

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS R. STEWART

Appeal No. 1998-1893
Application 08/088,125

ON BRIEF

Before OWENS, LIEBERMAN and JEFFREY SMITH, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the refusal to allow claims 18-21, 24, 26 and 27 as amended after final rejection. Claims 1-10 and 28-30, which are all of the other claims remaining in the application, stand withdrawn from consideration by the examiner

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method. Claims 18 and 20 are illustrative:

18. A method for providing a decorated foodstuff, comprising the steps of:

providing a reinforced edible film, comprising the steps of:

providing an edible polymer film forming solution;

providing a substrate constructed of a flexible sheet of food compatible material;

placing a quantity of said edible polymer film forming solution onto said substrate;

smoothing said edible polymer film forming solution to thereby provide a predetermined thickness of said edible polymer film forming solution with respect to said substrate; and

drying said edible polymer film forming solution to thereupon provide a flexible sheet of reinforced edible film comprising a dried edible polymer film that is releasably adhered to said substrate;

making an edible decoration of said edible polymer film, comprising at least one of:

shaping said edible polymer film; and

marking said edible polymer film;

providing a foodstuff having an external surface, wherein said external surface has a preselected amount of moisture;

peeling said edible decoration from said substrate; and

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THE REFERENCES

Golchert	4,024,287	May 17, 1977
Wittwer	4,478,658	Oct. 23, 1984
Schroeder	4,560,562	Dec. 24, 1985
Macpherson et al. (Macpherson)	5,017,394	May 21, 1991

Niwa et al. (Niwa) ¹ (Japan patent application)	59-11136	Jan. 20, 1984
Nagasawa ² (Japan patent application)	62-36151	Feb. 27, 1987

DIALOG abstract of Japan patent application no. 55-034966,
March 11, 1980 (Shigeo).

DIALOG abstract of Japan patent application no. 60-149366,
Aug. 6, 1985 (Katsuhiko).

DIALOG abstract of Japan patent application no. 63-291538,
Nov. 29, 1988 (Itaru).

DIALOG abstract of Japan patent application no. 02-097357,
Apr. 9, 1990 (Kuniharu).

DIALOG abstract of *Chilton's Food Eng.* 88 (Nov. 1984) (Chilton).

Dow Chemical Co., *METHOCEL Cellulose Ethers Tech. Handbook* 1-36
(Apr. 1988).

Sandy Lion Sticker Designs (1988).

DIALOG abstract of "Future and Present of Edible Film", *Food Packag.* 73-82 (May 1989) (Food Packaging).

Dow Chemical Co., *METHOCEL Food Gums* (Jun. 1992).

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THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 18, 19, 20, 26 and 27 over Macpherson in view of METHOCEL Cellulose Ethers Technical Handbook, METHOCEL Food Gums, Wittwer, Niwa, Nagasawa, Chilton, Itaru, Kuniharu, Shigeo, Katsuhiko and Food Packaging; claim 21 over these references further in view of Schroeder and Sandylion Sticker Designs; and claim 24 over the references applied to claims 18, 19, 20, 26 and 27, further in view of Golchert and Schroeder.

OPINION

We reverse the rejection of claims 18, 19, 21, 24, 26 and 27, and affirm the rejection of claim 20. We need to address only claim 18, which is the sole independent method claim, and claim 20.

Claim 18

Macpherson discloses a method for making a decorated foodstuff by screen casting a base shape of edible material onto release paper such as silicone release paper, drying the base

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moisture from the foodstuff and, if needed, water lightly misted onto the foodstuff and/or the base shape (col. 4, lines 31-34 and 58-59; col. 5, lines 39-42; col. 6, lines 34-39; col. 8, lines 9-20). The base shape has a thickness of 0.002" to 0.050" or more (col. 4, line 65 - col. 5, line 3). Macpherson states that "the present invention eliminates the need to die cut, trim or otherwise cut or size a preexisting, free standing sheet of edible material since a screen printing device is used to screen cast the base shape directly into its final two dimensional form from fluid base shape material, right onto the release paper, all in one step" (col. 2, lines 16-21). Macpherson does not set forth the scope of the term "base shape material" but, rather, provides three nonlimiting examples (col. 3, lines 4-8; col. 6, line 47 - col. 8, line 3). In each of the examples the base shape material contains sugar and a large amount of cake flour and cold water swelling corn starch.

The examiner argues (answer, page 7): "Certainly, Macpherson's film at the minimum includes constituents which can

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not indicate that the starch is water soluble, i.e., that a solution of the starch in water can be formed. Also, in the Rule 132 declaration of Krochta (filed August 24, 1995), paper no. 23), Krochta states (page 9) that "[i]ntrinsically, cake flour is incapable of forming a continuous polymeric film from solution." The examiner provides no evidence to the contrary.

The examiner states that because he is unclear as to whether Macpherson forms an edible polymer film from an edible polymer film forming solution, the examiner has interpreted Macpherson as not doing so. (answer, page 7). The examiner relies upon secondary references to remedy this deficiency in Macpherson.

Two of these references are METHOCEL Cellulose Ethers Technical Handbook and METHOCEL Food Gums. The examiner argues (answer, pages 7-8) that as acknowledged by the appellant (specification, page 10), METHOCEL Cellulose Ethers Technical Handbook (pages 2, 3 and 31) and METHOCEL Food Gums (page 5) disclose cast films of cellulose ethers which are strong, water soluble, clear, tough and smooth. The examiner argues that these

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Wittwer discloses a method for rendering pharmaceutical-containing or food-containing edible capsules tamper evident by placing a label which can be a strip or, preferably, a round patch or dot, over the seam between the capsule halves to form a seal such that the slightest mechanical force on the seam causes the seal to fracture along a line coincident with the seam (col. 2, lines 12-20; col. 3, lines 8-14). The labels are made from edible film forming materials which may be polymer film forming materials and may be in solution form (col. 2, lines 44-53; col. 4, line 58 - col. 5, line 24). The film forming material is applied to a horizontal flat surface or the like by, for example, continuous roller or knife coating, spraying or casting, and are dried, coated with an adhesive which may be water, peeled from the substrate surface, and applied to assembled capsules (col. 2, lines 54-56 and 63-33; col. 3, lines 15-16; col. 5, lines 52-61). Individual labels may be formed initially or a continuous sheet of label material may be formed and then punched or otherwise cut to form individual

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500 μ (0.020") (col. 6, lines 9-11).

The examiner argues that "[t]o modify Macpherson and substitute one conventional sheet forming substance for another conventional sheet forming substance for its art recognized and appellant's intended function would therefore have been obvious in view of the art [Macpherson, the METHOCEL references and Wittwer] taken as a whole" (answer, page 8).

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. See *Fritch*, 972 F.2d at 1266, 23 USPQ2d

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exemplified horizontal flat surface, as argued by the appellant (reply brief, page 4), is a lubricated glass plate (col. 10, lines 19, 43-44 and 59; col. 11, line 19). The examiner argues that Macpherson forms his edible film on a flexible sheet (brief, pages 18-19), but does not explain how Macpherson, the METHOCEL references and Wittwer would have fairly suggested to one of ordinary skill in the art the desirability of forming Wittwer's edible polymeric film on Macpherson's flexible sheet. The examiner has not established that the compositions of the films of Macpherson or Wittwer are sufficiently similar that one of ordinary skill in the art would have been led to use Macpherson's flexible sheet as the substrate to which Wittwer's edible polymeric film forming solution is applied, and has not provided any other reason as to why one the applied references themselves would have led one of ordinary skill in the art to form Wittwer's edible polymeric film on a flexible sheet. The examiner argues that Wittwer's disclosure of forming the film by continuous roller or knife coating, spraying or casting film forming

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technical reasoning in support of this argument, and the examiner's mere speculation is not a sufficient basis for a *prima facie* case of obviousness. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA 1962). For this reason and because the examiner has not explained how the other applied references remedy this deficiency in *Macpherson*, the METHOCEL references and Wittwer (answer, page 9), we reverse the rejection of claim 18 and claims 19, 21, 24, 26 and 27 which depend therefrom.

Claim 20

Claim 20 is a product-by-process claim. Hence, the patentability of the claimed invention is determined based on the product itself, not on the method of making it. See *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) ("If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a

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The appellant does not define "foodstuff". We therefore give this term its ordinary meaning, which is "[a] substance that can be used or prepared for use as a food."³

Wittwer discloses a capsule of the type "utilized in the pharmaceutical and food industries, to hold edible and pharmaceutically active materials such as medicines, vitamin preparations, and other edibles both solid and liquid" (col. 1, lines 19-23). The capsule has over the seam between its halves a label which preferably is in the form of a round patch or dot and which can have visible indicia such as logos, codes or the like imprinted thereon (col. 3, lines 1-14; col. 9, lines 19-22). Hence, Wittwer would have fairly suggested, to one of ordinary skill in the art, a foodstuff having thereon a round patch or dot which has visible indicia such as logos or the like on it and which serves, among other functions, to provide a decorative effect. The examiner finds that Wittwer's printed films are decorative (answer, pages 8 and 17), and the appellant does not challenge this finding (reply brief, pages 4-5). Since the

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challenged it, we accept it as fact. See *In re Kunzmann*, 326 F.2d 424, 425 n.3, 140 USPQ 235, 236 n.3 (CCPA 1964).

Wittwer's label is an edible film made by 1) providing an edible polymer film forming material which can be in solution form (col. 2, lines 44-51; col. 4, line 58 - col. 5, line 2), 2) providing a horizontal flat surface or the like as a substrate (col. 5, lines 54-58), the exemplified substrate being a plate of lubricated glass (a food compatible material) (col. 10, lines 19, 43-44 and 59; col. 11, line 19), 3) forming a film of the edible polymer forming solution of predetermined thickness on the substrate and drying the edible polymer film forming solution to form a sheet of reinforced edible polymer film releasably adhered to the substrate (col. 2, lines 63-66; col. 10, lines 44-45), the disclosed edible polymer film thickness range being 10 μ (0.0004") to 500 μ (0.020"), which encompasses the appellant's preferred range of 0.0004" to 0.0015" (specification, page 13), 4) marking the edible polymer film with indicia, which may be logos, codes or the like (col. 3, lines 1-4; col. 9, lines 18-22), 5) peeling

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lines 16-17).

Wittwer does not state that the "horizontal flat surfaces and the like" to which the edible polymeric film forming solution is applied can be a flexible sheet. However, Wittwer's marked edible polymeric film is made of the same material as the appellant's film, is formed like the appellant's film on a substrate from which it is peeled off, has a thickness within a range which encompasses the appellant's preferred range, and is attached to a foodstuff using a material which can be the same material used by the appellant, i.e., water. Consequently, even if the substrate on which Wittwer's edible polymeric film formed is inflexible, Wittwer's decorated foodstuff reasonably appears to be the same or substantially the same as a decorated foodstuff encompassed by the appellant's claim 20.

Whether a rejection is under 35 U.S.C. § 102 or § 103, when the appellant's product and that of the prior art appear to be identical or substantially identical, the burden shifts to the appellant to provide evidence that the prior art product does not

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F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. See *Best*, 562 F.2d at 1255, 195 USPQ at 434; *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The appellant has not provided such evidence. Accordingly, we affirm the rejection of claim 20.⁴

DECISION

The rejections under 35 U.S.C. § 103 of claims 18, 19, 26 and 27 over Macpherson in view of METHOCEL Cellulose Ethers Technical Handbook, METHOCEL Food Gums, Wittwer, Niwa, Nagasawa, Chilton, Itaru, Kuniharu, Shigeo, Katsuhiko and Food Packaging, claim 21 over these references further in view of Schroeder and Sandylion Sticker Designs, and claim 24 over the references applied to claims 18, 19, 26 and 27, further in view of Golchert and Schroeder, are reversed. The rejection under 35 U.S.C. § 103 of claim 20 over Macpherson in view of METHOCEL Cellulose Ethers

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Technical Handbook, METHOCEL Food Gums, Wittwer, Niwa, Nagasawa, Chilton, Itaru, Kuniharu, Shigeo, Katsuhiko and Food Packaging is affirmed.

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

AFFIRMED-IN-PART

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TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PAUL LIEBERMAN)	
Administrative Patent Judge)	APPEALS AND
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