

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte THOMAS J. KLOFTA and ALRICK V. WARNER

Appeal No. 2001-1242
Application No. 08/530,650

HEARD: February 5, 2001

Before ADAMS, MILLS and GRIMES, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3, 8-12 and 14-25, which are all of the claims pending in this application.

Claims 1 and 22 are illustrative of the claims on appeal and read as follows:

1. A lotion composition for treating tissue paper which is semi-solid at 20EC and which comprises:

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(A) from about 20 to about 95% of a substantially water free petrolatum emollient having a plastic or fluid consistency at 20EC;

(B) from about 5 to about 80% of an agent capable of immobilizing said petrolatum emollient on the surface of tissue paper treated with the lotion composition, said immobilizing agent having a melting point of at least about 35EC and comprising a member selected from the group consisting of C₁₄-C₂₂ fatty alcohols, C₁₂-C₂₂ fatty acids, and mixtures thereof;

(C) from about 1 to about 50% of a nonionic hydrophilic surfactant having an HLB value of at least about 4, wherein said hydrophilic surfactant is selected from the group consisting of ethoxylated alcohols having an alkyl chain of from about 8 to 22 carbon atoms and having an average degree of ethoxylation ranging from about 1 to about 54, ethoxylated sorbitan esters of C₁₂-C₁₈ fatty acids having an average degree of ethoxylation of from about 2 to about 20; and

(D) from about 1 to about 50% of an additional hydrophilic surfactant selected from the group consisting of dioctyl ester of sodium sulfosuccinic acid, silicone polyether copolymer, and mixtures thereof.

22. The composition of claim 14, wherein said additional hydrophilic surfactant is a silicone polyether copolymer.

The prior art references relied upon by the examiner are:

Buchalter	3,896,807	Jul. 29, 1975
Dake et al (Dake)	4,112,167	Sep. 5, 1978
Lavash	4,513,051	Apr. 23, 1985
Ampulski et al (Ampulski)	5,164,046	Nov. 17, 1992

Grounds of Rejection

Claims 1-3, 8-12 and 14-25 stand rejected under 35 U.S.C. § 103 over Buchalter, alone or in combination with Dake and/or Lavash.

Claims 22 and 24 stand rejected under 35 U.S.C. § 103 over Buchalter, by itself or in combination with Dake and/or Lavash, further in view of Ampulski of record.

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We reverse these rejections.

DISCUSSION

In reaching our decision in this appeal, we have given consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the noted rejections, we make reference to the examiner's Answer for the examiner's reasoning in support of the rejections, and to the appellants' Brief and Reply Brief for the appellants' arguments thereagainst. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 103

Claims 1-3, 8-12 and 14-25 stand rejected under 35 U.S.C. § 103 over Buchalter, alone or in combination with Dake and/or Lavash. Claims 22 and 24 stand rejected under 35 U.S.C. § 103 over Buchalter, by itself or in combination with Dake and/or Lavash, further in view of Ampulski of record.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). It is well-established that the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of

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ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In appropriate circumstances, a single prior art reference can render a claim obvious. See, e.g., B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). However, there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion. See B.F. Goodrich, 72 F.3d at 1582, 37 USPQ2d at 1318. This suggestion or motivation may be derived from the prior art reference itself, O'Farrell, 853 F.3d at 902, 7 USPQ2d at 1680, from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996); see also Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997) ("[T]he suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art."). Determining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness. With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

According to the examiner, Buchalter discloses (Answer, page 3):

formulations for treating tissue papers. The formulations comprise petrolatum (instant A), fatty alcohols (instant B), sorbitan esters (instant C) and dioctyl sodium sulphosuccinate (instant D).... As is evident from column 3, line 30 et seq., the oily component which includes petrolatum and isopropyl palmitate (a fatty acid ester) is from 1-99 %) and the emulsifier's amount is from 1-70%. Buchalter however, does not teach the amounts of specific surfactants. In the absence of a showing of unexpected results, the amounts are deemed to be parameters which an artisan manipulates to obtain the best possible results. An artisan would be motivated to use the instant amounts, particularly in view of Dake and Lavash who teach the use of the combination of emollients and surfactants in instant amounts for treating tissue papers (note the abstract, columns 9-10 and examples of Dake; column 6 and examples of Lavash.)

The examiner also acknowledges that none of the references teach silicone polyethers as the additional surfactant (Claims 22 and 24). However, the examiner argues the references teach generic surfactants and the use of an art known surfactant would be obvious to an artisan with the expectation of similar results.

In response to this rejection, appellants argue that the examiner has failed to establish a prima facie case of obviousness as the examiner has failed to identify the motivation for combining the various teachings within the Buchalter reference to arrive at appellants' claimed invention. Appellants punctuate this point arguing, "there was simply no motivation in any of the these references to combine two surfactants within the descriptions of Appellants' components (C) and (D). And finally there was no motivation to combine this surfactant system with an emollient and an immobilizing [agent] per the limitations of Appellants' claims." Brief, page 6.

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The examiner responds to appellants' arguments regarding lack of motivation, suggesting that, "since all the claimed components A-D are taught by Buchalter and the secondary references are suggestive of the combination of Buchalter's components in the instant amounts", a prima facie case has been established and the motivation for combination of the references articulated. Answer, pages 6-7.

On the facts and record before us, we find that the examiner has not established a prima facie case of obviousness. To begin, we find the examiner has mischaracterized the disclosure of Buchalter. Buchalter describes an article impregnated with skin-care formulations comprising an oil phase. The article may include tissue or toilet tissue. Column 3, lines 27-29. The oil phase which is in the form of a dry non-oily solid carried by the article of the invention comprises from about 1 to about 99% and preferably from about 30 to about 70% of an oily material and from about 99 to about 1% and preferably from about 70 to about 30% of an emulsifier. Column 3, lines 30-35. Thus, the formulation of Buchalter has primarily two components, an oil phase and an emulsifier. Examples of the oily material include petrolatum. Column 3, line 37. The emulsifying agent may include anionic emulsifiers, cationic emulsifiers and non-ionic emulsifiers. Examples of emulsifiers include cetyl alcohol as well as any one of those classified in four listed groups. Column 3, lines 42-50. These groups include long chain fatty acid partial esters of a hexitol anhydride, polyoxyalkylene derivatives of any one or any mixture of the indicated hexitol anhydride long chain fatty acid partial esters, polyoxyalkylene derivatives of glycol

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long chain fatty acid monoester and soaps of aliphatic acids, alkyl aryl sulfonates, alkyl aryl polyethersulfonates, fatty alcohol sulfates and sulfonic acid compounds. Examples of anionic emulsifiers are provided as well as other suitable emulsifiers. Column 4, lines 45-54. Thus, Buchalter primarily describes selection of a single emulsifier and does not appear to contemplate the specific surfactant mixture (C) and (D), as claimed.

In addition, according to Buchalter, "the oil phase may also include emollients such as cetyl alcohol which also functions as a stiffening agent, as well as film formers, deodorants, opacifiers, astringents, solvents and the like. In addition, stabilizers can be added to enhance the shelf life of the oil phase such as non-ionic surfactants, cellulose derivatives, protein and lecithin. All of the above types of materials are known in the art as additives for cream formulations." Column 5, lines 34-45.

However, what is missing from the examiner's analysis is specific evidence of reason, suggestion or motivation, as to why one of ordinary skill in the art would have been motivated to modify the disclosure of Buchalter to combine the two surfactants within the descriptions of appellants' components (C) and (D) or to combine this surfactant system with an emollient and an immobilizing agent, as claimed.

In cases such as this where a single prior art reference is alleged to render the claimed invention obvious, there must be a sufficient showing of a suggestion or motivation for any modification of the teachings of that reference necessary to reach the claimed invention in order to support the obviousness conclusion. Sibia Neuroscis., Inc. v. Cadus

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Pharm. Corp., 225 F.3d 1349, 1356, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000); B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). We agree with the appellants that the examiner has failed to provide necessary motivation to modify the disclosure of Buchalter to arrive at the claimed invention. Instead, in our opinion the examiner has picked and chosen from the individual components listed within Buchalter to arrive at the claimed lotion composition for treating tissue paper. This, however, is impermissible within the framework of section 103. In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also In re Mercier, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975).

We also do not find that the secondary references cited, Dake, Lavash or Ampulski overcome the deficiencies of Buchalter, or that the examiner has provided sufficient reason, suggestion or motivation for modification of Buchalter in view of the disclosures of Dake and Lavash, in a manner which would have rendered obvious the claimed invention.

The examiner, in essence argues that the motivation for combination of the references lies in the fact that all compositions are generally for the treatment of toilet tissue and that it is within the skill of the ordinary artisan to manipulate the amounts of the components of Buchalter to obtain the desired fluid nature of the composition to obtain the best possible results. Answer, pages 6 and 8. While the motivation to combine references does not have to be identical to patent owner's to establish obviousness, In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996), a reason,

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suggestion or motivation for modification of Buchalter by those of ordinary skill in the art at the time of the invention should be articulated by the examiner. For example, the appellants urge that the presence of an immobilizing agent provides "lotion compositions that do not exhibit undesired migration into paper-based substrates to which they are applied." Brief, page 3. Further, appellants state that the specifically claimed hydrophilic surfactants provide for a highly wettable paper product which makes substrates treated with the composition, especially suitable for use as toilet tissue. Id. The examiner does not indicate that either Buchalter or the secondary references suggest such a motivation for modification of the disclosure of Buchalter or explain what other specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the claimed surfactant combination or other modification of Buchalter.

Identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

In addition, the Federal Circuit has stated that "[the] mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re

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Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The Federal Circuit also has found that if a rote invocation of a high level of skill in the art could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. “To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.” In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Moreover, the use of hindsight in the selection of references that comprise the case of obviousness is forbidden. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

In the present case, the examiner has failed to indicate the specific understanding or principle within the knowledge of a skilled artisan, explicit or implicit, that would have motivated one with no knowledge of appellant’s invention to make the combination in the manner claimed. In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

The rejection of claims 1-3, 8-12 and 14-25 under 35 U.S.C. § 103 over Buchalter, alone or in combination with Dake and/or Lavash is reversed. The rejection of claims 22 and 24 under 35 U.S.C. § 103 over Buchalter, by itself or in combination with Dake and/or Lavash, further in view of Ampulski is reversed.

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CONCLUSION

The examiner's rejection of claims 1-3, 8-12 and 14-25 under 35 U.S.C. § 103 over Buchalter, alone or in combination with Dake and/or Lavash is reversed. The rejection of claims 22 and 24 under 35 U.S.C. § 103 over Buchalter, by itself or in combination with Dake and/or Lavash, further in view of Ampulski is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

DONALD E. ADAMS
Administrative Patent Judge

DEMETRA J. MILLS
Administrative Patent Judge

ERIC GRIMES
Administrative Patent Judge

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