

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. GLOVER

Appeal No. 95-4250
Application No. 08/086,395¹

ON BRIEF

Before WILLIAM SMITH, OWENS, and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1, 3-5, 7-9, 12, 14, 15, 17, 18, and 21-24 as amended subsequent to the final rejection (see the amendment

¹ Application for patent filed July 6, 1993.

dated January 06, 1995, Paper No. 8, entered as per the communication dated August 28, 1998, Paper No. 12). Claims 1, 3-5, 7-9, 12, 14, 15, 17, 18, and 21- 24 are the only claims remaining in this application.

BACKGROUND

The appellant's invention relates to a water in volatile silicone emulsion gel composition, a method of making the gel composition, and a method of use of the gel composition for moisturizing skin. The gel composition is made by measuring the refractive index of a water phase and an oil phase, matching the refractive indices thereof, adding the water phase to the oil phase and subjecting the phases to shear mixing. The oil phase comprises a volatile silicone selected from linear and cyclopolysiloxanes of specified formulas, a siloxane polyether, and an emollient. The water phase comprises water and an oxyethylene functional organosilane of a specified formula and optionally a water soluble humectant having a refractive index above 1.35.

According to appellant (specification page 2, line 16 through page 3, line 11 and pages 16 and 17, examples I and II), crystal clear gels may be made by matching the respective

water and oil phase refractive indices with or without using a separate humectant in addition to the oxyethylene organosilane (which functions as a humectant) in the water phase. An understanding of the invention can be derived from a reading of exemplary composition claims 21 and 22, which differ in that claim 22 requires a separate humectant in addition to an oxyethylene organosilane in the water phase that is used in making the composition.² Claims 21 and 22 are reproduced below.

21. A gel comprising a composition made by (i) forming an oil phase having a volatile silicone, a siloxane polyether, and an emollient; (ii) forming a water phase having water, a water soluble humectant with a refractive index above 1.35, and an oxyethylene functional organosilane; (iii) measuring the refractive index of the oil phase and the water phase; (iv) matching the refractive indices of the oil phase and the water phase; (v) adding the water phase to the oil phase; and (vi) subjecting the phases to shear mixing; the volatile silicone being selected from the group consisting of cyclopolysiloxanes of the formula $[(CH_3)_2SiO]_x$ and linear siloxanes of the formula $(CH_3)_3SiO[(CH_3)_2SiO]_ySi(CH_3)_3$ in which x is three to ten and y is zero to four; and the oxyethylene functional organosilane has the formula $RSiR'_3$ in which R is the radical $-O(CH_2CH_2O)_xR''$; R' is R or an alkyl radical having one to six carbon atoms; and R'' is selected from the group consisting of hydrogen, an alkyl

² Independent claims 1 and 12 are directed to methods of making the gel and independent claims 23 and 24 are directed to methods of using the gel that correspond with composition claims 21 and 22 and in which the differences in scope between method claims 1 and 12, and between method claims 23 and 24 also centers on the requirement of a separate humectant in the water phase in each of claims 1 and 23.

group of one to six carbon atoms, and an aryl group; and x is six to thirty.

22. A gel comprising a composition made by (i) forming an oil phase having a volatile silicone, a siloxane polyether, and an emollient; (ii) forming a water phase having water, and an oxyethylene functional organosilane; (iii) measuring the refractive index of the oil phase and the water phase; (iv) matching the refractive indices of the oil phase and the water phase; (v) adding the water phase to the oil phase; and (vi) subjecting the phases to shear mixing; the volatile silicone being selected from the group consisting of cyclopolysiloxanes of the formula $[(CH_3)_2SiO]_x$ and linear siloxanes of the formula $(CH_3)_3SiO[(CH_3)_2SiO]_ySi(CH_3)_3$ in which x is three to ten and y is zero to four; and the oxyethylene functional organosilane has the formula $RSiR'_3$ in which R is the radical $-O(CH_2CH_2O)_xR''$; R' is R or an alkyl radical having one to six carbon atoms; and R'' is selected from the group consisting of hydrogen, an alkyl group of one to six carbon atoms, and an aryl group; and x is six to thirty.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Yoneyama et al. (Yoneyama)	5,015,469	May 14,
1991		
Legrow et al. (Legrow)	5,157,139	Oct. 20,
1992		
Shioya et al. (Shioya)	5,306,838	Apr. 26,
1994		

Claims 1, 3-5, 7-9, 12, 14, 15, 17, 18, and 21-24 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failure to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. Claims 1, 3-5, 7-9, 12, 14, 15, 17, 18, and 21-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yoneyama in view of Legrow and Shioya. The above-noted rejections represent the only issues before us for review.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer for the examiner's reasoning in support of the rejections, and to the appellant's brief for the appellant's arguments thereagainst.

OPINION

Having considered the entire record of this application, including the arguments advanced by both the examiner and appellant in support of their respective positions, we agree with appellant that the claimed subject matter is not only reasonably definite in scope, but also would not have been obvious over the applied references as combined by the examiner. Accordingly, we will not sustain any of the examiner's rejections for reasons as follows.

Rejection under 35 U.S.C. § 112, second paragraph

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been

interpreted by one of ordinary skill in the art in light of appellant's specification and the prior art, sets out and circumscribes a particular area with a reasonable degree of precision and particularity. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner urges that the term "matching" in appellant's claims is indefinite (answer, page 4) in that no particular process steps for adjusting the refractive indices of the water and oil phases are indicated thereby. However, as indicated above, the claims are not read in a vacuum.

Appellant describes matching of the refractive indices as involving a comparison of the refractive index of the water phase and the refractive index of the oil phase and adjustment of the water phase composition if the respective indices differ in that one is higher or lower than the other (specification page 2, line 20 through page 3, line 11 and page 16, example I). In other words, the refractive indices are matched by adjusting the water phase composition as necessary to provide an oil phase and a water phase with equal refractive indices.

In light of appellant's specification wherein the process of matching the refractive indices is described, we agree with

appellant's conclusion that the claims including the phrase "matching the refractive indices..." are reasonably definite so as to be in compliance with 35 U.S.C. § 112, second paragraph. Accordingly, we can not sustain this rejection.

Rejection under 35 U.S.C. § 103 over

Yoneyama in view of Legrow and Shioya

Yoneyama discloses a water-in-oil emulsion composition and preparation method useful in cosmetic as well as other applications. The composition of Yoneyama includes an oil phase including silicone compounds and polyether modified silicone compounds and a water phase that is added thereto by mixing. The water phase of Yoneyama may include a polyhydric alcohol such as glycerine (Example 1-2), one of appellant's disclosed humectants (appellant's specification, page 13, lines 9-18).

The examiner acknowledges that Yoneyama does not disclose the use of an oxyethylene organosilane in the water phase and refractive index matching of the oil and water phases in preparing the composition as required by the appealed claims herein (examiner's answer, page 6). According to the examiner, it would have been obvious to one of ordinary skill in the art

at the time the invention was made to add an oxyethylene organosilane to the water phase in forming the composition of Yoneyama since Legrow teaches such organosilane compounds are clear and colorless and would be useful in cosmetics and Yoneyama discloses adding water soluble additives to the aqueous phase (answer, pages 7-9).

Appellant's basic argument with respect to the § 103 rejection appears to be that the applied references do not suggest the substitution of an organosilane compound as claimed herein for any of the constituents of the composition of Yoneyama such as the silicone compounds thereof.

We note that the examiner bears the initial burden of presenting a prima facie case of obviousness in rejecting claims under 35 U.S.C. § 103. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual 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 (Fed. Cir. 1988).
Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art.

In our view, the examiner has not furnished an adequate evidentiary foundation from which a conclusion of obviousness can be reached. In this regard, we do not find that the use of an organosilane as claimed herein would have been reasonably suggested for use in the composition of Yoneyama and would have been rendered obvious within the meaning of 35 U.S.C. § 103 by the teachings of Yoneyama taken together with Legrow and Shioya. In particular, the examiner has acknowledged and we agree that Yoneyama does not disclose organosilanes as being useful additives for their composition. While Legrow does teach that organosilanes of the type called for by the appealed claims herein may be used in cosmetics as well as in other applications (column 4, lines 1-7), we do not find this general suggestion of utility is sufficiently specific to teach the use of such organosilanes in the specific compositions of Yoneyama as a water phase ingredient. The evidentiary record furnished by the examiner

does not suggest any advantage or reason to employ organosilanes as claimed in the water phase of Yoneyama as a partial or complete substitute for some or all of the other component(s) thereof.³ While Shioya (column 11, lines 23-32) may suggest that substantially matching the refractive indices of the water and oil phases used in making a similar composition may enhance the transparency of the final composition, Shioya does not cure the deficiency noted above with respect to a lack of a teaching or suggestion for using organosilanes of the type claimed herein in the water phase of Yoneyama for preparing a clear gel composition.

We agree with the examiner (answer, page 14) that a *prima facie* case of obviousness under 35 U.S.C. § 103 does not require a suggestion in or expectation from the prior art that the use of organosilanes as taught by Legrow would have the same advantage or similar utility as a humectant or substitute therefore in the composition as claimed as apparently newly discovered by appellant herein.

³ We note that the use of an organosilane compound in the composition of Yoneyama necessarily involves a substitution since all of the utilized components of the composition must total 100% thereof.

In our view, however, at least one prior art supported reason or advantage for using an organosilane as taught by Legrow in the aqueous phase of Yoneyama is required to support the proffered rejection under § 103. Here, the most that can be concluded from the collective teachings of the applied references is that it might have been obvious for one of ordinary skill in the art to try an organosilane as a cosmetic ingredient as generally taught by Legrow. Of course, it is by now well settled that such is not the proper standard for determining obviousness under 35 U.S.C. § 103. In this regard, our court of review has made clear that "obvious to try" is not the correct standard for determining obviousness under 35 U.S.C. § 103. See In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). In this regard, no suggestion of using an oxyethylene functional organosilane as an aqueous phase constituent in a gel composition as disclosed by Yoneyama is suggested by the combined reference teachings.

Accordingly, we are constrained to reverse the rejection of the appealed claims under 35 U.S.C. § 103 because the examiner has simply failed to meet his burden of establishing

an evidentiary record to establish a *prima facie* case of obviousness of the claimed subject matter as a whole within the meaning of 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3-5, 7-9, 12, 14, 15, 17, 18, and 21-24 under 35 U.S.C. § 112, second paragraph as being indefinite for failure to particularly point out and distinctly claim the subject matter which applicant regards as the invention, and to reject claims 1, 3-5, 7-9, 12, 14, 15, 17, 18, and 21-24 under 35 U.S.C. § 103 as being

unpatentable over Yoneyama in view of Legrow and Shioya is
reversed.

REVERSED

WILLIAM F. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

PFK/jlb

Appeal No. 95-4250
Application No. 08/086,395

Page 14

PATENT DEPT. - MAIL CO1232
DOW CORNING CORP.
MIDLAND, MI 48686-0994