

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2005-0930
Application No. 09/965,792

ON BRIEF

Before WILLIAM F. SMITH, GARRIS, and FLEMING, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 - 9, 15 - 22, and 43 - 70. Claims 10 - 14, 23 - 42, and 71 - 76 have been withdrawn from consideration by the examiner.

Claims 1 and 9 are representative of the subject matter on appeal and read as follows:

1. A film-forming cosmetic composition comprising:

- particles of at least one polymer in an aqueous dispersion, wherein said at least one polymer has a glass transition temperature (T_g) ranging from 35°C to 80°C and a minimum film-forming temperature (MFT) such that $T_g - MFT \geq 8^\circ\text{C}$; and

- at least two organic solvents wherein:

- a first organic solvent has a molecular weight less than or equal to 200 and a boiling point, measured at ambient pressure, ranging from 100°C and 300°C, and

- a second organic solvent has a molecular weight greater than 200 and a boiling point, measured at ambient pressure, greater than or equal to 120°C.

9. A film-forming cosmetic composition comprising: a film-forming composition comprising:

- at least one polymer in an aqueous dispersion, wherein said at least one polymer has a glass transition temperature (T_g) ranging from 35°C to 80°C and a minimum film-forming temperature (MFT) such that $T_g - MFT \geq 8^\circ\text{C}$; and

- at least two organic solvents wherein:

- a first organic solvent has a molecular weight less than or equal to 200 and a boiling point, measured at ambient pressure, ranging from 100°C and 300°C, and

- a second organic solvent has a molecular weight greater than 200 and a boiling point, measured at ambient pressure, greater than or equal to 120°C.

The examiner relies upon:

Mondet et al. (Mondet)	5,965,116	Oct. 12, 1999
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A U.S. patent discussed by this merits panel is:

Leuridan et al. (Leuridan)	6,372,201 B1	Apr. 16, 2002
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Claims 1 - 9, 15 - 22, and 43 - 70 stand rejected under 35 U.S.C. § 103(a) with the examiner relying upon Mondet as evidence of obviousness. We reverse.

Discussion

As seen, claims 1 and 9 are directed to a film-forming cosmetic composition that comprises three components. The first component is either particles of at least one polymer in an aqueous dispersion (claim 1) or at least one polymer in an aqueous dispersion (claim 9) having a specified glass transition temperature (T_g) and a minimum film-forming temperature (MFT) such that $T_g - MFT \geq 8^\circ\text{C}$. The second two components are at least two organic solvents with the first organic solvent having a molecular weight less than or equal to 200 and a boiling point, measured at ambient pressure, ranging from 100°C and 300°C . and the second organic solvent having a molecular weight greater than 200 and a boiling point, measured at ambient pressure, greater than or equal to 120°C .¹

The examiner directs the reader of the Examiner's Answer to Paper No. 8 for explanation of the rejection. Examiner's Answer, page 3. Taking the examiner up on the invitation, we find from Paper No. 8 that the examiner first finds that Mondet teaches cosmetic compositions which comprise a copolymer having at least three different monomers and a glass transition temperature greater than 15°C . Paper No. 8, page 5. The examiner makes further findings regarding the monomer content and weight percentage of the Mondet copolymers. Id. The examiner however does not make an explicit finding that any of the copolymers described in Mondet satisfy the relationship $T_g - MFT \geq 8^\circ\text{C}$ as required by claims 1 and 9. Rather, the examiner states "[i]t is noted that a polymer from the prior art that has the same chemical composition as claimed in

¹ Claim 17, the remaining independent claim, is similar in scope with claims 1 and 9 and further requires that the film-forming cosmetic composition be a nail varnish.

the instant application necessarily has the same physical properties.” Id. From this statement we assume that the examiner is of the opinion that Mondet teaches or suggests polymers having the relationship required by the claims on appeal.

In regard to the first and second organic solvent required by claims 1 and 9, the examiner points out that Mondet describes the use of plasticizers in the cosmetic composition of that reference and that diethylene glycol butyl ether and dibutyl adipate are described as being useful plasticizers. Paper No. 8, page 5. Mondet does state at column 4, lines 21 - column 5, line 2, that the composition of that invention can optionally contain a plasticizer and sets forth an extensive list of compounds that may be used for that purpose. However, the examiner has not made any explicit findings in regard to whether diethylene glycol butyl ether and dibutyl adipate can be the first and second organic solvents required by claims 1 and 9.

In reviewing this aspect of the examiner’s case, we find that appellants set forth non-limiting examples of the first and second organic solvents that may be used in the present invention on pages 22 - 23 of the specification. We find dibutyl adipate is stated to be an example of the second organic solvent of the present invention at page 23 of the specification but fail to find diethylene glycol butyl ether listed as either the first or second organic solvent. Thus, the examiner’s fact finding is faulty in regard to the first organic solvent required by the claims on appeal.

However, we find that propylene glycol phenyl ether and dipropylene glycol methyl ether are stated by appellants to be examples of the first organic solvent of the

present invention at page 22 of the specification while Mondet states that these two compounds may be used as the plasticizer in that invention.

Thus, Mondet does set forth among the plasticizers useful in that invention compounds that can be used as the first and second organic solvents in claims 1 and 9 on appeal. In stating the rejection, the examiner determined that “[w]hile Mondet claims the use of at least one plasticizer [claim 18], the reference lacks specifically claiming two plasticizers” Paper No. 8, page 6.

The argument made by appellants is centered on whether Mondet fairly teaches the use of two plasticizers that meet the requirements set forth in claims 1 and 9 for the first and second organic solvents. Specifically, appellants argue that “the Office has not shown that motivation exists in Mondet to pick and choose ingredients to result in a very specific combination of (1) a first organic solvent with a molecular weight less than or equal to 200 and a boiling point, measured at ambient pressure, ranging from 100°C to 300°C, (2) a second organic solvent with a molecular weight greater than 200 and a boiling point, measured at ambient pressure, greater than or equal to 120°C, and (3) particles of at least one polymer with specific physical properties as presently claimed.” Appeal Brief, page 5.

In our view, the dispositive issue is whether Mondet fairly teaches or suggests picking from the list of plasticizers described in the reference, at least one that meets the claim requirements for the first organic solvent, and at least one that meets the claim requirements for the second organic solvent. The examiner’s position in this regard is two-fold. First, the examiner notes that Mondet “specifically claim[s] a

composition comprising at least one plasticizer (see claim 18).” Examiner’s Answer, page 6. By that statement, we take it that the examiner views the claim language “at least one plasticizer” as specifically teaching the use of two or more plasticizers in the Mondet composition. Second, the examiner relies upon In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) for the proposition that “[i]t is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose.”

After considering the respective positions of appellants and the examiner, we find that we are in agreement with appellants.

First, we do not find in the Examiner’s Answer or elsewhere in the record any fact finding by the examiner as to how many of the exemplified plasticizers in Mondet meet the requirements set forth in claims 1 and 9 for either the first organic solvent or the second organic solvent. While some of the compounds listed in Mondet are stated in this specification to be useful as either the first or second organic solvent, the examiner has not set forth how many of the listed compounds in Mondet actually meet the claim requirements. Thus, even if we were to agree with the examiner that it would have been obvious to use more than one plasticizer from those listed in Mondet, we do not know how many of the myriad combinations of two plasticizers derivable from the list would actually meet the requirements of claims 1 and 9. It may be many or it may be few. We simply do not know since the examiner has not favored the record with fact finding in this regard.

Second, the examiner's reliance upon the language in claim 18 as suggesting that the invention of Mondet includes the use of two plasticizers is misplaced. As set forth in In re Benno, 768 F.2d 1340, 1346, 226 USPQ 683, 686 (Fed. Cir. 1985), "[t]he scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses." Here, claim 18 of Mondet states that the claimed composition of that patent may comprise at least one plasticizer. That language is indicative of the scope of the claim in that compositions that meet the other requirements of that claim would infringe if they contained more than one plasticizer. However, the language of claim 18 relied upon by the examiner is not seen to be a statement that the invention of Mondet comprises at least two plasticizers. Reading Mondet as a whole as we must, we find no clear suggestion that the Mondet composition should comprise two or more of the stated plasticizers, let alone two or more of the stated plasticizers that meet the requirements set forth in claims 1 and 9 of this application in regard to the first and second organic solvents.

Third, we do not find the legal principle set forth in In re Kerkhoven to be applicable to the present facts. In Kerkhoven, the question was would it have been obvious to combine two different compositions in order to form a third composition that would be used for the very same purpose. Here, the examiner does not propose to combine two compositions in order to form a third composition. Rather, the examiner must pick and choose among a component of the composition of Mondet in order to arrive at a composition which would be within the scope of the composition set forth in claims 1 and 9 on appeal.

Other Issue

We direct appellants' and the examiner's attention to Leuridan. Leuridan issued as a United States Patent on April 16, 2002, from an application filed March 30, 2000. This application was filed in the United States on October 1, 2001. The inventive entities of Leuridan and the present application differ. Therefore, it appears that Leuridan is available as prior art under 35 U.S.C. § 102(e).

Leuridan describes a nail varnish composition that comprises an aqueous polymer dispersion, a first organic solvent, and a second organic solvent. See, e.g., column 1, lines 35 - 40; column 3, lines 9 - 65. The polymer may have the relationship $T_g - MFT \leq 20^\circ\text{C}$. Column 1, line 40.

We note that the first organic solvent of this invention is stated to be a coalescing agent. Specification, page 21. The second organic solvent of Leuridan is also stated to be a coalescing agent. Column 3, lines 42 - 44. We also note that Leuridan lists as the second organic solvent/coalescing agent compounds such as propylene glycol n-butyl ether, propylene glycol methyl ether acetate, and isopropyl lactate which are set forth on page 22 of the specification as being examples of the first organic solvent of this invention.

Furthermore, we note that the second organic solvent of this invention is stated to be a plasticizer. Specification, page 22. The first organic solvent of Leuridan is also stated to be a plasticizer. Column 3, lines 9 - 11. Leuridan describes diethyl adipate, diethyl phthalate, dibutyl phthalate, and diisobutyl adipate as examples of the first

organic solvent/plasticizer of that invention. These compounds are set forth on page 23 of the specification as being examples of the second organic solvent of this invention.

Finally, we direct attention to Example 1 of Leuridan that describes a nail varnish which comprises an aqueous polymer dispersion (JONCRYL SCX-8211), diisobutyl adipate which is one of the exemplified second organic solvents of the present invention and propylene glycol n-butyl ether and dipropylene glycol n-butyl ether which are exemplified in the present specification as being the first organic solvent.

Upon return of the application, the examiner should take a step back and review Leuridan in its entirety and determine its effect on the patentability of the claims pending in this application. The examiner should pay special attention to the nail varnish composition set forth in Example 1 of Leuridan that contains compounds which meet the requirements of the first and second organic solvents of claims 1 and 9. What is not clear from the record is whether the polymer and aqueous dispersion used in Example 1 meets the relationship $T_g - MFT \geq 8^\circ\text{C}$ required by the claims in this application. In this regard, it may be reasonable for the examiner to shift the burden to appellants to establish by objective evidence whether the specific polymer used in Example 1 of Leuridan meets this aspect of the present claims under the principles set forth in In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Apart from whether Example 1 anticipates certain of the claims set forth in this application, the examiner should consider the broader disclosure of Leuridan since Leuridan describes a nail varnish composition that comprises an aqueous dispersion of polymer particles and a first and second organic solvent with all three components bearing close relationship to the requirements set forth in the claims on appeal. It may be that the broader disclosures of Leuridan would have suggested the subject matter of the claims on appeal to one of ordinary skill in the art.

The decision of the examiner is reversed.

REVERSED

William F. Smith
Administrative Patent Judge

Bradley R. Garris
Administrative Patent Judge

Michael R. Fleming
Administrative Patent Judge

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Appeal No. 2005-0930
Application No. 09/965,792

Page 11

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