

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte VERONIQUE MAURIN and
BERNARD BEAUQUEY

Appeal No. 2004-0744
Application No. 09/671,188

HEARD: July 29, 2004

Before WINTERS, MILLS, and GREEN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 6, 8 through 10, 15 through 17, 20, and 22 through 42. Claims 7, 18, 19, and 21, which are the only other claims remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

Representative Claim

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

follows:

1. An antidandruff composition for treating the hair and the scalp, comprising in a cosmetically acceptable medium,
 - at least one pyridinethione salt,
 - at least one insoluble conditioner, and
 - at least one acrylic terpolymer containing, in amounts based on the total weight of monomers constituting the terpolymer:
 - acrylate monomer (a), in amount of 5% to 80% by weight and selected from the group consisting of a C₁-C₆ alkyl acrylate and a C₁-C₆ alkyl methacrylate;
 - monomer (b), in an amount of 5% to 80% by weight and selected from the group consisting of a heterocyclic vinyl compound containing at least one nitrogen or sulphur atom, a (meth)acrylamide, a mono- and di(C₁-C₄) alkylamino (C₁-C₄) alkyl (meth)acrylate, and a mono- and di (C₁-C₄) alkylamino (C₁-C₄) alkyl (meth)acrylamide; and
 - monomer (c), in an amount of 0.1% to 30% by weight and selected from the group consisting of:
 - i) a urethane produced by reaction between a monoethylenic unsaturated isocyanate and a nonionic surfactant comprising a block copolymer of 1,2-butylene oxide and of ethylene oxide with a C₁₋₄ alkoxy end;

- ii) a copolymerizable ethylenic unsaturated surfactant monomer obtained by condensation of a nonionic surfactant with an α , β -ethylenic unsaturated carboxylic acid or its anhydride;
- iii) an urea surfactant monomer produced by reacting a monoethylenic unsaturated monoisocyanate with a nonionic surfactant containing an amine function;
- iv) a (meth)allyl ether of formula $\text{CH}_2=\text{CR}_1\text{CH}_2\text{O}A_m\text{B}_n\text{A}_p\text{R}_2$ in which R_1 denotes a hydrogen atom or a methyl group, A denotes a propylenoxy or butylenoxy group, B denotes ethylenoxy, n is equal to zero or denotes an integer less than or equal to 200, m and p denote zero or an integer less than n, and R_2 is a hydrophobic group of at least 8 carbon atoms; and
- (v) a nonionic urethane monomer produced by reacting a monohydric nonionic surfactant with a monoethylenic unsaturated isocyanate.

The Prior Art References

In rejecting the appealed claims under 35 U.S.C. § 103(a), the examiner relies on the following prior art references:

Cardin et al. (Cardin)	5,104,645	Apr. 14, 1992
Coffindaffer et al. (Coffindaffer '666)	5,624,666	Apr. 29, 1997 ¹

Cardinali et al. (Cardinali), "Novel Cationic Compatible Rheology Modifiers for Hard-to-Thicken Personal Care Applications," Fragrance Journal, Vol. 27, No. 1, pp. 151-159 (1999)

The Rejection

Claims 1 through 6, 8 through 10, 15 through 17, 20, and 22 through 42 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Cardin, Cardinali, and Coffindaffer '666.

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. 21) and the Reply Brief (Paper No. 24); (3) the Examiner's Answer (Paper No. 22); (4) the above-cited prior art references; and (5) the **ELECTION OF SPECIES UNDER 37 C.F.R. §1.143** received August 16, 2001 (Paper No. 8).

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

Discussion

¹ In section (9) of the Examiner's Answer (Paper No. 22), the examiner includes U.S. Patent Number 5,648,323 issued July 15, 1997, to Coffindaffer et al., in the citation of prior art of record. That citation, however, appears to constitute an inadvertent error. This can be seen from a review of the final rejection (Paper No. 14) and the Examiner's Answer (Paper No. 22), section (10), where the examiner makes clear that Coffindaffer '666 is relied on to support the rejection under 35 U.S.C. § 103(a).

Claim 1, the broadest claim on appeal, calls for an antidandruff composition for treating the hair and scalp comprising three essential ingredients in a cosmetically acceptable medium. These ingredients are: (A) at least one pyridinethione salt; (B) at least one insoluble conditioner, and (C) at least one acrylic terpolymer containing specified monomers in specified amounts. In the **ELECTION OF SPECIES UNDER 37 C.F.R. §1.143** received August 16, 2001 (Paper No. 8), applicants elected the following species for prosecution in this application: (A) zinc pyridinethione (claim 40) as the “at least one pyridinethione salt;” (B) polydimethylsiloxane sold under the name “Mirasil[®] DM 500,000” (specification, page 34, Example II) as the “at least one insoluble conditioner;” and (C) Structure[®] Plus (claim 6) as the “at least one acrylic terpolymer.”

In the examiner’s statement of rejection, Cardin serves as the “jumping off” point. The examiner argues that Cardin discloses an antidandruff shampoo composition for treating the hair and scalp, comprising zinc pyridinethione in a cosmetically acceptable medium. Further, according to the examiner, Cardin discloses a polydimethylsiloxane conditioner in the composition; and the examiner argues that Cardin’s polydimethylsiloxane reasonably appears to be insoluble based on its disclosed viscosity. Accordingly, the examiner takes the position that Cardin discloses every feature of the antidandruff composition recited in claim 1 except for the “at least one acrylic terpolymer.” See Paper No. 22, page 3 (“The [Cardin] reference fails to teach . . . acrylic terpolymers”).

In an effort to bridge the gap between Cardin’s antidandruff shampoo composition and the composition recited in claim 1 on appeal, the examiner invites

attention to Coffindaffer's "anti-dandruff shampoos with particulate active agent and cationic polymer." The examiner argues that Coffindaffer, like Cardin, discloses an antidandruff shampoo composition for treating the hair and scalp, comprising zinc pyridinethione in a cosmetically acceptable medium. See, Coffindaffer, column 11, lines 38 through 44:

Preferred pyridinethione anti-dandruff agents are water insoluble 1-hydroxy-2-pyridinethione salts. Preferred salts are formed from heavy metals such as zinc, tin, cadmium, magnesium, aluminum and zirconium. The most preferred metal herein is zinc. The most preferred active is the zinc salt of 1-hydroxy-2-pyridinethione, often referred to as zinc pyridinethione (ZPT). (Emphasis added).

The examiner also points out that Coffindaffer, like Cardin, discloses particulate antidandruff agents. See Coffindaffer, column 11, lines 9 through 13 ("The particulate anti-dandruff agent [e.g. zinc pyridinethione] has a volume average particle size of from about 0.35 microns to about 5 microns, preferably from about 0.40 microns to about 3 microns, more preferably from about 0.45 microns to about 2 microns"); and Cardin, column 6, lines 27 through 34 ("The pyridinethione salts useful herein take the form of water-insoluble flat platelet particles which have a mean sphericity of less than about 0.65, preferably from about 0.20 to about 0.54, and a median particle size of from about 2 μ to about 15 μ , preferably from about 5 μ to about 9 μ , the particle size being expressed as the median equivalent diameter of a sphere of equal volume"). According to the examiner, it would have been obvious to a person having ordinary skill in the art to modify Cardin's antidandruff shampoo composition, per the teachings of Coffindaffer, by adding a stabilizing agent for the zinc pyridinethione antidandruff agent where the stabilizing agent is a soluble cationic polymer. See Coffindaffer's abstract; and see

column 12, lines 9 through 17:

The stabilizing agent hereof is a shampoo soluble cationic polymer. It has been found that very low levels of such cationic polymer can effectively aid in suspension stability of the particulate anti-dandruff agent in the present shampoo compositions, with substantially reduced deposition trade-offs versus conventional suspension technologies. By 'shampoo soluble' what is meant is that the cationic polymer is present in the shampoo in solubilized form.

Therefore, the examiner argues that the combined disclosures of Cardin and Coffindaffer would have led a person having ordinary skill in the art to an antidandruff composition for treating the hair and scalp comprising, in a cosmetically acceptable medium, zinc pyridinethione; insoluble polydimethylsiloxane conditioner; and a soluble cationic polymer stabilizing agent.

Next, the examiner refers to Cardin's disclosure of viscosity modifiers at column 12, lines 20 through 37. The examiner argues that a person having ordinary skill would have found it obvious to use Structure[®] Plus, per the teachings of Cardinali, in lieu of the viscosity modifier(s) disclosed by Cardin. The examiner argues that the Cardinali reference, entitled "Novel Cationic Compatible Rheology Modifiers for Hard-to-Thicken Personal Care Applications," discloses a number of advantages for Structure[®] Plus in hard-to-thicken personal care preparations; that Cardinali discloses "very high usefulness" of Structure[®] Plus in ultramild, conditioning, acid formulations which are hard to thicken; and that Structure[®] Plus thickens by activation with acid and surfactant, which is highly relevant to cosmetics (Cardinali, English translation, page 14). Emphasizing the property of cationic compatibility disclosed by Cardinali, the examiner argues that it would have been obvious to add Structure[®] Plus to an antidandruff

composition suggested by the combined disclosures of Cardin and Coffindaffer. In other words, the examiner argues, it would have been obvious to add Structure[®] Plus to an antidandruff composition for treating the hair and scalp comprising, in a cosmetically acceptable medium, zinc pyridinethione; insoluble polydimethylsiloxane conditioner; and a soluble cationic polymer stabilizing agent. The examiner concludes that the antidandruff composition recited in claim 1 on appeal would have been obvious to a person having ordinary skill in the art at the time the invention was made based on the combined disclosures of Cardin, Coffindaffer, and Cardinali. We disagree.

“It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965). That, however, is what the examiner has done here. As previously discussed, the examiner relies on the Coffindaffer ‘666 patent for its disclosure of a stabilizing agent for particulate antidandruff agents, e.g., zinc pyridinethione. Coffindaffer discloses that the stabilizing agent is a shampoo soluble cationic polymer (column 12, lines 9 through 17). The linchpin of the examiner’s argument is that it would have been obvious to a person having ordinary skill in the art to modify Cardin’s antidandruff shampoo composition, per the teachings of Coffindaffer, by adding a soluble cationic polymer stabilizing agent for the zinc pyridinethione antidandruff agent disclosed by Cardin. However, the examiner avoids reliance on Coffindaffer’s disclosure of suitable conditioning agents (column 16,

line 37 through column 18, line 7). Note, for example, Coffindaffer's disclosure that "[t]he conditioning agents for use herein include shampoo soluble conditioning agents and crystalline conditioning agents" (column 16, lines 39 through 41, emphasis added); that soluble conditioning agents can include soluble silicone fluids, e.g., polymethylsiloxanes (id., lines 42 through 45); and that "[t]he amount of such ingredients should preferably be chosen such that that entire amount added is soluble in the composition" (id., lines 56 through 58, emphasis added).

In our judgment, the examiner has fallen prey to the insidious effect of hindsight in stating the case of obviousness under 35 U.S.C. § 103(a) based on a combination of references. The examiner has not adequately explained why it would have been obvious "to pick and choose from any one reference [Coffindaffer] only so much of it as will support a given position [shampoo soluble cationic polymer], to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art [shampoo soluble conditioning agents, e.g., polymethylsiloxanes]." In re Hedges, 783 F.2d at 1041, 228 USPQ at 687. The examiner has not explained why the combined disclosures of Cardin, Coffindaffer, and Cardinali would have led a person having ordinary skill to an antidandruff composition containing the polydimethylsiloxane conditioner of Cardin, said to be insoluble based on its disclosed viscosity; but not containing the shampoo soluble conditioning agents (e.g., polymethylsiloxanes) disclosed by Coffindaffer. Accordingly, on these facts, we agree with applicants that "[t]he Examiner has merely reconstructed Appellants' claimed subject matter based on Appellants' own disclosure" (Paper No. 21, sentence bridging pages 25

and 26).

We conclude that the examiner has not established a prima facie case of obviousness of claims 1 through 6, 8 through 10, 15 through 17, 20, and 22 through 42. Accordingly, the examiner's decision rejecting those claims under 35 U.S.C. § 103(a) is reversed.

REVERSED

Sherman D. Winters)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Demetra J. Mills)	
Administrative Patent Judge)	APPEALS AND
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Appeal No. 2004-0744
Application No. 09/671,188

Page 11

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