

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL J. HALLORAN, KENNETH A. KASPRZAK
and PATRICIA D. HERTER

Appeal No. 94-1495
Application 07/972,342¹

ON BRIEF

Before DOWNEY, KIMLIN and METZ, Administrative Patent Judges.
DOWNEY, Administrative Patent Judge.

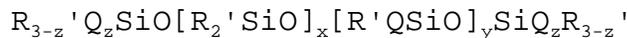
DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-6. Claims 7-11 are pending but stand withdrawn from consideration by the examiner pursuant to 37 C.F.R. § 1.142(b).

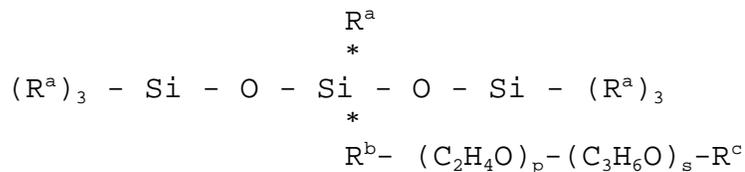
¹ Application for patent filed November 6, 1992.

Claim 1 is illustrative of the subject matter on appeal and correctly reads as follows²:

1. In a hair care composition containing an organic anionic surfactant and an organosilicon conditioning additive, the improvement comprising the organosilicon conditioning additive being a mixture of an amine functional silicone and a trisiloxane polyether, the amine functional silicone having the formula:



wherein R' denotes an alkyl group of 1 to 4 carbons or a phenyl group with the proviso that at least 50 percent of the total number of R' groups are methyl; Q denotes an amine functional substituent of the formula)R''Z in which R'' is a divalent alkylene radical of 3 to 6 carbon atoms and Z is a monovalent radical selected from the group consisting of)NR_2''', and)NR'''(CH_2)nNR_2'''; wherein R''' denotes hydrogen or an alkyl group of 1 to 4 carbons; and n is a positive integer having a value of from 2 to 6; z has a value of 0 or 1; x has an average value of 25 to 10,000; y has an average value of 0 to 100 when z is 1, y has an average value of 1 to 100 when z is 0; with the proviso that in all cases y has an average value that is not greater than one tenth the average value of x; the trisiloxane polyether having the formula:



wherein R^a is an alkyl group of one to six carbon atoms; R^b is a linking group and a radical selected from the group consisting of -O-, -C_mH_{2m}-, -C_mH_{2m}O-, C_mH_{2m-2}-, -C_mH_{2m-2}O-, and -C_mH_{2m}CO₂-; R^c is a terminating radical selected from the group consisting of hydrogen, an aryl group, a acyl group, and an alkyl group of one

² Appellant's claim 1 in the appendix does not properly reflect the amendments made to this claim at line 14 in Paper No. 4, filed Feb. 8, 1993.

Appeal No. 94-1495
Application 07/972,342

to six carbon atoms; m is an integer having a value two to eight;
p and s are each integers having values such that the oxyalkylene

Appeal No. 94-1495
Application 07/972,342

segment $-(C_2H_4O)_p-(C_3H_6O)_s-$ has a molecular weight in the range of 250 to 5,000; the oxyalkylene segment having fifty to one hundred mole percent of oxyethylene units $-(C_2H_4O)_p-$ and zero to fifty mole percent of oxypropylene units $-(C_3H_6O)_s-$.

The reference relied upon by the examiner is:

Ansher-Jackson et al. 5,100,657 Mar. 31, 1992
(Ansher-Jackson)

We specifically make of record the Noll reference, a reference attached to the appellants' brief and relied upon by the examiner in her rationale but not part of the statement of rejection.

Noll, "Chemistry and Technology of Silicones," pp. 373-376 (1968)

Claims 1-6 stand rejected under 35 U.S.C. § 103 as unpatentable over Ansher-Jackson. We reverse.

Opinion

Claim 1 is in Jepson format and recites a hair care composition containing an organic anionic surfactant and an organosilicon-containing additive. The preamble of the claim is impliedly prior art. In re Fout, 675 F.2d 297, 299-300, 213 USPQ 532, 535 (CCPA 1982); In re Ehrreich, 590 F.2d 902, 909, 200 USPQ 504, 510 (CCPA 1979). Appellants' invention is directed to an improvement wherein the organosilicon-containing additive comprises a mixture of two organosilicon conditioning additives described in claim 1 by certain specific formulae. The first

Appeal No. 94-1495
Application 07/972,342

silicon additive is an amine functional silicone and the second is a trisiloxane polyether containing only three silicon atoms.

Ansher-Jackson, the only reference relied upon by the examiner in her statement of rejection, is said to disclose a hair care composition comprising an amine functional silicone (column 15, lines 44-67), and a polysiloxane polyether containing four or more silicon atoms per molecule (column 9, lines 33-56) in an anionic surfactant base (column 6, lines 40-45). The examiner recognizes that Ansher-Jackson does not disclose the claimed trisiloxane polyether for she states: "[A]nsher-Jackson differs from the claimed invention in failing to teach a siloxane polyether comprising three silicone[sic, silicon] atoms per molecule." In order to remedy this deficiency, the examiner then asserts and concludes:

...applicant has clearly recognized that siloxane polyethers are well known in the art (page 6 of the specification citing Noll...) Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to substitute a known, equivalent species of siloxane polyether for that of Ansher-Jackson with the expectation of successfully deriving a hair care composition. (Page 3 of Examiner's Answer)

We cannot agree with the examiner's assertion and conclusion. Initially, we point out that there is no reason why

Appeal No. 94-1495
Application 07/972,342

the Noll reference should not have been part of the examiner's statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) [Where a reference is relied on to support a rejection, whether or not in a "minor capacity", there would appear to be no excuse for not positively including the reference in the statement of the rejection.]

The Patent and Trademark Office has the burden under 35 U.S.C. § 103 of establishing a prima facie case of obviousness. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). This burden can be satisfied when the PTO presents evidence, by means of some teaching, suggestion, or inference either in the applied prior art or our generally available knowledge, that would appear to have suggested the claimed subject matter to a person of ordinary skill in the art or would have motivated a person of ordinary skill in the art to combine the applied references in the proposed manner to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); Carella v. Starlight Archery Pro Line Co., 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); In re Rinehart, 531 F.2d 1048, 1051-1052, 189

Appeal No. 94-1495
Application 07/972,342

USPQ 143, 147 (CCPA 1976). The examiner has not carried forth her burden to establish that the skilled artisan would combine

Appeal No. 94-1495
Application 07/972,342

the relevant teachings as proffered to arrive at the claimed invention.

Appellants do not dispute the examiner's statement regarding the anionic surfactant or amino functional silicon additive. On the facts of this case, we cannot agree with the examiner's assertion that one of ordinary skill would have found it obvious to substitute a known equivalent species of siloxane polyether for that of Ansher-Jackson with the expectation of success. The examiner has provided no evidence to show that the claimed trisiloxane polyethers claimed are well known in the art. The examiner's reference to the Appellants' specification at page 6 to acknowledge that siloxane polyethers are well known in the art is misplaced and improper especially where, as here, the appellants have not admitted that the claimed trisiloxane polyethers are known. Nor has the examiner pointed out where in the Noll reference the claimed trisiloxane polyethers are described. At best, appellants acknowledges in their specification at page 6, that their claimed trisiloxane polyethers can be made by the methods described in the Noll reference. Our review of the Noll reference does not show any silicon compound falling within the scope of the claimed trisiloxane polyether. Since the examiner has provided no

Appeal No. 94-1495
Application 07/972,342

factual basis to support her position that the claimed trisiloxane polyether is known and is an equivalent species of Ansher-Jackson's siloxane polyether as she has proffered, the rejection cannot be sustained.

Since we do not find that the examiner has established a prima facie case of obviousness, it is not necessary for us to consider evidence of unobviousness or to antedate a reference.

The decision of the examiner is reversed.

REVERSED

MARY F. DOWNEY)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
EDWARD C. KIMLIN)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
ANDREW H. METZ)	
Administrative Patent Judge)	

Appeal No. 94-1495
Application 07/972,342

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