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23850	7590	09/28/2020	EXAMINER	
KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. 4th Floor WASHINGTON, DC 20005			COX, STEPHANIE A	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TORU NAKAJIMA, MAKOTO NAKAUMA, and
TAKAHIRO FUNAMI

Appeal 2020-000270
Application 12/921,223
Technology Center 1700

Before BEVERLY A. FRANKLIN, JEFFREY R. SNAY, and LILAN REN,
Administrative Patent Judges.

FRANKLIN, *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 1–12 and 15–20. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on September 17, 2020.

We REVERSE.

¹ 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 SAN-EI GEN F.F.I., INC. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Claim 1 is illustrative of Appellant’s subject matter on appeal and is set forth below:

1. A method of modifying starch, comprising subjecting a powdery mixture consisting essentially of starch and water-soluble hemicellulose at a weight ratio of 95:5 to 80:20 to moist-heat treatment at 100 to 200°C.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Yoshino et al. (“Yoshino”)	US 5,362,329	Nov. 8, 1994
Stute et al. (“Stute”)	US 5,489,340	Feb. 6, 1996
Narimatsu et al. (“Narimatsu”)	US 6,224,931 B1	May 1, 2001

REJECTIONS

Claims 1, 2, 4, 6, 7, 9, 11, 12, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshino in view of Narimatsu.

Claims 3, 5, 8, 10, and 17–20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshino and Narimatsu as applied to claims 1, 2, 4, 6, 7, 9, and 11–16 above, and further in view of Stute.

OPINION

We review the appealed rejections for error based upon the issues Appellant identifies, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011)

("[I]t has long been the Board's practice to require an applicant to identify the alleged error in the examiner's rejections."). Upon review of the evidence and each of the respective positions set forth in the record, we find that the preponderance of evidence supports Appellant's position in the record. Accordingly, we reverse each of the Examiner's rejections on appeal essentially for the reasons set forth in the record by Appellant, and add the following for emphasis.

Appellant states on page 6 of the Appeal Brief that the powdery mixture as recited in method claim 1 includes mixtures containing starch and water-soluble hemicellulose, and which do not contain other materials that would affect the basic and novel characteristics of the invention. Appellant explains that the basic and novel characteristics of the invention are suppression of swelling and disintegration of starch granules. Appeal Br. 7. Appellant states that as a result of the limitation of "a powdery mixture consisting essentially of starch and water-soluble hemicellulose", the powdery mixture cannot include any substance that would interfere with the basic and novel characteristics of the invention (suppression of swelling and disintegration of starch granules). Reply Br. 2. Appellant refers to the 37 CFR § 1.132 Declaration submitted with the Response filed on July 23, 2018 (hereafter the "Nakauma Declaration"). Appeal Br. 12–13. Appellant states that the Nakauma Declaration shows that wheat flour is an ingredient that interferes with the basic and novel characteristics of the invention (suppression of swelling and disintegration of starch granules) because no inhibitory effect on swelling and/or disintegration of starch granules resulted when wheat flour is included as an ingredient. Appeal Br. 13. As such, it is

Appellant's position that because the combination of Yoshino and Narimatsu includes wheat flour, the claimed subject matter is not suggested by the combination. Appeal Br. 10.

The Examiner states that the rejection is not relying upon bodily incorporating the entire composition of Narimatsu into Yoshino. Ans. 9. The Examiner states that Yoshino fails to teach heat treating water-soluble hemicellulose along with the starch, and that Narimatsu teaches adding water-soluble hemicellulose to starch in powder form. *Id.* The Examiner states that the rejection is relying upon incorporating the water-soluble hemicellulose into the composition of Yoshino. Ans. 9. However, we agree with Appellant that Narimatsu teaches adding water-soluble hemicellulose to a mixture of wheat flour and starch for the reasons presented on pages 3–5 of the Reply Brief. An adequate case has not been made in the record by the Examiner that such a teaching suggests adding water-soluble hemicellulose to a mixture of starch alone.

With regard to the Nakauma Declaration, we agree with Appellant that the Examiner's reasoning that the Nakauma Declaration is unpersuasive because Appellant has not compared the closest prior art (Ans. 8) is improper for the reasons stated on page 5 of the Reply Brief.

In view of the above, we reverse the rejections.

CONCLUSION

We reverse the Examiner's decision.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 4, 6, 7, 9, 11, 12, 15, 16	103	Yoshino, Narimatsu		1, 2, 4, 6, 7, 9, 11, 12, 15, 16
3, 5, 8, 10, 17–20	103	Yoshino, Narimatsu, Stute		3, 5, 8, 10, 17–20
Overall Outcome				1–12, 15–20

REVERSED