The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 Sabine Grimm and
Jean-Christophe Simon

Appeal No. 2005-0708
Application No. 09/968,967

HEARD: April 20, 2005

Before PAK, WALTZ, and TIMM, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1, 4, 6-13, 19-24, 26, 27, 29, 30, and 33-48.[1] Claims 14-18 are the only other claims pending in this application but stand withdrawn from further consideration by the examiner as directed to a non-elected invention (final Office

[1]Appellants submitted an amendment subsequent to the final rejection, which amendment was entered by the examiner (see the amendment dated Mar. 16, 2004, entered as per the Advisory Action dated Mar. 31, 2004; see also the Brief, page 3, ¶ IV).

action dated Aug. 27, 2003, page 2; Brief, page 2, ¶ III). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a method for producing a goniochromatic effect by applying to the skin a composition comprising at least one continuous lipophilic phase and at least one particulate phase, where the particulate phase comprises at least one goniochromatic pigment having an interferential multilayer structure and at least one other pigment other than said goniochromatic pigment (Brief, page 3).

Appellants state that the claims should be grouped into two groups corresponding to each group of rejected claims, with all claims in each group standing or falling together (Brief, page 5). Accordingly, we select claims 1 and 29 as representative of the two groups and decide the grounds of rejection in this appeal on the basis of these claims. See 37 CFR § 1.192(c)(7)(2003); *In re McDaniel,* 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Representative independent claim 1 is reproduced below:

1. A method for producing a goniochromatic effect on skin of human beings comprising:

applying to the skin of human beings a cosmetic composition comprising, in a cosmetically acceptable medium, at least one continuous lipophilic phase and at least one particulate phase being presented in a proportion of 0.05 to 50% by weight with respect to the total weight of the composition, said particulate phase comprising 0.01 to 25% by weight of at least one goniochromatic pigment having an interferential multilayer

structure comprising at least two layers, each layer being made of at least one material chosen from MgF_2, CeF_3, ZnS, ZnSe, Si, SiO_2, Ge, Te, Fe_2O_3, Pt, V, Al_2O_3, MgO, Y_2O_3, S_2O_3 [sic], SiO, HfO_2, ZrO_2, CeO_2, Nb_2O_5, Ta_2O_5, TiO_2, Ag, Al, Au, Cu, Rb, TI, Ta, W, Zn, MoS_2, Cr, mica oxide, and cryolite, and said particulate phase additionally comprising at least one pigment, other than said goniochromatic pigment, present in a quantity of 0.01 to 5% by weight.

The examiner has relied upon the following references as evidence of obviousness:

Simon (French Patent)	FR 2 777 178 A1	Oct. 15, 1999
Medelnick et al. (Medelnick) (German Offenlegungsschrift)[2]	DE 199 07 313 A1	Aug. 24, 2000

Claims 1, 4, 6-13, 19-24, 26-27, 30, 33 and 37-48 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Medelnick (Answer, page 3). Claims 29 and 34-36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Medelnick in view of Simon (Answer, page 6). Based on the totality of the record, we *affirm* both grounds of rejection on appeal essentially for the reasons stated in the Answer and those reasons set forth below.

[2]We rely upon and cite from full English translations of each reference, previously made of record.

OPINION

A. The Rejection over Medelnick

The examiner finds that Medelnick discloses goniochromatic pigments, alone or in combination with other pigments, in compositions for use as lipsticks, eye shadow, and eyeliner (Answer, page 3). The examiner further finds that Medelnick teaches compositions containing lipophilic continuous phases with a goniochromatic pigment in an amount from 1-50%, with a particulate phase comprising 2.4-65% of the composition, and additional pigments are exemplified in amounts of 0.5-0.9% (Answer, page 4). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art to discover the optimum amounts of each type of pigment within the ranges taught by Medelnick (Answer, paragraph bridging pages 4-5). We agree.

Appellants argue that none of the 45 examples in Medelnick specify exactly which goniochromatic pigment is used, but the examples only recite “gloss pigment” and their exact composition for any specific example is not provided (Brief, page 8; Reply Brief, page 3). Appellants further argue that it is unclear if any of the compositions of the examples in Medelnick have layers

that meet the limitations of the claimed goniochromatic pigments (Brief, page 9).

These arguments are not well taken. First we note that the disclosure of a prior art reference is not limited to its examples. *See In re Widmer,* 353 F.2d 752, 757, 147 USPQ 518, 523 (CCPA 1965). A prior art reference is available for all that it teaches and suggests to one of ordinary skill in the art. In this rejection on appeal, Medelnick specifically teaches that multilayer goniochromatic pigments as described are “to be understood as gloss pigments suitable for use in accordance with the invention.” Page 2, ll. 6-13. The specific multilayer structure taught by Medelnick as “gloss pigments” fall within the scope of the claimed “goniochromatic pigment having an interferential multilayer structure comprising at least two layers,” as specified in claim 1 on appeal (see Medelnick, page 2, ll. 18-33; compare with the materials listed in claim 1 on appeal).

Appellants argue there are at least four limitations whose choice must be made by the examiner (Brief, page 9), and Medelnick provides no rationale or functional arguments to pick the concentrations of the ingredients or the combination of the three instantly claimed ingredients (Brief, page 10).

These arguments are not persuasive. Medelnick clearly discloses cosmetic compositions applied to the skin where the composition contains at least one continuous lipophilic phase (i.e., a "fat phase," see, for example, Example 23 on page 10 of Medelnick) and a particulate phase of a goniochromatic pigment (page 2 in general), with a teaching of including other colored pigments (page 2, ll. 32-34; page 3, ll. 6-8), as well as exemplification of other pigments and their amounts (e.g., see Example 17). Thus Medelnick discloses every limitation of claim 1 on appeal, teaching amounts of the "gloss pigment" (page 3, ll. 3-6) and exemplifying amounts of the other types of pigments within the claimed amounts (see the Examples, especially Example 22). We further note that even assuming *arguendo* that Medelnick fails to disclose or suggest the amounts of each ingredient, such amounts would be well within the ordinary skill in this art, absent any showing of unexpected results.[3] *See In re Woodruff,* 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990)("The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other

[3]This statement is reinforced by appellants' disclosure that the amount of the at least one goniochromatic pigment "can easily be determined by a person skilled in the art on the basis of his general knowledge." Specification, page 5, ¶ [014].

variable within the claims. [Citations omitted]. These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical,* generally by showing that the claimed range achieves unexpected results"). We note that appellants have not proferred any evidence of unexpected results.

Appellants argue that the examiner's citation of *In re Aller*[4] is an "oversimplification" and cite *In re Geiger*[5] as "more factually relevant" (Brief, page 10). Appellants argue that, like *In re Geiger,* none of the three components are taught together, nor is there motivation here to provide for the three components (*id.*).

Appellants' arguments are not persuasive. As clearly shown and discussed above, Medelnick discloses all three components or limitations of claim 1 on appeal.

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of obviousness based on the reference evidence. Based on the totality of the record, including due consideration of

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[4]220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

[5]815 F.2d 686, 2 USPQ2d 1276 (Fed. Cir. 1987).

appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Accordingly, we affirm the examiner's rejection of claim 1, and the claims that stand or fall with claim 1, under section 103(a) over Medelnick.

B. The Rejection over Medelnick in view of Simon

The examiner adopts the findings from Medelnick as discussed above and in the Answer (Answer, page 6). The examiner recognizes that Medelnick fails to disclose a particulate phase with a pearlescent agent as required by claim 29 on appeal (*id.*). Therefore the examiner applies Simon for the teaching of makeup compositions containing a goniochromatic pigment and additional coloring agents such as pearlescent agents (*id.*). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art at the time of appellants' invention to incorporate the pearlescent agents taught by Simon into the particulate phase of Medelnick to achieve various colors and products that glitter in the light when applied to the user's skin (*id.*).

Appellants argue that Simon fails to provide any motivation to combine its teachings with Medelnick since Simon discloses pearlescent agents as having the drawback of not being intense

enough, and no function or purpose for adding them can be found in either Simon or Medelnick (Brief, page 13; Reply Brief, page 5).

These arguments are not persuasive. First, we note that Medelnick teaches the use of “other colored pigments” in addition to the goniochromatic pigment, and the above quoted term is generic to pearlescent pigments (see page 2, penultimate line; and page 3, ll. 1-2 and 6-8). Second, we determine that Simon teaches that it was well known in this art to use pearlescent pigments as coloring agents (page 2, ll. 4-5). Third, we determine that Simon does <u>not</u> teach away from the use of pearlescent pigments but merely teaches that these type of pigments allow for varied, but never intense, colors to be obtained with iridescent effects (Simon, page 2, ll. 9-11). Fourth, we determine that Simon teaches that goniochromatic pigments “confer iridescent effects somewhat like a pearlescent product” (page 2, ll. 12-14). Appellants provide the same disclosure as Simon regarding the “fairly weak color effects” with iridescent effects given by pearlescent pigments in the prior art (specification, ¶[003]). Accordingly, the use of pearlescent pigments as one type of coloring pigment used with the goniochromatic pigment composition of Medelnick would have

been obvious, whether in one particulate phase or in the two-layer structure taught by Simon, to produce or heighten the iridescent effect of the makeup composition.[6]

Appellants argue that Simon only teaches a two-layered product where the layers are not mixed or combined, one layer containing a goniochromatic pigment and the other layer containing a pearlescent pigment (Brief, page 14-15; Reply Brief, pages 6-7).

These arguments are not persuasive in view of the findings discussed above concerning the well known use of pearlescent pigments in cosmetic compositions, the teaching in Medelnick regarding the use of goniochromatic pigments along with other well known coloring pigments, and the teaching in Simon of the joint use of goniochromatic pigments and pearlescent pigments, although in two-layered structures.

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[6]The examiner's citation of U.S. Patent Nos. 6,517,820 and 6,468,550 in the "Response to Argument" section of the Answer (page 10) is not appropriate since these references were never recited in the statement of the rejection (Answer, page 6). Accordingly, these references are not considered as part of the evidence of obviousness. *See In re Hoch,* 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); *Ex parte Raske,* 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993). Therefore appellants' arguments regarding the use of these two new references are moot (Reply Brief, page 5).

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore we affirm the examiner's rejection of claim 29, and claims 34-36 which stand or fall with claim 29, under 35 U.S.C. § 103(a) over Medelnick in view of Simon.

C. Summary

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

CHUNG K. PAK Administrative Patent Judge	)	
THOMAS A. WALTZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CATHERINE TIMM Administrative Patent Judge	)	

TAW/jrg

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