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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* YUANLONG PAN, HUI XU, and  
SANDEEP BHATNAGAR

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Appeal 2019–006721  
Application 14/946,205  
Technology Center 1700

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Before KAREN M. HASTINGS, JEFFREY B. ROBERTSON, and  
JANE E. INGLESE, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner’s rejections of claims 1–12. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).<sup>2</sup>

We AFFIRM.

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<sup>1</sup> 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 Nestec S.A. (Appeal Br. 2).

<sup>2</sup> A Decision affirming the Examiner’s § 103 rejections of related subject matter in a co-pending application was mailed concurrently with this one (Appeal 2019–006710).

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

1. A method for promoting lean body mass, minimizing body fat gain, and maintaining weight without limiting caloric intake in an obese or overweight cat or dog, the method comprising:
  - administering to the obese or overweight cat or dog a pet food composition in an amount from 105% to 200% of the baseline maintenance energy requirement (MER) of the obese or overweight cat or dog, the pet food composition comprising:
    - from about 30% to about 65% protein,
    - from about 10% to about 20% carbohydrate, and
    - from about 10% to about 25% fat,
  - wherein the protein and the carbohydrate are in a weight ratio from about 4:1 to about 10:1.<sup>3</sup>

The following rejections under 35 U.S.C. § 112 are on appeal:

- 1) claims 1–12, first paragraph, as failing to comply with the written description requirement; and
- 2) claims 1–12, second paragraph, as indefinite.

The following rejections under 35 U.S.C. § 103 are on appeal:

- 3) claims 1–12 as unpatentable over the combined prior art of Schoenherr (US 2005/0025857 A1, published Feb. 3, 2005), Hill (Richard C. Hill, *Challenges in Measuring Energy Expenditure in Companion Animals: A Clinician's Perspective*, J. NUTR. 136 (2006)), Blanchard (Geraldine Blanchard et al., *Rapid Weight Loss with a*

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<sup>3</sup> Appellant's Specification states that "about" encompasses plus or minus 20% (Spec. ¶ 27).

*High-Protein Low-Energy Diet Allows the Recovery of Ideal Body Composition and Insulin Sensitivity in Obese Dogs*, J. NUTR. 134 (2004)), Serisier (S. Serisier et al., *Maintenance energy requirements in miniature colony dogs*, J. ANIM. PHY AND ANIM. NUTR., VOL. 97 (2013)), and Vasconcellos (Ricardo S. Vasconcellos et al., *Protein Intake During Weight Loss Influences the Energy Required for Weight Loss and Maintenance in Cats*, J NUTR. 139 (2009));

4) claim 1–12 as unpatentable over the combined prior art of Bui (US 2007/0286889 A1, published Dec. 13, 2007), Hill, Serisier, and Vasconcellos; with claims 7 and 10 rejected again adding Tissot-Favre (US 2014/0134135 A1, published May 15, 2014);

5) claims 1–6, 8, 11, and 12 as unpatentable over the combined prior art of Diez (Marianne Diez, *Weight Loss in Obese Dogs: Evaluation of a High-Protein, Low-Carbohydrate Diet*, J. NUTR. 132 (2002)), German (Alexander J. German et al., *Dietary Energy Restriction and Successful Weight Loss in Obese Client-Owned Dogs*, J. VET. INTERN MED. (2007)), Hill, Serisier, and Vasconcellos;

6) claims 7, 9, and 10 as unpatentable over the combined prior art of Diez, German, Hill, Serisier, Vasconcellos, and Tissot-Favre.

The Examiner also rejected claims 1–12 on the basis of nonstatutory double patenting (Final Act. 24). As pointed out by the Examiner, Appellant did not address the rejection and thus failed to show any error therein (Ans. 37<sup>4</sup>). Thus, this rejection is summarily affirmed.

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<sup>4</sup> All references to the Answer herein are to the Answer mailed July 19, 2019.

## ANALYSIS

### *The § 112 rejection for failing to comply with the written description requirement*

For an applicant to comply with the 35 U.S.C. § 112, first paragraph, written description requirement, the applicant's specification must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991)).

Claim 1 recites that the pet food composition of claim 1 is fed in an amount "from 105% to 200% of the baseline energy requirement (MER) of the obese or overweight cat or dog" (Appeal Br. 29, Claims App.). There is no dispute that the Specification explicitly describes this limitation (*e.g.*, Spec. ¶ 41). The Examiner's rejection is based on the circumstances that MER is at best an estimate that may be difficult to establish or calculate with precision (Ans. 4, 5). The Examiner relies on paragraph 39 of the Specification which gives various non-limiting examples of how to calculate the MER of humans and animals (Ans. 4). The Examiner also questions the examples for a dog and a cat set out in that paragraph (*id.*).

Appellant contends that even though there are various ways to determine the MER, one of ordinary skill in the art would have known these ways of determining or calculating the MER of an animal, and since the Specification explicitly states feeding a dog or cat 105 to 200% of their respective MER, this adequately shows that Appellant had possession of a the claimed subject matter (Appeal Br. 6, 7; Reply Br. 2, 3).

While we appreciate the Examiner’s concern with the examples given for a dog and a cat in paragraph 39 of the Specification, there is adequate evidence that one of ordinary skill in the art would have known how to determine the MER of a dog or a cat (*e.g.*, *see* Appeal Br. 7). Indeed, Appellant’s Specification describes that baseline MER may be “determined over a period of [time] using [a] feeding trial; or indirect or direct calorimetry” (Spec. ¶ 16; *see also* claim 2). We agree with the Examiner that determining such a MER is at best an estimate, dependent on various factors (*e.g.*, Ans. 26). However, in our view, this situation pertains to the breadth of the claimed subject matter, rather than to a question of written description. The broadest reasonable interpretation of the claim language in light of the Specification permits one of ordinary skill in the art to determine the MER in any known manner. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (the scope of the claims in patent applications is determined by giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (the specification is always highly relevant to the claim construction analysis, and is usually dispositive as it is the single best guide to the meaning of any disputed terms).

Thus, the description of determining baseline MER in Appellant’s Specification appears to be as precise as the subject matter permits (*e.g.*, Spec. ¶¶ 16, 39). Accordingly, we agree with Appellant that a preponderance of the evidence supports Appellant’s position that one of ordinary skill in the art would have understood that Appellant was in possession of the claimed subject matter. *Cf. Union Oil Co. of Cal. v. Atl.*

*Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000) (The claim need not use the same words as the specification; it is enough that one of ordinary skill in the art would recognize that the inventor invented what is claimed).

Accordingly, we reverse the Examiner’s § 112 rejection for lack of written description.

*The § 112 rejection for indefiniteness*

During prosecution, claims are interpreted using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). Claims are definite if they “set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed—not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.” *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). However, “breadth [of a claim] is not to be equated with indefiniteness.” *In re Miller*, 441 F.2d 689, 693 (CCPA 1971).

The Examiner found the language of claim 1 indefinite, essentially for the same reasons the Examiner found the Specification lacked written description support; that is, since determining the baseline MER is at best an estimate and the claim requires feeding an amount of food from 105% to

200% of the baseline MER, one would not know the metes and bounds of the claim.

Claim 1 is broad in the sense that it reads on a method of feeding 105% to 200 % of the baseline MER which may be determined by any known method of determining baseline MER for a dog or cat. However, claim 1 is not indefinite on the basis of its breadth alone. *In re Miller*, 441 F.2d at 693; *see also In re Gardner*, 427 F.2d 786, 788 (CCPA 1970) (“[B]readth is not indefiniteness.”). The Examiner has not explained sufficiently why one of ordinary skill in the art would not have understood how to use any one of the known method(s) of determining a baseline MER in the manner described in the Specification and in Appellant’s response (Spec. ¶¶ 16, 39; Appeal Br. 9, 10; Reply Br. 5, 6). As discussed previously, while we appreciate the Examiner’s concern with the examples given for a dog and a cat in paragraph 39 of the Specification,<sup>5</sup> Appellant’s Specification describes that baseline MER may be “determined over a period of [time] using [a] feeding trial; or indirect or direct calorimetry” (Spec. ¶ 16).

Appellant has also persuasively reasoned that the “baseline MER” language used in claim 1 “is as precise as the subject matter permits”,

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<sup>5</sup> These examples include an example formula for a dog and a cat, respectively, which each use a single number to multiply with a dog or cat’s weight. The Examiner cites to an article that says it is impossible to exactly determine how much calories a pet needs (*e.g.*, Ans. 5)). However, even given that any specific MER will be an estimate that may be determined by different methods, a preponderance of the evidence establishes that one of ordinary skill in the art would have known how to determine such a baseline MER (estimate) for any specific dog or cat. Indeed, no rejection is before us based on lack of enablement.

similar to the situation in *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1576 (Fed. Circ. 1986) (The court found the claim phrase “so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof” to be as accurate as the subject matter permitted, since automobiles are of various sizes) (*see, e.g.*, Appeal Br. 9; Reply Br. 5, 6).

In light of these circumstances, we agree with Appellant that one of ordinary skill in the art would have understood the broad scope of the claim in light of the Specification. Accordingly, we cannot sustain the Examiner’s rejection of the claims as being indefinite.

#### *The § 103 Rejections*

Upon consideration of the evidence on this record and each of Appellant’s contentions, we find that the preponderance of evidence supports the Examiner’s conclusion that the subject matter of Appellant’s claims is unpatentable over the applied prior art. We sustain all of the Examiner’s § 103(a) rejections essentially for the reasons set out by the Examiner in the Final Office Action and the Answer.

We add the following primarily for emphasis.

It has been established that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Likewise, it is also 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).

Appellant contends that each § 103 rejection, whether based on Schoenherr or Bui or Diez/German, is deficient for the same reasons, which reasons focus on the teachings of Serisier and/or Vasconcellos. Specifically, Appellant argues that “At most, *Serisier* teaches a diet that is higher than a preceding energy intake restriction in dogs that are no longer obese or overweight” (Appeal Br. 12). Similarly, Appellant argues that Vasconcellos suggests feeding cats an MER recommended for obese cats after obese adult cats lost weight (*id.*), such that there is no teaching or suggestion of feeding an obese or overweight cat or dog 105% to 200% of their MER as recited in claim 1.

These arguments are not persuasive of reversible error in the Examiner’s obviousness rejections because they fail to fully address the applied prior art, and the inferences that one of ordinary skill in the art would have made therefrom. Each of Schoenherr and Bui and Diez/German describes a pet food composition useful for weight management with the claimed components in amounts that overlap each of the claimed ranges. As pointed out by the Examiner, Serisier describes that MER increased by about 15% to 30% during a weight loss program, “likely related to increased metabolic efficiencies” (Serisier 65 (2<sup>nd</sup> column, last paragraph); *e.g.*, Ans. 9). Thus, for example only, one of ordinary skill would readily infer that an obese animal may still be overweight after weight loss, yet its MER increased such that one is now feeding above its baseline MER. Vasconcellos also exemplifies that high protein diets allow a higher energy

intake and that more energy may be required after weight loss to maintain weight (that is, an increase in MER) (Ans. 9, 10; Vasconcellos, Abstr.)

Appellant does not dispute the Examiner's obviousness determination that through the use of no more than ordinary creativity, one would have used amounts of protein and carbohydrate such that the claimed range of ratios would have been achieved/selected based on either one of Schoenherr or Bui or Diez/German (*e.g.*, Ans. 8, 14). Serisier and Vasconcellos were applied by the Examiner to exemplify that one of ordinary skill in the art would have known that as an animal loses weight, its MER increases such that it would have been within the level of ordinary skill to feed an animal at least its MER, and 105% is so close to 100% especially given the breadth of the MER estimate (*e.g.*, Ans. 9, 14, 19, 28).

It is also within the ordinary creativity of an artisan to feed an animal more of its baseline MER, especially in light of the fact that its MER may increase during weight loss. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000) ("The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another."). While a pet may not lose as much weight if one feeds it more than its baseline MER, it is common knowledge that a high protein diet may be beneficial for increased muscle mass. *See also In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) (court affirmed rejections based on art which rendered the claimed invention obvious to those of ordinary skill in the art despite the fact that the art teachings relied

upon were phrased in terms of a non-preferred embodiment or as being unsatisfactory for the intended purpose).

One would have readily appreciated that there are only three options; feed an overweight animal its MER, or more or less than its MER. Given the circumstances established in the prior art, e.g., that any specific pet's MER is an estimate (e.g., Ans. 14), as well as the fact that it is well known that increased protein/energy is desirable/necessary to increase muscle mass, feeding an overweight or obese dog or cat 105% more than their baseline MER is within the ordinary skill and common knowledge of an artisan. That is to say, with no more than the use of ordinary creativity and inferences based on the applied prior art in each rejection, one would have known that feeding a cat or dog more than its baseline MER is an option. *KSR Int'l*, 550 U.S. at 418; *see also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”); *Ball Aerosol & Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009) (Under the flexible inquiry set forth by the Supreme Court, the PTO must take account of “*the inferences and creative steps*,” as well as routine steps, that an ordinary artisan would employ.); *see also KSR Int'l*, 550 U.S. at 417 (It is a well-established principle that, for an improvement to be patentable, it must be more than the predictable use of prior art elements, or steps, according to their established functions).

While Appellant does present separate sections for various claims dependent from claim 1 (e.g., Appeal Br. 14–16), the remarks therein amount to no more than a recounting of the claim limitations. *See* 37 C.F.R. § 41.37(c)(1)(vii) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the

Appeal 2019-006721  
Application 14/946,205

claim.”); *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

Accordingly, we affirm all of the Examiner’s § 103 rejections.

#### CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1-12		Nonstatutory double patenting; Ser. No. 14/946,185, Blanchard, Vasconcellos	1-12	
1-12	112	Written Description		1-12
1-12	112	Indefiniteness		1-12
1-12	103	Schoenherr, Hill, Blanchard, Serisier, Vasconcellos	1-12	
1-12	103	Bui, Hill, Serisier, Vasconcellos	1-12	
7, 10	103	Bui, Hill, Serisier, Vasconcellos, Tissot-Favre	7, 10	
1-6, 8, 11, 12	103	Diez, German, Hill, Serisier, Vasconcellos	1-6, 8, 11, 12	
7, 9, 10	103	Diez, German, Hill, Serisier, Vasconcellos, Tissot-Favre	7, 9, 10	
<b>Overall Outcome</b>			1-12	

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**