

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte

SHAO XIANG LU, TERRY VAN LIEW, NATHALIE GEFFROY-
HYLAND, and MOHAMED KANJI

Appeal 2008-4206
Application 10/746,612
Technology Center 1600

Decided: November 21, 2008

Before TONI R. SCHEINER, DONALD E. ADAMS, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.

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DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-37,
47-51, 53, 54, and 57-94. Jurisdiction is under 35 U.S.C. § 6(b). We affirm-
in-part.

STATEMENT OF THE CASE

The claims are directed to a composition comprising a liquid fatty phase that comprises a “structuring agent comprising a polymer skeleton having a hydrocarbon-based repeating unit comprising at least one hetero atom,” “a silicone elastomer powder comprising a silicone elastomer core coated with a silicone resin,” and a “swelling agent for said powder.” (Claim 1.) The Specification describes the composition as a cosmetic providing a “cushiony, soft and silky feel upon application” (Spec. ¶ 2).

Claims 1-37, 47-51, 53, 54, and 57-94 are pending (App. Br. 5) and stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Ans. 3).¹ Claim 1, which is representative of the appealed subject matter, reads as follows:

A cosmetic composition comprising at least one liquid fatty phase comprising: at least one structuring agent comprising a polymer skeleton having a hydrocarbon-based repeating unit comprising at least one hetero atom; a silicone elastomer powder comprising a silicone elastomer core coated with a silicone resin; and at least one swelling agent for said powder.

ISSUE ON APPEAL

Claim 1 as originally filed recited a cosmetic composition comprising four components: a structuring agent, a liquid fatty phase, a silicone elastomer, and a swelling agent. During prosecution, the “liquid fatty phase” was deleted from the list and the claim was amended to read that the remaining three components (the structuring agent, elastomer, and swelling agent) were a part of the liquid fatty phase (*see* Ans. 3).

¹ The Examiner included claims 55 and 56 in the statement of the rejection, but these claims are canceled (App. Br. 5).

The Examiner contends that the amended claim lacks written descriptive support because the Specification does not contain a description of a liquid fatty phase comprising a structuring agent, a silicone elastomer, and a swelling agent.

The issue in this appeal is as follows: Does the amended claim lack written descriptive support because the Specification does not contain a description of a liquid fatty phase comprising a structuring agent, a silicone elastomer, and a swelling agent?

FINDINGS OF FACT (FF)

1. The Specification describes “a liquid fatty phase” in a composition. The composition also includes “a structuring agent comprising a polymer skeleton having a hydrocarbon-based repeating unit comprising at least one hetero atom,” “a silicone elastomer powder comprising a silicone elastomer core coated with a silicone resin,” and “a swelling agent for said powder” (Spec. ¶¶ 3, 5).
2. In certain embodiments, the Specification states that the “liquid fatty phase” is “structured with at least one structuring polymer” (*id.* at ¶ 18) and that “the structuring of the liquid fatty phase is obtained with the aid of at least one structuring polymer” (*id.* at ¶ 31).
3. In addition to the structuring agent, the Specification also states that the liquid fatty phase can comprise an oil which is compatible with the structuring agent (*id.* at ¶ 43).
4. Examples of fatty acid oils include C₁₂-C₁₅ benzoate and isononyl isononanoate (*id.* at ¶ 45 on p. 17).
5. “In addition to the liquid fatty phase, the cosmetic composition may also contain an aqueous phase, in which case, the cosmetic composition will be

in the form of an emulsion. . . . Examples of aqueous emulsions include . . . water-in-oil emulsions” (*id.* at ¶ 49).

6. Example 3 of the Specification describes a water-in-oil emulsion which comprises a structuring agent (Uniclear 100), a swelling agent (dimethicone DC 200 fluid), silicone elastomer powder (vinyl dimethicone/methicone silsesquioxane crosspolymer), and fatty acid oils (C₁₂-C₁₅ benzoate and isononyl isononanoate; FF4) (*id.* at ¶¶ 85-86).

7. The latter components are combined (phases A-F) and then mixed with an aqueous phase comprising water (G) to form an emulsion (*id.* at ¶ 86).

8. Persons of ordinary skill in the art would have recognized that the “oil” in the emulsion of Example 3 is the liquid fatty acid phase (FF5; App. Br. 24) and that the liquid fatty phase comprises the structuring agent, swelling agent, and silicone elastomer powder (i.e., phases A-F; FF7).

9. Example 6 of the Specification describes a “stick” in which a structuring agent (Uniclear 100 VG), swelling agent (dimethicone DC 200 fluid), and silicone elastomer powder (KSP-100) were mixed to obtain a “homogenous mixture” which was heated until “transparent and free of clumping” (Spec. ¶¶ 88-89).

10. The homogenous mixture, transparent and free of clumping, would be recognized as a fatty acid phase by persons of skill in the art (App. Br. 27).

11. In sum, Examples 3 and 6 of the Specification describe compositions in which a fatty acid phase comprises a structuring agent, a silicone elastomer powder comprising a silicone elastomer core coated with a silicone resin, and a swelling powder.

PRINCIPLES OF LAW

The purpose of the written description requirement is to “ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.” *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000). To that end, to satisfy the written description requirement, the inventor “must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). In describing the claimed invention, there is no requirement that the wording be identical to that used in the specification as long as there is sufficient disclosure to show one of skill in the art that the inventor “invented what is claimed.” *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000).

ANALYSIS

The dispute in this appeal arises because there is no express statement in the Specification that the claimed “liquid fatty phase” comprises 1) a structuring agent; 2) a silicone elastomer powder, and 3) a swelling agent as recited in claim 1. Instead, the “liquid fatty acid phase” is listed in the same list in which the structuring agent, silicone elastomer powder, and swelling agent appear (FF1). In other words, it is not explicitly stated that the liquid fatty phase comprises the three components which are now required by claim 1 to be part of it. Because there is no literal description of what is claimed, the Examiner rejects claim 1 as lacking a written description.

35 U.S.C. § 112, first paragraph, requires a written description of the claimed invention. The purpose of the written description requirement is to “ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.” *Reiffin*, 214 F.3d at 1345. To that end, to satisfy the written description requirement, the inventor “must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*.” *Vas-Cath*, 935 F.2d at 1563-64. In describing the claimed invention, there is no requirement that the wording be identical to that used in the specification as long as there is sufficient disclosure to show one of skill in the art that the inventor “invented what is claimed.” *Union Oil Co. of California*, 208 F.3d at 997.

To support their position that the subject matter of claim 1 is described in the Specification, Appellants point to examples in the Specification, each of which is asserted to exemplify a liquid fatty phase comprising a structuring agent, silicone elastomer powder, and swelling agent (App. Br. 24-27). The Examiner rejects the sufficiency of this evidence because the “[e]xamples are to specific ingredients and none of the claims are limited to these three ingredients” (Ans. 5).

We agree with Appellants that the Examiner erred in concluding that claim 1 lacks written description in the Specification. It is clear from the working examples described in the Specification that Appellants possessed at least two species of liquid fatty phases which comprise each of the three components required by claim 1: the structuring agent, the silicone powder, and the swelling agent (FF6-11). Since working examples are just that –

examples – persons of ordinary skill in the art would have understood them to be illustrative of a broader invention.

The Specification provides express disclosure of a broader invention in several instances. It states clearly that the structuring agent provides structure to the liquid fatty phase (FF2). Thus, although the structuring agent is in the same list as the liquid fatty phase in one place in the Specification (FF1), it is also disclosed that the agent may also be present in the liquid fatty phase in order to provide structure to it (FF2). This provides direct description of a generic invention in which a structuring agent is present in the liquid fatty phase, without limiting it to the specific structuring agents recited in Examples 3 and 6.

The Specification also describes compositions comprising liquid fatty acid and aqueous phases (FF5). In such compositions, the silicone powder and swelling agent are either in the liquid fatty phase or the aqueous phase. Example 3 indicates that the inventors conceived of both of the latter components as part of the liquid fatty phase (FF6-8).

Appellants have not overreached their contribution to the field by claiming a fatty phase with a structuring agent, elastomer powder, and swelling agent. *See Reiffin*, 214 F.3d at 1345. All three of the claimed components are explicitly described in the Specification as being present in the same composition (FF1). All three components are exemplified as being in the same composition (FF6-11). The structuring agent is specifically described as being present in the fatty phase for the purpose of structuring it (FF2). Therefore, persons of ordinary skill in the art would have recognized and necessarily understood that, in addition to the structuring agent, the liquid fatty phase could also contain the powder and the swelling agent

chosen for its function in swelling the powder. This conclusion is buttressed by Examples 3 and 6 which show compositions comprising all three components. Thus, while the Specification does not have a literal statement of what is now claimed, there is sufficient disclosure to convey to persons of ordinary skill in the art that the inventors invented what is now claimed. *See Union Oil Co. of California*, 208 F.3d at 997.

The Examiner argues that the examples “have different phases” and “none of the single phase does [comprise] all the three ingredients [which] are claimed” (Ans. 5). However, the Examiner does not provide any evidence to support this position. In the examples, the various components are characterized as being in phases which are sequentially added while mixing (Spec. ¶¶ 86-89). For instance, in Example 6, the components are mixed to form a transparent mixture and then melted until “homogenous” (Spec. ¶ 89), a state which would be understood to be a single phase (*see* App. Br. 24; FF9-10).

For the foregoing reasons, we reverse the rejection of 1-19, 21-37, 47-50, and 59-69, and 71-91.

Claims 53, 57, and 93

Claims 53, 57, and 93 are directed to compositions in which the structuring agent is ethylenediamine/stearyl dimer dilinoleate copolymer.

The compound “ethylenediamine/stearyl dimer dilinoleate copolymer” which is recited in claims 53, 57, and 93 as a structuring agent is expressly disclosed in the Specification (Spec. ¶ 88, “A2” as “Uniclear 100 VG”). Because of this explicit disclosure of the claimed compound, we reverse the rejection of claims 53, 57, and 93.

Claims 54, 58, and 94

Claims 54, 58, and 94 are directed to compositions in which the structuring agent is ethylenediamine/stearyl dimer tallate copolymer.

Appellants do not identify explicit disclosure of this compound in the Specification. Rather, they cite the Specification which states that Uniclear 80 and Uniclear 100 “may be mixtures of copolymers derived from monomers of (i) C₃₆ diacids and (ii) ethylenediamine” (Spec. ¶ 32) and definitions from the *International Cosmetic Ingredient Dictionary and Handbook* (Tenth Edition, 2004) (App. Br. 29-31).

This evidence does not persuade us that the Examiner erred in rejecting claims 54, 58, and 94 as lacking written description. The Specification states that Uniclear 80 and Uniclear 100 may be used as structuring agents (Spec. ¶ 32). The term “UNICLEAR” is described in the *International Cosmetic Ingredient Dictionary and Handbook* 3583 (Tenth Edition, 2004) as being the dilinoleate “(or)” the tallate copolymer. Appellants have not explained why persons of ordinary skill in the art would understand from this definition which of these polymers is represented by Uniclear 80 and 100.

The description of the tallate copolymer on pages 657-58 of the *International Cosmetic Ingredient Dictionary and Handbook* states that it is a copolymer of ethylenediamine and tall oil dimer acid monomers, end blocked with stearyl alcohol. This description is not the same as one in the Specification which characterizes specific Uniclear polymers as derived from C₃₆ diacids and ethylenediamine (Spec. ¶ 32).

Finally, Appellants argue that “Redacted Proprietary Documents” clearly show that “Uniclear” was known to be the dilinoleate and the tallate

copolymers. (App. Br. 30.) However, the issue is not whether “Uniclear” was generically known to cover the dilinoleate “(or)” the tallate copolymers, but whether the Specification specifically discloses the ethylenediamine/stearyl dimer tallate copolymer or an equivalent name that would be recognized to be the same compound. As to this issue, we see no evidence. Appellants may have provided evidence that “UNICLEAR” would be known to be the dilinoleate or tallate copolymer, but this insufficient evidence to establish that the particular Uniclear 80 or Uniclear 100 disclosed in the Specification is the claimed ethylenediamine/stearyl dimer tallate copolymer.

We affirm the rejection of claims 54, 58, and 94 as lacking writing description.

Claims 20, 51, 70, and 92

Claims 20, 51, 70, and 92 are drawn to a cosmetic composition in which “at least one structuring agent comprises a polyamide bonded to a fatty chain via an ester group, said at least one swelling agent is chosen from dimethicones, and said silicone resin comprises a polyorganosilsesquioxane.”

The Specification describes an embodiment in which the structural [sic, structuring] agent comprises a polyamide bonded to a fatty chain via an ester group, the swelling agent comprises a dimethicone, and the silicone elastomer core comprises a polyorganosilsesquioxane.

(Spec. ¶ 6.) As this description corresponds in scope to the compositions of claims 20, 51, 70, and 92, we conclude that the Specification contains a written description of these claims and reverse the rejection.

CONCLUSIONS OF LAW

We conclude that the Specification contains a written description of the amended claims and reverse the rejection of claims 1-37, 47-51, 53, 57, and 59-93. As to claims 54, 58, and 94, we conclude that the subject matter in these claims is not described in the Specification and the rejection of these claims is affirmed.

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-IN-PART

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