

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte CHRISTOPHER J. TARLETSKY, RICHARD J. NADOLSKY
and SHAWN L. MYERS

Appeal No. 2002-0099
Application No. 08/864,009

ON BRIEF

Before WINTERS, MILLS, and GRIMES, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 46, which are all of the claims pending in the application.

THE INVENTION

The invention relates to a process for preparing a composition of enhanced viscosity by adding a high molecular weight solid monocarboxylic acid, having a number average molecular weight between about 300 and about 3,000, to a liquid oil. The

resulting composition, having particular applicability in the cosmetic and pharmaceutical industries, is considerably more viscous than compositions of the prior art.

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A composition for topical application to skin and mucous membranes adjacent the skin, said composition containing:

- (A.) an oil selected from the group consisting of linear and branched chain hydrocarbons, cyclic hydrocarbons, aromatic hydrocarbons, naturally occurring hydrocarbon mixtures, a C₆ to C₁₈ carboxylic acid and triglycerides thereof, esters of an aromatic carboxylic acid and a C₆ to C₁₈ alcohol, esters of a lower fatty acid and an alcohol, silicone compounds and mixtures thereof; and
- (B.) a rheologically effective amount of a solid monocarboxylic acid having a number average molecular weight between about 300 and about 3,000.

THE PRIOR ART REFERENCES

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

Krzysik et al. (Krzysik)	5,288,482	Feb. 22, 1994
UNICID	Trademark Reg. No. 1935576	Nov. 14, 1995

THE ISSUE

The examiner suggests that “the metes and bounds of the instant claimed invention” are unclear (Paper No. 19, page 5). However, no appealed claim stands rejected under 35 U.S.C. § 112, second paragraph; accordingly, the issue of claim indefiniteness is not before us.

Furthermore, the specification stands objected to “as failing to provide proper antecedent basis for the claimed subject matter” (Paper No. 19, page 3). According to the examiner, “[t]here lacks antecedent basis [in the specification] for the recitation of “rheologically effective amount” [in claims 1 through 46]” (Paper No. 19, page 4). Again, however, the examiner has not entered a rejection of any claim on this ground. The examiner has not rejected any claim or claims under 35 U.S.C. § 112, first paragraph, for lack of adequate written, descriptive support in the original specification for the limitation “rheologically effective amount.” Accordingly, the issue of written descriptive support is not before us, and we have no authority to review the examiner’s mere objection to the specification. See 35 U.S.C. § 134(a) (an applicant for patent, any of whose claims has been twice rejected, may appeal from the decision of the [examiner] to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal); MPEP § 2163.06 (a rejection of claims is reviewable by the Board of Patent Appeals and Interferences, whereas an objection and requirement to delete new matter is subject to supervisory review by petition under 37 CFR § 1.181. If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition); and In re Hengehold, 440 F.2d 1395, 1403, 169

USPQ 473, 479-80 (CCPA 1971) (there are a host of decisions an examiner makes in the examination proceeding -mostly matters of a discretionary, procedural, or non-substantive nature - which are not appealable to the board when not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner; adverse decisions of examiners reviewable by the board must be those which are related, at least indirectly, to matters involving the rejection of claims).

The issue presented for review is whether the examiner erred in rejecting claims 1 through 46 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Krzysik and UNICID.

DELIBERATIONS

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

- (1) the instant specification, including Figures I, II, III, and IV, and all of the claims on appeal;
- (2) applicants' Appeal Brief (Paper No. 18);
- (3) the Examiner's Answer (Paper No. 19); and
- (4) the above-cited prior references.

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

DISCUSSION

The examiner argues that Krzysik discloses every feature of the subject matter sought to be patented in claims 1 through 46 except for a rheologically effective amount of a solid monocarboxylic acid having a number average molecular weight between about 300 and about 3,000. According to the examiner, Krzysik's lipstick products contain one or more emollients, which are "functionally equivalent" (Paper No. 19, page 6). Turning to the UNICID reference, the examiner notes that UNICID discloses polymeric carboxylic acids "for use in the cosmetic industry as an emollient."¹ The examiner argues that a person having ordinary skill would have found it obvious to substitute UNICID's polymeric carboxylic acids for any of the "functionally equivalent" emollients disclosed by Krzysik. As stated in Paper No. 19, paragraph bridging pages 4 and 5, "it would have been obvious to one of ordinary skill in the art to use the emollient taught by UNICID in the invention of Krzysik to obtain a composition containing an emollient because emollients are soothing, softening, less harsh and less abrasive to the skin." Therefore, in view the combined disclosures of Krzysik and UNICID, the examiner argues that a person having ordinary skill in the art would have arrived at the subject matter sought to be patented in claims 1 through 46 including the recited, effective amount of a solid monocarboxylic acid having a number average molecular weight between about 300 and 3,000. We disagree.

We first address the examiner's conclusion that "it would have been obvious to one of ordinary skill in the art to use the emollient taught by UNICID in the invention of

¹ Commercially available high molecular weight solid carboxylic acids having the formula RCOOH, wherein R is a branched chain or linear saturated hydrocarbyl radical, may be used in applicants' claimed

Krzysik to obtain a composition containing an emollient because emollients are soothing, softening, less harsh and less abrasive to the skin” (Paper No. 19, paragraph bridging pages 4 and 5). That conclusion, we believe, is an example of ipse dixit reasoning. After all, the lipstick products of Krzysik already contain one or more emollients. See column 2, lines 44 through 64, disclosing numerous emollient oils which may be employed in Krzysik’s “lip care cosmetic composition.” Where, as here, Krzysik discloses numerous emollient oils for use in lipstick products, it is unclear why a person having ordinary skill would have wanted to use the particular emollient of UNICID in the lipstick of Krzysik “to obtain a composition containing an emollient.” Again, the lipstick products of Krzysik already contain one or more emollients which, according to the examiner, “are soothing, softening, less harsh and less abrasive to the skin.”

Second, as pointed out by applicants, Krzysik discloses the use of emollient oils in a lip care cosmetic composition (column 2, lines 44 through 64). UNICID discloses a solid monocarboxylic acid for use in the cosmetics industry as an emollient. Applicants argue, and it stands to reason, that “[t]he use of a solid emollient, rather than a liquid emollient, in the Krzysik composition presents significant challenges associated with solubility and homogeneity” (Paper No. 18, page 8, last paragraph). On this record, the examiner does not adequately address that argument. The examiner does not establish adequate reason, suggestion, or motivation stemming from the prior art which would have led a person having ordinary skill to use the solid emollient of UNICID rather than

invention. Such carboxylic acids are sold by Petrolite Polymers Division of Petrolite Corporation as UNICID carboxylic acids. See the instant specification, page 5.

a liquid emollient in the Krzysik composition. In our judgment, therefore, the examiner's rejection under 35 U.S.C. § 103(a) is predicated on the impermissible use of hindsight and cannot stand.

The rejection of claims 1 through 46 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Krzysik and UNICID is reversed.

REVERSED

Sherman D. Winters
Administrative Patent Judge

Demetra J. Mills
Administrative Patent Judge

Eric Grimes
Administrative Patent Judge

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