UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/113,174	05/23/2011	Kyle M. Johnson	208-044US2	9118

27791 7590 09/27/2017

ALLISON JOHNSON, P.A.
3600 AMERICAN BLVD. W., SUITE 410
MINNEAPOLIS, MN 55431

EXAMINER	
BRANSON, DANIEL L	

ART UNIT	PAPER NUMBER
1616	

NOTIFICATION DATE	DELIVERY MODE
09/27/2017	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@ajiplaw.com
allison@ajiplaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KYLE M. JOHNSON[1]

Appeal 2016-001410
Application 13/113,174
Technology Center 1600

Before ERIC B. GRIMES, JOHN G. NEW, and TAWEN CHANG, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to an effervescent composition, which have been rejected as obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

STATEMENT OF THE CASE

The Specification states that

> [g]elatin dessert products are often prepared by boiling water on a stove, placing the boiling water in a container such as a bowl, adding the gelatin powder to the boiling water, stirring, adding ice or cold water to the mixture and stirring, and then placing the liquid in a

[1] Appellants identify the Real Party in Interest as Amerilab Technologies, Inc. (Appeal Br. 3.)

> refrigerator. The acts of boiling water on a stove and transferring boiling water from a pot to a bowl can be very dangerous, especially for young children.

(Spec. 1:13–17.)

The Specification describes a method of making a gelled composition using an effervescent tablet containing gelatin which, according to the Specification, "is simple to perform," "does not require the transfer of boiling liquid from one vessel to another," and eliminates the need to boil water on a stove and for stirring. (*Id.* at 3:8–12.) Further according to the Specification, "[t]he single serving and single dose formulations [of the invention] provide[s] gelatin in a form that enables consumers to easily prepare a dessert or a tasty vehicle for delivering an active agent such as a medicament or a vitamin." (*Id.* at 4:13–15.)

Claims 21–27 and 40–42 are on appeal. Claim 21 is illustrative and reproduced below:

> 21. An effervescent composition comprising:
> from about 10 % by weight to about 30 % by weight of an effervescent couple comprising an acid and a base;
> from at least 5 % by weight to about 20 % by weight of the acid;
> from at least 1 % by weight to about 15 % by weight of the base; and
> at least 200 mg of a gelatin that forms a gel, the gelatin comprising gelatin derived from a cow, gelatin derived from a pig, or a mixture thereof,
> the effervescent composition forming a gel when the effervescent composition is dissolved in heated water to form an aqueous composition and the aqueous composition is subsequently chilled.

(Appeal Br. Ai (Claims App.).)

The Examiner rejects claims 21–27 and 40–42 under 35 U.S.C. pre-AIA § 103(a) as obvious over Wehling,[2] Silvestrini,[3] Bonanomi,[4] and Pam.[5] (Final Act. 3.)

DISCUSSION

Issue

The Examiner finds that Wehling teaches an effervescent tablet comprising the claimed effervescent couple and an active agent, but does not "specifically teach that the active is gelatin comprising gelatin derived from a cow, pig or mixture thereof." (Final Act. 4–5.) The Examiner finds that Silvestrini, Bonanomi, and Pam cure this deficit. (*Id.*) In particular, the Examiner finds that Silvestrini teaches administering 8–16 grams of gelatin a day to a patient to treat hair thinning or loss; that Pam also teaches daily administration of 0.5–7 grams of gelatin, which may comprise a mixture hydrolyzed and non-hydrolyzed gelatin, for a similar purpose, and that "Bonanomi suggest[s] administering a partly hydrolyzed gelatin via an effervescent tablet which comprises 44 wt. % partly hydrolyzed gelatin . . . , about 19.5 wt. % metal base salt calcium carbonate, about 26.6 wt. % citric acid, about 1 wt. % dimethicone lubricant and about 19.5 wt. % maltodextrin binder." (*Id.* at 5.)

The Examiner concludes that a skilled artisan would be motivated to incorporate the gelatin of Silvestrini or Pam in Wehling's effervescent tablet, with a reasonable expectation of success, because "Wehling envisions

---

[2] Wehling, US 2003/0170301 A1, published Sept. 11, 2003.
[3] Silvestrini, U.S. Patent No. 4,749,684, issued June 7, 1988.
[4] Bonanomi, EP 1 407 677 A2, published Apr. 14, 2004.
[5] Pam, WO 2008/075333 A2, published June 26, 2008.

utilizing the effervescent tablet to administer a protein or amino acid active" and "Bonanomi provide an example of an effervescent tablet that comprises gelatin," e.g., 2.5 grams (*Id.* at 6.) The Examiner concludes that it would likewise be obvious to a skilled artisan to use porcine or bovine gelatin in order to prevent allergic reactions that might occur if fish gelatin were used, as suggested by Pam. (*Id.*)

With respect to the claimed amounts of acid, base, and gelatin, the Examiner finds that a prima facie case of obviousness exists because "the prior art range overlaps or touches a claimed range" and because the amount of gelatin active in a composition is an optimizable result effective variable. (*Id.*)

Appellant contends among other things that there is no suggestion in the cited art of "an effervescent composition that forms a gel when dissolved in heated water and then subsequently chilled." (Appeal Br. 8.)

The issue with respect to this rejection is whether a preponderance of the evidence of record supports the Examiner's conclusion that the claims are obvious over Wehling, Silvestrini, Bonanomi, and Pam.

Analysis

On balance, we find Appellant has the better argument. In particular, we agree that the Examiner has not sufficiently articulated a rationale why a skilled artisan would combine the components of Wehling's effervescent tablet and the non-hydrolyzed gelatin (i.e., gelatin that forms a gel)[6] of Silvestrini and Pam such that "the composition form[s] a gel when the

[6] Gelatin that is hydrolyzed such that it loses its native structure no longer gels, because "[t]he native structure is responsible for gelatin gelation." (Bonanomi ¶ 21.)

effervescent composition is dissolved in heated water to form an aqueous composition and the aqueous composition is subsequently chilled." (Appeal Br. Ai (Claims App.).)

The Examiner argues that "the claim is . . . a composition claim and the [limitation cited above] is directed to an intended use and resulting inherent properties of the composition when prepared in a specified way." (Final Act. 7; *see also* Ans. 2–3, 4 (arguing that "the combination of references suggest all of the limitations . . . , **including gelatin which gels, inherently resulting in a composition that is capable of gelling as claimed**").) The Examiner further argues that,

> even though Pam does not specifically teach preparing a gel in the same manner as required by Claim 21, Pam clearly teaches that use of a native porcine or bovine gelatin results in a gelled product (which contains water) and one of ordinary skill in the art would . . . likewise [have] recognized that use of a native gelatin, such as a bovine or porcine gelatin[,] would have given the composition the required gelling properties.

(Final Act. 7.)

We are not persuaded. While Pam shows that using native porcine or bovine gelatin can create a gelled product (e.g., a chewy candy), it does not suggest that any composition containing the amounts of acid, base, and gel-forming gelatin recited in claim 21 in any proportion will ***necessarily*** be capable of "forming a gel when it is dissolved in heated water to form an aqueous composition and the aqueous composition is subsequently chilled." (Appeal Br. Ai (Claims App.).) Neither has the Examiner pointed to any other evidence supporting this proposition. On the record before us, therefore, we find that the Examiner has not established a prima facie case that the above-recited limitation is merely an intended use or an inherent

property of a composition having the recited components, or that the cited art suggests a composition that explicitly or inherently meets this limitation. *Scaltech Inc. v. Retec/Tetra L.L.C.*, 178 F.3d 1378, 1384 (Fed. Cir. 1999) (holding that "[i]nherency may not be established by probabilities or possibilities" and that "[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency") (citations omitted).

SUMMARY

For the reasons above, we reverse the Examiner's decision rejecting claims 21–27 and 40–42.

REVERSED