

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY E. LE GROW
and JOHN C. SMITH JR.

Appeal No. 95-0222
Application 08/145,553¹

ON BRIEF

Before PAK, WARREN and WEIMAR, Administrative Patent Judges.

PAK, Administrative Patent Judge.

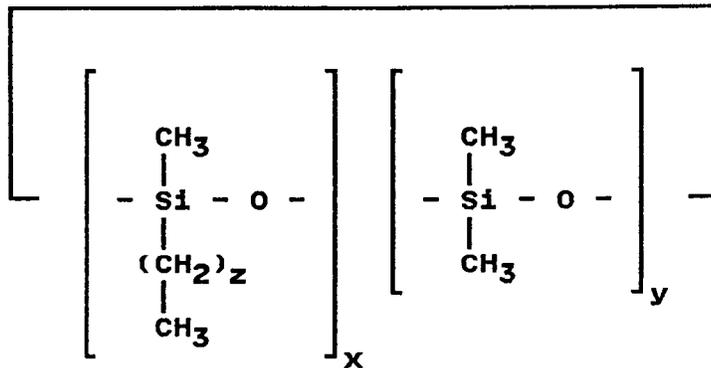
DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15 through 34, which are all of the claims remaining in the application.

¹ Application for patent filed November 4, 1993. According to appellants, this application is a continuation of Application 08/013,877 filed February 5, 1993.

Claim 15 is representative of the subject matter on appeal and reads as follows:

15. A composition comprising (i) from 30.0 to 97.8 percent by weight of an alkylmethylsiloxane having the formula



in which the sum of the integers x and y is four, five, or six, with the proviso that x and y cannot be zero; and z is an integer having a value of one of twelve; (ii) from 0.2 to fifty percent by weight of a cyclopolysiloxane having the formula $[(\text{CH}_3)_2\text{SiO}]_a$ in which a is an integer having a value of three to ten; and (iii) two to twenty percent by weight of a silicone gum selected from the group consisting of silanol endblocked polydimethylsiloxane gums having the formula $\text{HO}(\text{CH}_3)_2\text{SiO}[(\text{CH}_3)_2\text{SiO}]_n\text{Si}(\text{CH}_3)_2\text{OH}$, and polydimethylsiloxane gums having the formula $(\text{CH}_3)_3\text{SiO}[(\text{CH}_3)_2\text{SiO}]_n\text{Si}(\text{CH}_3)_3$, in which n is an integer having a value of from five thousand to fifty thousand.

The references of record relied upon by the examiner are:

Pader	4,364,837	Dec. 21, 1982
Bolich, Jr. et al. (Bolich)	4,902,499	Feb. 20, 1990
Cobb et al. (Cobb)	4,906,459	Mar. 6, 1990
Clement	5,118,507	June 2, 1992

Claims 15 through 34 stand rejected under 35 U.S.C. § 103 as unpatentable over Cobb or Bolich in view of Clement and Pader.

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We have carefully reviewed the record before us, including each of the arguments and comments advanced by appellants and the examiner in support of their respective positions. This review leads us to conclude that the examiner's rejection of claims 15 through 34 under § 103 is not well-founded. Accordingly, we will reverse the examiner's rejection. Our reasons for this determination follow.

In making a rejection under § 103, the examiner has the initial burden of supplying the factual basis for his or her position. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178, (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). That burden can be satisfied if the examiner supplies prior art references which would have reasonably suggested to one of ordinary skill in the art the claimed invention. In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984). However, it is impermissible within the framework of 35 U.S.C. § 103 to pick and choose from the prior art references only those portions which will support a given position without considering what each prior art reference would have fairly suggested to one of ordinary skill in the art. In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986).

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In the present case, the examiner has supplied the Cobb, Bolich, Clement and Pader references to support her rejection under § 103. However, none of these references, either individually or in combination, would have suggested the employment of the claimed amount of a cycloalkylmethylsiloxane defined by the claimed formula together with specific proportions of a particular cyclopolysiloxane and a particular polydimethylsiloxane gum. As acknowledged by the examiner, the Cobb, Bolich and Clement references are silent as to employing the claimed amount of the claimed cycloalkylmethylsiloxane. Moreover, the Pader reference as a whole would not have suggested to one of ordinary skill in the art to employ the claimed amount of the claimed cycloalkylmethylsiloxane together with specific proportions of the particular cyclopolysiloxane and the particular polydimethylsiloxane gum. As apparent from the Pader reference, a huge number of nonionic and cationic hair grooming agents, which may be inclusive of the claimed cycloalkylmethylsiloxane, are disclosed. Nowhere does the Pader reference, however, exemplify or show preference for siloxanes which are structurally identical or similar to the claimed cycloalkylmethylsiloxane. Nor does the Pader reference recognize the importance of

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employing the claimed amount of the claimed cycloalkylmethyl-
siloxane for the purposes of improving a skin care composition.

Accordingly, the decision of the examiner is reversed.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
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)	
ELIZABETH WEIMAR)	
Administrative Patent Judge)	
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