

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MASAAKIRA HORINO, MIWA OHARA,
KATSUKI OGAWA and SADAHI TAKATA

Appeal 2006-3082
Application 10/372,669
Technology Center 1600

Decided: September 7, 2007

Before TONI R. SCHEINER, DONALD E. ADAMS, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.

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DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 2-24.
We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF CASE

The claims in this appeal are directed to a composite powder comprising a “powdery base” and aluminum hydroxide. The aluminum hydroxide is adhered to the surface of the powdery base. The powder comprises “a formation of spherically shaped particles and mesh-like

formation of string shaped particles.” The powdery base “may preferably be clay mineral, barium sulfate, alumina, silica, magnesium fluoride and hydroxyapatite” (Spec. 13).

According to the Specification, “the . . . composite powders . . . are superior in a correcting effect of the troubled morphology of the skin, such as wrinkles, pore openings, . . . while also affording more spontaneous color tone and gloss, and further to cosmetics containing the same” (Spec. 1).

Claims 2-24, which are all the pending claims, are on appeal (Reply Br. 2). The claims stand rejected under 35 U.S.C. § 103 as obvious over Horino (JP 09-020609, published Jan. 21, 1997, English translation filed Dec. 9, 2003) (Answer 3). The claims stand or fall together because separate arguments for their patentability were not provided. See 37 C.F.R. § 41.37(c)(1)(vii). We select claim 2 for the purpose of deciding all issues in this appeal. Claim 2 reads as follows:

A composite powder comprising a powdery base and aluminum hydroxide adhered to at least a portion of the surface of said base, wherein said composite powder comprises a formation of spherically shaped particles and mesh-like formation of string shaped particles in said adhered aluminum hydroxide.

FINDINGS OF FACT

Horino

1. Horino teaches a cosmetic comprising “a coated powder prepared by firmly coating the surface of a clay mineral with an inorganic metallic hydroxide” (Horino, at (57) Abstract¹).

¹ All references to the Horino Japanese Patent are to its English translation which was filed on Dec. 9, 2003. Earlier in prosecution, the Japanese Patent

2. The clay minerals are disclosed to be “magnesium silicate systems . . . , a muscovite, a biotite, a lithia mica, talc (Horino, at [0017]).
3. The inorganic metal hydroxide can be “an aluminum hydroxide, a magnesium hydroxide, a calcium hydroxide, etc.” (Horino, at [0018]).
4. The coated powder has a honeycombed structure formed of ultrafine particles having an average diameter of 50 to 250 angstrom units (Horino, at Abstract (57); Answer 3).
5. Horino teaches that the cosmetic has excellent transparency and corrects skin color and blemishes on the skin (e.g., wrinkles and pores) (Horino, at [0001], [0014]-[0016]; Answer 3).

Specification

6. The powdery base of claim 2 “may preferably be clay mineral, barium sulfate, alumina, silica, magnesium fluoride and hydroxyapatite” (Spec. 13).
7. “[T]he present invention relates to composite powders which are superior in a correcting effect of the troubled morphology of the skin, such as wrinkles, pore openings, . . . while also affording more spontaneous color tone and gloss, and further to cosmetics containing the same” (Spec. 1).

was also referred to as “Masaaki” because the full name of the inventor is listed as “Horino Masaaki.” We note that Appellant provided an additional *partial* translation of the patent which was asserted to be more accurate. However, we found this partial translation to be confusing, especially in [0017] where the terminology describing the clay minerals was muddled. Thus, we do not rely on the partial translation.

Application of Horino to claims

8. Horino's description of a clay mineral (Horino, at Abstract (57) and [0017]) meets the limitation of claim 2 of a "powdery base." (Specification at 13 discloses that the powdery base can be a clay mineral).
9. The disclosure of a clay mineral *coated* with an inorganic metal hydroxide, such as aluminum hydroxide (Horino, at Abstract (57) and [0018]), satisfies the limitation recited in claim 2 of a "powdery base and aluminum hydroxide *adhered* to at least a portion of the surface of said base."
10. The difference between Horino's composition and the claimed composite powder is that claim 2 characterizes the latter as comprising "a formation of spherically shaped particles and mesh-like formation of string particles."
11. It is the Examiner's position that "the teachings of Horino suggest" that the Horino its composition would comprise "a formation of spherically shaped particles and mesh-like formation of string shaped particles" as recited in claim 2 (Answer 4).
12. The Examiner's presumption is based on the identity of components, of structure (metal hydroxide "coated" powder of Horino compared to aluminum hydroxide "adhered" powder of claim 2), and of function (correcting skin color and blemishes) between the compositions (Answer 3-4).
13. Alternatively, Horino describes the limitation of "a formation of spherically shaped particles and mesh-like formation of string particles" as recited in claim 2, where the fine particles with an average diameter of an average diameter of 50 to 250 angstrom units (Horino, at Abstract (57))

corresponds to the claimed “spherically shaped particles” and the honeycombed structure (*id.*) corresponds to the claimed “mesh-like formation of string particles.”

ANALYSIS

The rejection at issue in this appeal is under 35 U.S.C. § 103(a). The Examiner contends that the claimed subject matter would have been obvious in view of the composition described in Horino (Answer 3-4). With respect to independent claim 2, the only apparent difference between Horino’s coated powder and the claimed composite powder is that the latter is characterized in the claim as comprising “a formation of spherically shaped particles and mesh-like formation of string particles.” In our opinion, Horino’s coated composition possesses this characteristic (Findings of Fact (“FF”) 11-13). Thus, the rejection of claim 2 is more properly framed as anticipation under 35 U.S.C. § 102(b) and we address it below as such. However, dependent claim 3-24 recite additional limitations that the Examiner contends are obvious over Horino’s teachings (e.g., “[o]ne skilled in the art would expect to manipulate amounts . . . in order to achieve the most optimal composition”) (Answer 4), but these claims were not separately argued in this proceeding, and thus stand or fall with claim 2. Because anticipation is the epitome of obviousness, and the facts relied upon are the same, regardless of whether the rejection is characterized as under § 103 or § 102, we shall affirm the rejection under 35 U.S.C. § 103, but designate it as a new grounds of rejection under 37 C.F.R. § 41.50(b) in order to provide Appellants with the opportunity to respond to it. *See In re Meyer*, 599 F.2d 1026, 1029-1030, 202 USPQ 175, 178 (Fed. Cir. 1979).

“A patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention. Moreover, a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.” *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1667 (Fed. Cir. 2003) (internal citations omitted). See also *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1343 74 USPQ2d 1398, 1406 (Fed. Cir. 2005). “[A]fter the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to appellant to ‘prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.’ *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971).” *In re King*, 801 F.2d 1324, 1327 231 USPQ 136, 138 (Fed. Cir. 1986).

In this case, Horino describes each component recited in claim 2, including a powdery base and aluminum hydroxide adhered to it (FF 8-10). Based on the identity of components (FF 8, 9), of structure (metal hydroxide “coated” powder of Horino compared to aluminum hydroxide “adhered” powder of claim 2; (FF 1, 9), and function (correcting skin color and blemishes) (FF 5, 7) between the compositions (Answer 3-4), we conclude that it is reasonable to presume that Horino’s identical composition would also have “a formation of spherically shaped particles and mesh-like formation of string shaped particles in said adhered aluminum hydroxide” as recited in claim 2.

Furthermore, Horino characterizes its composition as having a honeycombed structure with fine particles, which is differently worded than claim 2, but appears to be equivalent to its limitation of “a formation of

spherically shaped particles and mesh-like formation of string particles” (FF 13).

For the foregoing reasons, we conclude that Horino teaches all elements recited in claim 2, either inherently or explicitly. Having established prima facie anticipation, it is Appellants’ burden to prove that Horino does not possess the claimed characteristic of “a formation of spherically shaped particles and mesh-like formation of string particles.”

Appellants seek to distinguish Horino’s coated powder from the claimed composite powder by evidence described in the Specification and discussed in a declaration under 37 C.F.R. § 1.132 by co-inventor Mr. Masaaki Horino (hereinafter “Horino Dec.”), who is also the same inventor of the cited Horino publication (Horino Dec. ¶¶ 1, 6). The evidence is comparison between a powder produced according to Example 1 (“Ex. 1”) of the Specification (Spec. 41-42) which is stated to be within the scope of claim 2 and a powder prepared according to the process described in Horino (Comparative Example 1 (“Comp. Ex. 1”) at Spec. 42-43) (Br. 10-11).

Appellants contend that a side-by-side comparison of SEM photomicrographs of the prior art powder and their own reveals that the powders have different structures (comparing photomicrographs (Figs. 1 and 2) of the powder of Ex. 1 to photomicrographs (Figs. A1-A3 of the Horino Declaration) of the powder of Comp. Ex. 1) (Horino Dec. ¶ 6). They also contend that the powder of Ex. 1 is superior to the powder of Comp. Ex. 1 as evaluated by frictional coefficient (Reply Br. 2) and other properties including extension, smoothness, transparency, gloss, natural color, and skin dimness (Reply Br. 7; Horino Dec. ¶ 6).

We do not find this evidence persuasive. Foremost, the evidence is based on only one comparison between a single embodiment (Ex. 1) of claim 2 – titanium mica coated with aluminum hydroxide (Spec. 42) – with just one example from Horino of muscovite coated with aluminum hydroxide. Claim 2, however, is not limited to the particular materials nor the specific process utilized in Ex. 1 of the Specification on which the comparison is based. Rather claim 2 is broader, covering “aluminum hydroxide adhered to at least a portion of the surface of said [powdery] base” produced by any process. Appellants have not attempted to show that other examples described in Horino – for example, comprising talc, magnesium silicate, or a mica as the powdery base (FF 2) – do not anticipate the broadly claimed composite powder of claim 2.² Thus, although Appellants contend that their evidence establishes a difference between the claimed invention and Horino, at most, if the evidence establishes what Appellants purport it does, it would only be sufficient to prove that Ex. 1 differs from Comp. Ex. 1 of Horino.

A claim is unpatentable if any scope of it is anticipated. (“When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.

Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 782, 227 USPQ

² Appellants assert that the “present invention” is “markedly superior” in six of nine categories assessed (Reply Br. 2). Only one embodiment of the claim is asserted to be different from Horino, but the claim scope is broader. Appellants have not provided rebuttal evidence to establish that Horino’s other examples do not anticipate claim 2.

773, 778 (Fed. Cir. 1985). See also *In re Petering*, 301 F.2d 676, 682, 133 USPQ 275, 280 (CCPA 1962) (a compound described in a reference, and a generic claim including that compound, are unpatentable under 35 U.S.C. §102(b)); *In re Slayter*, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960) (a generic claim can not be allowed if the prior art describes a species within the claimed genus).” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001)). Appellants have not provided sufficient evidence to rebut the case of prima facie anticipation because there are other examples disclosed in Horino which fall within the scope of claim 2³ and which we have reasonably presumed anticipate it.

In regard to the evidence presented by Appellants, we note certain flaws in it which preclude us from determining whether any scope of claim 2 has been distinguished over Horino.

Evidence in the Specification is provided that Horino’s coated powder had a dynamic frictional coefficient of 3.35×10^{-1} , “while that of the inventive product is 2.94×10^{-1} ” (Spec. 43). The Examiner objected: “looking at the dynamic frictional coefficient values closely, there is no significant differen[ce] between the claimed product and that of Horino, because the values are very close and do not appear to indicate patentable differences. The specification does not indicate statistical evaluation of the results to determine whether differences between the values are at least statistically significant” (Answer 5).

³ There is also no attempt to show that the results obtained for the Ex. 1 composite powder are representative of the results for other embodiments within its scope. Unexpected results must be “commensurate in scope with the degree of protection sought by the claimed subject matter.” *In re Harris*, 409 F.3d 1339, 1344, 74 USPQ2d 1951, 1955 (Fed. Cir. 2005).

In our opinion, the Examiner's objection is reasonable because the Specification does not reveal what the normal variations are when frictional coefficient measurements are made on the same material. Appellants acknowledge that the reported variation is "small," but argue "[w]hile not supported with a statistical analysis, such results show a statistically significant difference" (Reply Br. 2). This response does not address the Examiner's concern with the data. Appellants do not explain the basis for their assertion that the differences are "statistically significant," when they admit no statistical analysis was performed (Reply Br. 2).

SEM photomicrographs are provided by Appellants which purport to show that the structure of powder of Comp. Ex. 1 (Figs. A1-A3) is different from the structure of the powder of Ex. 1 (Figs. 1-2) (Horino Dec. ¶ 6). Appellants have not stated that the procedure for processing the powders for SEM analysis were the same for Ex. 1 and Comp. Ex. 1; consequently, it is not clear on the record that the photomicrograph reflect a side-by-side comparison.

In addition, Appellants refer (Horino Dec. ¶ 6) to differences that appear in the figures ("spherically shaped particles" versus "sharp projections, lumps, bumps, and dips"), but do not point to these structures in the photomicrographs. Figs. A1-A3, as reproduced in the copy provided to us, are of such poor quality that the so-called "lumps" and "bumps" can not be clearly distinguished. Nonetheless, even had Appellants explicitly pointed to the features of the two powders, the comparison would still be deficient for the reasons already discussed.

For the foregoing reasons, we affirm the rejection of claim 2 as obvious over Horino. Claims 3-24 fall with claim 2 because separate reasons for their patentability were not provided.

TIME PERIOD

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides “[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek

Appeal 2006-3082
Application 10/372,669

review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED; § 41.50(b)

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