

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 FRANK NAUMANN, ASTRID KLEEN,
HORST HOEFFKES, and BERND MEINIGKE

Appeal No. 2006-2423
Application No. 10/297,871

ON BRIEF

Before MILLS, GRIMES, and LEBOVITZ, Administrative Patent Judges.
LEBOVITZ, Administrative Patent Judge.

DECISION ON APPEAL

This appeal involves claims to compositions and methods for coloring hair. The examiner has rejected the claims as obvious over prior art. We have jurisdiction under 35 U.S.C. § 134. We reverse the prior art rejections as applied to the method claims, but vacate the rejections as they apply to the composition claims, and remand to the examiner for further consideration and to take appropriate action.

Background

The application provides methods for coloring keratin fibers in which at least one pyridoxine, pyridoxal, or pyridoxamine derivative of a formula (I) is used in combination with an oxidation dye precursor. Specification, page 1, lines 1-4; page 4, line 23; page 5, line 10. The formula (I) compounds are used as a component in hair colorants to produce a “medium blond” color. Id., page 4, lines 16-20. In addition, it was found that the “use of these compounds . . . during the coloring process leads to an improvement in the structure of keratin.” Id., page 4, lines 20-22.

Claims

Claims 24-30, 33-35, and 47 are appealed. Claims 33-35, 37-40, and 47 are directed to compositions; claims 24-30 are to methods of using the compositions to color hair. Each grouping has only one independent claim, 47 and 24 respectively. The claims read as follows:

24. In process for coloring keratin fibers, more particularly human hair, in which:

optionally, a pretreatment preparation is applied to the fibers,

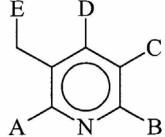
a colorant M2 is then applied to the fibers, optionally having been mixed immediately before application to the fibers from:

a component M2a containing at least one oxidation dye precursor of the primary intermediate type and/or an indole and/or indoline derivative and

a component M2b containing an oxidizing agent and/or an enzyme,

the colorant M2 being rinsed off the fibers after a contact time of from 5 to 30 minutes,

wherein said process comprises adding to at least one of the pre-treatment preparation or preparations M2a, M2b or M2 a compound of formula (I):

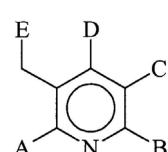


[Definitions of A-E substituents is omitted]

47. A hair coloring composition comprising:

colorant comprising an oxidation dye precursor of the primary intermediate type; and

a compound of formula (I):



[Definitions of A-E substituents is omitted]

Composition claim 47 requires two elements: 1) a colorant comprising an oxidation dye precursor; and 2) a compound of formula (I). Claim 24 is a method of using the composition in a process for coloring keratin fibers. It optionally includes applying a “pretreatment preparation” to the fibers. We will address the rejections of the method and composition claims separately.

Obviousness under 35 U.S.C. § 103

Claims 24-30, 33-35, and 47 stand rejection under 35 U.S.C. § 103(a) as unpatentable over Gast¹ in view of Lindenbaum².

¹ Gast et al. (Gast), U.S. Pat. No. 6,146,429, issued Nov. 14, 2000

² Lindenbaum, WO 96/25943, published Aug. 29, 1996

Gast describes a hair dye carrier composition that contains a hair dye, beeswax, and protein hydrolyzate. The composition can contain other conventional additives, including vitamins. Id., column 5, line 55.

Lindenbaum teaches formulations and methods for promoting hair or nail growth in animals. Lindenbaum, page 6, lines 16-19. The formulations contain effective amounts of a non-steroidal anabolic hormone in combination with a minimum essential medium. Id., page 7, lines 4-11. The minimum essential medium is a “nutrient media which supports cellular growth.” Id., page 11. It contains a number of preferred ingredients, including pyridoxine. Id. The formulations “are useful for increasing hair growth” and restoring natural hair color to the growing hair. Id., Abstract.

Method claims 24-30

The examiner rejected the claims as obvious over Gast in view of Lindenbaum. He gave the following explanation for the rejection:

Gast (US' 429) as a primary reference teaches a hair dyeing composition comprising a substantive dye of HC Red 13 (see col. 1, line 65) and the genus vitamins as conditioning substances (see col. 5, lines 53-55). Lindenbaum (WO' 943) as a secondary reference teaches a hair treating composition useful for restoring the hair color by dyeing hair follicles to produce color (see abstract) wherein the composition comprises pyridoxine as one of the preferable vitamin as claimed in claim 30 (see page 11, line 23-25). . . . Therefore, there is a clear and sufficient motivation to one having ordinary skill in the art to be motivated to incorporate the pyridoxine vitamin that taught by Lindenbaum (WO' 943) in the dyeing composition of Gast (US' 429) to arrive at the claimed invention with reasonable expectation of success for conditioning the hair, enhancing the growth of the hair and restoring the hair color as well.

Answer, pages 8-9.

Appellants argued that prima facie obviousness had not been established because Lindenbaum was not analogous art to the claimed subject matter since it taught formulations for enhancing hair or nail growth, not hair dyes. Brief, pages 5-6. They also contended that “the Lindenbaum reference teaches away from addition to a dye composition since it restores the natural color of the hair.” Id., page 8.

A prerequisite to a finding of obviousness is a determination of what constitutes “prior art” to the claimed subject matter. In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). This inquiry, “frequently couched in terms of whether the art is analogous or not,” is necessary in order to ascertain whether “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103; Clay, 966 F.2d at 658, 23 USPQ2d at 1060. “Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed.Cir.1986); In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).” Clay, 966 F.2d at 658-59, 23 USPQ2d at 1060.

We agree with Appellants that Gast and Lindenbaum are not properly combinable because they are not analogous prior art. As argued by Appellants, Gast is concerned with changing the natural color of hair by applying a hair dye. Lindenbaum, on the hand, describes a formulation for growing hair that has the “unexpected result” of

restoring the natural color to the nascent hair “in many instances where the hair color is diminished and characterized as being gray or graying.” Lindenbaum, Abstract; page 12, lines 3-7. These references occupy different fields of endeavor and have different purposes. They are therefore not properly combinable to render obvious the claimed subject matter.

The examiner asserted that the references were from the same field of endeavor because both teach hair treatment compositions. Answer, page 10. However, Lindenbaum cannot be considered to be within Appellants’ and Gast’s field merely because both relate to hair care. Lindenbaum teaches formulations for growing hair and restoring its natural color; both Gast and Appellants teach compositions for altering the natural hair color. These are clearly different fields of endeavor – hair coloring versus hair restoration.

Even when the prior art is not within the same field of endeavor, a reference may be still properly combined when pertinent to the problem an inventor seeks to solve. Clay, 966 F.2d at 658-59, 23 USPQ2d at 1060. “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” Clay, 966 F.2d at 659, 23 USPQ2d at 1061.

We do not see why a skilled worker would consider the problem of covering up natural hair color pertinent to a reference for growing hair and restoring it to its natural color. Lindenbaum’s purpose is to regrow naturally-colored hair. Appellant’s purpose is to color hair. A person of ordinary skill in the art would not reasonably have expected

to solve the problems of hair coloration by consider a reference dealing with regrowing hair. The examiner has failed to establish a case of prima facie obviousness.

Accordingly, we reverse the rejection of claims 24-30.

Composition claims 33-35, 37-40, and 47

With respect to the composition claims 33-35, 37-40, and 47, we are in different territory. Claim 47, the only independent claim in this grouping, characterizes the subject matter of the claim in its preamble as a “hair coloring composition.” In our view, this is an intended use and should not restrict its scope. Preamble language that merely states the purpose or intended use of the claimed subject matter is generally not treated as limiting the scope of the claim. Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 320 F.3d 1339, 1345, 65 USPQ2d 1961, 1964-65 (Fed. Cir. 2003); Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

From the record before us, it appears that the examiner may have required this feature to be present when performing the search for prior art. For example, our review of the STIC search report suggests that the search may have required the hair coloring utility, when the properly construed composition claims do not have this constraint.

Component 1 of claim 47 is a “colorant comprising an oxidation dye precursor.” Coupled with the claim preamble, we also find this insufficient to restrict the claim scope. The application devotes at least ten pages to the description of an extensive number of colorants, including colorants at least four different generic formulas. Specification, pages 9-18. Even though we recognize that the claim requires the

compound to be a “colorant,” without more evidence, we are disinclined to accept that all compounds in its scope would function only as colorants, and have no other activity.

The Board is required to give claims their broadest reasonable interpretation that is consistent with the specification. See e.g., In re Morris, 127 F.3d 1048, 1054-1055, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). “[D]uring patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed . . . An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in that way can uncertainties of claim construction be removed, as much as possible, during the administrative process.” In re Zletz, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). With this guiding principle, we decline to restrict the scope of claim 47 to require it to be for “hair coloring.” Since it appears that the examiner may have improperly incorporated this limitation into the composition claims, we vacate the rejection with respect to these claims, remand to the examiner for appropriate action consistent with this guidance.

Composition claims 37-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable Gast in view of Lindenbaum as applied to claims 24-30, 33-35, and 47 and further in view of Samain³. For the same reasons described above, we also vacate the rejection with respect to these claims, and remand to the examiner for appropriate action.

³ Samain et al. (Samain), U.S. Pat. No. 5,538,517, issued Jul. 23, 1996

Other issues

Claim 24 has an optional step in which a “pretreatment preparation is applied” to the keratin fibers. It is not evident from the record whether the examiner required this step to act in concert with the colorant M2, or whether it could include steps such as shampooing or conditioning hair prior to the colorant treatment. We do not find any limitation in the claim that would exclude the pretreatment preparation from being a shampoo, conditioner, gel, tonic, or other conventional hair care product. The application discloses hair tonics and other hair products that contain pyridoxine or its derivatives. Specification, page 4, lines 3-12. Upon return of the application to the technology center, we suggest the examiner consider the patentability of the method claims in view of this prior art and others like it.

We also notice that the STIC search report utilized structural searching to identify prior art. Word searching with “vitamin B6”, “pyridoxine,” or other pertinent terms may also identify relevant prior art. In this regard, Komai describes a hair color dye with pyridoxine (column 5, lines 67) and Oberthur discloses the addition of B6 analogs to temporary and permanent hair dye (column 10, lines 27-28). The relevance of these patents to the claimed subject matter should be considered, including the instant method claims.

Summary

The rejection of claims 24-30 over prior art is reversed. The rejection of claims 33-35, 37-40, and 47 is vacated and remanded for further action by the examiner.

REVERSED/REMANDED

Demetra J. Mills)
Administrative Patent Judge)
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) BOARD OF PATENT
Eric Grimes)
Administrative Patent Judge) APPEALS AND
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) INTERFERENCES
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Richard M. Lebovitz)
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