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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(2) is not binding precedent of the Board.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. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAIN RIBIER, PASCAL RICHART,
and ROSE-MARIE HANDJANI

Appeal No. 96-2897
Application 08/050,315¹

HEARING: April 7, 1999

Before WILLIAM F. SMITH, GRON, and LORIN, Administrative
Patent Judges.

GRON, Administrative Patent Judge.

¹ Application for patent filed May 10, 1993. According to applicants, this application is the U.S. designated filing of International Application PCT/FR92/00824, filed August 27, 1992. Applicants claim priority under 35 U.S.C. § 119 of the September 13, 1991, foreign filing date of French Application 91-11344.

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DECISION ON APPEAL UNDER 35 U.S.C. § 134

This is an appeal under 35 U.S.C. § 134 of an examiner's final rejection of Claims 36-39. The examiner has indicated that

Claims 50-52, the only other claims pending in this application, are allowed (Supplemental Examiner's Answer, p. 1, para. 3

(Paper No. 35)).

1. Introduction

Claims 36-39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by European Patent 274,961 (hereafter EP), published July 20, 1988. Claims 36-39 also stand rejected under 35 U.S.C. § 102(e) as being anticipated by Devissaguet et al. (Devissaguet), U.S. 5,049,322, patented September 17, 1991 (prior art under § 102(e) based on an application filing date of December 31, 1987). With regard to EP and Devissaguet, appellants state (Appeal Brief (Br.), p. 5, first sentence and n. 1):

One issue is presented for appeal¹

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¹ Although the Examiner has separately rejected claims 36-41 under Sections 102(b) and 102(e), the references upon which the Examiner relies are equivalent. See, page 2, lines 9-10 of the Office Action of June 5, 1995 (Paper No. 15). Accordingly, for the convenience of the Board, the appellants respectfully submit that only one issue is raised in the present appeal.

Accordingly, we shall only review the merits of the examiner's rejections of Claims 36-39 under Section 102(e) over Devissaguet. The rejections of the same claims under Section 102(b) over EP shall stand or fall with the examiner's rejections of Claims 36-39 under Section 102(e) over Devissaguet. Claims 36-39 on appeal are transcribed below:

36. A composition for the treatment of the upper epidermal layers of the skin, said composition comprising,
in a carrier suitable for topical application to the skin,
nanocapsules of a nonbiodegradable polymer encapsulating an oily phase,
said oily phase, encapsulated in said nanocapsules of said nonbiodegradable polymer, containing an effective active oil or an oil having anti-free radical activity,
said nanocapsules of said nonbiodegradable polymer having a size ranging from 100 to 1,000 nm and being present in an amount ranging from 0.1 to 20 percent by weight based on the total weight of said composition.

37. The composition of Claim 36 wherein said nanocapsules of said nonbiodegradable polymer have a size ranging from 200 to 800 nm.

38. The composition of Claim 36 wherein said nanocapsules of said nonbiodegradable polymer are present in an amount ranging from 0.5 to 10 percent by weight based on the total weight of said composition.

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39. The composition of Claim 36 wherein said nonbiodegradable polymer is selected from the group consisting of a vinyl chloride-vinylacetate copolymer and a methacrylic acid-methacrylic acid methyl ester copolymer.

2. Discussion

Our decision on review of the merits of the examiner's rejection of the subject matter appellants claim under 35 U.S.C. § 102 over the subject matter Devissaguet describes depends entirely on the interpretation to be accorded two phrases in Claim 36 on appeal. The examiner's answers and appellants' briefs emphasize arguable differences between the claimed subject matter depending upon the respective limiting capacity each attributes to the functional language and the manner in which each interprets the scope of the encapsulated "oily phase . . . containing an effective active oil" component of the claimed composition (Examiner's Answer (Ans.), p. 3, last para., to p. 4, last para.). We hold that the examiner erroneously interpreted the functional language of the claims on appeal and erroneously interpreted the term "active oil" of the same claims based on inadequate consideration of the description of the invention in appellants' specification.

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First, the claimed "composition" is defined as being useful "for the treatment of the upper epidermal layers of the skin" (Claim 36, l. 1-2). The examiner held that the claim language of utility does not further limit the claimed invention (Ans., p. 4, last para.)² and therefore cannot exclude nonbiodegradable nanocapsules containing an "active oil" such as "benzyl benzoate" which the prior art reference encapsulated in nanocapsules made of a nonbiodegradable copolymer of vinyl chloride and vinyl acetate (Ans., p. 4, third para., and Devissaguet, col. 5, Example 1). Appellants cited a standard chemical reference which indicated that benzyl benzoate "[m]ay cause skin irritation in humans" (The Merck Index, Eleventh Edition, Merck & Co., Inc., Rahway, N.J., p. 176, no. 1141 (1989)(Appeal Brief (Br.), Appendix B)) and argued that persons having ordinary skill in the art would not have understood that encapsulated skin irritants would be useful "for the treatment of the upper epidermal layers of the skin" as are the compositions appellants claim. Thus,

² Elimination of the need for fact-specific analysis of claims and prior art by reliance on *per se* rules in determining patentability is legally incorrect. In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995).

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appellants argue that the functional language excludes encapsulated benzyl benzoate from the claims (Br., p. 8). We hold that the functional language of Claim 36 excludes skin-irritating oils from the compositions appellants claim.

In determining anticipation in this case, the functional language in the preamble of Claim 36 is essential to particularly point out the invention and cannot be disregarded. See Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677-678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988), for its reference to the following instruction:

In re Stencel, 828 F.2d 751, 754-55, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987) states:

Whether a preamble of intended purpose constitutes a limitation to the claims is, as has long been established, a matter to be determined on the facts of each case in view of the claimed invention as a whole.

. . . .

This purpose, set forth in the [preambles of the] claims themselves, "is more than a mere statement of purpose; and that language is essential to particularly point out the invention defined by the claims." *In re Bulloch*, 604 F.2d 1362, 1365, 203 USPQ 171, 174 (CCPA 1979).

Accordingly, we reverse the examiner's rejection as based, at least in part, on an erroneous interpretation of the scope of the claimed subject matter.

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Second, Claim 36 defines the encapsulated "oily phase" as containing (1) an "active oil" (Claim 36, l. 8) or (2) an "oil having anti-free radical activity" (Claim 36, l. 8). See page 3, last full paragraph, of the Appeal Brief (Br.). At pages 5-6, bridging paragraph, of the Appeal Brief, appellants define the term "active oil" with reference to the specification as follows:

The presently claimed invention provides a cosmetic composition of nanocapsules of a biodegradable polymer which encapsulates an oily phase. The oily phase of the presently claimed composition contains an effective active oil or an oil having anti-free radical activity. The specification exemplifies an active oil as an oil which screens out UV-A and/or UV-B radiation; an oil having bactericidal and/or fungicidal activity, an oil with humectant activity or an oil with anti-free radical activity. See, page 6, line 19 to page 7, line 1 of the specification.

Thereafter, appellants argued (Br., p. 6, first full para.) that the oils Devissaguet discloses, i.e., "a vegetable or a mineral oil, or any oily substance, for example olive oil, benzyl benzoate, isopropyl myristate, glycerides of fatty acids . . . , volatile oils, etc." (Devissaguet, col. 3, l. 19-23), are not "active oil[s]" within the meaning of the term in appellants' claims.

Rather than interpret the term "active oil" in the claims

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in light of the teaching in the specification as a whole and give the term the broadest reasonable interpretation which is consistent with the invention described in the specification, as In re Zletz, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989), directs at 321, 13 USPQ2d at 1322, the examiner focussed on appellants' limited definition of the term based on the active oils the "specification exemplifies" (Br., p. 6, first full sentence). In so doing, the examiner erred. The examiner should have fairly considered what the term "active oil" would have meant to persons having ordinary skill in the art upon reading the description of the invention in the specification as a whole. We must remand this case so to allow the examiner to interpret the claim language and determine the scope of appellants' claims in accordance with established patent law. Only after having ascertained exactly what subject matter is being claimed should the examiner consider the patentability of the claimed subject matter under 35 U.S.C. §§ 102 and 103. "Once having ascertained exactly what subject matter is being claimed, the next inquiry must be into whether such subject matter is novel." In re Wilder, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). "Before considering the rejections under 35 U.S.C. 103 . . . we must first decide . . . [what]

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the claims include within their scope" In re Geerdes,
491 F.2d 1260, 1262, 180 USPQ 789, 791 (CCPA 1974).

On remand, before the examiner decides anew exactly what subject matter is being claimed, we direct the examiner's attention to page 6, line 19, to page 7, line 21, of the specification. More specifically, the examiner should compare the appellants' teachings at page 6, line 19, to page 7, line 1, and page 7, lines 2-21, to Devissaguet's Examples 2, 4, 5, 6, and 7 at columns 5-7 and Devissaguet's teachings at column 3, lines 19-33. For example, appellants' specification teaches that (1) simple triglycerides, triglycerides modified by oxyethylenation, volatile silicone oils and mineral oils are "nonactive carrier oils" (Spec., p. 7, l. 2-5), and (2) "[t]he active ingredient is preferably an oleophilic active ingredient which dissolves in oil" (Spec., p. 7, l. 6-7). However, the specification also teaches (Spec., p. 7, l. 10-21):

It is possible, according to the invention, to introduce into the oily phase at least one nonoily active ingredient in a carrier oil and/or in an active oil. This active ingredient, irrespective of its presentation, may be a humectant such as hyaluronic acid, orotic acid or a lipoprotein, an anti-acne agent, a lipid regulator such as an extract of Centella asiatica or gamma-

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orizanol,

anti-aging agent such as vitamin A palmitate, a colorant, a pigment, an emollient such as an isopropyl ester, a keratolytic agent such as retinoic acid or 5-n-octanoyl-salicylic acid.

Thus, when the specification teaches that "[t]he oily phase encapsulated in the nanocapsules may contain an active oil" (Spec., p. 6, l. 19-20) such as "an agent for screening out UV-A and/or UV-B, . . . and/or a bactericidal and/or fungicidal essential oil such as thyme oil, [and/or] an oil with humectant activity" (Spec., p. 6, l. 21-27), the examiner should ask whether persons having ordinary skill in the art reasonably would have interpreted the term "active oil" of Claim 36 in light of the teaching in appellants' specification as including

(1) active ingredients such as a colorant, a pigment, an emollient, a keratolytic agent, etc., in a nonactive carrier mineral oil (compare Devissaguet, col. 3, l. 24-33);
(2) vegetable oils or lipids such as olive and peanut oil (compare Devissaguet, col. 3, l. 19-20 and 21, and col. 7, Example 6); (3) mineral oils (compare Devissaguet, col. 3, l. 20); (4) glycerides of fatty acids (compare Devissaguet, col. 3, l. 21-22); (5) lipophilic medicinal agents such as the analgesic, anti-inflammatory agent indomethacin (compare

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Devissaguet, col. 3, l. 24-27, and cols. 5-6, Example 2); and/or lipophilic dyes or pigments (compare Devissaguet, col. 3, l. 28-29, and col. 6, Example 4). Only after determining exactly what subject matter is encompassed by appellants' claims should the examiner proceed to consider the patentability of the claimed subject matter under 35 U.S.C. § 102 over subject matter the prior art describes and under 35 U.S.C. § 103 in view of the prior art teachings.

On this record, we are constrained to reverse the examiner's finding of anticipation based on an erroneous interpretation of the functional language and scope of the claimed subject matter. However, we remand this case to the examiner for *de novo* interpretation of the meaning of the term "active oil," concomitant determination of the scope of the subject matter claimed, and thereafter, reconsideration of the patentability of pending Claims 36-39 under 35 U.S.C. §§ 102 and 103 in light of the prior art teaching of record.

3. Conclusion

We reverse the examiner's rejections of Claims 36-39 under 35 U.S.C. § 102(b) as being anticipated by European Patent 274,961, published July 20, 1988, and under 35 U.S.C. § 102(e)

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as being anticipated by Devissaguet.

We remand this application to the examiner for *de novo* claim interpretation and further action consistent with this decision and the supporting opinion.

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedures § 708.01(d) (7th ed., rev. 3, July 1998). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED; REMANDED

	William F. Smith)	
	Administrative Patent Judge)	
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	Teddy S. Gron)	BOARD OF
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)	INTERFERENCES
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