

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 GHITA LANZENDORFER, ANGELIKA BORMANN,
JENS NIELSEN, BIRGIT HARGENS,
HEIDI RIEDEL, and STEPHANIE VON THADEN

Appeal No. 2006-1383
Application No. 10/025,065

ON BRIEF¹

Before ADAMS, GRIMES, and GREEN, 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 1, and 3-8, which are all the claims pending in the application.

Claims 1 and 4 are illustrative of the subject matter on appeal and are reproduced below:

1. A cosmetic or dermatological emulsion of the oil-in-water type, comprising
 - (i) up to 90% by weight of a water phase,
 - (ii) 0.5% to 20% by weight of a lipid phase, based on the total weight of the preparation,

¹ Appellants waived their request for oral hearing. Paper received June 23, 2006. Accordingly, we considered this appeal on Brief.

- (iii) up to 10% by weight of one or more emulsifiers, and
- (iv) 0.2% to 0.3% by weight of one or more ammonium acryloyldimethyltaurates/vinylpyrrolidone copolymers.

4. The emulsion as claimed in claim 1, further comprising one or more dyes, coloring pigments, or a combination thereof.

The examiner relies on the following reference:

Löffler 6,489,395 Dec. 3, 2002

GROUNDS OF REJECTION

Claims 1, 3 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Löffler.

Claims 4, 5, 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Löffler in view of appellants' "admitted prior art".

We reverse the rejection of record. In addition, we encourage the examiner to consider the Other Issue section of this opinion and to take appropriate action.

DISCUSSION

Claims 1, 3 and 6

Claims 1, 3 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Löffler.

With reference to examples 1-7 of Löffler, the examiner finds (Answer, page 3) that Löffler teaches an oil-in-water composition comprising “69.10 - 81.90% water^[2], 5 - 20% lipid phase such as Jojoba oil and mineral oil, 0.1 - 5% oligoester emulsifiers which may be up to 10%, and [0.6 - 0.7%] Aristoflex AVC. . . .” According to the examiner (id.), the only difference between Löffler and appellants’ claimed invention, is that Löffler does not teach the use of “0.2 to 0.3% of Aristoflex AVC.” Appellants do not dispute these findings. See Brief, page 4.

Appellants, however, part company with the examiner when the examiner asserts (Answer, page 3), “[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize and determine the particular amount of Aristoflex AVC in the composition, e.g. 0.2 to 0.3% of Aristoflex AVC.” In contrast, appellants assert (Brief, page 4) that Löffler

merely lists Aristoflex AVC as an ingredient in some examples, but nowhere discloses what it is, what it does, or why it is present. The description is totally silent about . . . (Aristoflex AVC). In the face of this void, there is absolutely no teaching or suggestion to reduce the amount to 0.2-0.3%. For there to be such a suggestion, there would have to at least be some disclosure of the reasons why Aristoflex was included in the first place, or of what it does. No one would be motivated to “select optimum parameters . . . to achieve a beneficial effect”, as the Examiner contends, if they do not know what beneficial effect there is to be achieved, or what parameter is to be modified.

There is some merit to both sides of this argument, for the examiner is correct in that the “discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art,” In re Boesch, 617 F.2d

² For clarity, we note that the emulsions taught by Löffler “may comprise 5 to 95% by weight . . . water.” Löffler, column 3, lines 61-63.

272, 276, 205 USPQ 215, 219 (CCPA 1980) (citations omitted). Appellants, however, are equally correct in that our reviewing court has found an exception to this general rule where “the parameter optimized was not recognized to be a result effective variable,” In re Antonie, 559 F.2d 618, 621, 195 USPQ 6, 8 (CCPA 1977).

Therefore, to resolve this issue, we must look to the function of Aristoflex AVC serves in Löffler’s composition, and whether a person of ordinary skill in the art would have recognized that Aristoflex AVC is a result effective variable from the teachings of Löffler.

I. What purpose does Aristoflex AVC serve in Löffler’s composition?

The examiner does not identify, and we find no disclosure in Löffler regarding the function of Aristoflex AVC in Löffler’s disclosed compositions. In this regard, we note that Löffler’s only specific disclosure of Aristoflex AVC is in examples 1-7. Therefore, we find ourselves in agreement with appellants (Brief, page 4), “[n]o person reading Löffler would have any idea of what the Aristoflex AVC does in his compositions. . . .”

II. Is Aristoflex AVC a results effective variable?

From the foregoing discussion it should be clear that there is no evidence on this record that the prior art relied upon by the examiner recognized that Aristoflex AVC has any particular effect on the compositions taught by Löffler, which according to Löffler (column 1, lines 23-24) are “emulsions comprising an

oligoester.” As appellants point out (Brief, page 4), “[n]o person reading Löffler would have any idea of what the Aristoflex AVC does in his compositions, and would certainly have no reason to vary his amounts.” We agree. Simply put, the examiner failed to meet her burden of presenting the evidence necessary to establish a prima facie case of obviousness.

Conclusion:

For the foregoing reasons we reverse the rejection of claims 1, 3 and 6 under 35 U.S.C. § 103 as being unpatentable over Löffler.

Claims 4, 5, 7 and 8

Claims 4, 5, 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Löffler in view of appellants’ “admitted prior art”.

Despite Löffler’s disclosure that dyes may be added to the compositions disclosed therein (see column 4, lines 19-25, and column 5, lines 8-9), the examiner finds that Löffler “does not expressly disclose the compositions therein further comprising one or more dyes coloring pigments.” Answer, page 4. Therefore, the examiner relies on appellants’ specification to make up for this alleged deficiency in Löffler. Answer, bridging paragraph, pages 4-5.

This secondary evidence, however, fails to make up for Löffler’s failure to teach a composition comprising 0.2% to 0.3% by weight of one or more ammonium acryloyldimethyltaurates/vinylpyrrolidone copolymers as is required by appellants’ claimed invention. Accordingly, we reverse the rejection of claims

4, 5, 7 and 8 under 35 U.S.C. § 103 as being unpatentable over Löffler in view of appellants' "admitted prior art".

OTHER ISSUES

As discussed above, the evidence of record on appeal was deficient because it failed to establish why a person of ordinary skill in the art would add Aristoflex AVC to a composition. Without this knowledge, one would have no reason to "optimize" its amount in the composition taught by Löffler. Accordingly, upon receipt of the administrative file we encourage the examiner to take a step back and reconsider the invention together with the available prior art to determine why a person of ordinary skill in the art at the time of appellants' invention would include Aristoflex AVC in a composition such as that described by Löffler. For illustrative purposes, we direct the examiner's attention to Weihofen³, which teaches the use of Aristoflex AVC as a thickener.

If after having an opportunity to review the administrative file together with the available prior art, the examiner is of the opinion that a rejection is necessary, the examiner should issue the appropriate rejection, clearly and articulately explaining the basis of the rejection and the evidence relied upon to support the position taken.

³ Weihofen et al. (Weihofen), "Hydrafresh with the right polymer," Clariant, pages 32-33 (February 2001)

SUMMARY

The rejections of record are reversed.

Prior to taking any further action on the merits we encourage the examiner to consider the observations made in the “OTHER ISSUES” section and take appropriate action.

REVERSED

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Donald E. Adams)
Administrative Patent Judge)
) BOARD OF PATENT
)
Eric Grimes) APPEALS AND
Administrative Patent Judge)
) INTERFERENCES
)
Lora M. Green)
Administrative Patent Judge)

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