

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 KENNETH T. DODD, JOHN V. LAWLER,
and CHRISTOPHER S. COUGHLIN

Appeal No. 2005-2046
Application No. 10/101,004

ON BRIEF

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

MILLS, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and take appropriate action.

This is an appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 1-28, which are all of the claims on appeal in this application.

Representative claim 1 reads as follows:

1. A method of shaving comprising applying to an area of skin a shaving composition and shaving said area of skin, wherein the shaving composition comprises an aqueous polymer solution having a stress ratio in excess of 3.0 at a shear rate of 800 sec^{-1} .

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The prior art references cited by the examiner are:

Stoner et al. (Stoner)	5,902,574	May 11, 1999
Gold	5,342,617	Aug. 30, 1994
King	6,167,625B1	Jan. 2, 2001

References cited by the Merits Panel:

U.S. Pat. Application Publication US2003/0026775A1 ('775) published Feb. 6, 2003, filed April 30, 2001, the same date as the present application

U.S. Patent No. 6,682,726B2, issued Jan. 27, 2004 and filed April 30, 2001.

Background

The specification describes improved shaving compositions which contain a water soluble polymer or a combination of water soluble polymers, such as, for example, polyethylene oxide and natural or synthetic gums, to increase lubricity and enhance shaving performance. Specification, page 1.

“It has been found that polyethylene oxide and natural or synthetic gum, as described above, interact synergistically to substantially increase the stress ratio of a shaving composition, thereby reducing the coefficient of friction between the razor cartridge and the skin.” Specification, page 5.

Remand

Upon review of the record in the present case more relevant art has come to the attention of this Merits panel. This application is remanded to the examiner to consider whether a rejection under 35 U.S.C. §102 (f) should be made in the present application in view of Marchesi et al, U.S. Pat. Application Publication US2003/0026775A1 ('775) published Feb. 6, 2003, filed April 30, 2001, the same date as the present application,

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and the U.S. patent issuing therefrom, U.S. Patent No. 6,682,726B2 ('726), issued Jan. 27, 2004 and filed April 30, 2001. Appellants specification, page 6, states that the "aqueous shaving compositions may include about 0.05 to 3 ... by weight polyethylene oxide and about 0.1 to 5%...by weight polysaccharide gum." The compositions of Examples 1-5 of the '726 patent are within these ranges and thus inherently provide the claimed stress ratio and shear rate. Claims 6, 7 and 15 of the '726 patent appear to read on claim 1 of the present application. The '726 patent and '775 publication are to the same assignee, The Gillette Company, and lists Jenifer T. Marchesi, Yun Xu and Kenneth T. Dodd as inventors. The present application lists Kenneth T. Dodd, John v. Lawler, and Christopher S. Coughlin as inventors. Since the inventors do not appear to be the same, we recommend that the examiner consider whether a rejection of the claims under 35 U.S.C. 102 (f) is appropriate. In addition, the examiner should consider whether a double patenting rejection under 35 U.S.C. 101 is appropriate over claims 6, 7 and 15 of the '726 patent.

With regard to the pending rejection of claims 1-28 under 35 U.S.C. §103(a) over Stoner in view of Gold and King, the examiner should also consider the following upon remand of the application.

1. The examiner should carefully review the disclosure of Stoner. It would appear that Stoner exemplifies polyethylene glycol, PEG 14M (molecular weight 600,000) in Example 4, and PEG-150 distearate (molecular weight 6000) in Example 5. Appellants argue that a polyethylene glycol with a molecular weight greater than

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1,000,000 in combination with a gum provides the composition having the appropriate sheer rate and sheer stress, as claimed. The examiner should carefully consider whether Stoner supports a disclosure of an appropriate polyethylene oxide together with a natural or synthetic gum under the principles of In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 432 (CCPA 1977), to properly shift the burden to appellants to show that the compositions of Stoner do not possess the claimed stress ratio and shear rate. Put another way, is a polyethylene glycol having a molecular weight of 6000 or 600,000 the same or substantially the same as a polyethylene glycol having a molecular weight of 1,000,000 (Brief, page 2) or more to shift the burden to appellant under In re Best to show that such a composition resulting from the combination of a polyethylene glycol together with a gum, does not possess the same sheer rate and stress ratio?

2. It is recommended that the Examiner take a step back and reevaluate the shaving aid 21 disclosed in King at column 6, line 55 - column 7, line 4. It would appear that King describes his shaving aid as referring equally to "either a shave-aiding agent combined with a solid water soluble micro-encapsulating or microporous structure which retains the agent, or to that agent itself being a water soluble solid." In contrast, the appellants characterized the shaving composition used in the claimed method as an aqueous polymer solution (shave lotion, cream, foam or gel). Claim 1; Brief, page 2. The examiner should carefully consider whether either of the shaving aids described in King can be considered an aqueous solution or whether there is proper motivation to combine them with an aqueous solution, as required by the claims.

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CONCLUSION

Therefore, the application is remanded to the examiner to review the appropriateness of the pending rejection before us and to consider entering a new ground of rejection under 35 U.S.C. 101 for double patenting over claims 6 and 7 of U.S. Patent No. 6,682,726B2, issued Jan. 27, 2004 and filed April 30, 2001.

The examiner should also consider whether a rejection under 35 U.S.C. § 102 (f) over U.S. Pat. Application Publication US2003/0026775A1 ('775) published Feb. 6, 2003, filed April 30, 2001, the same date as the present application and U.S. Patent No. 6,682,726B2, issued Jan. 27, 2004 and filed April 30, 2001 is appropriate.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly,

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37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

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JOAN ELLIS)
Administrative Patent Judge)
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) BOARD OF PATENT
DEMETRA J. MILLS)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
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LORA M. GREEN)
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