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for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JOERG KAHRE,
HERMANN HENSEN,
THOMAS MUELLER-KIRSCHBAUM,
DAGMAR GOEBELS, and
HOLGER TESMANN

Appeal No. 2001-2395
Application No. 09/433,198

ON BRIEF

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

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 13 through 19, which are all of the claims remaining in the application.

Representative Claim

Claim 13, which is illustrative of the subject matter on appeal, reads as follows:

13. A process of treating washed hair to provide said hair with improved combability, comprising contacting said hair with a water-based composition comprising:

(a) from 0.1 to 3% by weight of a zwitterionic polymer,

(b) from 0.01 to 10% by weight of an alkyl polyglycoside corresponding to formula (I):

$$RO\text{-}(Z)_x \qquad (I)$$

in which

R is an alkyl radical containing 6 to 22 carbon atoms,

Z is a mono- or oligosaccharide,

x is a number of 1.1 to 5,

or adducts thereof with 1 to 10 moles of ethylene oxide or propylene oxide,

(c) from 0.5 to 20% by weight of a fatty alcohol; and

(d) the balance, water.

The Prior Art Reference

In rejecting the appealed claims on prior art grounds, the examiner relies on the following reference:

Müller et al. (Müller) WO 91/03229 Mar. 21, 1991[1]

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[1] In evaluating the merits of this case, we have relied on a PTO translation of the Müller reference prepared in February 2000 (copy enclosed with this opinion). When we discuss specific passages or portions of the Müller reference, we shall refer to the pagination as it appears in the PTO translation.

The Rejections

Claims 13 through 19 stand rejected under 35 U.S.C. § 102(b) as described by Müller.

Claims 13 through 19 further stand rejected under 35 U.S.C. § 103(a) as unpatentable over Müller.

Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including claims 13 through 19 on appeal; (2) applicants' Appeal Brief (Paper No. 13) and the Reply Brief (Paper No. 15); (3) the Examiner's Answer (Paper No. 14); (4) the Hensen declaration, filed under the provisions of 37 CFR § 1.132, executed May 26, 2000; and (5) the above-cited Müller reference.

On consideration of the record, including the above-listed materials, we reverse the examiner's prior art rejections.

35 U.S.C. § 102(b)

Independent claim 13 recites a process of treating washed hair, to provide said hair with improved combability, by contacting said hair with a water-based composition comprising (a) from 0.1 to 3% by weight of a zwitterionic polymer; (b) from 0.01 to 10% by weight of an alkyl polyglycoside; (c) from 0.5 to 20% by weight of a fatty alcohol; and

(d) the balance, water. Applicants' alkyl polyglycoside has the following formula:

$$RO\text{-}(Z)_x \qquad (I)$$

where R is an alkyl radical containing 6 to 22 carbon atoms, Z is a mono- or oligosaccharide, and x is a number of 1.1 to 5, or adducts thereof with 1 to 10 moles of ethylene oxide or propylene oxide.

We agree with the examiner's finding that Müller constitutes relevant prior art. Müller's process of treating washed hair, using aqueous hair care preparations containing zwitterion polymerizates, is similar to the instantly claimed process. We disagree, however, that Müller constitutes an anticipatory reference within the meaning of 35 U.S.C. § 102(b).

Müller does not clearly and unequivocally describe a water-based composition comprising (a) a zwitterionic polymer; (b) an alkyl polyglycoside; (c) a fatty alcohol; and (d) the balance, water, as recited in independent claim 13. In Example 2.5, Müller describes a hair rinse containing, <u>inter alia</u>, a zwitterionic polymer, fatty alcohol, and water <u>but no alkyl polyglycoside</u>. By the same token, in Example 2.8, Müller describes a hair shampoo containing a zwitterionic polymer, alkyl glucoside APG-600, and water <u>but no fatty alcohol</u>. We have also reviewed the broader passages in Müller's text, but do not find a description of applicants' water-based compositions. For example, Müller discloses aqueous preparations for cleaning and care of hair containing zwitterionic polymers and "all aids or additives that are customary for the particular purpose"

(page 12, lines 9 and 10). Elaborating on "aids or additives . . . customary for the particular purpose," Müller describes, e.g., hair rinses containing a zwitterionic polymer;

a fatty alcohol with 12 to 22 carbon atoms; a cationic surfactant; and water (page 12, lines 11 through 15). Müller does not describe a hair rinse containing (1) a zwitterionic polymer, a fatty alcohol, a nonionic surfactant, and water or (2) a zwitterionic polymer, a fatty alcohol, an alkyl polyglycoside, and water.[2]

Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically described in the prior art. Here, for the examiner's rejection to have been proper, Müller must clearly and unequivocally disclose the claimed process without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be proper, on the particular facts of a given case, in making a § 103 obviousness rejection; but have no place in making a § 102 anticipation rejection. In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972).

The rejection of claims 13 through 19 under 35 U.S.C. § 102(b) as described by Müller is reversed.

35 U.S.C. § 103(a)

The examiner argues that the process sought to be patented in claims 13 through 19 would have been obvious within the meaning of 35 U.S.C. § 103(a) based

[2] As pointed out by the examiner (Answer, page 6, first full paragraph), Müller discloses that his "alkyl (oligo)-glucosides" are nonionic surfactants. See Müller, page 11, lines 13 and 14.

on teachings found in Müller. We disagree.

Müller does not disclose or suggest applicants' water-based composition, recited in each claim on appeal. On the contrary, Müller discloses, in relevant part, hair rinses containing a zwitterionic polymer; a fatty alcohol with 12 to 22 carbon atoms; a cationic surfactant; and water (page 12, lines 11 through 15). Müller does not disclose or suggest an aqueous preparation for cleaning and care of hair containing a zwitterionic polymer; a fatty alcohol; an alkyl polyglycoside; and water. Again, as pointed out by the examiner, Müller discloses that "alkyl(oligo)-glucosides" are nonionic surfactants. See footnote 1, supra. It is only with the benefit of hindsight, we believe, using applicants' specification as a blueprint, that a person having ordinary skill would have arrived at the water-based composition recited in claims 13 through 19.

For these reasons, we conclude that the examiner failed to establish a prima facie case of obviousness of claims 13 through 19 over Müller. We find it unnecessary to discuss the Hensen declaration, filed under the provisions of 37 CFR § 1.132, relied on by applicants as rebutting any such prima facie case.

The rejection of claims 13 through 19 under 35 U.S.C. § 103(a) as unpatentable over Müller is reversed.

Other Issue

One further matter warrants attention.

On return of this application to the examining corps, we recommend that both applicants and the examiner re-evaluate the patentability of claims 13 through 19 in

light of U.S. Patent No. 6,056,947 ('947) issued May 2, 2002 to Kahre et al. In particular, we invite attention to claim 2 of the '947 patent where "component (a) is selected from the group consisting of amphoteric and zwitterionic polymers" (emphasis added). It would appear that the claims of U.S. Patent No. 6,056,947 (1) bear close relationship to claims 13 through 19 in this application; and (2) may provide basis for an obviousness-type double patenting rejection of claims 13 through 19 in this application. We think it best that the examiner address this issue in the first instance. If, on reflection, the examiner believes that an obviousness-type double patenting rejection of claims 13 through 19 is appropriate, the examiner should issue an Office action setting forth such rejection and giving applicants an opportunity to respond. A copy of U.S. Patent No. 6,056,947 is enclosed with this opinion.

Conclusion

In conclusion, for the reasons set forth in the body of this opinion, we do not sustain the examiner's rejections of claims 13 through 19 under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a). On return of this application to the examining corps, we recommend that applicants and the examiner re-evaluate the patentability of claims 13 through 19 in light of U.S. Patent No. 6,056,947.

The examiner's decision is reversed,

REVERSED

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Sherman D. Winters)

Administrative Patent Judge	)
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	) BOARD OF PATENT
William F. Smith	)
Administrative Patent Judge	) APPEALS AND
	)
	) INTERFERENCES
Eric Grimes	)
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