

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CARLOS PINZON and PAUL THAU

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Appeal 2008-1464  
Application 09/733,898  
Technology Center 1700

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Decided: May 29, 2008

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Before TONI R. SCHEINER, RICHARD M. LEBOVITZ, and  
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 336-368. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

It has been known since the mid 1960's to use high molecular weight polyamides to produce clear stick compositions for personal care products,

such as make-up, lipsticks, and sunscreens (Spec. 1). However, these polyamide compositions were unstable and during storage “the stick surface developed distinct oil droplets” (Spec. 1; App. Br. 6). The Specification describes compositions that comprise specific structuring polymers and oil-soluble esters comprising at least one free hydroxy group that are stated to result in a stable composition and “provide good gelling efficiency” (Spec. 2). The claims at issue in this appeal are directed to these compositions.

Claims 336-368 are pending and appealed. The following rejections are on review in this appeal:

1) Claims 336, 337, 340-352, 354-363, and 365-368 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Ross ‘209 (U.S. Pat. No. 5,000,209, Mar. 19, 1996) (Ans. 5);

2) Claims 336, 349, 354, and 363-368 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Pavlin (U.S. Pat. No. 5,783,657, Jul. 21, 1998) (Ans. 7, 8);

3) Claims 336-368 under 35 U.S.C. § 103(a) as obvious over Ross ‘209 in view of Pavlin, Deshpande (U.S. Pat. No. 5,034,219, Jul. 23, 1991), Giezendanner (U.S. Pat. No. 5,073,364, Dec. 17, 1991), or Delplancke (U.S. Pat. No. 6,506,716 B1, Jan. 14, 2003) (Ans. 6);

4) Claims 336, 339, 349, 354, 367, and 368 under 35 U.S.C. § 103(a) as obvious over Pavlin in view of Barone (U.S. Pat. No. 5,837,223, Nov. 17, 1998) (Ans. 8);

5) Claims 336-338, 352-354, and 366-368 under 35 U.S.C. § 103(a) as obvious over Pavlin and Elsnau (U.S. Pat. No. 4,049,792, Sept. 20, 1997) or Ross ‘925 (U.S. Pat. No. 5,603,925, Feb. 18, 1997) in view of Deshpande or Giezendanner (Ans. 9);

6) Claims 336-345, 349-362, and 366-368 under 35 U.S.C. § 103(a) as obvious over Pavlin and Elsnau or Ross '925 in view of Deshpande, Giezendanner, and Aul (U.S. Pat. No. 5,538,718, Jul. 23, 1996) (Ans. 10);

7) Claims 336-338, 346-348, 352-354, 367, and 368 under 35 U.S.C. § 103(a) as obvious over Pavlin and Elsnau or Ross '925 in view of Deshpande and Giezendanner, and further in view of Trinh (U.S. Pat. No. 5,540,853, Jul. 30, 1996), Melbouci (U.S. Pat. No. 6,197,100 B1, Mar. 6, 2001), or Palinczar (U.S. Pat. No. 4,699,799, Oct. 13, 1987) (Ans. 11);

8) Claim 357 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement (Ans. 4); and

9) Claim 357 under 35 U.S.C. § 112, second paragraph, as indefinite (Ans. 4).

Claim 336, 339, 352, 357, and 363 are representative and read as follows:

336. A composition comprising at least one liquid fatty phase, the liquid fatty phase comprising:

(i) at least one structuring polymer, wherein the at least one structuring polymer is at least one polyamide polymer comprising a polymer skeleton that comprises:

(1) at least one amide repeating unit;

(2) at least one terminal fatty chain chosen from the group consisting of alkyl chains and alkenyl chains, wherein the at least one terminal fatty chain is bonded to the polymer skeleton via at least one ester group; and

(3) optionally at least one pendant fatty chain chosen from alkyl chains and alkenyl chains, wherein the at least one pendant fatty chain is bonded to the polymer skeleton via at least one linking group; and

(ii) at least one oil-soluble ester comprising at least one free hydroxy group, with the proviso that the at least one oil-soluble ester is not castor oil; wherein the at least one oil-soluble ester is present in the composition in an effective amount to increase at least one of stability and gelling efficiency.

339. The composition of claim 336, wherein the at least one oil-soluble ester comprising at least one free hydroxy group is chosen from propylene glycol ricinoleate, isopropyl hydroxystearate, triisocetyl citrate, diisostearyl malate, octyl hydroxystearate, triisoarachidyl citrate, cetyl lactate, dioctyl malate, octyldodecyl hydroxystearate, di-isostearyl malate, and di-isostearyl lactate.

352. The composition of claim 336, further comprising at least one preserving agent.

357. The composition of claim [336, wherein the at least one fatty acid phase further comprises a polar oil] chosen from hydrocarbon-based plant oils with a high content of triglycerides comprising fatty acid esters of glycerol in which the fatty acids comprise chains having from 4 to 24 carbon atoms, said chains optionally being chosen from linear and branched, and saturated and unsaturated chains; synthetic oils or esters of formula  $R_5COOR_6$  in which  $R_5$  is chosen from linear and branched fatty acid residues comprising from 1 to 40 carbon atoms,  $R_6$  is chosen from a hydrocarbon-based chain comprising from 1 to 40 carbon atoms, and the number of carbon atoms in  $R_5$  plus the number of carbon in  $R_6$  is greater than or equal to 10; synthetic ethers containing from 10 to 40 carbon atoms;  $C_8$  to  $C_{26}$  fatty alcohols; and  $C_8$  to  $C_{26}$  fatty acids.

363. The composition of claim 336, further comprising at least one oil-soluble cationic surfactant.

### Claim 336

Claim 336 is the only independent claim on review. We find:<sup>1</sup>

1. Claim 336 is directed to a composition comprising at least one liquid fatty phase.
2. The liquid fatty phase comprises: (i) a “structuring polymer”; and (ii) at least one oil soluble ester with at least one free hydroxy group which is

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<sup>1</sup> Findings of Fact (“FF”).

present “in an effective amount to increase at least one of stability and gelling efficiency.”

3. The (ii) oil soluble ester is not castor oil.
4. The (i) structuring polymer is a polyamide polymer comprising: (1) at least one amide repeating unit; and (2) one terminal fatty acid chain bonded to the polymer skeleton by at least one ester group.

### DISCUSSION

1. Claims 336, 337, 340-352, 354-363, and 365-368 stand rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Ross ‘209 (Ans. 5).

### Findings of Fact

The following findings of fact are pertinent to the Examiner’s conclusion that the claims are anticipated, or in the alternative, obvious over Ross ‘209.

5. Ross ‘209 describes a gel or stick composition as an antiperspirant (Ross ‘209, Abstract).
6. Examples VII through IX of Ross ‘209 are directed to antiperspirant sticks comprising alkyl lactate and Uni-Rez 2931 (Ross ‘209, at col. 21, ll. 10-25; Ans. 5).
7. Alkyl lactate is (ii) an oil soluble ester with a free hydroxy group as required by the composition of claim 336 (FF 2; Ans. 5).
8. Uni-Rez 2931 is (i) a polyamide polymer (“structuring polymer”) (Ross ‘209, at col. 14, ll. 46-52), but it lacks a terminal fatty chain bonded to its polymer skeleton as in the structuring polymer of claim 336 (FF 4; Ans. 5).

9. However, Ross '209 teaches that various modifications can be made to the polyamide polymer:

In addition, various monofunctional reactants (including monofunctional alcohols, amines, acids, amino acids and hydroxy acids) can be used to modify the properties of the polyamide resins, such as solubility or tendency to gel.

(Ross '209, at col. 7, ll. 39-43; Ans. 5-6).

10. The Examiner finds that when Uni-Rez 2931 is modified with a monofunctional acid, as taught by Ross '209 (FF 9), “the fastest or easiest reaction would be with the terminal group, not with the group in the backbone (pendant group) since Ross et al do not teach any particular reaction condition or catalyst system” (Ans. 12).

11. Based on this teaching, the Examiner concludes that Ross '209 discloses or suggests a structuring polymer with the chemical structure required by element (i) of claim 336.

#### Analysis

The issue in this rejection is whether Ross '209's teaching to modify its polyamide polymer with a “monofunctional acid” would result in a structuring polymer having a terminal fatty acid bonded to its skeleton by an ester group as required by claim 336 (FF 4).

We agree with Appellants that the Examiner has not met the burden of providing adequate evidence that claimed structure is taught by Ross '209.

As argued by Appellants (Reply Br. 5-6), the Examiner does not provide evidence to support the conclusion that the “fastest or easiest reaction” (FF 10; Ans. 12) between a “monofunctional acid” and the Uni-Rez 2931 polyamide polymer would result in a structuring polymer that meets the limitations of claim 336. The Examiner acknowledges that Ross

‘209 does not “teach any particular reaction condition or catalyst system” (Ans. 12), but provides no evidence that conventional reaction conditions known to persons of ordinary skill in the art would have routinely and necessarily<sup>2</sup> produced the claimed structure. Accordingly, we reverse the rejection of independent claim 336, and dependent claims 337, 340-352, 354-363, and 365-368.

2. Claims 336, 349, 354, and 363-368<sup>3</sup> stand rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Pavlin (Ans. 7, 8).

#### Findings of Fact

12. Pavlin describes personal care products comprising ester-terminated polyamides (such as EPTA) blended with liquid hydrocarbons to form a composition having a gel consistency (Pavlin, Abstract).

13. The personal care products include deodorants, eye make-up, and lipstick (Pavlin, at col. 3, ll. 31-35).

14. Example 18 of Pavlin is directed to a gel comprising ETPA, an ester terminated polyamide polymer, and a castor oil (Pavlin, at col. 24, ll. 5-12; Ans. 7).

15. When the two components are combined, “a clear, hard gel was formed” (Pavlin, at col. 24, ll. 12).

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<sup>2</sup> “Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981); *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 630 Fed. Cir. 1987).

<sup>3</sup> Claims 363-365 are only rejected as obvious over Pavlin’s teaching (Ans. 8).

16. Pavlin teaches that the ester-terminated polyamides are preferably combined with low-polarity liquid hydrocarbons (Pavlin, at col. 15, ll. 12-16), such as esters (Pavlin, at col. 15, ll. 59-60).

17. Pavlin describes the amounts of the liquid hydrocarbon to combine with the polyamide polymer to prepare a gel (Pavlin, at col. 17, ll. 7-23; cols. 18-19, Examples 1 and 3), which persons of skill in the art would have recognized as the amounts necessary to produce a composition with a hard gel consistency.

18.

Suitable esters are those commonly employed in the cosmetics industry for the formulation of lipstick and make-up, e.g., the fatty acid esters mentioned above, and are often denoted as “cosmetic esters”. Other cosmetic esters include glycerol and propylene glycol esters of fatty acids, including the so-called polyglycerol fatty acid esters and triglycerides. Exemplary cosmetic esters include, without limitation, propylene glycol monolaurate, polyethylene glycol (400) monolaurate, *castor oil*, triglyceryl diisostearate and lauryl lactate. Thus, the liquid may have more than one of ester, hydroxyl and ether functionality. For example, C<sub>10-15</sub> alkyl lactate may be used in a *gel* of the invention.

(Pavlin, at col. 16, ll. 12-23) (Emphasis added).

19. Castor oil, the liquid hydrocarbon combined with the ester-terminated polyamide in Example 18 (FF 14), is characterized as an exemplary “cosmetic” ester, along with the several other esters including lauryl lactate and C<sub>10-15</sub> alkyl lactates (FF 18).

20. Persons of ordinary skill in the art would have understood castor oil to be equivalent to lauryl lactate and other C<sub>10-15</sub> alkyl lactates because of their appearance in the same list (FF 18) and Pavlin’s characterization of them as

“exemplary” and the teaching that, when combined with polyamides, they form gels (FF 15, 17; Ans. 7).

21. Pavlin’s teaching of an ester-terminated polyamide polymer, such as EPTA (FF 12, 14) meets the limitation of claim 336 of (i) a structuring polymer comprising (1) an amide and (2) terminal fatty acid chain (FF 2, 4).

22. Pavlin discloses that the polyamide polymer is combined with castor oil (FF 14); castor oil is (ii) an oil soluble ester as required by claim 336, but is excluded from the claim (FF 3).

23. However, Pavlin teaches the equivalency of castor oil to other oil soluble esters, such as alkyl lactates (FF 18-20; Ans. 7); thus, persons of ordinary skill in the art would have envisaged compositions comprising (i) an ester-terminated polyamide polymer and (ii) lauryl lactate or other C<sub>10-15</sub> alkyl lactates, meeting the limitations of claim 336 of components (i) and (ii) as required by claim 336 (Ans. 7).

24. In the alternative, persons of ordinary skill in the art would have had reason to combine Pavlin’s ester-terminate polyamide polymers with lauryl lactate or other C<sub>10-15</sub> alkyl lactates, which are taught as equivalent to castor oil, in order to produce a “hard gel” for a personal care product (FF 12, 15).

### Analysis

#### Anticipation

Anticipation requires a showing that each element of the claim is identifiable in a single reference arranged as in the claim. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005). In this case, we agree with the Examiner’s findings that Pavlin describes a composition that comprises each component of the claimed invention (FF 21-23). Thus, we turn to Appellants’ rebuttal arguments and evidence.

Appellants argue that “Example 18 of the [Pavlin] patent lacks any recognition of at least one oil-soluble ester present in an effective amount to increase at least one of stability and gelling efficiency” (App. Br. 21).

This argument is not persuasive. Anticipation does not require recognition that a prior art process achieve a result which is claimed. “Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art.” *MEHL/Biophile International Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999).

The more pertinent question is therefore whether the amount of oil-soluble ester described in Pavlin is “an effective amount to increase at least stability and gelling efficiency” of the composition as required by claim 336.

The PTO has the initial burden of providing evidence that the product described by the prior art is the same product which is claimed. *In re Marosi*, 710 F.2d 799, 802 (Fed. Cir. 1983). Once a prima facie case has been established, the burden shifts to Appellants “to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.” *In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). In this case, the Examiner had reason to believe that the amounts described in Pavlin meet the claim limitation because Pavlin characterizes its compositions as having a “gel consistency” and forming a “hard gel” (FF 12, 15). Thus, we find adequate evidence to have shifted the burden to Appellants to prove that the amounts of oil-soluble ester do not meet the claimed limitation.

Appellants acknowledge that Pavlin’s example “may teach gelling” but assert that Pavlin does not “teach or suggest that the castor oil may

increase at least one of stability and gelling efficiency” and “is entirely silent on the amount of castor oil added in Example 18” (App. Br. 21-22).

We do not agree. In Example 18, Pavlin states that the ester-terminated polyamide (EPTA) is “at 20% solids” (at col. 24, ll. 11-12) – indicating that 80% is castor oil. Example 18 also refers back to Example 3 (which refers back to Example 1) for its preparation, which discloses that the composition comprises 80% of the liquid hydrocarbon (Pavlin, at col. 18, ll. 25-27). Thus, Pavlin is not “entirely silent” on the amount of castor oil combined with the polymer.

Nonetheless, even were there no explicit disclosure on how much oil-soluble ester is present in Example 18, Pavlin describes how much polyamide to include in its compositions to prepare gels (FF 17). Appellants have not provided any evidence that these amounts do not satisfy the claim limitation.

Appellants also argue that “Example 18 teaches the inclusion of castor oil, whereas independent claim 336 specifically excludes castor oil as the at least one oil-soluble ester comprising at least one free hydroxy group” (App. Br. 21). However, the Examiner finds that Pavlin teaches castor oil as a cosmetic ester equivalent to several oil-soluble esters which satisfy the limitations of claim 336, such as lauryl lactate and other C<sub>10-15</sub> alkyl lactates (FF 20). Because of their equivalency, persons of ordinary skill in the art would have envisaged compositions comprising an ester-terminated polyamide polymer and lauryl lactate or other C<sub>10-15</sub> alkyl lactates, meeting the limitations of claim 336 of components (i) and (ii) as required by claim 336 (FF 23).

For the foregoing reasons, we affirm the rejection of claim 336 as anticipated by Pavlin. Claims 349, 354, and 366-368 fall with claim 336 because separate reasons for their patentability were not provided. 37 C.F.R. § 41.37(c)(vii)(1).

#### Obviousness

##### *Claims 336*

Appellants contend that “in order to arrive at the claimed invention, the skilled artisan would need to choose a single class of optional ingredients - oil-soluble esters comprising at least one free hydroxy group- from the optional low polarity liquids listed. Then the skilled artisan would have to include that ingredient in a composition in an amount effective to increase at least one of stability and gelling efficiency” (App. Br. 22). Appellants assert that there is “simply no teaching in the [Pavlin] patent that suggests the *desirability* of making the exact combination or modification proposed by the Examiner, at least not with any reasonable expectation of success, nor has the Examiner pointed to such evidence” (App. Br. 23).

We are not persuaded by this argument that the Examiner erred. Example 18 discloses an oil-soluble ester, castor oil, in combination with an ester-terminated polyamide polymer as in claim 336. Although castor oil is expressly excluded from the scope of the claim, persons of ordinary skill in the art would have recognized it as equivalent to other oil-soluble esters within the claim scope because of their appearance in the same list and the teaching that, when combined with polyamides, they form gels (FF 15, 17, 20; Ans. 7). For these reasons, we agree with the Examiner that any of these combinations would have been recognized as equivalent and therefore obvious to persons of ordinary skill in the art (FF 24).

Appellants also state that “the esters and cosmetic esters discussed in” Pavlin “are mentioned only as ‘suitable low polarity esters’ that may be ‘less irritating to the skin than liquids containing aromatic, ketone, and other functional groups.’ Col. 15, lines 57-59; see col. 15, lines 17-19. Thus, in order to arrive at the claimed invention, the skilled artisan would need to choose a single class of optional ingredients - oil-soluble esters comprising at least one free hydroxy group-from the optional low polarity liquids listed” (App. Br. 22). This argument is not persuasive. Esters, including those which are claimed, are expressly described as suitable “for the formulation of lipstick and make-up” (FF 18), which would have led persons of ordinary skill in the art to have combined them with Pavlin’s ester-terminated polyamide polymers to make a personal care product.

*Claims 363-365*

Claim 363 depends on claim 336 and further requires “at least one oil-soluble cationic surfactant.” The Examiner finds that Pavlin teaches adding surfactants to its compositions and that the use of “oil-soluble surfactant would be obvious since the composition of Pavlin et al is oil-based” (Ans. 8)

Appellants rely on the same arguments as for claim 336. Consequently, we affirm the rejection of claim 363 for same reasons as set forth above. Claims 364 and 365 fall with claims 363 because separate reasons for their patentability were not provided. 37 C.F.R. § 41.37(c)(vii)(1).

3. Claims 336-368 stand rejected under 35 U.S.C. § 103(a) as obvious over Ross ‘209 in view of Pavlin, Deshpande, Giezendanner, or Delplancke (Ans. 6).

The Examiner relies on Ross ‘209 and Pavlin for the same teachings as discussed above, and cites the additional references (Deshpande, Giezendanner, or Delplancke) to meet limitations in the dependent claims (Ans. 6-7).

Appellants contend that neither Ross ‘209 nor Pavlin teach a composition comprising the components recited in claim 336 (App. Br. 24), and the additional references “do not remedy these deficiencies” (App. Br. 25).

We affirm the rejection for the reasons discussed above. While we agree that Ross ‘209 does not describe or suggest a composition with the limitations recited in claim 336, we have found that Pavlin does (*see supra*). Since Appellants do not provide any further arguments to distinguish the claimed subject matter from the prior art, the rejection of claim 336 is affirmed; claims 337-368 fall with claim 336 because separate reasons for their patentability were not provided. 37 C.F.R. § 41.37(c)(vii)(1).

4. Claims 336, 339, 349, 354, 367, and 368 stand rejected under 35 U.S.C. § 103(a) as obvious over Pavlin in view of Barone (Ans. 8).

#### Findings of Fact

25. Claim 339 depends on claim 336 and further recites that the oil-soluble ester is one of a list of specifically recited esters, including “dioctyl malate.”

26. Barone describes cosmetic compositions, such as lipstick (Barone, at col. 1, ll. 49-50; Ans. 8).

27. Barone states that various oils may be included in its composition, including oils which comprise esters, and lists over 25 different examples; among the choices is dioctyl malate (Barone, at col. 4, ll. 43-62). Barone states that esters disclosed in “Cosmetic Ingredient Handbook”, which is incorporated by reference, can also be utilized in its compositions (Barone, col. 4, ll. 64-67).

28. Based on Barone’s teaching, persons of ordinary skill in the art would have recognized “dioctyl malate” as an oil-soluble ester of the same class of cosmetic esters described in Pavlin at column 16, lines 12-23 (FF 18, 19) and thus would have considered them equivalent for the purpose of producing a gel as described in Pavlin.

29. Since Pavlin states that cosmetic esters can be utilized “without limitation” to produce a gel in combination with an ester-terminated polyamide (FF 18), persons of ordinary skill in the art would have had a reasonable expectation of success that combining dioctyl malate, a conventional cosmetic ester, with an ester-terminated polyamide polymer (EPTA) would have resulted in a gel as taught by Pavlin.

30. Given that both Pavlin and Barone provide long lists of cosmetic esters from which to choose, we find that the selection of a particular ester and the amounts to combine with the polyamide polymer would have been within the level of ordinary skill in the art and the type of choice the skilled worker ordinarily makes.

#### Analysis

Appellants contend that the “Examiner . . . has not established . . . any suggestion or motivation to combine the teachings as proposed nor that

there is a reasonable expectation of success in making the proposed modification” (App. Br. 25).

This argument is not persuasive. Precise teachings directed to the specific subject matter of a claim are not required to reach a conclusion of obviousness. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). “[T]he teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kahn*, 441 F.3d 977, 987-988 (Fed. Cir. 2006). Here, we find that the equivalency of oil-soluble esters (FF 18-20, 28) would have suggested combining an ester-terminated polyamide polymer with any cosmetic ester (FF 28-30). *See Abbott Labs. v. Andrx Pharmaceuticals*, 452 F.3d 1331, 1340-42 (Fed. Cir. 2006) where evidence of interchangeability was considered a substantial argument that a person of ordinary skill in the art would be motivated to combine the prior art references. Given that both Pavlin and Barone provide long lists of cosmetic esters from which to choose, we find that the selection of a particular ester and the amounts to combine with the polyamide polymer would have been with the level of ordinary skill in the art and the type of choice the skilled worker ordinarily makes (FF 30).

Appellants assert that persons of skill in the art would not have had “a reasonable expectation of success that the combination of an ester-terminated polyamide polymer and dioctyl malate may result in an increase in stability and/or gelling efficiency” (App. Br. 29). We do not agree.

Pavlin states that cosmetic esters can be utilized “without limitation” to produce a gel in combination with an ester-terminated polyamide (FF 18). Based on this teaching, persons of ordinary skill in the art would have had a reasonable expectation of success that combining dioctyl malate, a conventional cosmetic ester, with an ester-terminated polyamide polymer would have resulted in a gel as taught by Pavlin (FF 29).

Appellants distinguish the prior art by asserting that Pavlin is not directed towards lipsticks (as is Barone), but merely discloses it as one of a laundry list (App. Br. 26-27). This argument is not persuasive. Barone is in the same field of invention as Pavlin: cosmetics. Both teach that oil-soluble esters are conventional components (FF 18, 27, 28); from Barone’s and Pavlin’s disclosures, persons of ordinary skill in the art would have recognized the equivalency of the oil-soluble esters. Appellants have not provided any arguments or evidence to the contrary. The fact that Barone’s disclosure may involve lipstick is not relevant since it is being relied upon for its broader teachings of cosmetic esters and their interchangeability (*see supra*).

Appellants state that Barone describes an anhydrous cosmetic composition with at least three specifically recited components, and that it would require “substantial picking and choosing from among various [additional] optional ingredients . . . to arrive at” the claimed composition (App. Br. 27). Appellants also state that Barone does not disclose polyamide resins (*id.* at 28).

This argument does not convince us that the Examiner erred. The rejection does not require persons of ordinary skill in the art to pick from optional ingredients. Once again, as discussed above, Barone is not cited for

its description of a particular cosmetic composition, but rather for its teaching of conventional oil-soluble esters that persons of ordinary skill in the art would have considered suitable to combine with Pavlin's ester-terminated polyamides.

We affirm the rejection of claim 336. Claims 339, 349, 354, 367, and 368 fall with claim 336 because separate arguments were not made for their patentability. 37 C.F.R. § 41.37(c)(vii)(1).

5. Claims 336-338, 352-354, and 366-368 stand rejected under 35 U.S.C. § 103(a) as obvious over Pavlin and Elsnau or Ross '925 in view of Deshpande or Giezendanner (Ans. 9).

The Examiner cites Elsnau, Deshpande, and Giezendanner for teaching antibacterial agents (Ans. 9) which, when included in a cosmetic composition, would meet the limitation of claim 352 of "at least one preserving agent." The Examiner notes that Pavlin refers to the Elsnau patent and incorporates it by reference for its teaching of additives to cosmetic personal care products (Ans. 9; Pavlin, at col. 17, ll. 29-33) and thus finds that any additive in Elsnau would have been considered to be part of Pavlin (Ans. 9).

We have considered Appellants' arguments (App. Br. 29-30), but do not find them persuasive. Pavlin clearly states that its gel can be combined with "ingredients" which are "conventionally incorporated into personal care products" (Pavlin, at col. 17, ll. 24-33). Since antibacterial agents (i.e., "one preserving agent") are a conventional additive – as evidenced by Elsnau and others – persons of ordinary skill in the art would have had reason to incorporate them into Pavlin's gel for their known and expected properties.

Appellants contend that Elsnau “provides no teaching or suggestion that would override the express teachings of” Pavlin “against the inclusion of compounds with hydroxy groups” (App. Br. 29). We do not agree. Pavlin describes oil-soluble esters with a free hydroxy group suitable for its compositions (FF 18) – and thus are expressly stated to be useful by Pavlin when combined with its polyamide polymer.

We affirm the rejection of claim 352. Claims 337, 338, 353, 354, and 366-368 fall with claim 352 because separate reasons for their patentability were not provided. 37 C.F.R. § 41.37(c)(vii)(1).

6. Claims 336-345, 349-362, and 366-368 stand rejected under 35 U.S.C. § 103(a) as obvious over Pavlin and Elsnau or Ross ‘925 in view of Deshpande, Giezendanner, and Aul (Ans. 10).

The Examiner’s rationale for the rejection is set forth on pages 10-11 of the Answer. Appellants argue that none of the cited references “remedy the . . . deficiencies of” Pavlin (App. Br. 30). We have already addressed this argument and found it unpersuasive.

The Examiner has set forth a logical reason for combining the prior art (Ans. 10-11). As we find no flaw in the Examiner’s reasoning, we affirm the rejection of claims 336-345, 349-362, and 366-368.

7. Claims 336-338, 346-348, 352-354, 367, and 368 stand rejected under 35 U.S.C. § 103(a) as obvious over Pavlin and Elsnau or Ross in view of Deshpande and Giezendanner, and further in view of Trinh, Melbouci, or Palinczar (Ans. 11).

The Examiner's rationale for the rejection is set forth on page 11 of the Answer. Appellants' argue that none of the cited references "go no further in . . . remedying any of the . . . deficiencies of" Pavlin (App. Br. 31).

The Examiner has set forth a logical reason for combining the prior art (Ans. 10-11). As we find no flaw in the Examiner's reasoning, we affirm the rejection of 336-338, 346-348, 352-354, 367, and 368.

**8.** Claim 357 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement (Ans. 4).

Claim 357 is directed to a composition of claim 336 in which the liquid fatty phase further comprises a synthetic oil or ester of formula  $R_5COOR_6$ , where  $R_5$  can be "branched fatty acid residues comprising from 1 to 40 carbon atoms." The Examiner states that a "fatty acid is known to have at least four carbon atoms" and that Specification fails to "show a fatty acid residue having 1 carbon atom" (Ans. 4).

Appellants contend that "[u]nder the Examiner's logic, however, the residue of a fatty acid can contain no fewer carbon atoms than the smallest fatty acid" (App. Br. 14).

Appellants have the better argument. The term "residue" means "remainder of something after removal of a part."<sup>4</sup> Thus, we agree with Appellants "that reactions involving fatty acids may certainly produce fatty acid residues" with less than four carbon atoms remaining when a part (a carbon) of the fatty acid has been removed (App. Br. 15). We reverse the rejection of claim 357 under 35 U.S.C. § 112, first paragraph.

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<sup>4</sup> The American Heritage Dictionary of the English Language, 1106 (1976).

9. Claim 357 stands rejected under 35 U.S.C. § 112, second paragraph, as indefinite (Ans. 4).

The Examiner contends that phrase “fatty acid residue” (*see supra*) is indefinite “since a fatty acid is known to have at least four carbon atoms” and cannot comprise “1 carbon atom” as permitted by claim 357 (i.e., where R<sub>5</sub> can be “branched fatty acid residues comprising from 1 to 40 carbon atoms”).

We reverse this rejection for the same reasons we reversed the rejection under 35 U.S.C. § 112, second paragraph.

#### CONCLUSION

We affirm the prior art rejections of claims 336-368 over Pavlin and others, but reverse the prior art rejection over Ross ‘209 alone, and the rejection of claim 357 under § 112, first and second paragraph.

#### TIME PERIOD

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

dm

Appeal 2008-1464  
Application 09/733,898

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