

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** ALFRED G. BARNET and MERRILL R. MEZIKOFSKY

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Appeal No. 1996-2732  
Application 08/241,524

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ON BRIEF

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Before GRON, ELLIS and SPIEGEL, ***Administrative Patent Judges.***

***Per curiam***

***DECISION ON APPEAL***

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 9 through 18. Claims 1 through 8 have been canceled. Claim 9 is illustrative of the subject matter on appeal and reads as follows:

9. In a shaving composition in the form of a self-foaming gel comprising water, a water-soluble soap, and a volatile hydrocarbon self-foaming agent, the improvement wherein said shaving composition additionally comprises a fluorosurfactant and a hydrogenated polyisobutene.

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The references relied upon by the examiner are:

Falk	4,089,804	May 16, 1978
Su	4,528,111	July 09, 1985
Aronson et al. (Aronson)	4,606,913	August 19, 1986

The claims stand rejected as follows:

I. Claims 9 through 18 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling disclosure.

II. Claims 9 through 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Su in view of Aronson and Falk.

We **reverse**.

### ***Discussion***

#### ***I.***

In view of its brevity, the examiner's rejection under 35 U.S.C. § 112, first paragraph, is reproduced in its entirety:

The Jepson language format claims, in effect, any self foaming gel to be improved. In fact, the specification provides limited types, thus requiring their identification and ratio of concentration. This applies to the (page 3) soap or detergent and propellant (page 4, last paragraph) [Answer, p. 3].

We find this argument unpersuasive.

The first paragraph of § 112 requires, ***inter alia***, that the specification enable those

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skilled in the art to which it pertains to make and use the claimed invention.

**PPG Indus., Inc. v. Guardian Indus. Corp.**, 75 F.3d 1558, 1564, 37 USPQ2d 1618, 1623 (Fed. Cir. 1996); **In re Wright**, 999 F.2d 1557, 1561, 27 USPQ 1510, 1513 (Fed. Cir. 1993); **In re Vaeck**, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991).

Although the statute does not so state, our appellate reviewing court has held that enablement requires that the specification teach such persons to make and use the claimed invention without “undue experimentation.”<sup>1</sup> **In re Vaeck**, 947 F.2d at 495, 20 USPQ2d at 1444. When making a rejection under this statute, it is the examiner’s burden to present reasons why the specification would not have enabled those skilled in the art to make and use the full scope of the claimed invention absent undue experimentation. **In re Angstadt**, 190 USPQ 214, 219 (CCPA 1976); **In re Marzocchi**, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). This the examiner has not done. Rather, we find that the examiner has only made an assertion that the soap and propellant of the composition must be identified and their ratios of concentrations disclosed. Answer, p. 3. Since the examiner has not performed the fact finding necessary

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<sup>1</sup> The court has also set forth the factors to be considered in determining whether a disclosure would require undue experimentation. **In re Wands**, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Those factors 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. [**In re Wands**, 858 F.2d at 737, 8 USPQ2d at 1404].

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to support this assertion, we reverse.

## **II.**

Turning to the rejection under 35 U.S.C. § 103, we find that the examiner has based his conclusion of obviousness on the teachings of Su, Falk and Aronson.

Su discloses a shaving cream gel comprising water, a water-soluble soap and hydrocarbon foaming agent. Su, col. 6, line 38- col. 7, line 24.

Falk discloses fluorosurfactant compositions which are said to “improve or impart properties such as wetting, penetration, spreading, leveling, foam stability, flow properties, emulsification, dispersion and oil and water repellency.” Falk, col. 4, lines 2-7. According to Falk, these properties commend themselves for use in numerous products including, *inter alia*, household products such as shaving foams. *Id.*, col. 6, line 54.

Aronson discloses a method of improving the stability of high-internal-phase emulsions (HIPE's) by incorporating an electrolyte into the aqueous phase of said emulsion. Aronson, col. 8, lines 27-34.

According to the examiner “Aronson provides the hydrogenated polyisobutene for topical application (Examples 10-12). Thus, one of ordinary skill in the cosmetic arts would find it obvious to formulate a Su self foaming gel, with the added benefits enhanced foam stability (Falk) and lubricant (Aronson).” Answer, p. 3.

We disagree.

It is well established that the examiner has the initial burden under § 103 to establish a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). While we agree with the examiner that (i) Su discloses that aspect of the Jepson claim which is admittedly prior art; i.e., Su discloses a self foaming gel comprising water, soap and a volatile self-foaming agent, and (ii) Falk would have suggested to one of ordinary skill in the art the addition of a fluorosurfactant to a shaving gel in order to improve or impart one or more of the desirable properties listed in col. 4, lines 2-7, of the patent, we find the examiner's rejection with respect to the Aronson patent to be problematic.

Aronson is directed to high-internal-phase emulsions (HIPE's) which are said to be useful in a variety of applications such as rocket and jet fuels, cosmetics and drugs, and in foods. *Id.*, col. 3, lines 19-33. It is not clear, and the examiner has not explained, the relevancy of HIPEs to the shaving cream art. For example, it is not clear whether the examiner is applying Aronson because he believes that (i) the claimed shaving gel is an HIPE, or (ii) the patent teaches or suggests that hydrogenated polyisobutene is a lubricant which is commonly used in emulsions. On this record, the examiner has made no mention of the former point and, with respect to the latter point, we do not find that Aronson teaches that hydrogenated polyisobutene compound is a lubricant, as stated in the Answer. Answer, p. 3. Rather, in the example relied upon by the examiner; i.e, Example 12, we find

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that Aronson teaches the use of hydrogenated polyisobutene as the oil phase of the water-in-oil emulsion described therein. Moreover, assuming **arguendo**, that hydrogenated polyisobutene is a lubricant, the examiner has not explained why it would have been obvious to one of ordinary skill in the art to use (i) the oil phase of a water-in-oil emulsion (Example 12) in the claimed shaving gels which are oil-in-water compositions, or (ii) that particular lubricant in a shaving cream gel out of the numerous oils disclosed by Aronson.

The examiner has not shown that some objective teaching or suggestion in the applied prior art, or knowledge generally available in the art would have led one of ordinary skill in the art to combine the references to arrive at the claimed invention. **Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.**, 745 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). To the contrary, the only place we find such suggestion is in the appellants' specification. Thus, we find that the examiner has relied on impermissible hindsight in making his determination of obviousness. **In re Fritch**, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) ("It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious"); **Interconnect Planning Corp. v. Feil**, 774 F.2d 1132, 1141, 227 USPQ 543, 550 (Fed. Cir. 1985); **W.L. Gore & Assocs. v. Garlock, Inc.**, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record

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convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”).  
Accordingly, the rejection is reversed.

We note that the appellants have provided two declarations as evidence of unexpected advantages or properties for the claimed composition(s). *In re Papesch*, 315 F.2d 381, 386-87, 137 USPQ 43, 47-48 (CCPA 1963). However, an applicant is not obligated to proffer evidence of nonobviousness until such time as the examiner has established a *prima facie* case of obviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1393, 7 USPQ2d 1222, 1227 (Fed. Cir. 1988). Thus, we have not considered the declaration evidence in our deliberations.

The decision of the examiner is reversed.

**REVERSED**

Teddy S. Gron	)
Administrative Patent Judge	)BOARD OF PATENT
	)
	)APPEALS AND
	)
Carol A. Spiegel	)INTERFERENCES
Administrative Patent Judge	)

***ELLIS, concurring.***

I am in complete agreement with the carefully-reasoned and well-written decision of the panel, and I write only to add that I do not find that the Aronson patent falls within the scope of relevant prior art.

A reference is considered relevant art if it “is within the inventor’s field of endeavor, and if it is not ... [it must be] reasonably pertinent to the particular problem confronting the inventor.” ***In re GPAC, Inc.***, 57 F.3d 1573, 1578, 35 USPQ2d 1116, 1120 (Fed. Cir. 1995). The Aronson patent does not meet either criterion. The appellants’ field of endeavor is related to shaving gels which must have certain properties [specification, p. 8]; whereas, Aronson is directed to high-internal-phase emulsions (HIPE’s) which are said to be useful in rocket and jet fuels, in cosmetics and drugs, and in foods such as dietary products. Aronson, col. 3, lines 19-33. In addition to the shortcomings of the rejection discussed by the panel on pages 5-6 above, I also find the examiner’s allegation that the present shaving gel compositions are within the field of cosmetic arts and, thus, within the same field of endeavor as Aronson, to be inappropriate and without support. In fact, to the contrary, I find that the term “cosmetic” is defined as “a preparation, as rouge or lipstick, designed to beautify the body by direct application. ... 1. Serving to beautify the body, 2.

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Serving to correct physical imperfections ‹cosmetic surgery› 3. b. Ornamental rather than functional. b. Having little or no significance : superficial ‹ cosmetic changes in procedures›.” **Websters II, New Riverside University Dictionary**, The Riverside Publishing Company (1988), p. 316. [Copy attached]. The examiner has not provided any explanation as to how the claimed shaving gels are related to the cosmetics industry.

Nor do I find that Aronson relates to the same problem addressed by the present invention. The claimed compositions are said to provide a comfortable shave by exhibiting attributes such as softening of the beard, avoiding nicks and cuts, improving razor glide and giving the perception of facial cleanliness after shaving. Specification, p. 8. In contrast, the teachings of Aronson are directed to improving the stability of HIPE’s by the incorporation of an electrolyte into the aqueous phase of the emulsion. Aronson, col. 8, lines 27-30.

Thus, in addition to the many fine points set forth above by the panel, I find the examiner’s reliance on Aronson to be misplaced. In my view, a person of ordinary skill in this art would not have been expected to turn to Aronson to look for lubricants to add to shaving cream gels. Accordingly, I find that the examiner’s combining of elements from a non-analogous source, in a manner that reconstructs the applicant’s invention to be improper. **In re Oetiker**, 977 F.2d at 1447, 24 USPQ2d at 1446.

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