

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 JOACHIM BUNGER, JUITA ZURLAGE,
and ALEXANDRA AXT

Appeal 2007-2308
Application 10/182,122
Technology Center 1600

Decided: July 12, 2007

Before TONI R. SCHEINER, DONALD E. ADAMS, and
LORA M. GREEN, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1, 2, 4-7, 9-16, 20-23, 25, and 27-29. Claims 3, 8, 18, 19, 24, and 26, the only remaining pending claims, have been withdrawn from consideration (Br. 2). We have jurisdiction under 35 U.S.C. § 6(b).

INTRODUCTION

Claim 1 is illustrative:

1. In a cosmetic or dermatological formulation comprising auxiliaries and/or excipients and one or more active ingredients selected from phylloquinone, and 2-hydroxy-5-methylaurophenone oxime, the improvement wherein said formulation further comprises

(a) one or more antioxidants

and/or

(b) one or more UV filters.

The Examiner relies on the following prior art references to show unpatentability:

Burger	5,665,367	Sep. 9, 1997
Bell	6,007,797	Dec. 28, 1999

The rejection as presented by the Examiner is as follows:

1. Claims 1, 2, 4-7, 9-16, 20-23, 25, and 27-29 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of Burger and Bell.

We reverse.

DISCUSSION

Claim 1 is drawn to a cosmetic or dermatological formulation that comprises three components: (1) auxiliaries and/or excipients, (2) phylloquinone (vitamin K1) and/or 2-hydroxy-5-methylaurophenone oxime, and (3) one or more an antioxidants and/or UV filters. The Examiner finds that Burger teaches a skin care composition that comprises an antioxidant (a

flavonoid¹, e.g., quercetin²) and sunscreens (a UV filter, e.g. octyl methoxycinnate³) in a cosmetically acceptable vehicle (excipient) (Answer 3). The Examiner finds that Burger's composition may be formulated as a lotion, cream, or gel (Answer 4)⁴. We note, however, that Burger's composition comprises two essential ingredients (1) retinol (vitamin A), a retinyl ester or mixtures thereof and (2) naringenin or quercetin (Burger, col. 2, ll. 57-59 and col. 3, ll. 24-25). We find that Burger expressly teaches a formulation comprising retinol (vitamin A), quercetin, octyl methoxycinnate, perfume, color⁵, and water⁶ (Burger, col. 12, ll. 38-55). The Examiner recognizes, however, that Burger does not teach a composition comprising phylloquinone (vitamine K1) (Answer 4). We also note that Burger does not teach a composition comprising 2-hydroxy-5-methyllaurophenone oxime. The Examiner relies on Bell to make up for this deficiency in Burger.

In this regard, the Examiner finds that Bell teaches the use of vitamin K1 as a counterirritant in sunscreen cosmetic compositions (Answer 4). More specifically, Bell teaches sunscreen compositions that may contain

¹ Appellants' Specification discloses that flavonoids are antioxidants (Specification 5).

² Appellants' Specification discloses that the quercetin is a preferred flavonoid (Specification 11).

³ Appellants' Specification discloses octyl methoxycinnamate as a suitable UV filter for the claimed formulation (Specification 11-12).

⁴ According to Appellants' Specification, the formulation of the present invention may be a gel, cream, or lotion (Specification 14-15).

⁵ According to Appellants' Specification, colorants and odor improvers (e.g. perfumes) are preferred auxiliaries (Specification 15).

⁶ According to Appellants' Specification, water is a customary excipient (Specification 15).

counterirritants such as, *inter alia*, Vitamin A and Vitamin K1 (Bell, col. 10, ll. 1-6).

Based on this evidence the Examiner finds that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Burger's composition to include phylloquinone (vitamin K1) (Answer 4). According to the Examiner, “[o]ne having ordinary skill in the art would have been motivated to do this to obtain sunscreen compositions which do not irritate the skin as suggested by Bell et al.” (Answer 4). We disagree.

As Appellants point out, Burger teaches a composition comprising retinol (vitamin A), retinyl ester and mixtures thereof (Br. 5). Therefore, Appellants argue that Burger's compositions already contain an ingredient that is comparable to the counterirritant taught by Bell - specifically, vitamin A (Br. 5). Contrary to the Examiner's assertion, Appellants argue that a person of ordinary skill in the art would not have been motivated to add a second counterirritant, e.g. vitamin K1, to Burger's composition which already contains the counterirritant vitamin A (Br. 5-6). We agree. Further, since retinol (vitamin A), retinyl ester and mixtures thereof are essential to Burger's composition, we find that one of ordinary skill in the art would not have been motivated to substitute vitamin K1 for vitamin A.

Despite the Examiner's unsupported assertion that person of ordinary skill in the art would have found it obvious to add an additional counterirritant to Burger's composition, we find nothing in the combination of references relied upon to suggest the use of more than one counterirritant. Instead, we find that one reading Burger and Bell in combination would recognize that Burger's composition already includes the counterirritant

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vitamin A and therefore would not have been motivated to add a second counterirritant to Burger's composition. As set forth in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007),

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

Here the rationale relied upon by the Examiner to combine Burger and Bell is not supported by the evidence of record. Accordingly, we reverse the rejection of claims 1, 2, 4-7, 9-16, 20-23, 25, and 27-29 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of Burger and Bell.

CONCLUSION

In summary, we reverse the rejection under 35 U.S.C. § 103.

REVERSED

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