

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(2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE G. SCHRODER

Appeal No. 1996-3028
Application No. 08/270,429

ON BRIEF

Before JOHN D. SMITH, PAK and WALTZ, **Administrative Patent Judges.**

WALTZ, **Administrative Patent Judge.**

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 1, 3 through 14, 20 and 23 as amended subsequent to the final rejection (see the amendment dated Sept. 5, 1995, Paper No. 6, entered as per the Advisory Action dated Sept. 7, 1995,

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Paper No. 7).¹ Claims 1, 3-14, 20 and 23 are the only claims remaining in this application.

According to appellant, the invention is directed to a reverse osmosis process for making a non-milk dairy beverage from a starting material selected from milk, defatted milk, whey, defatted whey, permeate, retentate, defatted retentate, and condensed or evaporated water from dairy starting materials (Brief, page 2). Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A method of making a non-milk dairy beverage comprising the steps of:

subjecting material selected from the group consisting of

milk,
defatted milk,
whey,
defatted whey,

permeate, retentate and defatted retentate of the filtration of a dairy starting material and condensate of the evaporated water from a dairy starting material to reserve osmosis to separate a pure dairy water permeate therefrom;

combining the dairy water with a non-milk additive

¹It is noted that the Advisory Action is incorrectly listed as Paper No. 6 and erroneously omits claim 23 from the claims rejected.

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in a non-milk dairy product for consumption, the dairy product being substantially pure and free of impurities from the dairy starting material; and

packaging the substantially pure non-milk dairy beverage.

The examiner has relied upon the following references as evidence of obviousness:

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| Girsh 1990 | 4,954,361 | Sep. 4, |
| Ermens et al. (Ermens) 1990 (Published European Patent Application) | 0 364 053 | Apr. 18, |

Appellant has relied upon the following references in rebuttal to the examiner's evidence of obviousness (Brief, Appendices B and C):

Dairy Research Review, Vol. 1, Issue 2, 1985 (Author and page nos. are unknown)

Jack Mans, "Fines as High as \$100,000 Per Day," *Dairy Foods*, p. 89, Apr. 1993.

The examiner has made a new ground of rejection in the Answer, with all of the claims on appeal now rejected under 35 U.S.C. § 103 as unpatentable over Ermens or Girsh (Answer, pages 3-4).² We reverse both of the examiner's rejections for

²Although the examiner has not explicitly stated that the final rejection of claims 1-16, 18, 20 and 23-26 under § 103 over Girsh in view of Coulter (U.S. Patent No. 2,712,504,

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reasons which follow.

issued on July 5, 1955) has been withdrawn, this rejection has not been repeated or restated in the Answer. Accordingly, we consider this rejection withdrawn. *See Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 663, 231 USPQ 649, 652 (Fed. Cir. 1986).

OPINION

The examiner finds that Ermens discloses a process in which a milk product is subjected to ultrafiltration, treated and packaged with the ultrafiltration permeate described as a clear liquid containing only salts, lactose, vitamins and low molecular weight nitrogen compounds (Answer, page 4). The examiner also finds that Ermens teaches that treatment of a dairy product by reverse osmosis produces only water, i.e., dairy water (*id.*). Similarly, the examiner finds that Girsh discloses the use of a permeate from the ultrafiltration of milk (Answer, page 5). The examiner recognizes that the process recited in the claims on appeal requires the use of reverse osmosis instead of the ultrafiltration disclosed by the applied prior art (Answer, page 4). From these findings, the examiner concludes that "it would have been within the skill of the ordinary worker to use the water from RO [reverse osmosis] *if* one did not want to retain the salts, lactose and vitamins of the UF [ultrafiltration] permeate." (Answer, sentence bridging pages 4-5, emphasis added). The examiner also concludes that it would have been obvious to use water

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from RO in place of the permeate from UF and to add non-milk ingredients for their known functions, depending on the degree of filtration desired and the ingredients from the milk

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which one wants left in the permeate (Answer, page 5). The examiner also states that "[r]everse osmosis only differs from UF by a matter of degree." (Supplemental Answer, Paper No. 18, page 2). We disagree.

Ermens specifically teaches that the ultrafiltration permeate of milk or milk products is desired because the "ultrafiltration permeate also has the same osmotic value as blood" and thus is advantageous as a thirst-quenching beverage (col. 2, l. 52-col. 3, l. 3; col. 6, ll. 5-29). Ermens teaches that reverse osmosis uses a membrane that is completely impermeable to lactose and salts and thus produces a permeate of pure water "but such a process is hardly useful for the preparation of beverages according to the invention." (col. 7, l. 55-col. 8, l. 4). The examiner has not established any reason, suggestion or motivation to support the conclusion that one of ordinary skill in the art would *not* have wanted to retain the salts, lactose, and vitamins of the UF permeate of Ermens and thus would have used the water from RO (Answer, sentence bridging pages 4-5). *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125,

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1127 (Fed. Cir. 1984) ("The mere fact that the prior art could
be

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so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. [Citations omitted].").

Girsh filters whole mammalian milk through an ultrafiltration apparatus to remove all hyperallergenic components (col. 3, ll. 3-6). Although Girsh teaches various levels of filtration (col. 3, ll. 13-50), the permeate collected from the ultrafiltration apparatus contains riboflavin, lactose, salt or ash, carbon compounds, dimethyl sulfide and other minerals (col. 4, ll. 52-61). The examiner has not established any reason, suggestion or motivation for using the water from RO, which has no components other than water, in place of the permeate from UF of Girsh containing, *inter alia*, riboflavin, lactose and ash (see the Answer, page 5). See *Gordon, supra*.

For the foregoing reasons, we determine that the examiner has not met the initial burden of establishing a *prima facie* case of obviousness. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Since we have reached this determination, we need not consider the sufficiency of

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appellant's rebuttal evidence (Appendices B and C attached to the Brief).³ *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Accordingly, the examiner's rejections of the claims on appeal under 35 U.S.C. § 103 as unpatentable over Ermens or Girsh are reversed.

OTHER ISSUES

Upon return of this application to the jurisdiction of the examiner, the examiner and appellant should reconsider the patentability of at least claim 14 under the doctrine of obviousness-type double patenting over claims 9, 12 and 15 of the parent of this application, now U.S. Patent No. 5,352,468.

³We note that the *Dairy Research Review* article, Appendix B, directly refutes the examiner's contention that reverse osmosis only differs from ultrafiltration "by a matter of degree" and "[i]t is not like it is a completely different process." (Supplemental Answer, Paper No. 18, page 2). The examiner has failed to consider appellant's evidence in rebuttal to the § 103 rejection (i.e., Appendices B and C, see the Supplemental Answer, Paper No. 18, page 5, last paragraph). "Objective evidence of nonobviousness, when present, *must* always be considered before reaching a legal conclusion under § 103. [Citation omitted]." *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315, 227 USPQ 776, 770 (Fed. Cir. 1985), emphasis added. We also note that the Mans article (Appendix C) is dated April 1993 and there has been no determination as to whether this article was published before appellant's effective filing date.

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The examiner should also consider whether the absence of any sterilizing step in the claimed process (except claim 23), in light of the broadest reasonable interpretation of the claimed term "for consumption" (see claim 1), raises any issues regarding lack of enablement and/or indefiniteness under the requirements of 35 U.S.C. § 112. See the specification, page 3, ll. 7-16 and 24; page 6, ll. 12-15; page 14, ll. 23-27; page 17, l. 16-page 18, l. 12; and the Mans article attached to the Brief as Appendix C.

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SUMMARY

The examiner's rejections of claims 1, 3-14, 20 and 23 under 35 U.S.C. § 103 as unpatentable over Ermens or Girsh are reversed.

The decision of the examiner is reversed.

REVERSED

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| JOHN D. SMITH |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHUNG K. PAK |) | |
| Administrative Patent Judge |) | APPEALS AND |
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| THOMAS A. WALTZ |) | |
| Administrative Patent Judge |) | |

TAW:hh

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