

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REMY F. GROSS, II,
JOHN P. DELMORE,
and
WALTER E. BUSKE¹

Appeal No. 2002-2029
Application No. 09/440,037

ON BRIEF

Before KRATZ, DELMENDO, and MOORE, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2002) from the examiner's final rejection of claims 1 through 14 and 20 through 23 (final Office action mailed May 22, 2001,

¹ The appellants submitted a request under 37 CFR § 1.48(b) (1997) to delete the third-named inventor, together with a request to cancel non-elected claims 15-19. (Reply filed Oct. 23, 2000, paper 6.) We note, however, that the examiner has not commented on the appellants' requests. Upon receipt of this application, the examiner should treat the appellants' requests as may be appropriate under the circumstances.

paper 11) in the above-identified application. Claims 15 through 19, which are the only other pending claims, stand withdrawn from further consideration pursuant to 37 CFR § 1.142(b) (1959). (Office action mailed Sep. 20, 2000, paper 5; Reply filed Oct. 23, 2000, paper 6.)

The subject matter on appeal relates to a process for accelerating the maturation of an unaged or partially aged beverage. According to the appellants, "[t]he present disclosure provides methods of aging beverages that result in distilled beverages that are aged for much shorter periods, even as short as about 30-40 days or even less, that have the character conventionally achieved only after four years of aging." (Specification, page 3, lines 15-17.) Further details of this appealed subject matter are recited in representative claims, 1, 20, and 23, the only independent claims on appeal, reproduced below:

1. A process for accelerating the maturation of an unaged or partially aged beverage comprising:
 - (a) determining a target concentration of ethyl acetate for the product of said maturation;
 - (b) providing an unaged or partially aged beverage with from about $\frac{1}{2}$ to about $2\frac{1}{2}$ grams/100 PL of ethyl acetate in excess of said target concentration;
 - (c) flowing said beverage of step (b) through a closed system wherein said closed system comprises a beverage aging wood product such that a beverage

passing through said system contacts said wood product; and

(d) processing said beverage in the presence of oxygen for a period of time sufficient to produce a matured beverage;

wherein said beverage-aging wood product is prepared by the process of:

- (i) comminuting raw, untreated wood into granules;
- (ii) heating said granules to a temperature of from about 100° C to about 240° C for a period of at least one hour;
- (iii) contacting the granules with a solution of aqueous ethanol containing from about 50% to about 95% ethanol at a temperature of up to about 55° C;
- (iv) separating the granules from the solution; and
- (v) heating the granules to a temperature of up to about 220° C for a period of at least about 15 minutes.

20. A method of maturing an ethanolic beverage to achieve a desired organoleptic character comprising:

- (a) combining
 - (i) a quantity of a raw distillate for maturation;
 - (ii) an amount of a beverage-aging wood product sufficient to effect the maturation; and
 - (iii) from about 2 to about 100 grams of ethyl acetate per 100° proof liter of the raw distillate; and

(b) processing said beverage under conditions effective to produce the maturation of the ethanolic beverage.

23. In a maturation process for producing an aged ethanolic beverage, the improvement which comprises

adding ethyl acetate prior to or during the maturation process in a quantity sufficient to accelerate the maturation.

The examiner does not rely on any prior art.

Claims 20 through 22 on appeal stand rejected under 35 U.S.C. § 101 as lacking utility. (Examiner's answer mailed May 21, 2002, paper 19, pages 3-4.) In addition, appealed claims 20 through 22 stand rejected under 35 U.S.C. § 112, ¶1, as failing to comply with the enablement requirement of the statute. (Id. at page 4.) Further, appealed claims 1 through 14 and 20 through 23 stand rejected under 35 U.S.C. § 112, ¶2, as indefinite. (Id. at pages 4-5.)

We reverse these rejections.

Rejection under 35 U.S.C. § 112, ¶2

Because claim construction is a threshold issue in any appeal in which claims are rejected under both the first and second paragraphs of 35 U.S.C. § 112, we consider first the rejection under 35 U.S.C. § 112, ¶2.² The examiner has taken the

² See In re Angstadt, 537 F.2d 498, 501, 190 USPQ 214, 217 (CCPA 1976) (citing In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971)).

position that "[c]laims 1, 20, and 23 are indefinite because the scope of 'matured beverage' is unknown."³ (Answer, page 4.)

Specifically, it is the examiner's position that neither the claims nor the accompanying description provide a standard for ascertaining the degree of maturation. (Id. at pages 5 and 8.)

We cannot agree with the examiner's analysis and conclusion. The specification contains the following enlightenment (page 7, lines 4-11):

The amount of ethyl acetate that is added or that is contained in the distillate prior to aging the beverage is somewhat flexible and is based on the amount of ethyl acetate in the raw beverage and the amount that is desirable in the finished, aged beverage. It is the experience of the present inventors, for example, that one may add enough ethyl acetate to the raw distillate to bring the concentration to a level that is somewhat higher than the desired concentration in the aged beverage. The target level may be based on a concentration found in a product that has been aged in a more conventional manner, whose organoleptic qualities one is trying to match, or a level may be based on a novel desired characteristic of the aged beverage. [Emphasis added.]

From this disclosure and the express terms of the claims, it is our judgment that one skilled in the relevant art would understand that the invention recited in the appealed claims is

³ We note that claims 20 and 23 do not recite the term "matured beverage." It appears to us, however, that the examiner's rejection is based on the belief that the term "maturing" and "maturation" in the preambles of claims 20 and 23, respectively, render indefiniteness. (Answer, p. 7.)

not limited to any particular degree of maturation, provided that the material steps of the process are carried out. In this regard, it has long been held that undue breadth is not indefiniteness. See, e.g., In re Goffe, 526 F.2d 1393, 1397-98, 188 USPQ 131, 135 (CCPA 1975).

For these reasons, we cannot uphold the examiner's rejection on this ground.

Rejections under 35 U.S.C. § 101
& 35 U.S.C. § 112, ¶1

The questions of whether a specification provides an enabling disclosure under 35 U.S.C. § 112, ¶1, and whether an application satisfies the utility requirement of 35 U.S.C. § 101 are closely related.⁴ In re Swartz, 232 F.3d 862, 863, 56 USPQ2d 1703, 1703 (Fed. Cir. 2000). To satisfy the enablement requirement of 35 U.S.C. § 112, ¶1, the specification must adequately disclose the claimed invention so as to enable one skilled in the relevant art to practice the invention at the time the application was filed without undue experimentation. Swartz, 232 F.3d at 863, 56 USPQ2d at 1703-04. To satisfy the utility requirement of 35 U.S.C. § 101, the invention must be operable to achieve useful results. Id.

⁴ The examiner's underlying reasons for both rejections are identical. (Answer, pp. 4-5.) Thus, if the rejection under 35

Our reviewing court has also made it abundantly clear that the initial burden of challenging an applicant's presumptively correct assertion of utility rests on the PTO. Swartz, 232 F.3d at 864, 56 USPQ2d at 1704. If the examiner provides evidence sufficient to show that one of ordinary skill in the art would reasonably doubt the asserted utility, the burden then shifts to the applicant to submit evidence to convince such a person of the invention's asserted utility. Id. In this case, we hold that the examiner has not satisfied the PTO's initial burden of proof.

According to the examiner, the "[a]ppellants are disclosing and claiming a process to produce a beverage having up to 10% ethyl acetate and, at such high level of ethyl acetate, such a beverage is considered to be undrinkable." (Answer, page 3.) We note, however, that the examiner's assertion is not supported by any evidence, let alone substantial evidence. For example, assuming that the examiner is correct that a beverage having "up to 10% ethyl acetate" (which is inclusive of low amounts of ethyl acetate) would be "undrinkable," there is still no explanation why such a beverage cannot be diluted.

U.S.C. § 101 fails, then the rejection under 35 U.S.C. § 112, ¶1, also fails.

While the appellants have conceded that the recitation "from about 2 to about 100 grams of ethyl acetate per 100° proof liter of the raw distillate" in claim 20 is inconsistent with the specification description⁵ and have thus offered to correct this error by amendment, we must agree with the appellants that this inconsistency does not raise any genuine issues under 35 U.S.C. §§ 101 and 112, ¶1.

For these reasons, we cannot uphold the examiner's rejections on either of these grounds.

Summary

In summary, our disposition of this appeal is as follows:
the rejection under 35 U.S.C. § 101 of appealed claims 20 through 22 as lacking utility is reversed;

the rejection under 35 U.S.C. § 112, ¶1, of appealed claims 20 through 22 as failing to comply with the enablement requirement of the statute is reversed; and

the rejection under 35 U.S.C. § 112, ¶2, of appealed claims 1 through 14 and 20 through 23 as indefinite is reversed.

⁵ See, e.g., specification, p. 1, ll. 17-20; p. 7, ll. 13-18.

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The decision of the examiner to reject the appealed claims
is reversed.

REVERSED

Peter F. Kratz)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Romulo H. Delmendo)	
Administrative Patent Judge)	APPEALS AND
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James T. Moore)	
Administrative Patent Judge)	

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