

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is not binding precedent of the Board.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 ROBERT LEE WELLS and KENDRICK JON HUGHES

Appeal 2007-0284
Application 10/454,564
Technology Center 1700

DECIDED: May 30, 2007

Before DEMETRA J. MILLS, ERIC GRIMES, and NANCY J. LINCK,
Administrative Patent Judges.

LINCK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal the Examiner's 35 U.S.C. § 102(b) rejection of claims 12 and 14-20, all pending claims in the above-identified application, based on U.S. 6,194,363 B1 ("Murray"). We have jurisdiction to decide this appeal under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

The field of Appellants' invention is conditioning shampoo compositions (Specification 1). The claimed subject matter is reflected in representative claim 12, reproduced below:¹

12. A conditioning shampoo composition comprising:
- a) a deterotive surfactant;
 - b) an aminosilicone having less than 0.5% nitrogen by weight of the aminosilicone;
 - c) a non-amino-functionalized silicone having a viscosity of at least 10,000 cs and
 - d) an aqueous carrier,
wherein the aminosilicone and non-amino functionalized silicone are in the form of emulsion drops containing a blend of the aminosilicone and non-amino-functionalized silicone.

ISSUE ON APPEAL

Appellants contend:

There is no teaching or suggestion in Murray to blend the pre-formed emulsion of amino-functionalized silicone with the separate pre-formed emulsion of non-amino-functionalized silicone before they are added to the shampoo composition. As a result, the shampoo compositions of Murray only contain emulsion drops of amino-functionalized silicone and separate emulsion drops of non-amino-functionalized silicone. . . . Thus, the compositions of Murray are structurally different from the claimed conditioning shampoo.

(Br. 5.)

¹ The claims are not separately argued. Thus we determine the patentability of the remaining claims based on our review of claim 12.

The Examiner responds:

[T]he mixing of the ingredients in Examples 1-2 would inherently result in a shampoo that contains emulsified drops that contain a blend of both aminosilicone and non-amino functionalized silicone, since mixing the emulsified aminosilicone with the emulsified non-amino functionalized silicone would necessarily result in a blend of the two emulsions, as required in the instant claims.

(Answer 4.)

Based on these conflicting positions, the single issue before us is, does Murray's mixing of pre-emulsified amino silicone and pre-emulsified non-aminosilicone in his aqueous shampoo inherently result in "emulsion drops containing a blend of the aminosilicone and non-amino-functionalized silicone," as required by claim 12?

FINDINGS OF FACT

1. Giving claim 12 its broadest reasonable interpretation, it requires at least some emulsion droplets containing both aminosilicone and non-amino-functionalized silicone particles. (See claim 12.)
2. Appellants do not dispute that Murray discloses all the elements of claim 12, except that required by the clause "wherein the aminosilicone and non-amino functionalized silicone are in the form of emulsion drops containing a blend of the aminosilicone and non-amino-functionalized silicone." (*See Br. passim.*)
3. Murray generally discloses that the "use of silicones as conditioning agents in cosmetic formulations is well known" and "dispersed

droplets of the silicone oil are suspended in the composition . . .” (Murray, col. 1, ll. 10-13.)

4. Murray further discloses “incorporating the silicone as a preformed aqueous emulsion” to avoid using an “in situ hot process[]” and thereby to make processing “easier.” (*Id.*, col. 1, ll. 39-48.)

5. According to Murray, a “typical method for incorporating insoluble, non-volatile silicone materials into a conditioning shampoo” is one “in which such materials are incorporated in the shampoo composition as a pre-formed aqueous emulsion . . .” (*Id.*, col. 1, ll. 49-54.)

6. More specifically, Murray discloses preparing a shampoo by “mixing” with water and other ingredients, a pre-emulsified non-amino functionalized silicone and a pre-emulsified amino functionalized silicone. (Murray, col. 9, l. 24 to col. 10, l. 19 (Examples 1 & 2).)

7. Appellants’ and Murray’s emulsions are “stable mixture[s] of two or more immiscible liquids”, i.e., silicones and water, “held in suspension by small percentages of emulsifiers.” Hawley’s Condensed Chemical Dictionary 460 (11th ed. 1987).

8. Appellants’ and Murray’s predominantly aqueous shampoos are “emulsions . . . comprised of a continuous [hydrophilic] phase”, i.e., water, “and a [hydrophobic] disperse phase”, i.e., the various silicones. *Id.*

9. In the absence of any teaching or suggestion to the contrary and based on the general laws of physics regarding the combination of hydrophobic and hydrophilic substances, Murray’s mixing the two pre-formed silicone emulsions in his aqueous-based shampoo in Examples 1 and 2 would result in at least some droplets containing amino functionalized

particles blending with some droplets containing non-amino functionalized particles in the hydrophobic (or oil) phase. (*See Answer 4.*)

PRINCIPLES OF LAW

With respect to claim interpretation:

[D]uring examination proceedings, “claims are given their broadest reasonable interpretation consistent with the specification. . . . [This] proposition ‘serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified,’ *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984), and it is not unfair to applicants, because ‘before a patent is granted the claims are readily amended as part of the examination process,’ *Burlington Indus., Inc. v. Quigg*, 822 F.2d 1581, 1583, 3 USPQ2d 1436, 1438 (Fed. Cir. 1987).”

In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

“Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.” *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997).

However, a limitation can be satisfied through inherency:

Where, as here, the claimed and prior art products are identical or substantially identical . . . , the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. . . . Whether the rejection is based on “inherency” under 35 U.S.C. § 102, on “prima facie obviousness” under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.

In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977) (footnote omitted). *See also In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) (“when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not”).

DISCUSSION

Appellants do not dispute that Murray discloses every limitation of claim 12, except the clause “wherein the aminosilicone and non-amino functionalized silicone are in the form of emulsion drops containing a blend of the aminosilicone and non-amino-functionalized silicone.” (*See Br. passim.*) Based on the laws of physics, in the absence of any evidence to the contrary, we find this disputed limitation is met: Murray’s mixing of pre-emulsified amino silicone and pre-emulsified non-aminosilicone in his aqueous shampoo inherently results in at least some “emulsion drops containing a blend of the aminosilicone and non-amino-functionalized silicone,” as required by claim 12. (*See Answer 4.*)

We disagree with Appellants’ unsupported argument that Murray’s shampoo compositions “only contain emulsion drops of amino-functionalized silicone and separate emulsion drops of non-amino-functionalized silicone” and thus are “structurally different from the claimed conditioning shampoo.” (Br. 5.) The Examiner has at least made a prima facie case to the contrary. Appellants have not provided any evidence to rebut the Examiner’s prima facie case. Thus, we affirm the Examiner’s § 102(b) rejection of claim 12.

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Since Appellants did not separately argue the patentability of claims 14-20, we also affirm their rejection pursuant to 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSIONS

We affirm the § 102(b) rejection of claims 12 and 14-20, all the pending claims, based on Murray.

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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