

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MYRA A. HOSHOWSKI

Appeal No. 1995-4072
Application No. 08/105,008¹

ON BRIEF

Before PAK, WALTZ and ROBINSON, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 1, 2, 4 through 22, 24 through 32 and 34 through

¹ Application for patent filed August 11, 1993. According to the appellant, the application is a continuation-in-part of Application No. 07/950,825, filed September 24, 1992, now abandoned.

38 which are all of the claims pending in the application. Claims 3, 23 and 33 were canceled subsequent to the final Office action dated September 23, 1994, Paper No. 9.

The subject matter on appeal is directed to methods for treating the hair. Claims 1, 19 and 29 are representative of the subject matter on appeal and read as follows:

1. A method of treating the hair comprising:

(a) applying a sufficient amount of an aqueous, transparent, leave-on hair conditioning composition to hair to impart a physical or esthetic property to the hair, said leave-on hair conditioning composition comprising:

(i) capsules having a diameter of about 425 to about 2800 microns, said capsules comprising:

(A) a water insoluble conditioning compound encapsulated in

(B) a shell material;

(ii) a suspending agent to suspend the capsules; and

(iii) a carrier comprising water;

(b) breaking the capsules while the capsules are in contact with the hair to release the water insoluble conditioning compound;

(c) while simultaneously disintegrating the shell material into residual particles having a diameter of about 10 microns or less; and

(d) allowing the hair conditioning composition and the residual particles of shell material to remain in contact with the hair at least until the next hair shampooing.

19. A method of treating the hair comprising:

Appeal No. 1995-4072
Application No. 08/105,008

(a) applying a sufficient amount of an aqueous, transparent, leave-on hair protectant composition to hair to impart a physical or esthetic property to the hair, said leave-on hair protectant composition comprising:

(i) capsules having a diameter of about 425 to about 2800 microns, said capsules comprising:

(A) a water insoluble hair protectant compound encapsulated in

(B) a shell material;

(ii) a suspending agent to suspend the capsules; and

(iii) a carrier comprising water;

(b) breaking the capsules while the capsules are in contact with the hair to release the water insoluble hair protectant compound;

(c) while simultaneously disintegrating the shell material into residual particles having a diameter of about 10 microns or less; and

(d) allowing the hair protectant composition and residual particles of shell material to remain in contact with the hair at least until the next hair shampooing.

29. A method of treating the hair comprising:

(a) applying a sufficient amount of an aqueous, transparent, leave-on hair dye composition to hair to impart an esthetic property to the hair, said leave-on hair dye composition comprising:

(i) capsules having a diameter of about 425 to about 2800 microns, said capsules comprising:

Appeal No. 1995-4072
Application No. 08/105,008

(A) a water insoluble hair dye
encapsulated in

(B) a shell material;

(ii) a suspending agent to suspend the
capsules; and

(iii) a carrier comprising water;

(b) breaking the capsules while the capsules are
in contact with the hair to release the water insoluble hair
dye;

(c) while simultaneously disintegrating the shell
material into residual particles having a diameter of about 10
microns or less; and

(d) allowing the hair conditioning composition and the
residual particles of shell material to remain in contact with
the hair at least until the next hair shampooing.

As evidence of obviousness, the examiner relies on the
following prior art:

Vanlerberghe et al. (Vanlerberghe)	5,021,200	Jan. 4,
1991		
Noda et al. (Noda)	5,089,269	Feb. 18, 1992
		(filed May 27, 1988)

Claims 1, 2, 4 through 22, 24 through 32 and 34 through
38 stand rejected under 35 U.S.C. § 103 as unpatentable over
the disclosure of Noda. Claims 29 through 32 and 34 through
38 stand rejected under 35 U.S.C. § 103 as unpatentable over
the combined disclosures of Noda and Vanlerberghe.

Appeal No. 1995-4072
Application No. 08/105,008

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the examiner and appellant in support of their respective positions. This review leads us to conclude that the examiner's § 103 rejections are not well founded. Accordingly, we will not sustain the examiner's § 103 rejections for essentially those reasons set forth in the Brief and the Reply Brief. We add the following for emphasis and completeness.

The examiner has the initial burden of establishing a *prima facie* case of obviousness regarding each and every limitation recited in the appealed claims. To satisfy this burden, the examiner primarily relies on the disclosure of Noda.² See Answer, pages 2 and 3. The examiner, however, does not demonstrate that the Noda reference teaches, or would have suggested, (1) **aqueous, transparent, leave-on hair** conditioning, protectant or dye compositions; (2) a carrier comprising water; and (3) the residual particles

² The Vanlerberghe reference is relied upon to show that it would have been obvious to employ a dye in the capsule described in Noda.

Appeal No. 1995-4072
Application No. 08/105,008

(disintegrated fragments) resulting from the disintegration of capsules having a diameter of about 425 to about 2800 microns being equal to or less than about 10 microns³.

The examiner, for example, refers to the descriptions at column 18, line 45, and column 19, line 20, of the Noda disclosure for an aqueous, transparent composition. See Answer, page 5. However, nowhere do such descriptions provide an aqueous transparent **composition**. The descriptions relied upon by the examiner are directed to a transparent capsule wall film, not the transparent composition.

The examiner also does not indicate where Noda describes a carrier containing water. Nor does the examiner explain why the use of water as a carrier in the composition described in Noda would have been obvious to one of ordinary skill in the art. The examiner simply ignores appellant's argument

³ We determine that the appealed claims require all fragments resulting from the disintegration of capsules having a diameter of about 425 to about 2800 microns be equal to or less than 10 microns. This interpretation is consistent with the description at pages 17 and 18 of the specification. Note also that the arguments advanced by both the examiner and appellant in the Answer, the Brief and the Reply Brief support this interpretation.

Appeal No. 1995-4072
Application No. 08/105,008

regarding a carrier containing water at page 5 of the Reply Brief.

Further, although the examiner recognizes that Noda does not describe the claimed residual particle sizes, it appears that the examiner takes the position that such sizes are inherent in the method described in Noda. See Answer, page 3. The examiner attempts to equate Noda's residual particles creating "no feeling of foreign matter" with the claimed residual particle sizes. However, there is no evidence that residual particles which must produce "no feeling of foreign matter" on people must necessarily be in the claimed particle sizes (about 10 microns or less).

In view of the foregoing, we conclude on this record that the examiner's findings of fact are simply insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103. Accordingly, we reverse the examiner's decision rejecting claims 1, 2, 4 through 22, 24 through 32 and 34 through 38 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

Appeal No. 1995-4072
Application No. 08/105,008

§ 1.136(a).

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
DOUGLAS W. ROBINSON)	
Administrative Patent Judge)	

jrg

Appeal No. 1995-4072
Application No. 08/105,008

Milton Honig
Unilever United States Inc.
Patent Department
45 River Road
Edgewater, N.J. 07020