

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte

ODILE SONNEVILLE-AUBRUN and JEAN-THIERRY SIMONNET

Appeal 2008-1763¹
Application 09/860,466
Technology Center 1600

Decided: June 3, 2008

Before DONALD E. ADAMS, LORA M. GREEN, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-22 and 30-36, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Appellants waived their request for Oral Hearing (Paper received April 10, 2008).

INTRODUCTION

The claims are directed to an oil-in-water nanoemulsion (claims 1-19, 21, 22, and 30-36) and a cosmetic or dermatological composition (claim 20).

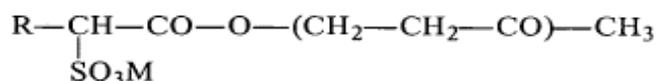
Claims 1, 15, 18, and 34 are illustrative:

1. An oil-in-water nanoemulsion, comprising oily phase globules dispersed in an aqueous phase, wherein said oily phase globules have an average size of less than 100 nm, and wherein said nanoemulsion further comprises:

(1) at least one amphiphilic lipid selected from the group consisting of nonionic amphiphilic lipids, anionic amphiphilic lipids, and mixtures thereof, wherein said anionic amphiphilic lipid or lipids are selected from the group consisting of (a) mixed esters of fatty acids and of fatty alcohols, of carboxylic acids and of glycerol; (b) alkyl ether citrates; (c) alkenyl succinates; (d) fatty esters of phosphoric acid; and (e) mixtures thereof; and

(2) a nanoemulsion thickening effective amount of at least one non-crosslinked anionic polymer comprising at least one hydrophobic chain, and wherein the weight ratio of the amount of oily phase to the amount of amphiphilic lipid ranges from 1.2 to 10.

15. A nanoemulsion according to Claim 1, further comprising at least one additional anionic amphiphilic lipid selected from the group consisting of alkaline salts of dicetyl and dimyristyl phosphate; alkaline salts of cholesterol sulphate; alkaline salts of cholesterol phosphate; lipoamino acids and their salts; sodium salts of phosphatidic acid; phospholipids; and alkylsulphonic derivatives of formula:



in which R represents C₁₆-C₂₂ alkyl radical and M is an alkali metal or an alkaline earth metal.

18. A nanoemulsion according to Claim 1, which has a turbidity ranging from 60 to 600 NTU.

34. A nanoemulsion according to Claim 1, which has a turbidity ranging from 70 to 300 NTU.

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

Tobe et al. (translation PTO 05-4882) ²	JP SHO 58[1983]-27636	Feb. 18, 1983
Peffly et al.	US 5,972,356	Oct. 26, 1999
Restle et al.	US 6,039,936	Mar. 21, 2000
Halloran	US 6,153,569	Nov. 28, 2000

The rejections as presented by the Examiner are as follows:

1. Claims 1-14 and 17-22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle and Peffly.
2. Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Tobe.
3. Claims 30-36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Halloran.

We affirm the rejection of claims 1-14, 17, and 19-22 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle and Peffly.

We affirm the rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Tobe.

We affirm the rejection of claims 30-36 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Halloran.

We reverse the rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle and Peffly.

We enter a new ground of rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Halloran.

² The Examiner refers to this document as the “Shiseido abstract” (Ans. 3).

DISCUSSION

Claim Interpretation:

Claim 1:

Claim 1 is drawn to an oil-in-water nanoemulsion. The nanoemulsion comprises:

- A. oily phase globules having an average size of less than 100 nm dispersed in an aqueous phase;
- B. at least one amphiphilic lipid; and
- C. a nanoemulsion thickening effective amount of at least one non-crosslinked anionic polymer that comprises at least one hydrophobic chain.

Claim 1 requires that the amphiphilic lipid is selected from the group consisting of nonionic amphiphilic lipids, anionic amphiphilic lipids, and mixtures thereof.

Claim 1 requires that the anionic amphiphilic lipid or lipids are selected from the group consisting of (a) mixed esters of fatty acids and of fatty alcohols, of carboxylic acids and of glycerol; (b) alkyl ether citrates; (c) alkenyl succinates; (d) fatty esters of phosphoric acid; and (e) mixtures thereof.

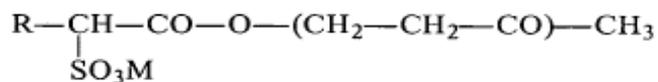
Claim 1 requires that the weight ratio of the amount of oily phase to the amount of amphiphilic lipid ranges from 1.2 to 10.

Claim 15:

Claim 15 depends from and further limits claim 1 to require that the nanoemulsion further comprising at least one additional anionic amphiphilic lipid.

Claim 15 requires that this additional anionic amphiphilic lipid is selected from the group consisting of alkaline salts of dicetyl and dimyristyl

phosphate; alkaline salts of cholesterol sulphate; alkaline salts of cholesterol phosphate; lipoamino acids and their salts; sodium salts of phosphatidic acid; phospholipids; and alkylsulphonic derivatives of formula:



in which R represents C₁₆-C₂₂ alkyl radical and M is an alkali metal or an alkaline earth metal.

Claim 18:

Claim 18 depends from and further limits the nanoemulsion of claim 1 to have a turbidity ranging from 60 to 600 NTU.

Claim 34:

Claim 34 depends from and further limits the nanoemulsion of claim 1 to have a turbidity ranging from 70 to 300 NTU.

Findings of Fact (FF):

1. Restle teaches an oil-in-water emulsion, wherein the oil globules have a mean size of less than 150 nm, comprising an amphiphilic lipid phase containing at least one nonionic amphiphilic lipid and at least one cationic amphiphilic lipid for use in cosmetics (Restle Abstract).
2. Restle teaches that “[t]he oil globules of the emulsions of the invention preferably have a mean size ranging from 30 to 150 nm, more preferably from 40 to 100 nm and more preferably still from 50 to 80 nm” (Restle, col. 7: ll. 64-67; Ans. 4).
3. Restle teaches that “the ratio by weight of the amount of oil to the amount of amphiphilic lipid phase ranges from 2:1 to 10:1” (Restle, col. 1: ll. 50-58; Ans. 4).

4. Restle teaches that

[t]he non-ionic amphiphilic lipids of the invention are preferably chosen from silicone surfactants and esters of at least one polyol chosen from the group formed by polyethylene glycol containing from 1 to 60 ethylene oxide units, sorbitan, glycerol containing from 2 to 30 ethylene oxide units or polyglycerols containing from 2 to 15 glycerol units and of at least one fatty acid containing at least one saturated or unsaturated, linear or branched, C₈-C₂₂ alkyl chain. It is also possible to use mixtures of the above compounds.

(Restle, col. 1: ll. 59-67; Ans. 4.)

5. Restle's emulsions "can contain additives for improving, if necessary, the transparency of the formulation" (Restle, col. 7: ll. 17-19; Ans. 4).

6. Restle teaches that transparency improving

additives are preferably chosen from the group formed by: lower C₁-C₈ alcohols, such as ethanol; glycols, such as glycerol, propylene glycol, 1,3-butylene glycol, dipropylene glycol or polyethylene glycols containing from 4 to 16 ethylene oxide units and preferably from 8 to 12.

(Restle, col. 7: ll. 20-26.)

7. Restle's emulsions may also contain thickeners which can be

cellulose derivatives, such as hydroxymethylpropylcellulose, fatty alcohols, such as steryl, cetyl and behenyl alcohols, derivatives of algae such as stia gum, natural gums, such as gum tragacanth, and synthetic polymers, such as the mixtures of polycarboxyvinyl acids sold under the name Carbopol . . . the mixture of Na acrylate/acrylamide copolymers sold under the name Hostacerin PN 73.

(Restle, col. 7: ll. 54-63.)

8. Restle's composition can be used in hair styling formulations (Restle, col. 8: ll. 18-31).
9. Peffly teaches "compositions suitable for styling hair" (Peffly Abstract; Ans. 4).
10. Peffly teaches that non-silicone containing nonionic, anionic, cationic, and amphoteric polymers, and mixtures thereof can be used in hair styling compositions (Peffly, col. 10: ll. 5-9; *see also* Peffly, col. 11: ll. 3-16; Ans. 4-5).
11. Peffly teaches that "the nonsilicone-containing hair styling polymers are preferably present in a combined amount of from about 0.01% to about 20% . . . most preferably from about 0.5% to about 10% by weight of composition" (Peffly, col. 10: ll. 9-14; Ans. 5).
12. Peffly teaches that hair styling compositions may contain "thickening agents (e.g., polymeric thickeners, such as xanthan gum) (Peffly, col. 22: ll. 59-60).
13. Peffly teaches the use of acrylate steareth itaconate copolymer (Structure 2001)³ as a thickener (Peffly, col. 36: ll. 18-40 (Example XI)).
14. Halloran teaches NTU (Nephelometric Turbidity Unit) "is the unit of measure for the turbidity or haze of a liquid" (Halloran, col. 3: ll. 44-45).
15. Halloran teaches that "[t]he haze value of a relatively turbid solution is about 100 NTU's or higher, and mixtures with a slight haze give values of 20 to 50 NTU's" (Halloran, col. 3: ll. 47-50).

³ Acrylate steareth itaconate copolymer (Structure 2001) is an anionic polymer within the scope of Appellants' claimed invention (*see e.g.*, Spec. 12: 10-12).

Obviousness:

1. Claims 1-14 and 17-22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle and Peffly.

While Appellants do not specifically identify separate claim groupings, Appellants provide separate arguments for claim 18. Accordingly, we have interpreted this to mean that claim 18 is grouped separately from claims 1-14, 17, and 19-22. Therefore, we limit our discussion to representative claim 1 and claim 18. 37 C.F.R. § 41.37(c)(1)(vii).

Based on the combined teachings of Restle and Peffly the Examiner concludes that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition taught by Restle et al. by substituting the hair styling polymers with the anionic polymers disclosed by Peffly et al. because both references teach the same type of hair styling emulsions such as hairspray, gel, and styling lotion. Similarly, Restle et al. teaches using hair styling polymers. Peffly et al. teaches specific examples of using anionic polymers in hair styling hairspray and gel compositions.

(Ans. 5-6.)

More specifically, the Examiner reasons that since Restle teaches the use of acrylate/acrylamide copolymers as thickeners in compositions that are useful in styling hair and Peffly teaches the use of acrylate steareth itaconate copolymer as a thickener in a hair styling composition it would have been obvious to substitute Peffly's acrylate steareth itaconate copolymer for Restle's acrylate/acrylamide copolymers as both are recognized in the art as thickening agents for hair styling compositions (Ans. 9; FF 7-8 and 13). We

find no error in the Examiner's prima facie case of obviousness. "Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious." *In re Fout*, 675 F.2d 297, 301 (CCPA 1982); *see also In re Mayne*, 104 F.3d 1339, 1340 (Fed. Cir. 1997) ("Because the applicants merely substituted one element known in the art for a known equivalent, this court affirms [the rejection for obviousness]."). *Accord KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007) ("when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result").

Claim 1:

In response, Appellants assert that "Peffly discloses myriad styling polymers (see, cols. 4-11 in Peffly), a disclosure which is too broad and too general to motivate one skilled in the art to focus on and to select the claimed polymers for use in Restle's nanoemulsions" (App. Br. 4 (emphasis removed)). While Peffly discloses a variety of polymers that may be used in hair styling compositions, there is no evidence on this record that a person of ordinary skill in the art would *not* have considered any of these polymers for use in Restle's hair styling composition. Nevertheless, as the Examiner has explained, it would have been prima facie obvious at the time the invention was made to substitute Peffly's acrylate steareth itaconate copolymer for Restle's acrylate/acrylamide copolymers as both are recognized in the art as thickening agents for hair styling compositions (Ans. 5-6). We find no error in the Examiner's reasoning.

Appellants assert that Peffly “provides no guidance whatsoever concerning which polymer(s) could be advantageously added to a nanoemulsion while, at the same time, maintaining the nanoemulsion’s transparency” (App. Br. 6). We note, however, that claim 1 does not require the claimed oil-in-water nanoemulsion to be transparent. Further, contrary to Appellants’ intimation, claim 1 does not require that a particular polymer be used to “maintain the nanoemulsion’s transparency” (*id.*). While Appellants assert that “the presently claimed invention . . . relates to the use of specific polymers in transparent nanoemulsions” that is not what is claimed. Accordingly, we are not persuaded by Appellants’ assertion that the rejection is, “[a]s a matter of law”, incorrect (App. Br. 6).

For the same reasons we are not persuaded by Appellants’ assertion that their Specification (Spec. 3: 13-21), the Sonnevile-Aubrun Declaration, and the Simonnet Declaration, demonstrate “that merely choosing any polymer to incorporate into a composition will not necessarily result in a transparent, thickened nanoemulsion” (App. Br. 6). As discussed above, there is no requirement in claim 1 that a polymer exhibits any effect on the transparency of the composition. In order to establish unexpected results for a claimed invention, objective evidence of non-obviousness must be commensurate in scope with the claims which the evidence is offered to support. *In re Greenfield*, 571 F.2d 1185, 1189 (CCPA 1978); *In re Lindner*, 457 F.2d 506, 508 (CCPA 1972); *In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971).

We also disagree with Appellants’ assertion that the “polymer choice is critical with respect to whether a transparent nanoemulsion can be obtained” (App. Br. 7). Restle teaches that transparency improving additives

can be added to the composition (FF 5-6). Claim 1 does not exclude the addition of Restle's transparency improving additives. For the foregoing reasons, we are not persuaded by Appellants' assertion that "[n]othing in Restle teaches or suggests that transparency problems can be addressed by adding a specific type of polymer to the emulsion" (App. Br. 4 (emphasis removed)). Accordingly, we disagree with Appellants' assertion that Restle "provides no motivation whatsoever to use non-disclosed thickening agents in an attempt to produce a transparent nanoemulsion without having to add glycols or lower alcohols to the emulsions. Thus, Restle teaches away from the claimed invention rather than suggesting it" (App. Br. 5 (emphasis removed)).

While Appellants may "have discovered that by using the claimed polymers (and not other polymers), thickened, transparent nanoemulsions can be produced" (App. Br. 6) this is not what they have claimed. The Examiner has provided through a preponderance of the evidence that oil and water emulsion within the scope of the claimed invention were known in the art prior to Appellants' filing date and has provided a reasonable rationale as to why a person of ordinary skill in the art would have modified Restle with the specific thickener taught by Peffly. "In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." *KSR*, 127 S.Ct. at 1742; *see also In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992) ("[T]he law does not require that the references be combined for the reasons contemplated by the inventor."). Therefore, we are not persuaded by Appellants' assertion that "[n]othing in Restle teaches

or suggests that transparency problems can be addressed by adding a specific type of polymer to the emulsion” (Reply Br. 2). As the Examiner explains “just because acrylate/acrylamide copolymers were not necessarily added to [Restle’s] . . . composition to improve transparency does not mean that there is no motivation to add these copolymers” e.g., as thickening agents (Ans. 9).

Further, to the extent that Appellants’ would argue that their declarations provide unexpected results, we note that in order to establish unexpected results for a claimed invention, objective evidence of non-obviousness must be commensurate in scope with the claims which the evidence is offered to support. *In re Greenfield*, 571 F.2d 1185, 1189 (CCPA 1978); *In re Lindner*, 457 F.2d 506, 508 (1972); *In re Tiffin*, 448 F.2d 791, 792 (1971).

In addition, for the foregoing reasons we are not persuaded by Appellants’ assertion that Restle “teaches away from the claimed invention” because Restle directs one to include transparency improving additives to improve the transparency of the composition (App. Br. 5; *see generally* Reply Br. 2). A reference is said to “teach away” from a claimed invention when it “suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” *In re Gurley*, 27 F.3d 551, 553, (Fed. Cir. 1994). On this record, the Examiner has provided a reasonable rationale for combining Restle and Peffly. Further, based on the teachings of Restle one of ordinary skill in the art would, if necessary, include additional additives which are not excluded from claim 1 to improve the transparency of the claimed invention.

Accordingly, we find that the preponderance of the evidence on this record favors the Examiner.

Accordingly, we affirm the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle and Peffly. Claims 2-14, 17, and 19-22 fall together with claim 1.

Claim 18:

Appellants assert that “[n]othing in any of the cited references would motivate one skilled in the art to combine the required elements with the reasonable expectation that a nanoemulsion having the required visual characteristics would result” (App. Br. 5). We agree. The Examiner expressly admits on this record that “[w]hile Restle et al. generally teaches the method of improving the transparency of the composition by adding ethanol or glycols (col. 7, lines 21-31), the reference does not mention the specific limitations of instant claims 30-36” (Ans. 7). A comparison of claim 18 and claim 34, reproduced above, demonstrates that these claims differ only in the turbidity range recited. The Examiner fails to identify any portion of Restle or Peffly that would teach or suggest the turbidity range recited in claim 18. Accordingly, we reverse the rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle and Peffly, in favor of the new ground of rejection set forth below.

2. Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Tobe.

The claims have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Therefore we limit our discussion to claim 15.

The Examiner relies on the combination of Restle and Peffly as discussed above (Ans. 6). The Examiner finds that the combination of “Restle and Peffly fails to teach lipoamino acids or their salts” (*id.*). The Examiner relies on Tobe to teach “cosmetic oil-in-water emulsions containing N-acyl acidic amino acids and/or their salts, such as sodium N-stearoylglutamate, sodium n-myristoylglutamate” (Ans. 6).

Based on this evidence the Examiner concludes that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the hair styling compositions of the combined references by incorporating the anionic terpolymer because of the expectation of successfully producing a [sic] stable cosmetic emulsions that are non-irritating to sensitive skins. Further modifying the composition by adding lipoamino acids or its salts would have been also obvious, as suggested by the [Tobe] . . . abstract, because of the expectation that the additive would provide a long shelf-life of the composition.

(Ans. 6-7.)

Appellants do not address the rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Tobe. Therefore, having identified no error in the Examiner’s prima facie case of obviousness, we affirm the rejection of claim 15 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Tobe. Claim 16 falls together with claim 15.

3. Claims 30-36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Halloran.

The claims have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, we limit our discussion to representative claim 34.

The Examiner relies on the combination of Restle and Peffly as discussed above. In addition, the Examiner finds that “[w]hile Restle et al. generally teaches the method of improving the transparency of the composition by adding ethanol or glycols (col. 7, lines 21-31), the references does not mention the specific limitations of the instant claims 30-36” (Ans. 7; FF 5-6). Therefore, the Examiner relies on Halloran to teach that “a relatively turbid solution has about 100 NTU’s or higher optical clarity, while mixtures having a slight haze have values of 20 to 50 NTU’s” (Ans. 7; FF. 15).

Based on this evidence the Examiner concludes that “[i]t would have been obvious to one having ordinary skill in the art at the time of the invention was made to have adjusted the desired transparency of the composition as motivated by Halloran et al. because of the expectation of successfully producing a hazy or relatively turbid composition” (Ans. 7).

In response, Appellants assert that Halloran “uses spectrometry to determine NTU values, whereas the present application determines NTU values using a turbidimeter. Thus, Halloran cannot teach or suggest the NTU values required by the claims” (App. Br. 5-6). We are not persuaded.

NTU values are a unit of measure (FF 14). Appellants identify no evidence on this record to support their intimation that a unit of measure will

change depended on the device used to take the measurement. By way of example, we note that an “inch” is a unit of measure that will remain the same whether a practitioner uses a ruler or a yard stick.

Appellants assert that “[n]othing in any of the cited references would motivate one skilled in the art to combine the required elements with the reasonable expectation that a nanoemulsion having the required visual characteristics would result” (App. Br. 5). We disagree. Halloran teaches that NTU values are a “unit of measure for the turbidity or haze of a liquid” (FF 14). In addition, Halloran teaches that “[t]he haze value of a relatively turbid solution is about 100 NTU’s or higher, and mixtures with a slight haze give values of 20 to 50 NTU’s” (FF 15). Restle teaches that the transparency of a composition can be adjusted by adding transparency improving additives to the composition (FF 5-6). Therefore, a person of ordinary skill in the art would appreciate that turbidity is a results effective variable which can be regulated by the addition of transparency improving additives.

Accordingly, we find no error in the Examiner’s conclusion that “[i]t would have been obvious to one having ordinary skill in the art at the time of the invention was made to have adjusted the desired transparency of the composition as motivated by Halloran et al. because of the expectation of successfully producing a hazy or relatively turbid composition” (Ans. 7). “[I]t is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Geisler*, 116 F.3d 1465, 1470 (Fed.Cir.1997) (quoting *In re Aller*, 220 F.2d 454, 456 (CCPA 1955); *In re Kulling*, 897 F.2d 1147, 1149 (Fed.Cir.1990) (finding no clear error in Board of Patent Appeals and Interferences’ conclusion that the amount of eluent to be used

in a washing sequence was a matter of routine optimization known in the pertinent prior art and therefore obvious).

Accordingly, we affirm the rejection of claim 34 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Halloran. Claims 30-33, 35, and 36 fall together with claim 34.

New Ground of Rejection:

Claim 18 is rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Halloran for the same reasons as set forth above with regard to claim 34. In this regard, we recognize that Appellants argued claim 18 together with claims 34-36 relating to the combination of Restle, Peffly, and Halloran (App. Br. 5). For the reasons set forth above, we are not persuaded by Appellants' arguments.

TIME PERIOD FOR RESPONSE

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 C.F.R. § 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 appellants, 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 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.

CONCLUSION

In summary:

we affirm the rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Tobe.

we affirm the rejection of claims 30-36 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Halloran.

we reverse the rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle and Peffly.

we enter a new ground of rejection of claim 18 under under 35 U.S.C. § 103(a) as unpatentable over the combination of Restle, Peffly, and Halloran.

TIME PERIOD FOR RESPONSE

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.”

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37 C.F.R. § 41.50(b) also provides that the Appellants, 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....

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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 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 appellant elects 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.

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

Ssc:

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