

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte CHARLES RUPERT TELFORD BROWN, PETER FAIRLEY,  
and STANLEY LAM

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Appeal No. 2002-1559  
Application No. 09/282,708

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ON BRIEF

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Before SCHEINER, MILLS, and GREEN, Administrative Patent Judges.

GREEN, 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 1-7 and 9-14. Claims 1 and 10 are representative of the subject matter on appeal, and read as follows:

1. A hair treatment composition which has a thickened fluid form comprising:
  - (i) a first phase comprising at least one naturally derived polymer which is capable of forming a reversible gel, which polymer is present in the composition as a shear gel having a multiplicity of separate gel particles which have been formed by subjecting the polymer to shear while gel formation takes place, and

(ii) a second phase suspended therein.

10. A method for treating hair which comprises contacting said hair with an effective amount of a composition according to claim 1.

The examiner relies upon the following references:

Vermeer	5,641,480	Jun. 24, 1997
Brown et al. (Brown)	EP 0 355 908	Dec. 12, 1996

Claims 1-3, 10 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Brown. Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by Brown. Claims 4, 5 and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Brown and Vermeer. Finally, claims 11-13 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Brown, Hawley and Vermeer. After careful review of the record and consideration of the issues before us, we affirm the rejection of claims 1-5 and 9-14, but reverse the rejection of claims 6 and 7<sup>1</sup> under 35 U.S.C. § 103(a) over Brown.

#### BACKGROUND

According to the specification, suspending agents are commonly used in hair treatment compositions to improve stability against phase separation and

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<sup>1</sup> We note appellants' statement that claim 7 stands or falls with claims 1-5. See Appeal Brief, page 11. Claim 7, however, was subject to a separate rejection than claims 1-3 and 4-5, and thus is treated with respect to the rejection with which it was included.

settling of suspended material. The specification notes that crystalline suspending agents and inorganic structurants are commonly used suspending agents, and states that “they can adversely affect lathering performance and impart an undesirably cloudy appearance to the composition,” and that “they tend to get co-deposited along with the ingredients it is desired to deposit, which can lead to dulling of the hair through excessive build up and reduced performance.” Id. at 1.

The specification teaches that a number of polymers of biological origin, such as agar, carrageenan, furcelleran, gellan and pectin, when in aqueous solution, form reversible gels, wherein they melt when heated but revert to a gel when cooled down. Id. at 2.

According to the specification,

hair treatment compositions comprising a continuous phase formed from such shear gels display excellent resistance to phase separation and settling of suspended materials. The shear gels are tolerant to the presence of surfactant, and may under some circumstances boost the conditioning performance of the hair treatment composition.

Id. at 4.

## DISCUSSION

### 1. Rejection under 35 U.S.C. § 102(b) over Brown

Claims 1-3, 10 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Brown.

We initially note that appellants assert that claims 10 and 14 do not stand or fall with composition claims 1-3. See Appeal Brief, page 11. Appellants do not, however, separately argue the patentability of those claims, so we focus our analysis on claim 1. See 37 CFR 1.192(c)(7).

According to the rejection, Brown teaches “liquid cosmetic compositions, including hair treatment compositions, comprising gelling polysaccharides (e.g. agar, carrageenan, gellan).” Examiner’s Answer, page 3. The rejection notes that the compositions of Brown may “also comprise other components and may contain two or more phases,” and that Brown specifically teaches that their compositions may be used as hair gels. See id. at 4.

We recognize that in order for a prior art reference to serve as an anticipatory reference, it must disclose every limitation of the claimed invention, either explicitly or inherently. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). It is our determination that Brown teaches a composition meeting all of the requirements of claim 1.

Claim 1 is drawn to a composition comprising a first phase comprising at least one naturally derived polymer which is capable of forming a reversible gel, which polymer is present in the composition as a shear gel having a multiplicity

of separate gel particles which have been formed by subjecting the polymer to shear while gel formation takes place, with a second phase therein. See claim 1.

Brown, as set forth by the rejection, teaches “a liquid-based composition comprising at least one gelling polysaccharide capable of forming a reversible gel,” and also teaches that the composition can comprise two or more phases. See Brown, pages 2 and 4. Thus, Brown teaches all of the components required by the claimed composition.

Appellants do not argue that Brown does not teach a composition comprising a first phase comprising at least one naturally derived polymer which is capable of forming a reversible gel, which polymer is present in the composition as a shear gel having a multiplicity of separate gel particles which have been formed by subjecting the polymer to shear while gel formation takes place, with a second phase therein. Rather, appellants argue that while Brown states that the gel composition may be used to create a product for personal care, such as a hair gel, Brown teaches that such products may be obtained if the right ingredients are added thereto, and Brown fails to teach what those right ingredients may comprise.

This argument is not found to be convincing because the claim only requires the gel composition, and does not require those other “right ingredients.” The statement in the preamble of “[a] hair treatment composition”

Moreover, even if we were to read the preamble as breathing life into the body of the claim, Brown, although admittedly teaching the use of the gel composition in a broad range of products, specifically teaches that the gel

composition may be used in a hair gel. See Brown, page 4, lines 50-55. Thus Brown teaches all of the elements of the claim—a gel composition as part of a hair treatment composition. Because the claim requires no more than the gel composition, and because Brown teaches that the gel composition may be used in a hair treatment composition such as a hair gel, the burden shifts to appellants to demonstrate that the gel composition taught by Brown would not be expected to have utility in a hair treatment composition or that one of ordinary skill would not know what the right ingredients are. See, e.g., In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) (noting that an anticipatory reference need only place the public in possession of the invention, and that such possession is achieved if one of ordinary skill could combine the reference with his own knowledge to make the claimed invention).

Appellants argue further that:

If this is a proper reading of Brown, then as stated at page 23, lines 11-14, Brown anticipates transparent or opaque emulsions, lotions, creams, pastes or gels. Brown further anticipates shampoos, conditioners and hair styling gels, and yet there is no explicit teaching in Brown for any of these compositions.

Moreover . . . under the present reading of Brown it could be said to read on all types of antiperspirant compositions. These would include, roll-ons, creams, soft solids, sticks, powders, sprays, and other antiperspirants. It cannot be that this is a proper reading of Brown when in fact Brown gives no specific examples or

concrete directions regarding the formation of antiperspirant materials.

Appeal Brief, pages 12-13. Appellants conclude that Brown does not disclose all the categories of final products to which it makes reference, therefore it does not fairly disclose the claimed compositions. See id. at 13.

We agree that Brown would fairly anticipate those other products if all that those products required was the gel composition taught by Brown. If the claim required additional ingredients, the burden would be on the office to demonstrate that the inclusion of those additional ingredients would have been obvious to one of ordinary skill in the art.

Moreover, Appellants appear to be arguing that the only way Brown could anticipate the claimed hair treatment composition is if it specifically provided an example of such a hair care composition. A reference need not have reduced to practice an invention, however, in order to serve as an anticipatory reference. See In re Siveramakrishnan, 673 F.2d 1383, 1384, 213 USPQ 441, 442 (CCPA 1982); In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985).

The rejection of claims 1, 2, 3, 10 and 14 under 35 U.S.C. § 102(b) over Brown is therefore affirmed.

2. Rejection under 35 U.S.C. § 103(a) over Brown

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being obvious over Brown.

Brown is relied upon as set forth above, and also for teaching the use of emulsifiers and cationic polymers. See Examiner's Answer, page 4.

According to the Examiner's Answer:

Brown [ ] do[es] not specifically teach shampoo compositions as claimed in Claim 6. However, the overall disclosure in Brown [ ] would have suggested to the artisan of ordinary skill that their compositions could be modified, depending on the desired properties of the final product. For example, Brown [ ] teach[es] that "in addition to the above ingredients conventionally used in products for personal care, the compositions according to the invention can optionally comprise ingredients such as colourant, preservative, antioxidant, in amounts which are conventional in the cosmetics, pharmaceutical etc." See p.5, line [sic] 52-54. In addition, Brown [ ] exemplif[ies] a cleanser gel. See p.10, Example 12.

Therefore, the reference clearly gives one a reasonable expectation of success for modifying the reference's composition in order to make a shampoo composition of the instant invention.

With respect to claim 7 of the instant invention, Brown [ ] do[es] not teach fatty alcohol. However, Brown [ ] teach[es] fatty ester (e.g. isopropyl myristate) and oils used for the same art-recognized purpose as fatty alcohols. Therefore, it would have been obvious to one of ordinary skill in the art at time of the invention to employ fatty alcohols with the reasonable expectation of deriving the same cosmetic effect as set forth in the references.

Id. at 4-5.

Appellants argue that claim 6, which is drawn to shampoos having specific ranges of surfactant and cationic deposition agent is not suggested by Brown.

With respect to claim 7, appellants argue that while Brown suggests adding fatty esters, the reference does not teach or suggest the addition of a fatty alcohol.

The burden is on the examiner to make a prima facie case of obviousness, and the examiner may meet this burden by demonstrating that the

prior art would lead the ordinary artisan 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, 1598-99 (Fed. Cir. 1988). The findings of fact underlying the obviousness rejection, as well as the conclusions of law, must be made in accordance with the Administrative Procedure Act, 5 U.S.C. 706 (A), (E) (1994). See Zurko v. Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999). Findings of fact underlying the obviousness rejection, upon review by the Court of Appeals for the Federal Circuit, must be supported by substantial evidence within the record. See In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). In addition, in order for meaningful appellate review to occur, the examiner must present a full and reasoned explanation of the rejection. See, e.g., In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1432 (Fed. Cir. 2002).

With respect to claim 6, the rejection does not address the limitation of the amount of surfactant in the shampoo composition as required by the claim, nor did it address the amount of a cationic deposition polymer set forth by the claim. All we have is the conclusory statement of the examiner, with no supporting evidence, that the disclosure of Brown “would have suggested to the artisan of ordinary skill that their composition could be modified, depending on the desired properties of the final product.” Examiner’s Answer, page 4. Conclusory statements as to teaching, suggestion or motivation to arrive at the claimed invention, however, do not adequately address the issue of obviousness. See Lee, 277 F.3d at 1343-44, 61 USPQ2d at 1433-34.

Similarly, with respect to claim 7, the rejection does not address the limitation of the amount of cationic surfactant in the hair treatment composition as required by the claim, nor did it address the amount of fatty alcohol as set forth by the claim. Again, all we have is the conclusory statement of the examiner, with no supporting evidence, that the disclosure of Brown teaches the use of fatty esters and oils “used for the same art-recognized purpose as fatty alcohols,” and that “it would have been obvious to one having ordinary skill in the art at the time of the invention to employ fatty alcohols with the reasonable expectation of deriving the same cosmetic effect as set forth in the references.” Examiner’s Answer, page 5.

Therefore, because the rejection fails to set forth a prima facie case of obviousness, the rejection of claims 6 and 7 under 35 U.S.C. § 103(a) over Brown is reversed.

3. Rejection under 35 U.S.C. § 103(a) over Brown and Vermeer

Claims 4, 5 and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Brown and Vermeer.

Again, we note that appellants assert that claim 9 does not stand or fall with claims 4 and 5. See Appeal Brief, page 11. Appellants, do not, however, separately argue the patentability of those claims, so we focus our analysis on claim 4.<sup>2</sup> See 37 CFR 1.192(c)(7); see also In re Dance, 160 F.3d 1339, 1340 n.2, 48 USPQ2d 1635, 1636 n.2 (Fed. Cir. 1998) (noting that dependent claims

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<sup>2</sup> Claim 9 is dependent on claim 4.

not argued separately on the merits rise or fall with the independent claim to which they relate).

Brown is relied upon as above. The rejection acknowledges that Brown does not teach the use of metal salts of pyridinethione as required by claims 4 and 9, and does not teach the pearlescent agent required by claim 5. See Examiner's Answer, page 5.

Vermeer is relied upon for teaching hair care compositions, such as shampoos and conditioners, which are in the form of thick liquids, e.g. gels, and for teaching that such compositions may contain pearlescent agents such as ethylene glycol stearates and titanium dioxide coated mica, and may also contain zinc pyridinethione and other agents. See id.

The Examiner's Answer concludes:

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use zinc pyridinethione and/or pearlescent agents of Vermeer for compositions of Brown [ ] for their art-recognized purpose.

Id.

Appellants argue that Vermeer merely adds that "one can use zinc pyridinethione and other hair care ingredients in its compositions," and that "[a]ny number of publications might have supplied this information." Appeal Brief, page 14. Appellants conclude that "[s]ince Brown fails to disclose the claimed treatment compositions, and makes only passing reference to hair gels, one skilled in the art would not combine the teachings of Brown and Vermeer, to arrive at the claimed compositions of claims 4, 5 and 9." Id. at 14-15.

As set forth above, we find that Brown does teach a hair care composition. Therefore, Brown provides the necessary teaching for adding ingredients to the gel composition that are routinely used in hair care compositions, such as those taught by Vermeer.

Therefore, the rejection of claims 4, 5 and 9 under 35 U.S.C. § 103(a) over the combined teachings of Brown and Vermeer is affirmed.

4 Rejection under 35 U.S.C. § 103(a) over Brown, Hawley and Vermeer

Claims 11-13 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Brown, Hawley and Vermeer.

Brown is relied upon as above, and for also teaching that “nonionic, anionic or cationic emulsifiers can be used in their compositions.” Examiner’s Answer, page 6. Hawley is relied upon for teaching that “emulsifiers are surfactants by definition.” Id. The Examiner’s Answer acknowledges that “Brown [ ] do[es] not specifically teach the anionic surfactants of Claims 11-13.” Id.

Vermeer is relied upon for teaching that the claimed anionic surfactants are commonly used in hair care compositions. The Examiner’s Answer concludes:

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to employ the anionic surfactants or Vermeer for the hair care compositions of Brown [ ] for their art-recognized purpose.

Id.

Appellants argue that Hawley “comes no closer to suggesting the claimed hair treatment compositions,” and that the rejection should be withdrawn for the same reasons already discussed.

Appellant’s arguments are not found to be convincing for the reasons given above with respect to the rejections of claims 1-5, 9, 10, 12 and 14.

Therefore, the rejection is affirmed.

AFFIRMED-IN-PART; REVERSED-IN-PART

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Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Demetra J. Mills	)	
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