

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ISABELLE HANSENNE  
and  
HANI FARES  
Appellants

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Appeal 2008-3740  
Application 11/510,364<sup>1</sup>  
Technology Center 1600

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Decided: June 20, 2008

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Before TEDDY S. GRON, CAROL A. SPIEGEL, and  
TONI R. SCHEINER, *Administrative Patent Judges*.

SPIEGEL, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Application 11/510,364 ("the 364 application") was filed 24 August 2006. The real party in interest is said to be L'Oréal (Appeal Brief under 37 C.F.R. § 41.37, filed 18 October 2007, ("App. Br.") 3).

I. Statement of the Case

Appellants appeal under 35 U.S.C. § 134 from the final rejection of claims 18-25, 28-31, and 33. Claims 1-17, 26, 27, and 32, the only other pending claims, have been withdrawn from consideration. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

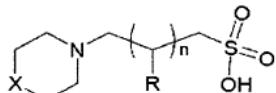
The subject matter on appeal relates to a method comprising applying a composition containing an extract of *Emblica officinalis*, a hydroxy acid, and an N-substituted aminosulfonic acid to the skin. Claim 18 is illustrative and reads (App. Br. 9).

18. A method of depigmenting skin, comprising applying to the skin, a composition comprising:

(e) an extract of *Emblica officinalis*;

(f) at least one hydroxyl [sic] acid;

(g) at least one N-substituted aminosulfonic acid having the structural formula (I):

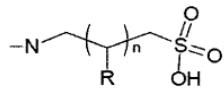


(I)

in which R is chosen from a hydrogen atom, -OH or -NH<sub>2</sub>; X is chosen from an oxygen atom, a group corresponding to:



or a group corresponding to:



and n is an integer from 0 to 3; and

(h) optionally, at least one photoprotective agent.<sup>2</sup>

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<sup>2</sup> We note that when X is N, a covalent bond to N is missing.

In response to an election of species requirement in the Office Action of December 12, 2006, Appellants elected glycolic acid as the hydroxyl acid and 4-(2-hydroxyethyl) piperazine-1-propanesulfonic acid as the N-substituted aminosulfonic acid (FR<sup>3</sup> 2). Thus, claims drawn to methods of applying compositions including these two species to the skin are before us.

The Examiner finally rejected claims 18-25, 28-31, and 33 under 35 U.S.C. § 103(a) as obvious over Hansenne,<sup>4</sup> Galey,<sup>5</sup> and De Poilly<sup>6</sup> (FR 3; Ans.<sup>7</sup> 3).

Appellants have relied on the same arguments for all the appealed claims. Therefore, we decide this appeal on the basis of claim 18. 37 C.F.R. § 41.37(c)(1)(vii).

## II. Opinion

### A. The prior art

According to Galey,

[a]ging of the skin is generally reflected by the appearance of wrinkles and fine lines, by yellowing of the skin which develops a wizened appearance accompanied by the appearance of pigmentation marks, by disorganization of the elastin and collagen fibers resulting in a loss of elasticity,

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<sup>3</sup> Office Action mailed 30 May 2007 ("FR").

<sup>4</sup> Hansenne et al., US Patent Application Publication 2004/0028642 A1, "Cosmetic Composition Comprising an Extract of Emblica Officinalis and Methods of Using the Same," published 12 February 2004 ("Hansenne").

<sup>5</sup> Galey et al., US Patent Application Publication 2003/0232063 A1, "Aminosulfonic Acid Compounds for Promoting Desquamation of the Skin," published 18 December 2003 ("Galey").

<sup>6</sup> De Poilly, US Patent Application Publication 2004/0096406 A1, "Composition Containing Ascorbic Acid Compound and Screening Agent, Method of Use," published 20 May 2004 ("De Poilly").

<sup>7</sup> Examiner's Answer mailed 19 December 2007 ("Ans.").

suppleness and firmness, or by the appearance of telangiectasias (Galey ¶ 10).

Galey discloses aminosulfonic acid derivatives having the structure recited in claim 18 (Galey ¶ 38), including 4-(2-hydroxyethyl) piperazine-1-propane-sulfonic acid (*id.* ¶ 68), as "active agents for promoting the desquamation of the skin and/or for stimulating epidermal renewal and/or for combating aging of the skin" (*id.* ¶ 28).

Hansenne discloses "a method of treating at least one skin condition chosen from acne, wrinkles and signs associated with aging" by applying a composition comprising hydroxy acids, e.g., alpha-hydroxy acids including glycolic acid, and an *Emblica officinalis* extract (Hansenne ¶¶ 16 and 30).

De Poilly discloses adding a photoprotective ingredient, i.e., a UV-screening agent, such as terephthalylidene dicamphor sulphonic acid, to cosmetic and dermatological compositions (De Poilly ¶¶ 2, 10, 28, and 55).

#### B. The Examiner's findings and conclusion

The Examiner found Galey teaches applying to the skin a composition comprising 4-(2-hydroxyethyl) piperazine-1-propanesulfonic acid, and N-substituted aminosulfonic acid, for combating aging skin, including yellowing of the skin and appearance of pigmentation marks. The Examiner further found Hansenne teaches applying to the skin a composition comprising applying *Emblica officinalis* and glycolic acid for combating pigmented skin. The Examiner relied on De Poilly for teaching the photoprotective agent optionally present in the claimed invention. The Examiner concluded, in relevant part, it would have been *prima facie* obvious to combine the teachings of Hansenne and Galey because "all the

compositions yielded beneficial results in [the] cosmetic industry." [Ans. 3-4.]

C. The Appellants' position

Appellants essentially argue that the applied prior art, alone or in combination, fails to teach or suggest using *Emblica officinalis* extract as the active skin depigmenting agent *per se* in the applied composition (App. Br. 6-7; Reply Br.<sup>8</sup> 2-3).

D. Analysis

A claimed invention is not patentable if the subject matter of the claimed invention would have been obvious to a person having ordinary skill in the art. 35 U.S.C. § 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, (2007); *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966). Facts relevant to a determination of obviousness include (1) the scope and content of the prior art, (2) any differences between the claimed invention and the prior art, (3) the level of skill in the art and (4) any relevant objective evidence of obviousness or non-obviousness. *KSR*, 127 S. Ct. at 1734, *Graham*, 383 U.S. at 17-18. A person having ordinary skill in the art uses known elements and process steps for their intended purpose. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63 (1969). Furthermore, functional language in a claim may or may not further limit the scope of the claimed subject matter. *In re Pearson*, 494 F.2d 1399, 1402-1403 (CCPA 1974).

Here, we find that the preamble is duplicative of the limitations in the body of the claim. The steps of the claimed method recite applying to the

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<sup>8</sup> Reply Brief Under Board Rule § 41.41, filed 16 January 2008 ("Reply Br.").

skin a composition comprising elements known in the prior art to treat signs associated with skin aging, including the appearance of pigmentation marks. Specifically, the prior art teaches applying compositions comprising 4-(2-hydroxyethyl) piperazine-1-propanesulfonic acid (Galey) or a combination of an *Emblica officinalis* extract and glycolic acid (Hansenne) to the skin to treat signs associated with skin aging, such as yellowing of the skin accompanied by the appearance of pigmentation marks (Galey and Hansenne). Thus, it would have been *prima facie* obvious to one of ordinary skill in the art to combine the known compositions of Galey and Hansenne for their intended purpose of treating signs associated with aging skin.

A discussion of De Poilly is unnecessary to our decision.

Appellants argue that Hansenne teaches using *Emblica officinalis* extract for its stabilizing, not depigmenting, properties (App. Br. 6). However, the preamble of claim 18 is entitled to no patentable weight since the intended functional use is inherent in the recited method steps. Furthermore, as noted by the Examiner (Ans. 6), Appellants did not claim that *Emblica officinalis* extract was being used as an active depigmenting component. Even if the extract were so claimed, it is well settled law that the motivation to combine the references does not have to be identical to that of the applicant to establish obviousness. *In re Dillon*, 919 F.2d 688, 693 (Fed. Cir. 1990). Moreover, we note that one of ordinary skill in the art would have been aware at the time the 364 application was filed that, "Extracts of *Emblica officinalis* have been identified as being effective depigmentation agents. In that respect, Appellants' specification

acknowledges that FR2730408 discloses skin lightening compositions containing extracts of *Emblica officinalis* and  $\alpha$ -hydroxy acids" (Spec. ¶ 2).<sup>9</sup>

Finally, Appellants have not submitted objective secondary evidence of non-obviousness, e.g., evidence showing unexpected results when applying the specific combination of an *Emblica officinalis*, glycolic acid, and 4-(2-hydroxyethyl) piperazine-1-propanesulfonic acid to the skin as claimed.

Therefore, based on the foregoing, we affirm the Examiner's final rejection of claims 18-25, 28-31, and 33 under § 103 as obvious over Hansenne, Galey, and De Poilly.

### III. Order

Upon consideration of the record, and for the reasons given, it is ORDERED that the decision of the Examiner rejecting claims 18-25, 28-31, and 33 under 35 U.S.C. § 103(a) as obvious over Hansenne, Galey, and De Poilly is AFFIRMED; and

FURTHER ORDERED that 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).

AFFIRMED

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<sup>9</sup> According to the Information Disclosure Statement filed, 3 November 2006, by Appellants, FR2730408 was published, 14 August 1996.

Appeal 2008-3740  
Application 11/510,364

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