

Commissioner's Decision #1366
Décision du Commissaire #1366

TOPIC: F01; O00
SUJET: F01; O00

Application No.: 2,371,743

Demande n° : 2,371,743

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,371,743 having been rejected under subsection 30(3) of the *Patent Rules*, has consequently been reviewed in accordance with paragraph 30(6)(c) of the *Patent Rules* by the Patent Appeal Board and the Commissioner of Patents. The findings of the Board and the ruling of the Commissioner are as follows:

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INTRODUCTION

- [1] Patent application number 2,371,743, entitled “Alcoholic Yogurt Refreshment” was rejected by the Examiner because the claimed invention was considered anticipated and obvious in view of a single prior art publication.
- [2] The application was referred to the Patent Appeal Board for review, and a panel of three Board members was established. This review is based on the prosecution record, including the reports exchanged between the Examiner and the Applicant, and the Applicant’s written submissions to the panel. Although offered, the Applicant declined our invitation to a hearing.
- [3] For the reasons that follow, we recommend that the application be refused.

BACKGROUND

- [4] The present application is for an “eatable” (a term that we will explain later) alcoholic refreshment made from a commercially available alcohol and a yogurt base. Unlike alcoholic beverages, the “eatable” refreshment has a solid or semi-solid thickness which makes it spill-resistant. The practical benefit of being resistant to spillage is that the refreshment is easy to transport and can be enjoyed during social activities where spillage and the use of glassware are undesirable, such as picnics, boat cruises or pool-side.
- [5] According to the Examiner’s Summary of Reasons [SOR], all of the claims on file were anticipated by a prior art document that disclosed subject matter encompassed by the claims. Moreover, all of the claims on file were directed to subject matter that would have been obvious to the person skilled in the art in view of that same piece of prior art, combined with the common general knowledge of the skilled person.
- [6] The Applicant disputed these allegations. With respect to anticipation, the Applicant submitted the prior art cited does not disclose the claimed invention, and so it fails the first part of the two-step test for anticipation set out by the Supreme Court in *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61 [*Sanofi*]. The Applicant further submitted the test for obviousness set out by the Supreme Court in *Sanofi* was not properly followed in the Final Action, and that in any case claims 1-14 are not obvious in view of the cited art and common general knowledge.

THE ISSUE

[7] Two defects were identified in the Final Action and SOR. However, our finding in relation to the issue of anticipation is sufficient to dispose of the application. This review addresses the following question:

(1) Are the claims anticipated?

[8] Anticipation of the invention considers the subject matter defined by the claims, and so we will begin with a purposive construction of the claims before proceeding with our analysis.

PURPOSIVE CONSTRUCTION

[9] Purposive construction is done to objectively determine what the person skilled in the art would have understood the scope of the claims to be, based on the particular terms used in the claims: *Free World Trust v Electro Santé Inc*, 2000 SCC 66 [*Free World Trust*]. Claims are construed in an informed and purposive manner from the viewpoint of the notional “person skilled in the art” in light of that person’s common general knowledge (*Free World Trust*, para. 51).

[10] Construction is based on the patent specification itself without resort to extrinsic evidence (*Free World Trust*, para. 66). During purposive construction, the elements of the claimed invention are identified as essential or non-essential (*Free World Trust*, para. 50). An element is considered non-essential if, based on a purposive construction, the skilled addressee would appreciate an element of the claim could be omitted or substituted without having a material effect on the working of the invention (*Free World Trust*, para. 55).

[11] In recognizing that a patentable invention is “an inventive solution to a practical problem”, an invention must be disclosed and claimed in a manner that provides “the person skilled in the art with an operable solution”: Office Patent Notice published March 08, 2013, entitled “*Practice Guidance Following the Amazon FCA Decision*” and its accompanying memo, PN 2013-02. Accordingly, the identification of the problem and solution provided by the invention informs the determination of which elements of the claim(s) are essential to solving the problem. The panel informed the Applicant in a letter dated November 12, 2013, of our intention to conduct the purposive construction of the claims according to the guidelines provided in the Patent Notice. The Applicant did not challenge the correctness of

the guidelines.

[12] We will first identify the person skilled in the art and their common general knowledge.

The Person Skilled in the Art and Their Common General Knowledge

[13] In the Final Action, the Examiner identified the person skilled in the art as “a food scientist with knowledge of yogurt foodstuffs”, and possessing common general knowledge based in part on the background information in the application and in part in knowledge of food chemistry, specifically the production of yogurt products. The Applicant did not dispute these characterizations of the skilled person and their common general knowledge. In a letter to the Applicant, we expressed our concern that, based on the claimed subject matter, this definition was somewhat narrow in that knowledge of “alcohol” is not accounted for.

[14] In response, the Applicant submitted the skilled person would be a “food scientist with common general knowledge of foodstuffs, and in particular common general knowledge of yogurt foodstuffs, and common general knowledge of alcoholic foodstuffs.” Moreover, the Applicant submitted common general knowledge of a foodstuff would include “some particular knowledge” related to the food chemistry and production of that foodstuff, but only insofar as that particular knowledge would indeed qualify as common general knowledge. The Applicant further submitted, in response to questions raised in our letter, that “common general knowledge of alcoholic foodstuffs” would include “knowledge of a particular combination of alcoholic foodstuffs and JELL-O®, as for example JELL-O® shots, or any other combination of an alcoholic foodstuff with a non-alcoholic foodstuff”, but “only insofar as it would qualify as common general knowledge within each art.”

[15] Since the Applicant and Examiner agreed the person skilled in the art should be characterized as a food scientist, and this definition is reasonable in view of the teachings of the description, we accept this definition. The person skilled in the art is a food scientist, and the common general knowledge of that person includes some particular knowledge of yogurt foodstuffs and some particular knowledge of alcoholic foodstuffs. We accept the Applicant’s submissions that common general knowledge of yogurt foodstuffs and alcoholic foodstuffs includes knowledge of their respective food chemistry and production, insofar as the knowledge qualifies as common general knowledge. Also, we accept that common general knowledge of alcoholic foodstuffs includes knowledge of a particular combination of alcoholic foodstuffs and JELL-O®, as for example JELL-O® shots, and knowledge of any other combination of an alcoholic foodstuff with a non-alcoholic foodstuff insofar as that

knowledge would indeed qualify as common general knowledge. Moreover, as stipulated by the Examiner, the common general knowledge is also based in part on the background information provided in the application.

The Problem and Solution

- [16] During the course of our review, we presented the Applicant with a proposed characterization of the “problem” to be solved and the “solution” to that problem based on the specification, and we invited the Applicant to make submissions on the appropriate construction of the claims on file. In response to our letter, the Applicant submitted the problem addressed by the claim had never before been identified, “arising in the context of a new and unobvious class of product: an alcoholic yogurt refreshment which is resistant to spillage and hence possesses improved portability” (our emphasis). It further submitted the “practical problem” was one of “formulating the new class of product” in order to “imbue the new alcoholic yogurt refreshment with the properties for spill resistance and hence portability” (our emphasis added). According to the Applicant, the solution to this problem is the claimed composition which “includes *a semi-set or set-type yogurt combined with an alcohol* such that the *ethanol* content of the composition is within a respectively claimed *range*” (the Applicant’s emphasis).
- [17] We cannot accept the characterization of the problem to be solved in its entirety. During prosecution, the Examiner stated in the letter of April 8, 2008, that the “concept of adding alcohol to a yogurt food composition is not new”(our emphasis). The Applicant did not dispute this statement. This statement was made in relation to a number of prior art references which had been previously cited for anticipation but were later withdrawn when the claims were amended to recite the specific ethanol concentrations of the present claims. The prior art citations included mixtures of yogurt with sake, peach schnapps and Grand Marnier™, all of which had ethanol contents below 2%. Moreover, since anticipation and obviousness were the grounds for rejection in the Final Action and SOR, whether or not this is “a new and unobvious class of product” is in dispute. Adopting a characterization of the “problem to be solved” that imparts novelty and ingenuity to the refreshment would be improper and premature at this stage of our analysis. Novelty and obviousness are assessed, in accordance with the appropriate tests, only after the claims have been purposively construed.
- [18] As a point of clarification, based on the problem and solution submitted by the Applicant, the ethanol concentration could be interpreted as providing the spill-resistance, but this is not

consistent with the description. The experiments were designed with the requirement that the refreshment contain an overall ethanol concentration commensurate with socially acceptable limits for mixed alcohol products (page 6). For a spirit or liqueur containing 40% ethanol, as in the experimental trials, the 2% to 11.5% ethanol concentration range of the claims translates to an alcoholic refreshment containing from 1/3 of a shot (or 0.5 fluid ounces) to 2 shots (or 3 fluid ounces) of the alcohol. The skilled person would recognize this range is on par with standard mixed alcoholic beverages. It is within this range that the amounts of yogurt and alcohol were tested to determine the proportions that provide the properties of spill-resistance and portability.

[19] We therefore accept that the practical problem addressed by the claimed invention was one of formulating the class of products—alcoholic yogurt refreshments containing a socially acceptable amount of alcohol—in order to imbue the alcoholic yogurt refreshment with the properties for spill resistance and hence portability. We accept the Applicant’s characterization of the solution, adding only that it is the claimed eatable composition, having an ethanol content of the composition within the range of 2% to 11.5%, which includes a semi-set or set-type yogurt combined with an alcohol.

[20] Before we determine which elements of the claimed invention are essential to solving this problem, it is clear in reviewing the arguments that a number of terms require consideration. To provide context, we will first introduce the claims.

The Claims

[21] There are 14 claims on file, claims 1 and 13 are the only independent claims. Claim 1 of the application is as follows:

An eatable alcoholic refreshment, which is not a beverage, comprising:

a semi-set or set-type yogurt; and
an alcohol;

wherein the refreshment has an ethanol concentration between 2% and 11.5% by volume.

[22] Claim 13 is directed to:

A method of preparing the eatable alcoholic refreshment according to any one of

claims 1 to 12, comprising: mixing the alcohol with the semi-set or set type yogurt.

- [23] Claims 2-12 are dependent claims which refer back to claim 1. Claims 2 and 3 define narrower ethanol concentrations which fall within the range of that defined in claim 1. Claims 4-6 define specific ratios of alcoholic beverage to yogurt. Claims 7 and 8 define specific flavours of yogurt, and claims 9-12 specific types of alcohol to be used in the eatable refreshment.
- [24] Dependent claim 14 refers back to claim 13, and defines that “mixing” includes homogenizing the alcohol and yogurt mixture.

Eatable Alcoholic Refreshment

- [25] The term “eatable”, as it is used in the claims, relates to the thickness or consistency of the refreshment. This term is not to be confused with “edible” which would denote something which is fit for consumption, or safe to eat. This point was made by the Applicant in the response to the Final Action, in addressing the Examiner’s obviousness analysis.
- [26] It is clear from the specification that “eatable” goes directly to the consistency of the refreshment. On page 9 of the description, in relation to the experimental data, it is said that “more alcohol can be added to firmer yogurt providing the refreshment remains eatable with a spoon. The test for this is whether the refreshment will hold upright a plastic spoon inserted into its’ [*sic*] center.” (our emphasis added) Notably, this is the same test defined on page 5 for determining whether a mixture will resist spillage:

A mixture is described as resisting spillage when a plastic spoon inserted into the mixture, at room temperature, will remain vertical.

- [27] The panel notes that these tests are identical except that “spill resistance” is said to be measured at room temperature specifically. However, it is clear from the description on page 9 that spill resistance was also measured at cooler temperatures.
- [28] Given that “eatable” and “spill resistance” both denote consistency, and are both measured according to the same test, it is reasonable that the person skilled in the art would consider these terms to be synonymous within the context of this application.
- [29] Before we leave the subject of consistency and resistance to spillage, we refer to the Applicant’s submissions on pages 2-3 of the letter to the panel dated February 11, 2014,

relating to the appropriate construction of the claims:

Applicant performed numerous experiments to validate the types of compositions of yogurt and alcohol and resulting ethanol concentrations which solve the problem, i.e. possess the advantages, and the experimental results inform the recitations of the claims, and the ranges claimed therein. As such Applicant's comments regarding an appropriate construction of the claims are that the advantages, one of particular importance of which is resistance to spillage, according to the experimental evidence, are achieved by a combination of the semi-set or set-type yogurt and the alcohol in such a manner that the ethanol concentration of the refreshment falls within the various claimed ranges.

[30] Notably, the Applicant has emphasized the recitations of the claims were informed by the experimental results, which evidence shows the refreshments defined by the claims achieve a consistency that is spill-resistant. This statement is consistent with the description on pages 8-9 where, based on the experiments, it is concluded refreshments made from set-type or semi-set yogurt and alcohol, in proportions commensurate with the claims, are said to either resist spillage, maintain the eatable consistency, or both.

The Yogurt

[31] The claims define using either a "semi-set or set-type yogurt." According to the description, these designations represent the viscosity or thickness needed in order to produce a refreshment having the "eatable" consistency.

[32] According to the description, yogurts are said to generally range in consistency from thick to thin. The thickest yogurt is a "set-type" yogurt, also referred to as "set-solid." This yogurt is thick enough it can be tipped on its side without significant movement. At the opposite end of the spectrum are liquid yogurts which are said to be thin and can be "poured like milk." In our view, the skilled person would understand a yogurt that can be "poured like milk" to be a drinkable yogurt beverage having a consistency similar to milk.

[33] No explicit definition of "semi-set" yogurt was provided in the description, but the yogurts tested, which were all designated as either semi-set or set-type, were said to vary "in thickness from runny to set-solid" (page 5). Two semi-set yogurts were tested. The first was said to be semi-set at refrigerator temperature and "even more runny" at room temperature, suggesting it was runny at refrigerator temperature. The second was said to have a similar consistency to the first. According to the description, a "creamy" yogurt is not set, but is

reluctant to move if the container is tilted through 45 degrees. Based on these teachings, the person skilled in the art would interpret semi-set yogurts to range in thickness from “runny” to “creamy.”

- [34] Based on these teachings, the person skilled in the art would construe “semi-set or set-type yogurt” as yogurts which range in thickness from runny to set-solid.
- [35] According to the description, only prepared and commercially available yogurt products were tested, though non-commercially available products would yield the same results when the same ingredients are used.
- [36] There were a few different flavours of yogurts tested, but there was no teaching in the description that would lead the person skilled in the art to conclude that substituting one yogurt flavour for another would have a material effect on the operation of the claimed invention. Since the problem to be solved is to formulate the alcoholic yogurt refreshment so that it is imbued with the properties of spill resistance and portability, we conclude the person skilled in the art would appreciate the particular flavour of the yogurt as being a non-essential element of the claims.

The Alcohol

- [37] The independent claims specify the refreshment comprises “an alcohol” and that the final ethanol concentration of the refreshment is between 2% and 11.5% by volume.
- [38] According to the background of the description, consumable alcohol products are typically composed of 40% ethanol per volume or less of ethanol. Products with 40% or more are generally intended to be mixed with another beverage to reduce the ethanol concentration. Wine and beer are said to contain far less ethanol, 9-16% and 3-6% respectively.
- [39] Three specific types of alcohol were used in the tests; Paddy™ Irish Whiskey, Vodka and Drambuie™. The description states “(a)lthough Drambuie™ was the only liqueur tested, any other liqueur could have been used.” All of the alcohol sources tested contain 40% ethanol, but the claims are not limited to alcohols having this concentration. The only condition placed on the alcohol in the independent claims is that it provides an overall ethanol concentration of the alcohol/yogurt refreshment within a socially acceptable range of 2% and 11.5% by volume.

[40] All of the specific alcohols tested and featured in the dependent claims contained the same ethanol concentration of 40% by volume. There is no teaching in the description that would lead the person skilled in the art to conclude that substituting one alcohol source for another having the same ethanol concentration would have a material effect on the operation of the claimed invention. Since the problem to be solved goes to formulating the alcoholic yogurt refreshment so that it is imbued with the properties of spill resistance and portability, we conclude the person skilled in the art would appreciate the specific type of alcohol as being a non-essential element of the claims.

Essential Elements

[41] All of claims 1-14 on file were found to be anticipated by the Examiner. Notably, neither the Examiner nor the Applicant drew a distinction between any of these claims. In our view, the person skilled in the art would not consider any of the dependent claims to define additional elements which have a material effect on the working of the claimed invention, as we explain below. Accordingly, the claims will stand or fall together with our analysis of independent claims 1 and 13.

[42] As mentioned above, the skilled person would not consider that any of the dependent claims define subject matter that goes directly to solving the problem of formulating the refreshment to provide the properties of spill-resistance and portability. The ethanol concentration ranges defined in claims 2 and 3 are still within the socially acceptable limits, narrowing from within the broader range of claim 1 has no direct bearing on spill-resistance or portability. Moreover, because the ethanol concentration of the alcohol source used is not defined in claims 4-6, these claims do not fully address the proportions that provide spill-resistance. While the proportions are indeed the same as the trials which were shown to be spill-resistant using a 40% alcohol, since the strength of the alcohol is not also defined in the claims, the limits are arbitrary. This is because alcohols can vary significantly in strength. For example, if an 80% alcohol were used, proportions of 1 part alcohol to 34 parts yogurt—which is outside the scope of claims 4-6—would also achieve spill-resistance, and with an ethanol concentration of 2.3%, would also be within the socially acceptable limit. For this reason, the person skilled in the art would not consider the proportions of claims 4-6 as essential elements having a material effect on achieving the spill-resistance.

[43] As we have already explained above at [36] and [40], we have concluded the skilled person would recognize the specific yogurt flavours and types of alcohols of claims 7-12 are non-essential elements since they are unrelated to solving the problem of imbuing the

alcoholic yogurt refreshment with the properties of spill-resistance and increased portability. Moreover, since no distinction was made by the Applicant with regard to “homogenizing” in claim 14, and the description makes it clear “that any method of mixing would be suitable, even one that would render the mixture homogenized”, we conclude the skilled person would consider this to be a non-essential element having no material effect on the operation of the claimed invention.

[44] For these reasons, the person skilled in the art would not consider that dependent claims 2-12 and 14 provide any essential elements in addition to those of the independent claims, claims 1 and 13, upon which they depend.

[45] The essential elements of the alcoholic yogurt refreshment of claim 1 are i) an eatable consistency, and ii) an ethanol concentration between 2 to 11.5% by volume, made from iii) a yogurt having a consistency ranging from runny to set-solid, and iv) an alcohol.

[46] The method of claim 13 has the same essential elements as claim 1, adding the step of v) mixing the alcohol with the selected yogurt.

ISSUE (1) ARE THE CLAIMS ANTICIPATED?

Legal Framework

[47] The statutory provision relevant for assessing anticipation is subsection 28.2(1) of the *Patent Act*. That subsection provides, in part:

The subject-matter defined by a claim in an application for a patent in Canada (the “pending application”) must not have been disclosed

(a) more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere;

(b) before the claim date by a person not mentioned in paragraph (a) in such a manner that the subject-matter became available to the public in Canada or elsewhere.

[48] In *Sanofi*, the Supreme Court explicitly endorsed using a two-step test for anticipation wherein the requirements of “prior disclosure” and “enablement” are each considered.

Step One of the Test for Anticipation: "Prior Disclosure"

[49] The first step of the test for anticipation is set out at paragraph 25 in *Sanofi*, in reference to the House of Lords decision *Synthon BV v SmithKline Beecham plc*, [2005] UKHL 59 [*Synthon*]. As explained in *Synthon*, in order to meet the disclosure requirement for anticipation there must be disclosure of subject matter which, if performed, would necessarily result in infringement of the claim(s).

[50] The point is also made that it is not necessary the person performing the subject matter be aware of the fact they are infringing (para. 25 *Sanofi*, citing a reference from *Synthon* at para. 22, which discusses their earlier decision *Merrell Dow Pharmaceuticals Inc v H.N. Norton & Co Ltd*, [1995] UKHL 14 [*Merrell Dow*]):

...whether or not it would be apparent to anyone at the time, whenever subject matter described in the prior disclosure is capable of being performed and is such that, if performed, it must result in the patent being infringed, the disclosure condition is satisfied.

[51] Two other cases that consider this same point are *Abbott Laboratories v Canada* 2008 FC 1359 [*Abbott*¹] (aff'd 2009 FCA 94) and *Abbott Laboratories v Canada* 2006 FCA 187 [*Abbott*²]. Both cases cite the same excerpt from *Merrell Dow* which underscores the principle that it is not necessary that a person carrying out a prior disclosure recognizes what is happening, or what is present, for there to be infringement:

...whether or not a person is working [an] invention is an objective fact independent of what he knows or thinks about what he is doing.

[52] Both *Abbott*¹ and *Abbott*² relate to crystalline forms of the compound clarithromycin. Abbott had discovered three different crystalline forms of this compound, which it named Form 0, Form I and Form II (herein simply referred to by their Form number).

[53] Abbott's claim to Form I was found to be invalid for anticipation in *Abbott*¹, despite the fact that the prior art in question made no mention of Form I. Even though it had not been recognized at the time, the witnesses for both parties agreed that a person following the process taught in the prior art would inevitably produce at least some of the product in Form I. This was enough for the Court to conclude that to practise the prior art would be to infringe the claim, hence the claim was anticipated. The following quote was taken from *Merrell Dow*:

...if the recipe which inevitably produces the substance is part of the state of the art, so is the substance.

This quote accompanied the discussion of a case from the European Enlarged Board of Appeal involving a claimed process for making flavour concentrates which was anticipated by a cookbook recipe for pressure cooking chicken and stews.

[54] In *Abbott*², Abbott's claim to Form 0 was found to be invalid for anticipation. The prior art in question made no mention of Form 0, but it was common ground that anyone following the prior art process to produce Form I or Form II would inevitably produce Form 0 along the way in an intermediate step. Even though Form 0 was not recognized in the prior art, the Court held that did not matter, again citing *Merrell Dow*. A person carrying out the prior art process would infringe the claim to Form 0, and so there was anticipation.

[55] The final consideration set out at paragraph 25 of *Sanofi* for the first step of the anticipation test is that the person skilled in the art is taken as trying to understand what the author of the prior art disclosure meant; trial and error experimentation is not permitted in the first stage when considering "prior disclosure."

[56] If the first step of the anticipation test is satisfied, it is then necessary to advance to the next step and consider enablement, which is explained in the next section.

Step Two of the Test for Anticipation: "Enablement"

[57] After "prior disclosure" has been established, enablement is considered. At the enablement stage, the question is whether or not the person skilled in the art would be able to work the invention based on the information provided. Trial and error experiments are permitted at this stage, so long as they do not involve an inventive step. The skilled person must be able to perform the disclosed subject matter, or make the invention, without undue burden (para. 33 *Sanofi*).

Conclusion: Legal Framework

[58] To summarize the principles we will apply in the present case, for there to be anticipation:

- i) a single prior art reference must disclose subject matter which, if performed, would necessarily result in infringement of the claim(s),
- ii) the subject matter must be disclosed in an enabling manner such that the skilled person would be able to work the invention without having to exercise inventive ingenuity, and
- iii) even if it was not recognized at the time, if a prior art recipe which inevitably produces a substance is part of the state of the art, so is the substance, even if it is produced in an intermediate step.

The Recipe – Hirshberg

[59] The prior art in this case is a recipe from a cookbook; Hirshberg, Meg Cadoux, “Grand Marnier Fruit Salad”, *The Stoneyfield Farm Yogurt Cookbook*, Altona: D. W. Friesen & Sons, 1991, pp. 68 [Hirshberg]. The recipe calls for 2 apples, 2 oranges, 2 bananas, 2 peaches, 2 pears, 1 cup grapes, ½ cup cantaloupe (or any other fresh fruit), ¾ cup of raisins, ½ cup chopped walnuts or sunflower seeds, ¼ cup finely shredded coconut, 1 cup plain yogurt, ¼ cup honey at room temperature, and ¼ cup Grand Marnier. The body of the recipe is reproduced below:

Coconut, honey, and Grand Marnier add the perfect touches to this very special dish.

Peel all the fruit, remove the seeds and cores, and cut into small pieces. Place the fruit in a large bowl and add the raisins, walnuts, and coconut. In a separate bowl, mix together the yogurt, honey, and Grand Marnier. Pour the yogurt mixture over the fruit mixture and stir to combine thoroughly. Refrigerate or serve immediately. (our emphasis added)

Yield: 6 to 8 servings.

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[60] The mixture of plain yogurt, honey and Grand Marnier contained in the “separate bowl” is the composition at issue. It is common ground that Grand Marnier contains 40% alcohol, that the proportions of yogurt, honey and Grand Marnier provide a mixture with an overall

ethanol concentration of 6.7% by volume, and that the mixture contains 1 part Grand Marnier to 4 parts yogurt (in line with the examples). It is also common ground that Hirshberg does not explicitly disclose using a semi-set or set-type yogurt.

[61] In the Final Action and SOR, the Examiner maintained the claimed alcoholic yogurt refreshment is anticipated by Hirshberg. Specifically, the mixture contained in the separate bowl was said to anticipate the claims. Although Hirshberg does not recognize the mixture in the bowl has an “eatable” consistency, the Examiner took the position that the product produced by the prior art recipe would be “eatable.”

[62] In response, the Applicant took the position that the plain yogurt of Hirshberg was neither a semi-set nor a set-type yogurt. It also argued that using plain yogurt, instead of a semi-set or set-type yogurt, would not necessarily provide a composition with the eatable consistency that provides the properties of spill-resistance and portability which is achieved by the claimed refreshment.

Where the Shoe Pinches

[63] Central to all of the arguments on record is how the person skilled in the art would interpret “plain yogurt” in Hirshberg, and what consistency the resulting composition would have based on that interpretation. In our view, this is where the shoe pinches in the case. As mentioned above, the Examiner acknowledges in the Final Action that Hirshberg does not explicitly disclose using a semi-set or set-type yogurt as in the present claims. The question is whether the person skilled in the art, in trying to understand what the author of the prior art recipe meant, would understand “plain yogurt” to be a yogurt having a consistency in the range of runny to set-solid, which is how “a semi-set or set-type yogurt” was construed at [34]. If they would, the resulting mixture would necessarily have the “eatable” consistency since the ingredients and ethanol concentration would be the same as the refreshments defined in the independent claims. This would mean that all of the essential elements i)-v) of claims 1-14 would be disclosed, and the disclosure requirement would be satisfied.

Analysis Using The *Sanofi* Two-Step Approach

Step 1: Prior Disclosure

How Would the Person Skilled in the Art Understand “Plain Yogurt?”

- [64] As explained in *Sanofi*, the person skilled in the art is taken as trying to understand what the author of the prior art disclosure meant. The skilled person was characterized at [15] as a food scientist, having common general knowledge that includes knowledge of yogurt foodstuffs and knowledge of alcoholic foodstuffs. The skilled person would recognize that this recipe comes from a cookbook which is directed to a home cook—an ordinary layperson. In interpreting what the author of the recipe meant, the skilled person would consider what “plain yogurt” would have meant to an ordinary layperson at the date of its publication.
- [65] The Hirshberg recipe calls for “plain yogurt.” Nothing else is said about the yogurt *per se*. The fact that this is a recipe for fruit salad indicates the final product is something to eat, and not drink. This is consistent with the statement in the recipe referring to the final product as being “a very special dish”, which again indicates something to eat, as opposed to something to drink. In our view, the skilled person would understand that the author of the recipe intended “plain yogurt” to mean a standard yogurt having a consistency which would be eaten with a spoon, as opposed to a drinkable yogurt beverage. This is consistent with the Oxford dictionary definition of “yogurt” as “a semi-solid sourish food prepared from milk fermented by added bacteria.”
- [66] This is also consistent with an argument made by the Applicant in its letter to the panel of February 11, 2014. The Applicant reasoned that the consistency of the yogurt used will be maintained throughout the process described in Hirshberg, and that if the recipe were carried out using, for example, a “thin runny yogurt”, which it reasoned would be neither a semi-set or set-type yogurt, the mixture at every point during the process would be thin and runny. We agree with the Applicant on this point: in our view, neither the person skilled in the art, nor an ordinary layperson, would expect the process defined by the recipe to increase the thickness of the “plain yogurt” in any way. Therefore, in recognizing the prior art recipe prepares something to eat, and not drink, the skilled person would consider the author intended “plain yogurt” to be an eatable yogurt with a semi-solid consistency, in line with the Oxford dictionary definition of “yogurt” being a “semi-solid sourish food.”

[67] As discussed under purposive construction at [34], the skilled person would construe the claimed “semi-set or set-type yogurt” used in the claims as a yogurt having a consistency ranging from runny to set-solid. The skilled person would expect the “plain yogurt”—as a semi-solid yogurt having an eatable consistency—to fall squarely within the range of runny to set-solid. We therefore do not agree with the Applicant’s submissions in response to the Final Action and SOR that the plain yogurt of Hirshberg is neither a semi-set nor a set-type yogurt, or that it would not necessarily provide the consistency achieved by using semi-set and set-type yogurt.

The Applicant’s Arguments

[68] The Applicant provided two main arguments to support its position relating to the consistencies of the plain yogurt and the Hirshberg mixture which we must address before we can proceed.

[69] The first argument we will consider was raised in the letter to the panel dated February 11, 2014. The Applicant submitted that “plain yogurt” includes within its scope forms of yogurt which are neither semi-set nor set-type yogurt, such as “thin or runny yogurt” that would not result in products having the same physical properties of resistance to spillage as the claimed refreshment, as was shown through experimentation (our emphasis added). If the skilled reader selected such a yogurt, performing the subject matter disclosed would not result in infringement, and the disclosure requirement would not be satisfied.

[70] The panel first wishes to point out that the statement that runny yogurt is neither semi-set nor set-type is not consistent with the description. As we explained at [33], the person skilled in the art would construe “semi-set yogurt” in the claims as including runny yogurt, based on the teachings of the Applicant’s own description. As such, arguing that “plain yogurt” includes “runny yogurt” does not distinguish the Hirshberg mixture from the claimed composition.

[71] The panel also wishes to point out the statement that “thin or runny yogurt” was shown through experimentation to not provide the resistance to spillage is problematic. The experiments tested semi-set and set-type yogurts exclusively, and all of the experiments produced refreshments having ethanol concentrations within the claimed range of 2% to 11.5%. Stating that any tested yogurt was shown through experimentation not to work calls into question the scope of the claims on file. Moreover, this statement contradicts the conclusions drawn in the description that—based on the various proportions of yogurt and

40% alcohol tested in the experiments—refreshments made from semi-set and set-type yogurts and having an ethanol concentration in the range of 2% to 11.5% resist spillage. Likewise, this statement contradicts the Applicant’s submission mentioned at [29]-[30] that, according to the experimental evidence, which informed “recitations of the claims, and the ranges therein”, resistance to spillage is achieved by combining alcohol and semi-set or set-type yogurt in such a manner that the ethanol concentration of the refreshment falls within the claimed range.

[72] Since these statements are not consistent with the teachings of the description, we decline to give them any weight. It is worth noting that, if the Applicant’s submissions were correct and not all yogurts falling within the scope of the claims will produce a refreshment having the claimed consistency, this would indicate that the claims include within their ambit embodiments that would not operate. Consequently the claims would not comply with section 2 of the *Patent Act*, which requires an invention be “useful”, i.e. that everything within the claim works.

[73] Before we proceed, the Applicant has also submitted that “plain yogurt” includes “thin yogurt” within its scope. Since no alternative definition was provided, we will take “thin yogurt” to have the meaning it was given in the Applicant’s description. According to the description, a “thin” yogurt is a liquid yogurt that can be “poured like milk.” As mentioned at [32], the skilled person would construe this as a drinkable yogurt beverage having a consistency similar to milk. As we have already stated above at [65]-[66], we do not agree the skilled person would interpret the “plain yogurt” of Hirshberg to include drinkable yogurt beverages. Even though the Applicant has defined in its description that yogurt has a broad spectrum of viscosities including “thin” yogurts, we do not agree that the person skilled in the art would consider “plain yogurt”—as it is used in Hirshberg, or in general—to include liquid yogurt drinks having a consistency similar to milk.

[74] The second argument which we will consider was made in response to the Final Action. The panel notes these statements were repeated in Applicant’s response to the SOR, but the quoted passages below are from the response to the Final Action. These statements were made in relation to the issue of obviousness, but because these statements go directly to the consistency of the “plain yogurt” and the Hirshberg mixture, we find it appropriate to consider them here.

[75] According to the Applicant, the only thing Hirshberg says relating to consistency is that the yogurt mixture is to be poured over the fruit mixture. On that basis, the Applicant submitted

that Hirshberg “positively and explicitly” describes that “the mixture of plain yogurt and Grand Marnier is a pourable liquid”, and so there is no reason “why any kind of yogurt other than “plain yogurt”, which itself is the liquid pourable kind should be used” (page 17, our emphasis added). The Applicant also submitted it is clear the mixture in the “separate bowl” is “a pourable liquid which is inherently not resistant to spillage” (page 15, our emphasis added).

- [76] We do not agree with the Applicant that the word “pour” indicates the mixture or the yogurt disclosed in Hirshberg is inherently not resistant to spillage, as submitted. The skilled person would expect that the ordinary layperson would be aware of viscous or semi-solid mixtures, such as cake batter, pancake batter and molasses, that are thick yet pourable. Moreover, the Applicant’s own example 26 features a mixture of set-type yogurt and 50 mL of alcohol which was described as both “runny” and “pourable.” Not only does this example fall within the parameters of the claims, but it was the basis for the upper end of the claimed alcohol concentration being 11.5% made from mixing 1 part of a 40% alcohol with 2.5 parts yogurt. Moreover, the refreshment of example 17 which is made from 6 parts set-type yogurt and 1 part of a 40% alcohol, having an ethanol concentration of only 5.7% was also described as having a pourable consistency. Accordingly, the word “pour”, as it is used in Hirshberg, cannot distinguish the consistency of the prior art mixture from the claimed refreshments.
- [77] For the reasons stated above, the Applicant’s arguments do not change our conclusions. We do not agree with the Applicant that “plain yogurt” would be interpreted as including a “thin yogurt” which can be poured like milk. Moreover, arguments that “plain yogurt” and the Hirshberg mixture are “runny” or “pourable” fail to distinguish the claimed subject matter from the prior art.

Conclusions for Step 1: Prior Disclosure

- [78] The person skilled in the art would interpret the “plain yogurt” of Hirshberg as being the same as the “semi-set or set-type yogurt” of the claims. In following the Hirshberg recipe, a person skilled in the art would produce a composition that necessarily infringes the present claims, and they would do so according to the same method claimed. Consistent with *Abbott*¹ and *Abbott*², even though it was not recognized in the prior disclosure, the intermediate mixture produced in the “separate bowl” would inevitably have the same “eatable” consistency as the claimed refreshment since the ingredients, ethanol concentration and mixing step are all within the scope of the essential elements of claims 1-14. The disclosure requirement is satisfied.

Step 2: Enablement

[79] Given the straightforward and uncomplicated nature of the subject matter, we have no doubt the skilled person would be able to work the prior art recipe based on the teachings provided.

Conclusions

[80] The claims on file are anticipated by Hirshberg, which discloses subject matter which, if performed, would necessarily result in infringement of the claims. Even though it was not recognized at the time, the composition of Hirshberg would have the “eatable” consistency prescribed by the plastic spoon test, since the ethanol concentration is within the claimed range and the ingredients are the same. Even if the narrower ethanol concentrations and proportions of alcohol to yogurt of claims 2-6 had been considered as essential elements in our analysis, the disclosure requirement would still have been satisfied: the ethanol concentration and relative amounts of yogurt and alcohol of the Hirshberg mixture are within the ranges defined in those claims.

RECOMMENDATIONS OF THE BOARD

[81] We recommend that the application be refused for lack of compliance with paragraph 28.2(b) of the *Patent Act*, since the claims are anticipated.

[82] As our finding on this issue is sufficient to dispose of the application, it is not necessary to make a determination in respect of the obviousness defect identified by the Examiner.

Cara Weir
Member

Mark Couture
Member

Christine Teixeira
Member

DECISION OF THE COMMISSIONER

[83] I concur with the findings and the recommendation of the Board. As the claimed subject matter is anticipated, and therefore non-compliant with paragraph 28.2(b) of the *Patent Act*, I hereby refuse the application in accordance with section 40 of the *Patent Act*.

[84] Under section 41 of the *Patent Act*, the Applicant has six months within which to appeal my decision to the Federal Court of Canada.

Sylvain Laporte
Commissioner of Patents

Dated at Gatineau, Quebec
this 28th day of May, 2014