

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte RICHARD T. MURPHY and WOLFGANG R. BERGMANN

Appeal No. 2001-1151
Application No. 08/605,651

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and SCHEINER, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 8, 19, 20, 29, 31 through 33 and 35. In Paper No. 17, received March 11, 1997, applicants proposed an amendment canceling claims 9, 10 and 12, which are the only other claims remaining in the application. In the advisory action mailed March 28, 1997 (Paper No. 18), the examiner stated that applicants' proposed amendment canceling claims 9, 10 and 12 "will be entered upon filing of a Notice of Appeal and an Appeal Brief." We note, however, that the cancellation of those claims has not yet been physically entered in the file.

REPRESENTATIVE CLAIM

Claim 3, which is illustrative of the subject matter on appeal, reads as follows:

3. A cosmetic stick product consisting of a solid organic matrix comprising the following parts by weight of ingredients:

| | |
|-----------------------|-------|
| volatile oil | 10-55 |
| liquid emollient | 1-35 |
| low melting point wax | 20-30 |

and the solid organic matrix contains between about 0.5-20 weight percent of an encapsulated powder composition homogeneously dispersed therein, wherein the encapsulated powder composition comprises (1) discrete crystallites of at least one ingredient selected from alkali metal and ammonium bicarbonates, and (2) between about 0.1-20 weight percent of discrete crystallites of a fragrance ingredient; and wherein the crystallites are in the form of polymer surface-coated particles, and the crystallite ingredients have an average particle size in the range between about 5-80 microns [emphasis added].

THE PRIOR ART REFERENCES

In rejecting the appealed claims under 35 U.S.C. § 103, the examiner relies on the following prior art references:

| | | |
|--------------------------|-----------|---------------|
| Murphy et al. (Murphy) | 5,376,362 | Dec. 27, 1994 |
| Morehouse | 5,354,559 | Oct. 11, 1994 |
| Barr et al. (Barr) | 5,354,737 | Oct. 11, 1994 |
| Deckner et al. (Deckner) | 4,919,934 | Apr. 24, 1990 |

THE REJECTIONS

Claims 1 through 4, 6 through 8, 19, 20, 29, 31 through 33 and 35 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Murphy, Morehouse and Barr. Claim 5 stands separately rejected under the same statutory provision as unpatentable over the same combination of references, further taken in view of Deckner.

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials:

- (1) the instant specification, including all of the claims on appeal;
- (2) applicants' Appeal Brief (Paper No. 20);
- (3) the Examiner's Answer (Paper No. 21); and
- (4) the above-cited prior art references.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejections under 35 U.S.C. § 103.

DISCUSSION

We agree with the examiner's finding that Murphy here constitutes the closest prior art. Murphy discloses every feature of the subject matter sought to be patented in claim 3 except the limitation "(2) between about 0.1-20 weight percent of discrete crystallites of a fragrance ingredient; and wherein the crystallites are in the form of polymer surface-coated particles." As pointed out by the examiner, a perfume or fragrance may be included in the cosmetic stick product of Murphy (column 7, lines 14 through 18; column 9, lines 51 through 57; column 10, lines 20 through 23; column 10, lines 27 through 48). Murphy does not, however, disclose discrete crystallites of a fragrance ingredient where the crystallites are in the form of polymer surface-coated particles.

In an effort to bridge that gap, the examiner relies on Morehouse. The examiner argues that a person having ordinary skill would have been motivated to modify

Murphy's product by encapsulating the perfume or fragrance ingredient with a starch hydrolyzate acid ester, per the teachings of Morehouse, "to improve stability against oxidation" (Examiner's Answer, page 4, second paragraph). By modifying Murphy's cosmetic stick product in this manner, the examiner argues, a person having ordinary skill in the art would have arrived at the subject matter sought to be patented in claim 3. We disagree.

In our judgment, the examiner's analysis is flawed. The only apparent reason a person having ordinary skill would have looked to Morehouse's technology, to improve Murphy's product, is if the perfume or fragrance of Murphy were subject to an undesirable degree of oxidation. In other words, if the perfume or fragrance ingredient were subject to oxidation in Murphy's cosmetic stick product, producing an undesirable odor, then a person having ordinary skill would have looked to the technology disclosed by Morehouse to resolve that problem. In that event, it would have been logical to apply the teachings of Morehouse to encapsulate the perfume or fragrance of Murphy in the manner proposed by the examiner.

On this record, however, the examiner has not entered a finding that perfume or fragrance, in the cosmetic stick product of Murphy, is subject to an undesirable degree of oxidation. Nor is it apparent that this would be the case, in view of the solid organic matrix disclosed by Murphy. We therefore find that the combination of Murphy and Morehouse, essential to the rejection of all the appealed claims, is improper. The remaining references relied on by the examiner, Barr and Deckner, do not cure the

above-noted deficiency, i.e., the improper combination of Murphy and Morehouse.

Accordingly, we reverse both section 103 rejections on appeal.¹

The examiner's decision is reversed.

REVERSED

Sherman D. Winters
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

Toni R. Scheiner
Administrative Patent Judge

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ELD

¹ In the text, we have focused attention on independent claim 3 because Murphy discloses every feature of the subject matter sought to be patented in claim 3 except for one claim limitation. Independent claims 1 and 29 include that same limitation, and differ from Murphy additionally in view of the recitation "wherein at least about 10 weight percent of the encapsulated particles have a core content of both bicarbonate and fragrance crystallites." A fortiori, the section 103 rejection of all claims on appeal must fall in view of the improper combination of Murphy and Morehouse.

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