

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MICHAEL CHARLES CHENEY, ALLISON WRIGHT,
ADELINO DOSSANTOS, JR., STEPHEN ROY BARROW, RICHARD
LOREN MCMANUS, and PHILIP EDWARD MINER

Appeal 2008-5795
Application 10/916,290
Technology Center 1600

Decided: December 22, 2008

Before DEMETRA J. MILLS, ERIC GRIMES, and FRANCISCO C.
PRATS, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a cosmetic composition. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

The Specification discloses “a cosmetic composition of exceptionally pleasant aesthetics” that “delivers a silky feel transitioning after rub-in to a powdery, dry satin or velvety afterfeel” (Spec. ¶ 8). The Specification also discloses that the “afterfeel aesthetics are achieved with a combination of tapioca starch and polyacrylate in bead form having number average particle size ranging from about 1 to about 50 micron” (*id.*).

Claims 1-10 are on appeal.

Claims 1 and 4 are representative and read as follows:

Claim 1: A cosmetic composition comprising:

- (i) from about 0.1 to about 10% by weight of tapioca starch;
- (ii) from about 0.001 to about 5% by weight of polyacrylic beads of number average particle size ranging from about 1 to about 50 micron;
- (iii) from about 0.01 to about 10% by weight of an emulsifier;
- (iv) optionally, an effective amount to provide an initial silky feel upon skin contact of a polysiloxane material;
- (v) optionally, from about 0.1 to about 20% by weight of a C₁₂-C₂₂ fatty acid;
- (vi) optionally, from about 0.001 to about 40% by weight of polyhydric alcohol;
- (vii) optionally, an effective amount to preserve of a preservative; and
- (viii) a cosmetically acceptable carrier which is water present in an amount from about 50 to about 95% by weight.

Claim 4: The cosmetic composition according to claim 1 wherein the polysiloxane material is a dimethiconol.

OBVIOUSNESS

The Issue

The Examiner has rejected claims 1-3 and 5-10 under 35 U.S.C. § 103(a) as obvious in view of Faryniarz¹ and National Starch.² The claims have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner's position is that Faryniarz discloses cosmetic compositions containing porous polymethyl methacrylate particles, emulsifiers, starch, and water; that National Starch discloses that "tapioca starch can be used in emulsion systems for imparting smooth, silky feel to formulations;" and that the ordinary skilled artisan would have been motivated to modify the cosmetic compositions of Faryniarz with the tapioca starch disclosed by National Starch "to obtain formulations having smooth, silky skin feel" (Answer 3-4).

Appellants contend that the Examiner erred in finding that there is a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings to arrive at the invention of claim 1 (Appeal Br. 7-9).

The issues presented are: (1) Does the evidence support the Examiner's conclusion that one of skill in the art would have been motivated

¹Faryniarz et al., US 6,495,123 B1, Dec. 17, 2002.

²National Starch and Chemical Company product bulletin, product Tapioca Pure (28-1810). (The bulletin carries a date stamp of "04/29/2004" but also states "Rev. 12.27.2001" (page 4), indicating that it was available as of December 2001. Appellants do not dispute that the contents of the bulletin are prior art to the claims on appeal).

to use the tapioca starch of National Starch in the cosmetic composition of Faryniarz, and, if so, (2) have Appellants overcome the *prima facie* case with evidence of unexpected results?

Findings of Fact

1. Faryniarz discloses a cosmetic composition that includes an organic sunscreen agent, a water-insoluble powdered polymer formed as porous particles (0.01 to 10% by weight), and water (1 to 99% by weight) (*Faryniarz*, col. 1, ll. 50-61).
2. Faryniarz discloses that “[i]llustrative porous polymers include polymethyl methacrylate” (*id.* at col. 2, ll. 25-26).
3. Faryniarz discloses that “[a]verage particle size may range from about 0.1 to about 100, preferably from about 1 to about 50 ... micron” (*id.* at col. 2, l. 7-11).
4. Faryniarz discloses that “[o]rdinarily the compositions will be water and oil emulsions” (*id.* at col. 3, ll. 58-59).
5. Faryniarz discloses that “[e]mulsifiers may also be present in [the] cosmetic compositions” at a concentration “range from about 0.1 to about 40%, preferably from about 1 to about 20%, optimally from about 1 to about 5% by weight of the total composition” (*id.* at col. 5, ll. 5-9).
6. Faryniarz discloses that “[t]hickening agents may be included in [the] compositions” and that polysaccharides, including “starches, natural/synthetic gums and cellulosics,” are particularly useful as thickening agents (*id.* at col. 5, ll. 46-49). Faryniarz discloses that “[r]epresentative of the starches are chemically modified starches such as aluminum starch octenylsuccinate” and that “[a]mounts of the thickener may range from

about 0.001 to about 5%, preferably from about 0.1 to about 2%, optimally from about 0.2 to about 0.5% by weight” (*id.* at col. 5, ll. 49-51; col. 6, ll. 8-10).

7. National Starch discloses that tapioca starch can “be used in emulsions to change the texture of formulas … to give increased cushion and richness to the formulation” and that the tapioca has “a negligible effect on the viscosity of an emulsion” and “leave[s] a soft after feel on the skin” when incorporated into an emulsion (National Starch 3).

8. The Specification discloses that compositions with polyacrylic beads and tapioca starch have a superior silky/powdery feel versus compositions of polyacrylic beads without tapioca starch (or any other starch) (Spec. 20-21, Example 11). The Specification does not assert that the combination of polyacrylic beads with tapioca starch shows unexpected results.

9. The Specification also discloses that a composition containing polyacrylic beads and tapioca was evaluated in a stick/slip test using a weighted sled on a glass plate coated with the composition, but does not compare the polyacrylic bead/tapioca starch combination with compositions containing other starches or containing either tapioca or polyacrylic beads alone (Spec. 21-22, Example 12).

10. Appellants have provided a declaration under 37 C.F.R. § 1.132 (Declaration of Philip Miner, filed Jul. 27, 2006).

11. The Miner Declaration provides data on stick/slip performance of a weighted sled on a glass plate coated with a test composition (Miner Declaration, ¶¶ 4-5). Mr. Miner declares that the data shows that a

combination of tapioca and polyacrylic beads “synergistically improves stick/slip friction of a typical cosmetic composition” and that “AOS [aluminum starch octenylsuccinate] is a starch which does not result in a similar good performance” (*id.* at ¶ 5).

Principles of Law

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007). “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious,” the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

“Mere improvement in properties does not always suffice to show unexpected results.” *In re Soni*, 54 F.3d 746, 751 (Fed. Cir. 1995). “[I]t is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the specification does not suffice.”” *Id.* at 750.

“[W]hen unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared with the closest prior art.” *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991).

Attorney argument is not evidence. *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

“Synergism, in and of itself, is not conclusive of unobviousness in that synergism might be expected.” *In re Kollman*, 595 F.2d 48, 55 n.6 (CCPA 1979).

Analysis

The claim is directed to a cosmetic composition that contains certain amounts of tapioca starch, polyacrylic beads, an emulsifier and water. Faryniarz discloses an emulsion composition that contains a sunscreen agent, polyacrylic beads, an emulsifier, water, and starch as a thickener. National Starch discloses that using tapioca starch in cosmetic emulsion compositions provides cushion and richness, and leaves a soft after feel on the skin.

Based on these teachings, it would have been obvious to a person of ordinary skill in the art to use the tapioca starch taught by National Starch in Faryniarz's composition in order to provide cushion, richness, and a soft after feel to the composition. Such a combination would appear to be a combination of known elements to yield predictable results as discussed in *KSR*, 127 S. Ct. at 1739.

In addition to disputing the Examiner's *prima facie* case, Appellants argue that comparative experiments have demonstrated unexpected results (Appeal Br. 9). In particular, Appellants argue they have presented comparative experiments "demonstrating that AOS is inferior to tapioca" and demonstrating "synergy between tapioca and Ganzpearl" (i.e. polyacrylic beads) (*id.*).

The record indicates that compositions with polyacrylic beads and tapioca starch have a superior silky/powdery feel versus compositions of polyacrylic beads without tapioca starch (or any other starch) (Spec. 20-21, Example 11) and improved slip versus stick performance for compositions of polyacrylic beads and tapioca starch versus compositions of polyacrylic

beads and the AOS starch of Faryniarz (the Miner Declaration). The Specification does not characterize the results of Example 11 (i.e., the silky/powdery feel comparison) as unexpected and neither the Specification nor the Miner Declaration characterizes the results of the stick/slip assessment as showing unexpectedly superior results for the combination of polyacrylic beads with tapioca starch. Although the Miner Declaration does state that synergistic results are obtained with the combination of polyacrylic beads and tapioca, the data provided in the Miner Declaration do not show results obtained with tapioca alone without polyacrylic beads and thus it cannot be determined from the data provided whether synergistic results are obtained with the combination. Further, in accordance with *In re Kollman*, 595 F.2d at 55 n.6, synergistic results are not necessarily unexpected.

Appellants' arguments and evidence are not sufficient to overcome the prima facie case of obviousness. The prior art suggests that tapioca starch imparts improved skin feel properties to cosmetic compositions and thus the suggested combination would have been expected to provide improved skin feel properties. Unexpected results must be established by factual evidence, and Appellants have not provided evidence of unexpectedly superior skin feel. Although the Appeal Brief contains statements that the composition of claim 1 provides unexpected results, in accordance with *In re Pearson*, 494 F.2d at 1405, attorney arguments are not evidence. The only place the cited results are characterized as unexpected is in Appellants' brief, and the record does not provide sufficient factual evidence to establish unexpected results for the claimed composition.

The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as obvious in view of Faryniarz, National Starch, and Labrousse.³

The Examiner's position is that Labrousse discloses that cosmetic compositions containing a combination of starch and dimethiconol protect the skin from the effect of atmospheric pollutants, and that the ordinary skilled artisan would have been motivated to modify the cosmetic compositions suggested by Faryniarz and National Starch with dimethiconol to obtain the protective effect suggested by Labrousse (Answer 4-5). We agree with the Examiner's reasoning and conclusion.

Appellants contend that the Labrousse reference does not cure the deficiencies of Faryniarz and National Starch in suggesting the invention of independent claim 1 (Appeal Br. 12).

This argument is not persuasive for the reasons discussed above.

Conclusions of Law

The evidence supports the Examiner's conclusion that one of skill in the art would have been motivated to use the tapioca starch of the National Starch reference in the cosmetic compositions of Faryniarz to arrive at the invention of claim 1, and Appellants' argument that they have provided unexpected results is not adequately supported by the evidence.

SUMMARY

We affirm the rejection of claims 1-3 and 8-10 as being obvious in view of Faryniarz and National Starch and the rejection of claim 4 as being obvious in view Faryniarz, National Starch and Labrousse.

³ Labrousse et al., US 2002/0161104 A1, Oct. 31, 2002.

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AFFIRMED

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