

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2005-0914
Application No. 09/843,219

ON BRIEF

Before ELLIS, ADAMS, and MILLS, 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 33-52, which are all the claims pending in the application.

Claim 36¹ is illustrative of the subject matter on appeal and is reproduced below:

36. A reversible cosmetic composition comprising:
a water-based cosmetically acceptable carrier;
a photochromic composition dispersed within the carrier; and
a fixed color dye dispersed within the carrier and located exterior to the dispersed photochromic composition.

The references relied upon by the examiner are:

¹ While we refer to claim 36 as illustrative of the subject matter of appeal, we emphasize that every claim on appeal requires, *inter alia*, a fixed color dye and a photochromic composition, wherein the "fixed color dye [is] dispersed within the carrier and located exterior to the dispersed photochromic composition." See e.g., claims 33, 43, and 47.

Akashi et al. (Akashi)	5,166,345	Nov. 24, 1992
Coates et al. (Coates)	5,188,815	Feb. 23, 1993
Ohno et al. (Ohno)	5,628,934	May 13, 1997
Motion et al. (Motion)	5,656,668	Aug. 12, 1997

GROUNDINGS OF REJECTION

Claims 36, 39 and 42 stand rejected under 35 U.S.C. § 102 as anticipated by Ohno.

Claims 37 and 38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ohno.

Claims 33, 35 and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ohno in view of Motion.

Claims 34 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ohno in view of Akashi.

Claims 47-50 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ohno in view of Coates.

Claims 43, 45, 46 and 51 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ohno in view of Coates and Motion.

Claims 44 and 52 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ohno in view of Coates and Akashi.

We reverse.

DISCUSSION

THE REJECTION UNDER 35 U.S.C. § 102:

According to the examiner (Answer, page 3), “Ohno discloses an emulsified foundation comprising zinc oxide and zirconium oxide composite possessing photochromic properties, water, preservative, and iron oxide....”

According to the examiner (id., emphasis added), Ohno “teaches that the ingredients are dispersed in the mixture.” We note, however, that each claim on appeal requires that the ingredients be more than dispersed in the mixture, each claim on appeal requires that requires that the composition be structured in such a way that the fixed color dye is located exterior to, at least², the dispersed photochromic composition. Accordingly, we disagree with the examiner’s assertion (Answer, page 3) that Ohno “meets every limitation of [] claim 36.”

“Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.” Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). Since the examiner failed to meet her burden of demonstrating that Ohno teaches a composition wherein the “fixed color dye” is “located exterior to the dispersed photochromic composition,” the rejection of claims 36, 39 and 42 under 35 U.S.C. § 102 as anticipated by Ohno is reversed.

² We note that for claims 43 and 47 the fixed color dye is “located exterior to the dispersed photochromic and thermochromic compositions.”

THE REJECTIONS UNDER 35 U.S.C. § 103:

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of going forward with evidence or argument shift to the applicant.” In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

Ohno:

The examiner relies on Ohno as applied in the rejection under 35 U.S.C. § 102. In addition, the examiner finds (Answer, page 4), Ohno teaches the use of 1-60% photochromic color pigments, up to 20% photochromic titanium oxide, up to 20% ordinary titanium oxide, parabene, 2% iron oxide, ordinary pigments, UV absorbers, preservatives, water and thickeners. The examiner, however, failed to meet her burden of demonstrating that Ohno teaches a composition wherein the “fixed color dye” is “located exterior to the dispersed photochromic composition.” Accordingly, we reverse the rejection of claims 37 and 38 under 35 U.S.C. § 103 as being unpatentable over Ohno.

Ohno in view of Motion:

The examiner relies on Ohno as set forth above. According to the examiner (Answer, page 5), “Ohno fails to teach the pH of the composition.” To make up for this deficiency, the examiner relies on Motion to teach “topical compositions having pH in the range of 5.8-7.5.” The examiner, however, failed

to meet her burden of demonstrating that the combination of Ohno and Motion teach a composition wherein the “fixed color dye” is “located exterior to the dispersed photochromic composition.” Accordingly, we reverse the rejection of claims 33, 35 and 40 under 35 U.S.C. § 103 as being unpatentable over Ohno in view of Motion.

Ohno in view of Akashi:

The examiner relies on Ohno as set forth above. According to the examiner (Answer, page 5), Ohno “fails to teach [a] photochromic composition comprising a benzene derivative and a binder.” To make up for this deficiency, the examiner relies on Akashi to teach photochromic compositions comprising binders wherein the photochromic polymers have a benzyl group. The examiner, however, failed to meet her burden of demonstrating that the combination of Ohno and Akashi teach a composition wherein the “fixed color dye” is “located exterior to the dispersed photochromic composition.” Accordingly, we reverse the rejection of claims 34 and 41 35 U.S.C. § 103 as being unpatentable over Ohno in view of Akashi.

Ohno in view of Coates:

The examiner relies on Ohno as set forth above. According to the examiner (Answer, page 6), Ohno “fails to teach [a] thermochromic composition.” To make up for this deficiency, the examiner relies on Coates to teach “thermochromic cholesterol liquid crystalline phases useful in cosmetics in

general.” The examiner, however, failed to meet her burden of demonstrating that the combination of Ohno and Coates teach a composition wherein the “fixed color dye” is “located exterior to the dispersed photochromic composition.”

Accordingly, we reverse the rejection of claims 47-50 under 35 U.S.C. § 103 as being unpatentable over Ohno in view of Coates.

Ohno in view of Coates and Motion:

The examiner relies on the combination of Ohno and Coates as set forth above. According to the examiner (Answer, page 7), the combination of “Ohno and Coates fail to teach the pH of the composition.” To make up for this deficiency, the examiner relies on Motion to teach “topical compositions having pH in the range of 5.8-7.5.” The examiner, however, failed to meet her burden of demonstrating that the combination of Ohno, Coates and Motion teach a composition wherein the “fixed color dye” is “located exterior to the dispersed photochromic composition.” Accordingly, we reverse the rejection of claims 43, 45, 46 and 51 under 35 U.S.C. § 103 as being unpatentable over Ohno in view of Coates and Motion.

Ohno in view of Coates and Akashi:

The examiner relies on the combination of Ohno and Coates as set forth above. According to the examiner (Answer, page 5), Ohno and Coates³ “fail to teach [a] photochromic composition comprising a benzene derivative and a binder.” To make up for this deficiency, the examiner relies on Akashi to teach photochromic compositions comprising binders wherein the photochromic polymers have a benzyl group. The examiner, however, failed to meet her burden of demonstrating that the combination of Ohno, Coates and Akashi teach a composition wherein the “fixed color dye” is “located exterior to the dispersed photochromic composition.” Accordingly, we reverse the rejection of claims 44 and 52 under 35 U.S.C. § 103 as being unpatentable over Ohno in view of Coates and Akashi.

REVERSED

Joan Ellis)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
Donald E. Adams)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
Demetra J. Mills)
Administrative Patent Judge)

³ We note that the examiner refers to the combination of Ohno, Coates and Motion. Answer, page 7. Motion, however, is not relied upon in the statement of the rejection. Accordingly, we interpret the examiner’s reference to Motion to be a typographical error.

ZARLEY LAW FIRM P.L.C.
CAPITAL SQUARE
400 LOCUST, SUITE 200
DES MOINES IA 50309-2350