UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREGORY E. URBANSKI and KEVIN W. LANG

Appeal 2013-002044
Application 11/170,614[4]
Technology Center 1700

Before PETER F. KRATZ, BEVERLY A. FRANKLIN, and ELIZABETH M. ROESEL, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the decision of the majority to affirm the Examiner's obviousness rejections.

It is well settled that the burden of establishing a prima facie case of non-patentability resides with the Examiner. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

For reasons articulated by Appellants in the Appeal Brief and Reply Brief, it is my view that the Examiner has failed to carry the burden to establish a sustainable rationale articulating why one of ordinary skill in the

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[4] According to Appellants, the Real Party in Interest is Delavau LLC. App. Br. 1.

art would have been led to merge the disparate processes of Gross and Wong in a manner that would have resulted in a combined process that any of the rejected method claims would read on. In this regard, the Examiner has not articulated how the Examiner's proposed modification of the process of Gross is compatible with the stated process objectives of Gross including carrying out the enzyme hydrolysis of Gross to an extent or degree such that a stable, homogenous colloidal dispersion or gel will result after a following high shear step. After all, the mere fact that the degree of hydrolysis may be a result effective variable for the process of Gross with a workable range for the stated objectives of Gross and the degree of hydrolysis may be a result effective variable for the disparate process of Wong with another workable range for the different stated objectives of Wong does not provide sufficient reason for selective merger of these disparate processes without furnishing a reasonable explanation as to why one of ordinary skill in the art would seek to employ the degree of hydrolysis taught by Wong for the purposes of improving the sensory characteristics of soy fiber without substantial dietary fiber reduction as sought by Wong as a degree of hydrolysis that would be expected to be appropriate and suitable for the process of and results sought by Gross. Hence, the process of Wong is designed for different desired objectives than those of Gross and the Examiner has not established how the proposed modification of the hydrolysis step of Gross based on Wong's teachings is consonant with and/or trumps the teachings of Gross as to the appropriate measure/degree of hydrolysis that is needed for ultimately forming the stable, homogenous colloidal dispersion or gel sought by Gross (Gross 7, ll. 10–30).

In other words, the Examiner has not established that Wong provides alternative hydrolysis conditions that one of ordinary skill in the art would have expected to be suitable for the purposes of the method and products sought by Gross in order to prima facie establish the obviousness of this aspect of the proposed merger of the teachings of the applied references. *See In re Sebek*, 465 F.2d 904, 907 (CCPA 1972) (rejection based on optimization was reversed because the claimed values were outside the prior art range). Here, it is my view that the weight of the evidence supports Appellants' arguments that there is an insufficient basis articulated by the Examiner for one of ordinary skill in the art to modify the method of Gross based on the disparate teachings of Wong in a manner so as to arrive at subject matter embraced by the appealed claims.

In addition, I would reverse because the Examiner fails to specifically address and weigh the Declaration of Dr. Gregory E. Urbanski brought forward by Appellants as evidence supporting their arguments and bearing on the ultimate obviousness question before us (Reply Br. 3–4; App. Br. 8–9; *see generally* Ans.).