

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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARY M. FOX

Appeal No. 2002-2146
Application No. 09/428,261

ON BRIEF

Before KIMLIN, GARRIS, and WALTZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1, 23, 47 and 64 through 91, which are the only claims remaining in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a calcium supplement that comprises a primary calcium source of calcium carbonate, a sufficient amount of a secondary calcium source to provide from 0% to 30% of the supplement's total

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soluble calcium ions in solution, and an edible acid component comprising a mixture of citric acid and malic acid in specified amounts so that at least 75% of the supplement's soluble calcium ion remains in solution for at least about 2 days (Brief, page 2).

Appellant states that the claims should be grouped into three groups and presents reasonably specific, substantive reasons for the separate patentability of each group (Brief, pages 2 and 4-5). Accordingly, we select one claim from each grouping (i.e., claims 1, 23 and 69), with all other claims in each group standing or falling together, and limit our consideration to these selected claims to the extent they have been separately argued. See *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002), and 37 CFR § 1.192(c)(7)(2000). Claim 1 is representative of the invention and is reproduced below:

1. A calcium supplement comprising:

(a) a primary calcium source comprising calcium carbonate and, optionally, a sufficient amount of a secondary calcium source to provide from 0% to 30% of the supplement's total soluble calcium ions when said supplement is placed in solution;

(b) less than an effective amount of a material selected from the group consisting of sucrose, glucose, fructose, high fructose corn syrup, invert sugar, sugar alcohols, pectin, algins, hydrolyzed starches, edible

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gums, and mixtures thereof to keep at least 75% of the supplement's soluble calcium ion in solution for at least about 2 days after said supplement is placed in solution; and

(c) an edible acid component comprising a mixture of citric acid and malic acid;

wherein the percentage of citric acid to total acid is at least 23% and not more than 75%; the weight ratio of acid equivalents to base equivalents is from 0.5 to 1.8; and at least 75% of the supplement's soluble calcium ion remains in solution for at least about 2 days after said supplement is placed in solution.

The examiner relies upon Mehansho et al. (Mehansho), U.S. Patent No. 4,992,282, issued Feb. 12, 1991, as evidence of obviousness. Accordingly, the claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mehansho (Answer, page 3).¹ We *affirm* the examiner's rejection essentially for the reasons stated in the Answer, the reasons set forth in the decision in related Appeal No. 1995-1058 (Paper No. 23 in Application No. 07/906,638), and those reasons discussed below.

OPINION

A. Background

This application is a continuation of Application No. 07/906,638, now abandoned, where a merits panel of this Board

¹The references to Gailley and Boncy et al., as applied in the final Office action dated Aug. 28, 2001, Paper No. 13, have not been repeated in the Answer (see pages 2-3). Accordingly, we consider that the examiner has withdrawn these references.

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issued a decision dated Sep. 18, 1997, Paper No. 23, in Appeal No. 1995-1058, affirming the examiner's rejection of claims 1-14 under 35 U.S.C. § 103 over Mehansho (Paper No. 23, pages 1-3). For comparison purposes, a copy of illustrative independent claim 1 from Appeal No. 1995-1058 is reproduced below:

1. An effervescent calcium supplement comprising a unit dosage mixture of:

(a) a primary calcium source comprising calcium carbonate;

and

(b) an edible acid component comprising a mixture of citric acid and malic acid;

wherein the percentage of citric acid to total acid is at least 23% and not more than 75% and the weight ratio of acid equivalents to base equivalents is from 0.8 to 1.8; and whereby when said effervescent calcium supplement is deposited in aqueous medium at least 75% of the soluble calcium ion remains in solution for at least about 2 days.

B. The Rejection

The examiner finds that Mehansho discloses a carbonated soft drink which contains a combination of calcium carbonate, citric acid and malic acid, where the calcium carbonate, citric acid and malic acid are premixed in dry form (Answer, page 3). The examiner finds that this formulation acts as a calcium supplement, either alone or in combination with a beverage (*id.*). The examiner adopts the reasoning from the decision in Appeal No. 1995-1058 to establish that the particular weight ratio of

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acid:base equivalents recited in claim 1 on appeal is taught by Mehansho (*id.*; see the decision in Appeal No. 1995-1058, pages 4-5). The amount of citric acid and malic acid taught by Mehansho overlaps the claimed ranges (see the decision in Appeal No. 1995-1058, page 4).

With respect to claim 1 on appeal, the examiner finds that this claim differs from the reference by requiring "less than an effective amount" of a premix stabilizer to keep at least 75% of the supplement's soluble calcium ion in solution for at least about 2 days (Answer, page 3). However, the examiner finds that Mehansho teaches that 1 to 14% of these stabilizers, if used, should be present in the beverage (*id.*, citing col. 11, ll. 9-20), while the amounts of sugar premix stabilizers taught by appellant that are "less than an effective amount" include the same range, i.e., 1 to 14% (specification, page 11, ll. 10-15). Therefore the examiner concludes that since the same composition has been taught by the reference as recited in claim 1 on appeal, it would have been obvious that at least 75% of the supplement's soluble calcium ions would have stayed in solution for at least about 2 days (Answer, page 4).

Claims 23 and 69 exclude the use of various sugars as premix stabilizers through the term "consisting of" and a negative

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limitation, respectively. We note that the term "consisting of" closes the claim language to only the recited components or ingredients. See *Vehicular Techs. v. Titan Wheel Int'l, Inc.*, 212 F.3d 1377, 1383, 54 USPQ2d 1841, 1845 (Fed. Cir. 2000). With respect to these claims, the examiner finds that Mehansho discloses a beverage containing calcium carbonate, citric acid and malic acid, teaching that the sugars used as premix stabilizers are "optional," although "preferred" (Answer, pages 4-5; see col. 12, ll. 34-37; col. 13, ll. 8-9 and 29-30). From these findings, the examiner concludes that it would have been obvious to exclude the sugar stabilizers of Mehansho (Answer, page 5). We agree.

Appellant argues that the examiner has not shown that the cited art teaches or suggests the claimed limitation that at least 75% of the supplement's soluble calcium ions are kept in solution for at least about 2 days (Brief, page 3). This argument is not persuasive since, as discussed by the examiner (Answer, pages 3-5), Mehansho teaches the same calcium supplement composition as recited in the claims and thus it would have been reasonably expected that the calcium ions would have been kept in solution to the same extent as the claimed supplement. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir.

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1990) (Discovery of a new property of a previously known composition cannot impart patentability to claims to the known composition); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977) (Where the claimed and prior art products are identical or substantially identical, the PTO can require an applicant to prove that the prior art products do not necessarily possess the characteristics of the claimed product). On this record, there is no objective evidence that the calcium supplement of Mehansho differs from the claimed calcium supplement.

Appellant argues that the claims now contain premix stabilizer limitations that exclude or limit the amounts of such stabilizers, and such limitations are not taught or suggested by the cited art (Brief, page 3). This argument is not persuasive. As discussed above, claim 1 limits the amounts of recited sugar premix stabilizers to "less than an effective amount" to keep at least 75% of the calcium ions in solution for at least about 2 days (see the Brief, page 4), but this amount is defined in the specification as including from 1 to 14% of the listed sugar stabilizers (see the specification, page 11, ll. 11-12). Since this is the same amount of premix stabilizers taught by Mehansho (col. 11, ll. 14-15), this limitation recited in claim 1 on

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appeal does not distinguish over the cited reference. With regard to the exclusion of such sugar stabilizers from claims 23 and 69 (see the Brief, page 5), we repeat our remarks *supra* that the use of premix stabilizers in Mehansho is "optional" (see col. 13, ll. 8-9). See col. 13, ll. 52-55, where Mehansho teaches that the dry mixture of calcium carbonate, citric acid and malic acid may be added to the sugar or water solution to produce a calcium supplement.

Appellant also argues that, according to Mehansho, "a premix stabilizer is required if calcium malate and calcium citrate species are to remain in solution for more than a few hours" (Brief, page 3, citing Mehansho, col. 12, ll. 27-29). This argument is not well taken since Mehansho does not teach the above quoted requirement. Mehansho teaches that "[w]ithout added stabilizers, the highly soluble calcium citrate species are stable in the premix solution for periods up to only about a few hours." See col. 12, ll. 27-29. Mehansho does not teach that the calcium malate species will become insoluble but only that the highly soluble citrate species will "tend to disproportionate" to the corresponding acid and more insoluble calcium citrate salts (col. 12, ll. 29-33). Therefore, even if a portion or all of the calcium citrate species becomes insoluble

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in the water solution, one of ordinary skill in this art would have reasonably expected that high amounts of calcium ions within the scope of the claims would still remain in solution due to the malate species, with or without a premix stabilizer (see the amounts of citric acid and malic acid taught by Mehansho at col. 11, l. 55-col. 12, l. 7, and Example II at cols. 15-16).

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Accordingly, we affirm the examiner's rejection of claims 1, 23, 47 and 64-91 under 35 U.S.C. § 103(a) over Mehansho.

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

AFFIRMED

Edward C. Kimlin)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Bradley R. Garris)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Thomas A. Waltz)	
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