

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARRY BUSSEY JR. and BUDDY HARRY BUSSEY III

Appeal No. 2001-1140
Application No. 08/867,771

ON BRIEF

Before PAK, OWENS, and JEFFREY T. SMITH, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal the decision of the Primary Examiner finally rejecting claims 29, 30 and 34. We have jurisdiction under 35 U.S.C. § 134.^{1, 2}

¹ In rendering this decision, we have considered Appellants arguments presented in the Brief, filed April 14, 2000 and the Reply Brief, filed July 31, 2000.

² The Examiner has indicated that the subject matter of claims 1 to 6, 8, 9, 13 to 15, 18, 19, 22 to 27, 32 and 33 is allowable. The Examiner has withdrawn the final rejection of claims 22 to 26, 32 and 33. The Examiner has indicated that the subject matter of claim 31 would be allowable if written in independent form. (Answer, pp. 2-3).

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not specifically argued will stand or fall with its base claim. Note *In re King*, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants concerning the above-noted rejection, we refer to the Answer and the Briefs.

OPINION

The Examiner rejected claims 29, 30 and 34 under 35 U.S.C. § 103(a) as unpatentable over Lacourse. The Examiner has determined that Lacourse would have suggested operating the extruder at a temperature that falls within the scope of the claimed invention. Specifically, the Examiner states “Lacourse et al. at least suggest operating the extruder at a temperature within the claimed range by only approximately specifying the lower limit of the operating temperature range (i.e. ‘about 150°C (about 302°F)). (Answer, p. 4).

Appellants assert that the subject matter of claim 29 distinguishes over the method of Lacourse specifically “in the step of heating a mass of starch inside an extruder to a low temperature, i.e. to a temperature in a range of from 150°F to 300°F whereas Lacourse heats a mass of starch in an extruder to a high temperature of from about 150°C to 250°C [302°F to 482°F]. These ranges do not overlap.” (Brief, p. 7). Appellants also assert that there is no motivation to use a temperature lower than 150°C. (Reply Brief, p.1).

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We are not persuaded by Appellants' assertions. Lacourse discloses the lower limit of the operating temperature for the extruder starts from **about** 150°C [**about** 302°F].

Lacourse also discloses in the Background of the Invention section that it is known that a dispersible, hydrophobic porous starch product could be produced by extrusion of the starch at a temperature of 100°C to 250°C [212°F to 482°F] and a moisture content of 4 to 15 percent. (Col. 2, ll. 3 to 6). Thus, from this disclosure, a person of ordinary skill in the art would have recognized that starch can be extruded at temperatures below 150°C [302°F], such as those within the claimed range. “[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) (A process for catalytically producing carbon disulfide by reacting sulfur vapor and methane in the presence of charcoal at a temperature of “about 750-830°C” was found to be suggested by a reference which expressly taught the same process at 700°C because the reference referred to prior art catalytic processes for converting methane with sulfur vapors into carbon disulfide at temperatures greater than 750°C (albeit without charcoal)). Thus, we conclude that it would have been *prima facie* obvious to employ the claimed temperature in the process of Lacourse.

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In any event, it has also been held that a *prima facie* case of obviousness exists when the claimed range and the prior art range do not overlap but are close enough such that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985) (concluding that a claim directed to an alloy containing “0.8% nickel, 0.3% molybdenum, up to 0.1% maximum iron, balance titanium” would have been *prima facie* obvious in view of a reference disclosing alloys containing 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium). Thus, the extrusion temperature of **about** 150°C [302°F] would have rendered the claimed temperature of 300°F *prima facie* obvious since one of ordinary skill in the art would have reasonably expected to produce the same or similar extrudate at either temperature.

Claim 34 further defines the method of claim 29 by specifying that “the blowing agent is injected into the mass in a selectively controlled manner in dependence on the degree of the extrudate to bring the extrudate to a desired foamed state.” Claim 29 discloses that the blowing agent is injected in an amount up to 20% by weight. Lacourse discloses that water may be added to the extruder so that the product has a total moisture content of preferably 13 to 19% to allow for desired expansion and cell structure formation in the prepared product. (Col. 5, ll. 29 to 39). Thus, a person of ordinary skill in the art would

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have been motivated to perform the method of Lacourse employing the same amount of water required by the claimed invention even if for a different purpose than that intended by Appellants. *See In re Kronig*, 539 F.2d 1300, 1304, 190 USPQ 425, 428, (CCPA 1976) (“[I]t is sufficient here that [the reference] clearly [suggests] doing what appellants have done.”).

Based on our consideration of the totality of the record before us, having evaluated the *prima facie* case of obviousness in view of Appellants’ arguments, we conclude that the subject matter of claims 29, 30 and 34 would have been obvious to a person of ordinary skill in the art from the combined teachings of the cited prior art. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

CONCLUSION

The rejection of claims 29, 30 and 34 under 35 U.S.C. § 103(a) over Lacourse is affirmed.

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Time for taking action

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

AFFIRMED

CHUNG K. PAK
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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