combinations of the eight sugars listed by Gyeong from which a person having ordinary skill in the art could choose. Appeal Br. 12. Similarly, Appellant also calculates that there are 262,143 possible combinations of the 18 sugars listed in Koivistoinen. *Id.* In *Tatarka*, however, the prior art “[did] not identify only a finite number

of predictable solutions.” *Tatarka*, 2016 WL 1239173 at*2. *Tatarka*, therefore, at most stands for the proposition that an examiner must provide a rationale to select a particular species that is suggested by disclosure of an open ended list of possibilities. This is not such a case.

Third, as the Examiner points out, isomaltulose is specifically identified in the list provided by Gyeong and Koivistoinen. *See* Answer 15 (“To use a named compositional component would have been encompassed or at the very least obvious when one of ordinary skill in the art was practicing the prior art as disclosed.”). We agree with the Examiner.

For these reasons, we determine that the Examiner did not err by finding that the prior art describes or suggests creating jelly confectionaries with isomaltulose.

B. *The Examiner Did Not Err by Finding that Lees & Jackson Suggests the Turbidity Limitation Recited in Claims 17 and 38*

Appellant argues that Lees & Jackson fails to describe or suggest how to create a jelly confectionary comprising isomaltulose and having a turbidity of 100–250 NTU. Appeal Br. 13–15. Claims 17 and 38 both require the jelly confectionary to have a turbidity in this range when measured at 578 nm. *Id.* at 18, 20.

In rejecting claim 17 and 38, the Examiner found that Lees & Jackson describes jelly confectionaries cooled at 5–10°C after deposition in molds as having better sparkle from reflected light. Final Act. 3, 8–9, 11–12. The Examiner found that a person having ordinary skill in the art would have used Lees & Jackson’s production method to make the jelly confectionaries described or suggested by Gyeong or Koivistoinen to obtain better sparkle. *Id.* the Examiner further found that the jelly confectionaries resulting from

the combination of Gyeong and Lees & Jackson or Koivistoinen and Lees & Jackson would be substantially identical to the claimed jelly confectionaries. *Id.*; *see also* Answer 16–19. Based upon this finding, the Examiner required Appellants to demonstrate that the product described or suggested by the prior art differs from the claimed product. *Id.* (citing *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977)).

Appellant argues that the Examiner erred because the cited portion of Lees & Jackson does not describe production of a jelly confectionary comprising sugar. Appeal Br. 14 (citing Lees & Jackson 247). This argument is not persuasive because the cited portion of Lees & Jackson does not expressly limit the production method to jelly confectionaries that do not include sugar. *See* Lees & Jackson 247. Even if Appellant were correct, Lees & Jackson specifically contemplates the manufacture of jelly confectionaries that include sugar. *See* Lees & Jackson 249 (describing the effect of sugar solution temperature on the gelling power of gelatin).

Thus, the Examiner was entitled to rely upon the burden-shifting authorized by *Best*. Because Appellant has not met its burden of demonstrating a difference between the jelly confectionary described or suggested by the combination of prior art references relied upon in the rejections of claims 17 and 38, we do not reverse the rejections of these claims.

IV. CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
17, 18, 23–27, 35	103(a)	Gyeong, Lees & Jackson	17, 18, 23–27, 35	

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
19, 20	103(a)	Gyeong, Lees & Jackson, AAPA	19, 20	
21, 22, 37	103(a)	Gyeong, Lees & Jackson, Francisca	21, 22, 37	
38, 39	103(a)	Gyeong, Lees & Jackson, AAPA, Francisca	38, 39	
17–21, 23, 26, 27, 35, 38	103(a)	Koivistoinen, Lees & Jackson	17–21, 23, 26, 27, 35, 38	
22, 24, 25	103(a)	Koivistoinen, Lees & Jackson, Francisca	22, 24, 25	
37, 39	103(a)	Koivistoinen, Lees & Jackson, Francisca, AAPA	37, 39	
Overall Outcome			17–27, 35, 37–39	

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

AFFIRMED