

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY E. LEGROW
and JOHN C. SMITH JR.

Appeal No. 95-0415
Application 08/013,877¹

ON BRIEF

Before WINTERS, WARREN and WEIMAR, Administrative Patent Judges.
WEIMAR, Administrative Patent Judge.

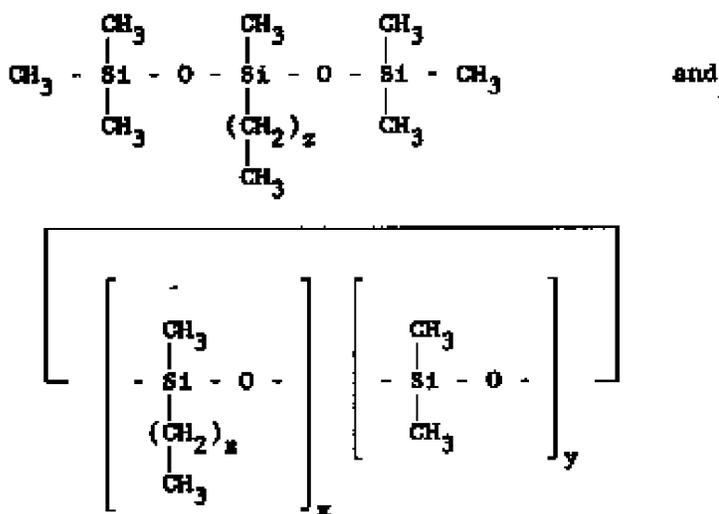
DECISION ON APPEAL

This is an appeal from the examiner's decision finally rejecting claims 1-14, which are all of the claims in the

¹ Application for patent filed February 5, 1993.

application. Claims 1, 2 and 13 are illustrative of the claimed subject matter and they read as follows:

1. A composition comprising (i) from 30.0 to 97.8 percent by weight of an alkylmethylsiloxane having a formula selected from the group consisting of



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 to 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.

2. The composition of Claim 1 in which z is 5-7.

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13. A method of conditioning human skin comprising applying an effective amount of the composition of Claim 1 to the skin as a coating, and rubbing the composition into the skin.

The references relied upon by the examiner are:

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 ON APPEAL

We observe that claims 13 and 14 were omitted from the statement of the rejection in the Final Rejection, even though the subject matter of these claims was addressed in light of the teachings of the applied prior art. We also observe that appellants discuss these claims in relationship to the applied prior art in the Appeal Brief and they did not file a Reply Brief to contest the inclusion of claims 13 and 14 in the rejection under 35 U.S.C. § 103 in the Examiner's Answer. Thus, as appellants were fully apprised of the inclusion of claims 13 and 14 in the ground of rejection, we hold the examiner's omission to be harmless error.

Claims 1-14 stand rejected under 35 U.S.C. § 103 over Cobb or Bolich in combination with Clement.

We affirm this rejection only with respect to claims 1 and 9-14. With respect to claims 2-8, we reverse this rejection.

BACKGROUND

Compositions intended for conditioning skin to either prevent or treat dry skin are known in the prior art. Lotions and other compositions intended for use in the conditioning of skin are topically applied and function by forming a film which allows for moisture retention. See pages 1 and 2 of the specification. Prior art compositions intended for skin conditioning as well as other cosmetic purposes, such as hair conditioning treatments, include silicone fluids as well as silicone gums.

Claims 1-12 herein are directed to compositions comprising three silicone components in specified amount ranges, while claims 13 and 14 are drawn to the topical application of the compositions. The specification indicates that the claimed invention offers three distinct advantages over typical conditioning compositions. These advantages are 1) faster absorption into the skin; 2) a less greasy feel; and, 3) a

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smoother coating on the skin after application of the composition to the skin. See page 2 of the specification.

DISCUSSION

Claims 2-8 are separately argued as being patentably distinct from the remaining claims. Thus, we will focus the discussion on claims 1 and 2.

Cobb and Bolich each teach compositions which contain combinations of volatile silicone fluids and silicone gums. Clement teaches a composition which is topically applied to the skin and contains volatile silicone carriers and silicone gums in concentrations that fall within the ranges of claim 1.

Both Cobb and Bolich disclose the use of silicone fluids in the disclosed compositions which are linear polydimethyl siloxanes. The first embodiment of the alkylmethylsiloxane ingredient of claim 1 herein is a genus of compounds which also are linear polymeric siloxanes. They differ from the linear compounds disclosed by both Cobb and Bolich by requiring at least an ethyl group on the repeated silicone moiety.

It is reasonable to conclude that the close structurally related ethyl and propyl homologs of the specifically disclosed linear siloxane would possess similar physical properties and

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thus be useful in the same manner as the applied prior art. Both Cobb (column 2, line 61 - column 3, line 32) and Bolich (column 3, line 35 - column 4, line 6) discuss the desired physical properties of the volatile carrier. These properties include the boiling point, water solubility and viscosity. One of ordinary skill in the art would recognize that the close homologs would

possess physical properties within or very near to these disclosed numeric values. Thus, we agree that the similarity in chemical structure and properties between the applied prior art and the compounds of the claims is sufficiently close to support a *prima facie* case of obviousness. See In re Payne, 606 F.2d 303, 313-314, 203 USPQ 245, 254-255 (CCPA 1979).

The claims require the use of a cyclopolydimethyl siloxane in addition to the alkylmethylsiloxane in the compositions. Both Cobb (column 3, lines 6-8) and Bolich (column 3, lines 49-50) teach the use of cyclopolydimethyl siloxanes such as those claimed as volatile carriers. The references also teach that mixtures of volatile carriers are contemplated. See Cobb (column 2, lines 61-62) and Bolich (column 3, lines 36-40). It would

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have been obvious to a person having ordinary skill in the art to have included any two volatile carriers or obvious variants thereof in a composition of the prior art in light of this express teaching.

To the extent that the compositions of Cobb and Bolich are taught to be used as shampoos and conditioners (see the examples of both references) the methods of claims 13 and 14 would have been obvious to the ordinary artisan as well. Human skin

encompasses human scalp. Moreover, Clement teaches similar formulations specifically for use in conditioning skin, which formulations include combinations of volatile silicone carriers and silicone gums. See column 1, lines 43-56 and column 2, lines 19-43 of Clement.

Appellants' arguments speak to the absence of an explicit teaching of the use of an alkylmethylsiloxane as claimed by the applied prior art. The arguments do not include reasons why a person of ordinary skill in the art would not, at the time of the invention, have reasonably expected structurally similar

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compounds to have similar properties and function in the context of the compositions disclosed by the prior art in a similar manner.

With respect to claims 2-8, the claimed alkylmethyilsiloxane component is limited to at least a hexyl moiety in the central portion of the molecule. We do not agree with the examiner's conclusion that the molecules set forth in claims 2-8 are so similar as to have a reasonable expectation of similar physical properties so as to expect such molecules to function in a similar manner in the context of the applied prior art. The examiner has not pointed to any recitation of properties that would support such a conclusion.

With regard to the discussion of unexpected properties contained on pages 6 and 7 of the Appeal Brief, we note that on pages 13 and 14 of the specification a comparison is presented in which the embodiment of the presently claimed composition contains a linear alkylmethyilsiloxane with a central hexyl moiety. Having concluded that the use of such a compound in the compositions of the claims would not have been rendered obvious from the teachings of the prior art we do not reach this rebuttal

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evidence. We do wish to point out, however, that the evidence is not commensurate in scope with claims 1 and 9-14 and thus, cannot overcome the *prima facie* case of obviousness with respect thereto. See In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972).

CONCLUSION

The decision of the examiner refusing to allow claims 1 and 9-14 is affirmed.

The decision of the examiner refusing to allow claims 2-8 is reversed.

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AFFIRMED-IN-PART

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