

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 DIETER REINEHR,
GEORGES METZGER, PETER MICHAELIS
And HELMUT LUTHER

Appeal 2007-0107
Application 10/013,885
Technology Center 1700

Decided: June 22, 2007

Before CHUNG K. PAK, PETER F. KRATZ, and CATHERINE Q. TIMM,
Administrative Patent Judges.

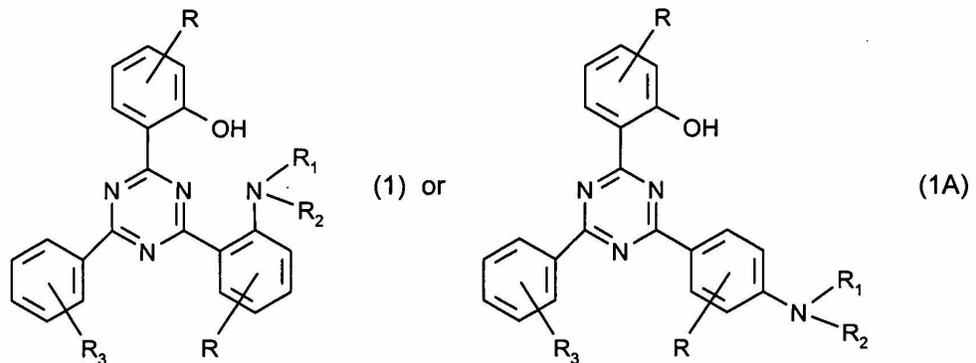
KRATZ, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's refusal to allow claims 1, 5-7, 17, and 28-31, the only claims that remain pending in this application. The claims of this application were twice rejected. We have jurisdiction pursuant to 35 U.S.C. § 6.

Appellants' invention is directed to a cosmetic preparation comprising at least one compound of a formula 1 or a formula 1A as specified in appealed claim 1, or a process for stabilizing a cosmetic preparation against light, oxygen and/or heat damage which process includes the step of adding a stabilizer comprising a compound according to claim 1. Claim 1 is illustrative and reproduced below:

1. A cosmetic preparation comprising at least one compound having the formula:



in which

R and R₁ are hydrogen;

R₂ is -C(=O)-R₄ in which R₄ is C₁-C₂₀alkyl, or C₂-C₂₀alkyl interrupted by 1 to 6 oxygen atoms; and

R₃ is hydrogen or C₁-C₂₀alkoxy,

and a cosmetically acceptable auxiliary.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Hardy	US 3,118,887	Jan. 21, 1964
Duennenberger (I)	US 3,259,627	Jul. 5, 1966
Duennenberger (II)	US 3,270,016	Aug. 30, 1966
Schellenbaum	US 3,278,534	Oct. 11, 1966
Biland	US 3,293,249	Dec. 20, 1966
Grossmann	US 3,957,780	May 18, 1976
Susi	US 4,619,956	Oct. 28, 1986

Claims 1, 5-10, 17, and 28-31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hardy or Susi, each in view of Duennenberger I, Duennenberger II, Schellenbaum, Biland, or Grossman.¹

Appellants argue the claims as a group with an emphasis in the argument added for claim 28 (Br. 12). Thus, we select claim 1 as the representative claim on which we shall decide this appeal as to the rejected

¹ Claims 29-31 were inadvertently omitted from the Examiner's statement of this rejection as set forth in the Office action mailed December 09, 2005. Compare the rejected claims identified in the Office Action Summary with the rejected claims identified in the grounds of rejection set forth on page 2 of the December 09, 2005 Office Action. Also, this Office Action inconsistently identifies itself as a non-final action and a final action. See item 2(b) of the Office Action Summary and page 3 of the December 09, 2005 Office Action. However, the claims are twice rejected, a subsequently filed amendment was entered by the Examiner and the record reflects that Appellants have voiced no complaint via petition. Indeed, Appellants list claims 29-31 as being among the rejected claims which are the subject of this appeal (Brief 10) and the Examiner lists claims 29-31 as being among the rejected claims in the Answer. *See Answer 3*. Thus, these inconsistencies are sufficiently resolved to proceed with deciding this appeal as to the rejected claim, including claims 29-31. No prejudicial error is apparent. A separate obviousness rejection over Hardy and a separate obviousness rejection over Susi, which rejections are addressed in the Brief, are no longer maintained by the Examiner (Answer 2 and 3).

claims, with the exception of claim 28. We shall consider claim 28 separately to the extent the latter claim has been separately argued in the Brief.

We acknowledge Appellants' reference to the "Board's Decision on 3/25/05" (Br. 2). A copy of the prior Board decision is furnished in the Related Proceedings Appendix to the Brief. In that Decision, the panel affirmed, *inter alia*, an obviousness rejection of the then appealed claims based on the same prior art evidence that is before us here in this appeal. Appellants state that the claims have been narrowed subsequent to the last appeal, after filing a Request for Continued Examination (RCE). (Br. 2-3). However, we find no persuasive reason presented in Appellants' Brief that warrants a different outcome here because of the alleged narrower appealed claims before us in this appeal or for any other reason proffered in the Brief. Accordingly, we affirm the Examiner's decision to reject the claims for the reasons set forth in the Answer. We add the following for emphasis.

The Examiner has found that each of Hardy and Susi discloses substituted 2-OH phenyl diaryl s-triazine compounds of a formula, which embraces substituted triazine compounds required as part of Appellants' representative claim 1 preparation (Answer 3 and 4). Both Hardy and Susi disclose that such compounds are useful as UV absorption or protection agents, particularly with respect to polymers (Hardy; col. 1, l. 11- col. 2, l. 9; Susi; col. 4, ll. 10-37 and col. 11, ll. 25-32). The Examiner turns to Grossmann, Biland and Duennenberg I and II to evidence that substituted aryl triazine compounds that are useful in plastics as UV absorbers are also useful as a UV absorber in a wide variety of organic-containing

compositions or formulations, such as cosmetic preparations. According to the Examiner,

Although the primary references do not discuss the use of their U.V. absorbers in cosmetic media, the secondary references each relate that typically 2-OH phenyl substituted s-triazines finding applications as U.V. absorbers in polymeric compositions are generally useful for the same purpose for cosmetic media as well. Thus it would have been obvious to one having ordinary skill in the art; at [t]he time the invention was made, to incorporate applicants' U.V. absorbers in cosmetic formulations. See also, Decision on Appeal on Appeal No. 2005-0451, pp. 10-12.

(Answer 4).

Appellants make substantially the same arguments with respect to the Examiner's reliance on Hardy or Susi with an exception at page 8 of the Brief. *See* Brief in its entirety. Appellants maintain that representative claim 1 requires a composition including a triazine compound of a formulation that differs from the preferred and exemplified formulations of Hardy or Susi. Moreover, Appellants contend that a suggestion or motivation is lacking for the Examiner's proposed combination of references.

Thus, the main issues before us in this appeal are: Have Appellants identified a lack of motivation or rationale for the Examiner's proposed modifications of Hardy or Susi or otherwise established reversible error in the Examiner's rejection? We answer these questions in the negative and affirm the Examiner's obviousness rejection.

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level

of ordinary skill in the art; and (4) any secondary consideration (e.g., the problem solved). *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). “[A]nalysis [of whether the subject matter of a claim is obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see also *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006)(“The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.”). The analysis supporting obviousness, however, should be made explicit and should “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements” in the manner claimed. *KSR*, 127 S. Ct. at 1732, 82 USPQ2d at 1389.

Hardy and Susi disclose a number of triazine compounds are useful in protecting polymeric materials from deterioration due to exposure to ultraviolet light. Merely because Hardy and Susi disclose a variety of effective triazine compounds does not render any particular formulation less obvious. *Merck & Co. v. Biocraft Labs, Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989). From our perspective, one of ordinary skill in the art would have arrived at a compound embraced by compounds employed in representative appealed claim 1 by simply

following the teachings of Hardy or Susi in selecting a compound that is effective in protecting against the effects of ultraviolet light. Furthermore, the determination of obviousness is bolstered by the fact that the claimed compound is used for substantially the same purpose (UV protection) as taught by Hardy and Susi.

In this regard, Hardy, for example, teaches that X, Y and Z could be phenyl radicals with X being substituted with an hydroxyl group ortho to the point of attachment to the triazine nucleus and that constituents (R-R8) could be, *inter alia*, hydrogen or an acylamino group (col. 1, l. 56 – col. 2, l. 9). Moreover, the disclosed examples and particularly preferred embodiments of Hardy or Susi (for example, Formula II of Hardy) do not constitute a teaching away from a broader disclosure of less preferred embodiments. *See In re Susi*, 440 F.2d 442, 446, 169 USPQ 423, 426 (CCPA 1971). After all, it cannot be overemphasized that a reference must be considered in its entirety and that the disclosure of a reference is not limited to specific working examples contained therein. *See In re Fracalossi*, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976).

Thus, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to determine, through nothing more than routine experimentation, the workable structures of the triazine compound of the general formulas of Hardy or Susi in order to protect against the effects of ultraviolet light and in so doing arrive at UV protective compounds encompassed by the compound formulas used in the preparation or composition of representative claim 1.

Appellants focus on the exemplified compounds, such as Example 13, and the Formula II compounds of Hardy is misplaced in that both Hardy and Susi also teach or suggest other compounds that are UV protective, as evidenced by Formula I of Hardy or Susi. The fact that Hardy and Susi disclose a variety of effective triazine compounds, some of which are not embraced by Appellants' narrowed claims, does not negate the teaching of other particular formulations, as disclosed in these references. One of ordinary skill in the art would have arrived at a compound included within the compounds employed in representative appealed claim 1 by following the teachings of Hardy or Susi in selecting a compound that is effective in protecting against the effects of ultraviolet light.

Appellants also argue that the triazines of the secondary references are structurally different from Hardy or Susi. Hardy or Susi are directed to using their UV absorbers in polymers. Thus, Appellants assert that there is no motivation to combine the secondary references with Hardy or Susi in forming a cosmetic preparation as maintained by the Examiner as the secondary references indicate preferences for different triazines than those of Hardy or Susi (Br. 10-12). However, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Here, the secondary references evince that triazines are known, in general, to be useful as UV absorbers for a variety of uses, including

polymer protection as well as for cosmetic preparations. For example, Duennenberger I teaches a variety of hydroxyaryl triazines as being useful for UV protection of a variety of organic materials, including textiles, resins, polymers, and cosmetic preparations, including sunburn oils and creams (col. 4, l. 46- col. 6, l. 31).

Duennenberger II is directed to hydroxyaryl triazines that are described as being useful as UV stabilizers for: organic materials including, *inter alia*: textile materials such as natural materials or synthetic polymer materials; lacquers and films such as polyamides and polypropylene, polyesters, etc.; natural or synthetic resins; rubbers; and cosmetic preparations (col. 5, l. 18- col. 6, l. 73). Biland teaches hydroxyphenyl triazines that are said to be useful as UV protectors for organic materials such as natural and synthetic polymer textiles, lacquers and films including polymeric films, natural or synthetic resins, rubbers, and cosmetic preparations (col. 14, l. 15 – col. 15, l. 71). Schellenbaum and Grossmann disclose hydroxyphenyl triazines that are useful as a UV protector for organic materials (Schellenbaum; col. 9, l. 8 – col. 10, l. 69; Grossmann; col. 1, ll. 33-37).

Hence, the combined teachings of the applied references collectively would have suggested that hydroxyphenyl triazines, such as disclosed by Hardy and Susi, would have been reasonably expected by one of ordinary skill in the art to be useful for UV protection of organic materials such as found in cosmetic formulations in addition to the protection of plastic or polymer materials, as was focused on and specifically described in Hardy and Susi. In this regard, Appellants' contentions to the effect that Hardy or Susi is too broad in the description of the disclosed genus of compounds and

too narrow in their described use of the triazines in combination with polymers to be suggestive of the claimed combination are untenable. This line of argument ignores the full teachings and inferences that can be drawn from the combined teachings of Hardy or Susi taken with the applied secondary references and the level of skill in the art represented by the collective teachings of the applied references.

Indeed, Appellants' line of argument is undercut by their own Specification disclosure which embraces a large genus of triphenyl triazines and describes a multitude of uses for the disclosed broad genus of compounds (Specification 1, third para.; 3, last full para.; 8, last para. and 43, second full para.). Appellants' assertions that the Examiner's proposed combination of references would have been militated against by asserted structural distinctions between the triazines of Hardy or Susi and the triazines of the secondary references has not been substantiated with persuasive evidence showing that one of ordinary skill in the art would have found a cosmetic utility for the UV absorbers of Hardy or Susi unpredictable. In this regard, merely pointing out differences in the triazine compounds of the secondary references and those of Hardy or Susi does not explain why those structural differences would have dissuaded one of ordinary skill in the art to employ the UV absorbing triazine of Hardy or Susi in a cosmetic formulation.

As for the additional argument with respect to claim 28, it would have been reasonably predictable that one of ordinary skill in the art would have found that the disclosed UV protective triazine of Hardy or Susi would have been useful in a sunscreen product in light of the teachings of the secondary references, as discussed above. In particular, we note that Biland, for

example, teaches that triazine compounds can be used as an ultraviolet absorber/protector for cosmetic media including sunburn oils and creams (col. 15, ll. 53-55). One of ordinary skill in the art would have been led to employ the triazine compound of Hardy or Susi in a cosmetic as taught, for example, in Biland, motivated by the reasonable expectation of preventing sunburns, especially given the UV absorbing properties of the triazine compounds of Hardy or Susi. Moreover, claim 28 does not specify any particular sunscreen product compositional requirements beyond those already recited in representative claim 1. Accordingly, Appellants' additional arguments with respect to claim 28 are not persuasive of reversible error in the Examiner's obviousness assessment.

As a final point, we note that Appellants do not rely on any evidence tending to establish unexpected results for the claimed subject matter in the Brief.

Having reconsidered the evidence of record for and against a conclusion of obviousness in light of the respective arguments advanced by Appellants and the Examiner, it is our determination that, on balance, the evidence weighs most heavily in favor of an obviousness conclusion with respect to the rejections under consideration encompassed by representative claim 1.

CONCLUSION

The decision of the Examiner to reject claims 1, 5-10, 17, and 28-31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hardy or Susi, each in view of Duennenberger I, Duennenberger II, Schellenbaum, Biland, or Grossman is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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