

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL M. CHRYSAM
and TURIDDU A. PELLOSO

Appeal No. 95-3328
Application 07/794,764¹

ON BRIEF

Before WILLIAM F. SMITH, ELLIS, and WEIMAR, **Administrative Patent Judges.**

ELLIS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2

¹ Application for patent filed November 18, 1991. According to the appellants, this application is a continuation-in-part of Application 07/665,629, filed March 6, 1991, now abandoned; which is a continuation-in-part of Application 07/624,056, filed December 7, 1990, now abandoned; which is a continuation-in-part of Application 07/410,161, filed September 20, 1989, now abandoned.

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and 4 through 24, all the claims pending in the application.

As a preliminary matter we acknowledge the appellants' request for a postponement of the oral hearing originally set for May 6, 1998. However, during a conference held by this merits panel in preparation for said hearing, it was determined that an oral hearing would not be necessary in view of our disposition of the issues on appeal.

The three independent claims, claims 1, 12 and 22, are illustrative of the subject matter on appeal and read as follows:

1. A fat product having a solids content at 80°F of at least about 4% and a solids content of at least about 1% at 92°F consisting essentially of an interesterified blend of high stearic soybean oil and another oil or fat.

12. A fat product comprising an interesterified blend of at least about 50% high stearic soybean oil and another oil or fat, said blend having a solids content at 80°F of at least about 6% and a solids content at 92°F of at least about 1%, and containing essentially no hydrogenated fat.

22. A fat product comprising a blend of at least about 75% high stearic soybean oil and another oil, said blend having been interesterified in the presence of 1,3-specific lipase under conditions effective to achieve a solids content of at least about 6% at 80°F and at least about 1% at 92°F, and containing essentially no hydrogenated fat.

The references relied on by the examiner are:

List et al. (List), "'Zero Trans' Margarines: Preparation,

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Structure, and Properties of Interesterified Soybean Oil-Soy Trisaturate Blends," **Journal of the American Oil Chemists' Society**, vol. 54, pp. 408-413 (1977).

Miller et al. (Miller), "High-Temperature Stabilities of Low-Linolenate, High Stearate and Common Soybean Oils," **Journal of the American Oil Chemists' Society**, vol. 65, pp. 1324-1327 (1988).

Claims 1, 2, and 4 through 24 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over List in view of Miller. We **reverse**.

OPINION

It is apparent from the independent claims set forth above, that all of the claims on appeal require that the fat product have a solids content of at least 4% or 6% at 80EF, and at least 1% at 92EF.

However, the examiner states on p. 4 of the Answer that

It is appreciated that the particular melting properties of the product are not recited [in the applied prior art] however, with regard to claims 1 and 2, these are preamble limitations carrying no weight in product claims.

We find that this reading of the referenced limitations out of the claims constitutes clear error on the part of the examiner. **In re Geerdes**, 491 F.2d 1260, 1262, 180 USPQ 789,

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791 (CCPA 1974) ("every limitation in the claim must be given effect rather than considering one in isolation from the others"). Accordingly, the rejection is summarily reversed.

In response to the rejection, the appellants have proffered as evidence of an "unexpected result," a table of fat products with their respective solids content. Brief, p. 7. However, since we find, on these facts, that the examiner has failed to establish a *prima facie* case of obviousness, there is no burden on the appellants to provide such a showing. Accordingly, we have not considered the appellants' arguments with respect to the referenced table.

Other Issues

In the case before us, it appears that the examiner has not properly considered the scope of the claims. The appellants are not claiming all interesterified blends of high stearic soybean oils but, rather, they are only claiming those subsets which possess specific melting points. In addition, we point out that independent claim 1 does not specify the amount of high stearic soybean oil, oil or fat present in the

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blend. Thus, it appears that the claimed fat product can contain almost 100% tallow, lard, etc.; i.e., fat products which naturally possess a solids content of at least about 4% or 6% at 80°F and at least about 1% at 92°F. See claim 9. Accordingly, upon return of this application to the corps, the examiner should consider whether (i) the claims were properly interpreted, and (ii) all relevant areas of the art were searched.

The decision of the examiner is reversed.

REVERSED

WILLIAM F. SMITH)
Administrative Patent Judge)
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) BOARD OF PATENT
JOAN ELLIS)
Administrative Patent Judge) APPEALS AND
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) INTERFERENCES
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