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for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DEGUANG ZHU and YAO ZHU

Appeal No. 2005-0403
Application No. 09/748,466

ON BRIEF

Before ADAMS, MILLS and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 5, 9-14 and 16, which are all the claims pending in the application.

Claim 5 is illustrative of the subject matter on appeal and is reproduced below:

5. A method of increasing skin firmness and elasticity, reducing lines and wrinkles of skin, improving age spots and clarity of skin, raising ability of skin or scalp to scavenge oxygen free radicals, raising ability of skin or scalp against UV-induced damage, treating aging of skin or scalp, preventing skin or scalp from aging, treating winter itch, or improving secretion of sebaceous and sweat glands comprising:
   topically applying an effective amount of a composition consisting essentially of insulin, which can be natural, synthetic, recombinant, human or animal, to the skin or scalp.

The examiner relies on the following prior art:

Hinson	5,145,679	Sep. 8, 1992

GROUND OF REJECTION

Claims 5, 9-14 and 16 stand rejected under 35 U.S.C. § 102(b) as anticipated by Hinson.

We affirm.

CLAIM GROUPING

According to appellant (Brief, page 3), "[c]laims 5, 9-14 and 16 stand or fall together." Since all claims stand or fall together, we limit our discussion to representative independent claim 5. Claims 9-14 and 16 will stand or fall together with claim 5. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

DISCUSSION

According to the examiner (Answer, bridging paragraph, pages 3-4),

> Hinson teaches a method for treating skin conditions such as skin lesions, skin rash, etc. comprising topically applying to the surface of the skin a topical emollient which is a solution consisting essentially of glucose and insulin, wherein insulin is present as a concentration of 0.06-2 units/ml. See Abstract; col. 1, lines 13-17; col. 2, lines 34-36. The compositions of Hinson can be applied to the skin or scalp. See Examples. With respect to the limitations recited in the preambles of [c]laims 5 and 9, it is noted that newly discovered results of known processes (i.e. topically applying a compositions consisting essentially of insulin to the skin or scalp) are not patentable because such results are inherent. Since the method step (i.e., topically applying a compositions consisting essentially of insulin) is the same, the result (i,e,, increasing skin firmness, etc.) will inherently be the same.

In response appellants argue (Brief, pages 5-6),

> Hinson discloses a topical emollient containing a source of glucose and insulin for the treatment of circulation induced lesions (Hinson, abstract). The circulation induced lesions, such as skin lesions, ulcers and maladies, are a pathologic result caused by diabetes, phlebitis, or other circulatory problems (Hinson, col. 1, lines 12-35).
>
> In contrast, the method of the presently claimed invention includes applying the composition of the present invention to skin or scalp, not skin lesions, skin ulcers, or skin maladies. Skin lesions, skin ulcers, and skin maladies as defined in Hinson are not encompassed by the definition of skin as used in the present application. For example, the term "wounds" which includes lesions, is considered separate and distinct from skin at page 6, lines 11-15, of the specification.

In response, the examiner asserts (Answer, page 4) that he was unable to identify a "clear" definition of the term "skin" as it is used in appellants' specification. To the contrary, with reference to pages 2-3 of appellants' specification the examiner finds (Answer, page 4), "the specification lists wound treatment and skincare in diabetic patients as possible uses of insulin and does not distinguish between treating 'pathological' and 'physiological' changes in the skin." According to the examiner (page 5), "[t]he fact that Applicant may have discovered yet another beneficial effect from the method set forth in the prior art does not mean that they are entitled to receive a patent on that method." We agree. It is well established that merely discovering and claiming a new benefit of an old process cannot render the process again patentable. See In re Woodruff, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Thus, we agree with the examiner (Answer, page 5), appellants' discovery that the topical application of a composition, consisting essentially of insulin, to skin

confers an additional benefit not disclosed by Hinson, cannot render the claimed process patentable.

After the PTO establishes a prima facie case of anticipation, the burden shifts to the appellants to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Thus, appellants' burden before the PTO is to prove that the subject matter of the method shown to be in the prior art does not possess the characteristics of the claimed method.

In this regard, we recognize appellants' assertion (Brief, page 6),

> Hinson does not provide any motivation for treating physiological changes in skin such as those recited in the pending claims. Rather, Hinson only teaches treating pathological changes in the skin, such as the formation of skin lesions and skin ulcers, with a mixture of insulin and glucose. Hinson also does not provide a reasonable expectation that the compositions of the presently claimed invention would be able to treat physiological changes in skin such as those recited in the pending claims.

According to appellants (Reply Brief, page 4), "Hinson does not inherently or expressly disclose treating 'skin' with an effective amount of a composition consisting essentially of insulin…." Notwithstanding appellants' assertion to the contrary, Hinson teach the application of an effective amount of an insulin composition to the legs and feet of a patient suffering with severe varicose veins and phlebitis. See Hinson, column 3, example 3. In our opinion, this is an express disclosure of the treatment of skin with an effective amount of a composition consisting essentially of insulin. Appellants have not demonstrated

that the amount of insulin present in the composition disclosed by Hinson is ineffective in their claimed method, or that Hinson's composition is distinct from the composition consisting essentially of insulin as set forth in appellants' claimed method.

Accordingly, we affirm the rejection of claim 5 under 35 U.S.C. § 102(b) as anticipated by Hinson. As discussed supra claims 9-14 and 16 fall together with claim 5.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Donald E. Adams Administrative Patent Judge	) BOARD OF PATENT
Demetra J. Mills Administrative Patent Judge	) APPEALS AND
Lora M. Green Administrative Patent Judge	) INTERFERENCES

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