

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANJEEV MIDHA, SHARI RENEE THOMSON,
and MICHAEL ALBERT SNYDER

Appeal No. 2004-0369
Application No. 09/822,704

ON BRIEF

Before TIMM, GRIMES, and GREEN, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-3, 6-18, 20, and 22-26. Claims 4, 5, 19, 21, and 26-34, the only other claims pending in the application, have been withdrawn from consideration by the Examiner pursuant to an election/restriction requirement. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to a composition containing non-spherical microparticles, a polymer, and a carrier. According to the specification, one example of microparticles meeting the requirements of the claims is Laponite™, a synthetic hectorite (specification, p. 5, ll. 23-26 and p. 6, ll. 17-18). Claim 1 is illustrative of the subject matter on appeal:

1. A leave-in hair cosmetic composition, comprising non-spherical microparticles exhibiting a mean particle size of less than about 100µm in its longest dimension, a water-soluble or water-swellaable polymer and aqueous carrier, wherein the combination of the polymer and the microparticles results in a film-forming network.

The Examiner rejects some of the claims under 35 U.S.C. § 112, ¶ 1. All of the claims are rejected under 35 U.S.C. § 103(a).¹ As evidence of obviousness, the Examiner relies upon the following prior art references:

Hinks (International Application published under the PCT)	WO 93/07855	Apr. 29, 1993
Allec et al. (Allec)	5, 660,839	Aug. 26, 1997
Dupuis	6,261,578B1	July 17, 2001

The specific rejections are as follows:

1. Claims 10-12, 24, and 25 stand rejected as lacking compliance with the enablement requirement of 35 U.S.C. § 112, ¶ 1. The Examiner's reasoning is presented in the Final Rejection, Paper No. 9 (Answer, p. 3).

¹A rejection of claim 7 under 35 U.S.C. § 112, ¶ 2 was withdrawn (Answer, p. 2).

2. Claims 1-3, 6-18, 20, and 22-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dupuis in view of Hinks and further in view of Allec. The Examiner's reasoning is presented in the Final Rejection, Paper No. 9 (Answer, p. 3).

We reverse with respect to the rejection under 35 U.S.C. § 112, ¶ 1, but affirm with respect to the rejection under 35 U.S.C. § 103(a). Because our reasons differ from those of the Examiner, we designate our affirmance as involving a new ground of rejection. Our reasons follow.

OPINION

Enablement

There are two groups of claims rejected under the enablement requirement of § 112, ¶ 1. The first group, claims 10-12, is directed to the surface modification of microparticles. These claims require the surface be modified with a charge, hydrophobic functional groups, hydrophilic function groups, or a combination thereof. The second group, claims 24 and 25, are directed to the surface modification of microspheres. Claim 24 requires the surface be modified by attachment of an ionic group. Claim 25 requires the surface be modified by attachment of an organic or inorganic material.

The Examiner concludes that the claims are not in compliance with the enablement requirement of § 112, ¶ 1 based on an analysis of various *Wands* factors. *See In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)(Factors to take into consideration include: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance

presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.). Specifically, the Examiner concludes that undue experimentation would be necessary to modify the surfaces of the microparticles and microspheres as claimed because the level predictability in the art is unknown, there is no guidance in the specification for modifying the surfaces, and there are no working examples (Final Rejection, pp. 4-5).

Appellants, however, argue that the specification includes a discussion of how to accomplish microparticle surface modification at page 6, lines 22-27 and how to accomplish microsphere surface modification at page 16, lines 2-5 (Brief, p. 4). These two sections of the specification read as follows:

The surface of the microparticles of the present invention can be modified with a charge or at least one functional group that is hydrophobic or hydrophilic or a combination thereof. The surface charge can be through a static development or with the attachment of various ionic groups directly or linked via short, long or branched alkyl groups.
(specification, p. 6, ll. 23-27).

The surface of the microsphere may be charged through a static development or with the attachment of various ionic groups directly or linked via short, long or branched alkyl groups.
(specification, p. 16, ll. 2-4).

The burden is on the examiner to advance acceptable reasoning inconsistent with enablement. *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982). We

cannot agree that the Examiner has met that burden. While the Examiner states that there is no guidance in the specification for modifying the surfaces of the microparticles and microspheres, the portions of the specification cited by Appellants do provide guidance. These portions of the specification state that modification can be accomplished by static development or attachment of chemical groups. The Examiner provides no reason to doubt the objective truth of these statements in the specification and such a general discussion of the method can satisfy the enablement requirement. *See In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971) and *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

Obviousness

The Examiner rejects all the claims as obvious over the combination of Dupuis, Hinks and Allec.

Dupuis describes a composition containing thickening and/or gelling polymers (Dupuis, col. 1, ll. 40-41) and an aqueous carrier (Dupuis, col. 1, ll. 54-55; col. 4, ll. 51-58). The composition can be used as rinse-out or leave-in hair products including products to maintain hairstyle (Dupuis, col. 5, ll. 51-67). The products have good fixing properties (Dupuis, col. 1, ll. 45-47). In addition, to water-soluble or water-swellaible polymer and aqueous carrier, the composition of Dupuis may contain adjuvants that are common in the cosmetics field such as other standard gelling agents and/or thickeners (Dupuis, col. 5, ll. 23-25). Hinks indicates that Laponite XLG and Laponite XLS were standard gelling and thickening agents in the cosmetics field (Hinks, p. 2, ll. 15-24). It would have been obvious to one of ordinary skill in the art to use

the Laponite microparticles in the composition of Dupuis for the known gelling and thickening properties of these microparticles. The prior art provides evidence that those of ordinary skill in the art would have found it obvious to formulate a composition containing non-spherical microparticles of the claimed particle size as well as water-soluble or water-swellaible polymer and aqueous carrier as required by claim 1.

Claim 1 further requires that the combination of the polymer and the microparticles results in a film-forming network. Dupuis obtains a thick, non-pasty gel that spreads very well on the hair and has good fixing power (Dupuis, col. 6, ll. 42-44). We find that such an easily spread gel of Dupuis containing Laponite microparticles would result in a film-forming network as claimed.

Appellants argue that there is no motivation to combine the references (Brief, p. 5-6). But Appellants' arguments ignore the broader aspects of the teachings of the references. It is well settled that a prior art reference is relevant for all that it teaches to those of ordinary skill in the art. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992). Dupuis suggests formulating leave-in styling compositions with gelling polymers and aqueous carrier. Dupuis also suggests adding standard cosmetic gelling and thickening agents. Hinks provides evidence that those of ordinary skill in the art used Laponite products as gelling and thickening agents in cosmetics. There is a suggestion to make the combination.

Appellants also argue that the references do not teach or suggest all the claim limitations: Namely, that the combination of prior art does not teach or suggest "a combination comprising

both non-spherical microparticles and polymers *wherein the combination of the microparticles and the polymers results in a film-forming network.*” (Brief, p. 7). But the composition of Dupuis is a gel, a network by definition. Moreover, the gel spreads easily and is, therefore, film-forming. Those are desirable properties which would be preserved by one of ordinary skill in the art when adding microparticles to the composition. Appellants point no objective evidence supporting to the contrary.

As a final point, we note that Appellants base no arguments upon objective evidence of non-obviousness such as unexpected results. We conclude that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 1-3, 6-18, 20, and 22-26 which has not been sufficiently rebutted by Appellant.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1-3, 6-18, 20, and 22-26 under 35 U.S.C. § 103(a) is affirmed, but the decision of the Examiner to reject claims 1-12, 24, and 25 under 35 U.S.C. § 112, § 1 is reversed.

We denominate our affirmance as involving a new ground of rejection. 37 CFR § 1.196(b)(2003). 37 CFR § 1.196(b) provides that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 CFR § 1.196(b) also provide that the appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner.
...
- (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

AFFIRMED

37 CFR § 1.196(b)

CATHERINE TIMM)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERIC GRIMES)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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