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Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARINE KHAYAT and DIDIER CANDAU

Appeal No. 1997-3900
Application 08/258,024

HEARD: November 16, 2000

Before ROBINSON, SPIEGEL, and SCHEINER, Administrative Patent Judges.

ROBINSON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims
1 - 8 and 10-11 which are all of the claims pending in the case.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A cosmetic or dermatological composition in the form of a stable oil-in-water emulsion, comprising

(a) from 15 to 50% by weight of at least one vegetable oil containing at least 40% linoleic acid triglycerides,

(b) from 2 to 7% by weight of a self-emulsifiable composition comprising from 60 to 90% by weight of at least one fatty alcohol having from 12 to 22 carbon atoms, from 10 to 40% by weight of at least one alkylpolysaccharide whose alkyl chain has from 12 to 22 carbon atoms, and from 0 to 5% by weight of polysaccharide,

(c) from 0.5 to 5% by weight of a coemulsifying agent selected from the group consisting of at least one saturated fatty alcohol having from 16 to 32 carbon atoms, a saturated fatty acid having from 16 to 32 carbon atoms and a mixture thereof,

(d) from 0.1 to 1% by weight of a gelling agent, and the remainder consisting essentially of an aqueous phase.

The references relied upon by the examiner are:

Orr et al. (Orr)	4,976,953	Dec. 11, 1990
Ziegler	5,310,5556	May 10, 1994
Brancq et al. (Brancq)	WO 92/06778	Apr. 30, 1992

GROUND OF RECORD

Claims 1 - 8 and 10-11 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies on Brancq, Ziegler, and Orr.

We reverse.

BACKGROUND

The invention is described by applicants, at page 1 of the specification, as being directed to a composition in the form of a stable oil-in-water emulsion which consists essentially of at least one vegetable oil with a high linoleic acid content, a surface active agent based on fatty alcohols and of a gelling agent. The composition is stated to be useful in various cosmetic and dermatological applications.

DISCUSSION

The rejection under 35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicants. (Id.) In order to meet that burden the examiner must provide a reason, based on the prior art, or knowledge generally available in the art as to why it would have been obvious to one of ordinary skill in the art to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n.24, 227 USPQ 657, 667 n.24 (Fed. Cir. 1985). On the record before us, the examiner has not met the initial burden of establishing why the prior art, relied on, would have led one of ordinary skill in this art to modify the oil-in-water emulsions of Brancq in a manner to arrive at the presently claimed composition. The examiner

acknowledges that (Answer, page 3¹):

Brancq differs from the claimed invention in failing to specify the vegetable oil as comprising at least 40% linoleic acid and in failing to teach specifically a coemulsifier (sic, coemulsifier) (although fatty alcohols are present as part of the self-emulsifying system) or gelling agent (although cellulose and may be part of the self-emulsifying system).

The examiner cites Ziegler as teaching cosmetic emulsions comprising .5-20% vegetable oil such as sunflower oil, which is identified by applicants as a vegetable oil within the scope of the claims, and which is disclosed as containing linoleic acid as its primary constituent. (Answer, page 3). Ziegler is, also, urged to teach oily emollients such as fatty acids and fatty alcohols and gelling agents such as xanthan gum which are the same as those identified by applicants as being within the scope of the claims. (Answer, page 4). Orr is cited as teaching cosmetic emulsions comprising 1-20% emollient including vegetable oils such as sesame oil, which falls within the scope of the claimed invention and fatty alcohols, vegetable waxes in combination with 1-10% emulsifier such as a fatty alcohol and gelling agents such as tree exudates and water. (Id.). The examiner then concludes that:

¹ We note that the pages of the Examiner's Answer are misnumbered with an additional unnumbered page appearing between numbered pages 2 and 3. Our reference throughout this opinion reflects the page number which would be appropriate if the pages were correctly numbered.

[I]t would have been obvious to one having ordinary skill in the art at the time of the invention to select the claimed vegetable oils for use in the Brancq emulsion with the reasonable expectation of deriving a cosmetic composition with emollient properties. The motivation lies in the selection of species within the Brancq generic disclosure in view of the disclosed use and advantage of such species by the secondary references. While the primary reference includes fatty alcohols, it would have been within the skill of the art to include a fatty acid or fatty alcohol as the claimed "coemulsifier" in view of the disclosed use of such as either emulsifiers or emollients by the secondary references. The motivation lies in achieving an emollient or additive emulsifier effect. The inclusion of a gelling agent within Brancq is also within the skill of the art in view of the secondary reference teaching of the thickening ability and conventional use of such. [Examiner's Answer, pp. 4-5]

What is missing from the examiner's discussion of the rejection are those facts or evidence which would have directed one of ordinary skill in this art to modify the teaching of Brancq in the manner required to arrive at the claimed invention. As urged by appellants (Principal Brief, page 7):

In order to arrive at the presently claimed composition, starting from example 3 of Brancq et al, one of ordinary skill in the art would have had to, at a minimum, take the following steps:

Step 1: increase the amount of vegetable oil, i.e., of sweet almond oil of Brancq et al, from 5% up to an amount between 15-50% by weight.

Step 2: replace the sweet almond oil by the same amount of a vegetable oil containing at least 40% linoleic acid triglycerides.

Appeal No. 1997-3900
Application 08/258,024

Step 3: add from 0.5 to 5% by weight of a coemulsifying agent.

Step 4: replace the specific polyacrylamide synthetic gelling agent (SEPIGEL 305) of Brancq et al. with a natural gelling agent specified by the presently claimed invention.

We do not question that one of ordinary skill in this art could select and combine the various components required by the claims on appeal in a manner to arrive at a composition which would fall within the scope of the present claims. However, the fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, we find no reason stemming from the prior art which would have led a person having ordinary skill to the modify the composition of Brancq by substituting the various components described by Ziegler and Orr. Thus, in our opinion, the examiner has failed to establish a prima facie case of obviousness within the meaning of 35 U.S.C. § 103 of the subject matter of the claims on appeal.

Where, as here, the examiner fails to establish a prima facie case of obviousness, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). Therefore the rejection of claims 1-8 and 10-11 under 35 U.S.C. § 103 is reversed.

Appeal No. 1997-3900
Application 08/258,024

CONCLUSION

The examiner's rejection of claims 1-8 and 10-11 under 35 U.S.C. § 103 as obvious over the combined teachings of Brancq, Ziegler, and Orr is reversed.

REVERSED

Douglas W. Robinson)
Administrative Patent Judge)
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Carol A. Spiegel) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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Appeal No. 1997-3900
Application 08/258,024

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