The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 PATRICIA LEMANN, ANNICK COLLETTE and ISABELLE BARA

Appeal No. 2006-0391
Application No. 10/366,371

HEARD: March 7, 2006

Before ELLIS, ADAMS and GRIMES, Administrative Patent Judges.

ELLIS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the examiner's final rejection of claims 1-4, 7-37, 40-69, 76 and 77. Claims 5, 6, 38, 39 and 70-75 have been canceled.

Claims 1, 13 and 17 are representative of the subject matter on appeal and reads as follows:

1. An anhydrous composition comprising at least one silicone oil, at least one pigment, and at least one oxyalkylenated silicone substituted at the α and ω positions, wherein said anhydrous composition contains less than 1% by weight of water with respect to the total weight of the composition.

13. The composition according to Claim 1, wherein said at least one pigment is chosen from titanium, zirconium and cerium dioxides, zinc, iron and chromium oxides, ferric blue, pearlescent agents, carbon black, barium, strontium, calcium, aluminium lakes, pigments coated with silicone compounds, pigments coated with polymers, pigments coated with amino acids, and pigments coated with a mixture chosen from silicone compounds, polymers, and amino acids.

17. The composition according to Claim 13, wherein said polymers are polyethylenes.

The references relied upon by the examiner are:

Nojima	5,650,139	Jul. 22, 1997
Barone et al. (Barone)	5,034,216	Jul. 23, 1991

The claims stand rejected as follows:

I. Claims 1-4, 7-16, 18-37, 40-49, 51-69, 76 and 77 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nojima.

II. Claims 17 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nojima and Barone.

We have carefully considered the respective positions of both the appellants and the examiner and find ourselves in substantial agreement with that of the appellants. Accordingly, we reverse.

Background and Discussion

The anhydrous compositions recited in claim 1, above, are said to be useful for cosmetic, dermatological, hygienic or pharmaceutical purposes. Specification, p. 3, line 10. With respect to their use in cosmetics, the specification discloses that said compositions are “particularly stable . . . [and]

homogeneous, making possible a uniform and homogeneous make-up . . . [which] can be applied and spread easily . . . without leaving a feeling of greasiness." Id., p. 3, lines 17-19 and p. 4, lines 5-6.

According to the specification (p. 4, lines 11-17), "[t]he term 'anhydrous composition' is understood to mean a composition comprising less than 5% by weight of water with respect to the total weight of the composition, preferably from 1% to 2% of water, more preferably less than 1% of water. Most preferably still, the composition does not comprise water at all. The compositions of the invention are preferably devoid of polyvalent alcohols, that is to say of alcohols comprising at least two OH groups, such as propylene glycol, butylene glycol, glycerol or sorbitol."

I. Claims 1-4, 7-16, 18-37, 40-49, 51-69, 76 and 77

The examiner argues that Nojima discloses anhydrous cosmetic compositions which contain "from 0.1% to 50% of polyoxyalkylene modified organopolysiloxanes (including those of the instant invention), from 1 to 90% of an oil such as solid, semi-solid or liquid oil (e.g. silicone oil, waxes, hydrogenated jojoba oil, lanolin, liquid paraffin, etc), from 0.1 to 95% of pigments (e.g. talc, mica, silica, polyethylene power [sic, powder], titanium oxide, iron oxide, zinc oxide, iron oxide-coated mica, silicone-treated pigments, etc.) and other cosmetically acceptable substances." Answer, pp. 3-4. The examiner further argues that the cosmetic compositions disclosed by Nojima "are free from polyhydric alcohols." Id., p. 4. The

examiner acknowledges that "Nojima does not explicitly teach the claimed combination of at least one silicone oil, at least one pigment and at least one oxyalkylenated silicone substituted at the α and ω positions"; however, he concludes that because Nojima teaches each of the elements of the claimed invention,

> [i]t is within the skill of an ordinary practitioner to select silicone oils among other oils disclosed by Nojima and the organopolysiloxanes substituted at the α and ω positions among four other organopolysiloxanes disclosed by Nojima by routine experimentation. One having ordinary skill in the art would have been motivated to do this to obtain the desired cosmetic properties of the compositions [Answer, p. 4].

The appellants disagree, arguing that there is no suggestion to pick a oxyalkylenated silicone substituted at the α and ω positions from the four (4) types of oxyalkylenated silicones disclosed in the patent (Brief, pp. 14-16) and to combine said oxyalkylenated silicone (substituted at the α and ω positions) with at least one silicone oil (pp. 16-18) when the patent discloses twenty (20) examples of solid oils, semisolid oils and liquid oils. According to the appellants, Nojima discloses eighty (80) different oil "options from which to choose, only two of which may read on the presently claimed invention," without providing any reasons for choosing the silicone oil required by the present invention. Brief, p. 18.

It is well established that the examiner has the initial burden under § 103 to establish a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). To that end, it is the examiner's responsibility to show that some objective teaching or suggestion in

the applied prior art, or knowledge generally available [in the art] would have led one of ordinary skill in the art to combine the references to arrive at the claimed invention. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

Here, we find that the claims are directed to a subgenus of compounds, which the examiner alleges is embraced by the genus of compounds taught by Nojima. However, the fact that the claimed compound may be encompassed by the prior art genus does not, by itself, render said compound obvious. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994); In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992). According to the examiner, one must first select an oxyalkylenated silicone substituted at the α and ω positions from the polyoxyalkylene-modified organopolysiloxanes set forth in column 2 of Nojima and then select a silicone oil from the possible solid, semi-solid and liquid oils set forth in column 3 (lines 38-63), to produce one of the claimed compositions. Thus, by picking and choosing, amongst the genus of compounds disclosed by Nojima, one of ordinary skill in the art might eventually arrive at a compound within the scope of the claims. We do not agree with this reasoning. In view of the large number of variables taught by the applied prior art, we find that it is necessary for Nojima to provide some suggestion or motivation to make the claimed species or subgenus in order to render the claimed invention obvious. In re Baird, 16 F.3d at 382. No such teachings have been pointed out by the examiner. Accordingly, given the myriad of possible compounds taught by Nojima, and the lack of any suggestion to select the

oxyalkylenated silicone and silicone oil necessary to make the compounds described in the claims, we cannot sustain this rejection.

Accordingly, Rejection I is reversed.

II. Claims 17 and 50

Since the affirmance of the rejection of claims 17 and 50 is contingent upon our finding that the subject matter of claims 1-4, 7-16, 18-37, 40-49, 51-69, 76 and 77 would have been obvious to one of ordinary skill in the art in view of the teachings of Nojima, which we did not, it reasonably follows that we reverse this rejection as well.

REVERSED

Joan Ellis Administrative Patent Judge	) BOARD OF PATENT
Donald E. Adams Administrative Patent Judge	) APPEALS AND
Eric Grimes Administrative Patent Judge	) INTERFERENCES

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