

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte PETER J. MALTON,
LYNETTE A.M. HOLLAND,
GEORGE RIZZI, and
GABOR HELTOVICS

Appeal No. 2004-0384
Application No. 09/979,424

ON BRIEF

Before WINTERS, GRON, and SCHEINER, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 5 and 7 through 12, which are all of the claims pending in the application.

The Invention

The present invention relates to cosmetic compositions and, in particular, to long-lasting fragrance compositions. According to applicants, they have surprisingly found that compositions comprising fragrance and cyclic oligosaccharides having one or more unsubstituted alkyl substituents, wherein the weight ratio of (a) fragrance to (b) cyclic

oligosaccharide is greater than about 1:1, provide an initial burst of fragrance and improved longevity (specification, page 2, lines 11 through 14). Applicants state that

While not wishing to be bound by theory, it is believed that the fragrance material complexes with cyclic oligosaccharide of the present invention. It is believed that the stability profile of the complexes formed between the fragrance and the cyclic oligosaccharides of the present invention is such that a perceptible amount of fragrance is released over a sufficiently long time to satisfy the consumers desire for long lasting fragrance. In addition, it is believed that the weight ratio of fragrance to cyclic oligosaccharides in the present invention ensures that there is a 'burst' of fragrance on application of the composition to a suitable substrate [e.g., the skin or hair]. [Id., lines 16 through 23].

Additionally, applicants disclose that compositions of the present invention may comprise about 20% or greater of a volatile solvent by weight of total composition (id., page 9, lines 19 through 23).

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A cosmetic composition comprising:
 - (a) fragrance
 - (b) cyclic oligosaccharides having one or more unsubstituted alkyl substituents;and
 - (c) about 20% or greater of a volatile solvent; and

wherein the weight ratio of (a) to (b) is greater than about 1:1. [Emphasis added].

The References

In rejecting applicants' claims on prior art grounds, the examiner relies on the following references:

Trinh et al. (Trinh '937) (PCT Application)	WO 96/04937	Feb. 22, 1996
Trinh et al. (Trinh '940) (PCT Application)	WO 96/04940	Feb. 22, 1996
Lucas et al. (Lucas '341) (PCT Application)	WO 98/56341	Dec. 17, 1998
Lucas et al. (Lucas '342) (PCT Application)	WO 98/56342	Dec. 17, 1998

The Rejection

Claims 1 through 5 and 7 through 12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Trinh '940, Trinh '937, Lucas '341, and Lucas '342.

Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicants' Appeal Brief (Paper No. 13); (3) the Examiner's Answer (Paper No. 15); (4) the Office Action mailed February 26, 2002 (Paper No. 4), the Final Rejection mailed October 2, 2002 (Paper No. 9), and the Advisory Action mailed February 4, 2003 (Paper No. 12); and (5) the above-cited prior art references.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection under 35 U.S.C. § 103(a).

Discussion

Independent claim 1, the broadest claim on appeal, includes the limitation “about 20% or greater of a volatile solvent.” The examiner’s position to the contrary, notwithstanding, the combined disclosures of Trinh ‘940, Trinh ‘937, Lucas ‘341, and Lucas ‘342 constitute insufficient evidence to support a conclusion of obviousness of claims including that limitation.

First, the examiner argues that recitation of “a volatile solvent” in claim 1 “reads on” water; that this constitutes the broadest reasonable interpretation of claim 1 consistent with the specification, page 9, line 18 through page 10, line 8; and that Trinh ‘940 discloses cosmetic compositions comprising greater than 20% of water, by weight of total composition (Paper No. 15, page 6, second paragraph). Accordingly, the examiner argues that “this limitation [about 20% or greater of a volatile solvent] is met and clearly taught by Trinh [‘940].” The argument lacks merit.

As stated in In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983):

It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969), and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977).

We have carefully considered the passage in applicants’ specification running from page 9, line 18, through page 10, line 8, describing a “volatile solvent.” Additionally, we note the ensuing passage at page 11, lines 9 through 13, describing water:

Water

The compositions of the present invention may also comprise water. If present, the water will preferably comprise from about 0.1% to about 40%, more preferably from about 1% to about 30%, even more preferably about 5% to about 20%, by weight, of total composition. [Emphasis added].

Giving claim 1 its broadest reasonable interpretation consistent with the specification, and reading applicants' claim language in light of the specification as it would be interpreted by one of ordinary skill in the art, we conclude that "a volatile solvent" does not "read on" water. On the contrary, "a volatile solvent" recited in claim 1 excludes water. This follows from a review of the specification in its entirety where (1) applicants describe the volatile solvent at page 9, line 18, through page 10, line 8; and (2) applicants state, in the ensuing passage at page 11, line 10, that "the compositions of the present invention may also comprise water" (emphasis added).

Where, as here, the examiner's argument is based on an incorrect claim interpretation, i.e., that "a volatile solvent" in claim 1 "reads on" water, the argument is not persuasive. On these facts, we agree with applicants that the Trinh '940 disclosure of cosmetic compositions comprising greater than 20% of water, by weight of total composition, does not suggest the cosmetic composition recited in claim 1 requiring "about 20% or greater of a volatile solvent." We disagree that Trinh '940 discloses or suggests the cosmetic composition of claim 1, considered as a whole, including the limitation "about 20% or greater of a volatile solvent." Nor has the examiner established that Trinh '937, Lucas '341, or Lucas '342 cures the above-noted deficiency of Trinh '940.

We note in passing that claim 1 does not expressly recite “about 20% or greater of a volatile solvent, by weight of total composition” (emphasis added). However, giving this claim its broadest reasonable interpretation consistent with the specification, In re Sneed, 710 F.2d at 1548, 218 USPQ at 388, we conclude that “by weight of total composition” is the only plausible interpretation which the facts permit. This is clear from a review of the specification, page 9, lines 18 through 23.

Second, the examiner argues that Trinh ‘940 suggests a cosmetic composition comprising about 20% or greater of low molecular weight monohydric alcohols (Paper No. 15, page 6, paragraph 3). The argument lacks merit. Trinh ‘940 discloses and claims an aqueous composition for reducing malodor impression “wherein said composition contains less than 5%, by weight of the composition, of low molecular weight monohydric alcohols” (Trinh ‘940, claim 1, emphasis added). On these facts, Trinh ‘940 teaches away from, not toward, the claim limitation “about 20% or greater of a volatile solvent.” Again, we disagree that Trinh ‘940 discloses or suggests the cosmetic composition of claim 1, considered as a whole, including the limitation “about 20% or greater of a volatile solvent.” Nor has the examiner established that Trinh ‘937, Lucas ‘341, or Lucas ‘342 cures the above-noted deficiency of Trinh ‘940.

Conclusion

In conclusion, for the reasons set forth in the body of this opinion, we reverse the examiner's rejection of claims 1 through 5 and 7 through 12 under 35 U.S.C. § 103(a).

The examiner's decision is reversed.

REVERSED

)	
Sherman D. Winters)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
Teddy S. Gron)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Toni R. Scheiner)	
Administrative Patent Judge)	

Appeal No. 2004-0384
Application No. 09/979,424

Page 8

The Procter & Gamble Company
Intellectual Property Division
Winton Hill Technical Center - Box 161
6110 Center Hill Avenue
Cincinnati, OH 45224

dem