

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-LOUIS GUERET

Appeal No. 1998-1939
Application No. 08/403,288

HEARD: May 16, 2000

Before CALVERT, FRANKFORT, and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 26, all the claims in the application.

The claims on appeal are drawn to a brush for the application of a make-up product (claims 1 to 22, 25 and 26), a method for applying nail varnish (claim 23), and a unit for applying a nail varnish (claim 24). They are reproduced in

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Appendix I of appellant's brief, except for the minor
discrepancies noted in section (8) of the examiner's answer.

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The references applied in the final rejection are:

Dyche 1955	2,721,561	Oct. 25,
Gueret (Gueret '281) 1990	4,927,281	May 22,
Guerret 1991	5,020,551	Jun. 4,
Newell 1992	5,159,736	Nov. 3,
Gueret (Gueret '011) 1993	5,238,011	Aug. 24,
Pihl et al. (Pihl) 1995	5,443,906	Aug. 22,
	(effective filing date Mar. 19,	
1992)		
Cole 1985 (British Application)	2,159,699	Dec. 11,
Van Niekerk 1991 (European Application)	405,819	Jan. 2,
Gueret (WO Application) (Gueret '251)	93/14251	Jul. 22, 1993 ¹

Claims 1 to 26 stand finally rejected under 35 U.S.C. 103 as unpatentable over Newell in view of Gueret '011, Cole, Van Niekerk, Pihl, Gueret '251, Gueret '281, Guerret and Dyche.²

¹ A copy of a translation of this reference, prepared for the PTO, is enclosed herewith.

² Our consideration of this appeal has not been facilitated by the manner in which the examiner has stated the rejection. Although several of the references appear to be relevant only to limitations recited in dependent claims, the examiner has simply lumped all the references together in one rejection, leaving it to this Board (and appellant) to attempt

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Turning to claim 1, we glean from the examiner's answer (page 3, section (11), lines 4 to 16, and section (13), first three paragraphs) that the examiner found this claim to have been obvious over Newell in view of Gueret '011 and Cole.

to determine from the examiner's comments (in which he does not state precisely what he considers would have been obvious) in what combinations and to which claims the various references are intended to be applied.

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After fully considering the record in light of the arguments presented in appellant's brief and reply brief, we conclude that claim 1 is unpatentable over the combined teachings of Newell, Gueret '011 and Cole.

Newell discloses a brush usable as, inter alia, "an applicator for applying cosmetics to one's face and/or hands" (col. 1, lines 23 to 25). A tuft of axially-extending bristles 11 is attached to handle 12 by a filament ("staple") 20, made of various plastics (col. 2, lines 45 to 48). The material of the bristles is not specified, except that they, like the rest of the brush, are made of plastic (col. 3, lines 37 to 46).

Cole discloses brushes of various configurations for applying cosmetics such as mascara or lipstick (page 1, line 34). All the disclosed brushes have axially-extending bristles 13, 18, 20, 23, etc.; the brush of Figure 8 also has radially-extending bristles 27. The bristles may be in the form of tufts, can be stapled to the handle (page 2, lines 87 to 96), and are made from "rubber or plastics materials" (page 1, lines 41 to 45).

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Gueret '011 discloses a brush having radially-extending bristles 2 for applying "a make-up product having a liquid to pasty consistency, especially mascara" (col. 2, lines 67 and 68). The patent teaches that in order to deposit a sufficient quantity of make-up while still being soft to avoid irritating contact with the eye (col. 1, lines 14 to 19 and 44 to 47; col. 4, lines 12 to 14), the bristles should be made of elastomeric or thermoplastic material, i.e. (col. 2, lines 32 to 37):

The material is preferably selected from the following group of materials: silicone, EVA=ethylene vinyl acetate copolymer, polyether amide block copolymer, polyester elastomer, EPDM=ethylene propylene diene monomer rubber, polyurethane, SBS=styrene butadiene styrene, latex and nitrile butadiene rubber.

In view of this disclosure of Gueret '011, we consider that it would have been obvious to one of ordinary skill in the art to make the axially-extending bristles of the brushes of Cole out of one of the materials disclosed by Gueret '011, supra, including a thermoplastic elastomer such as EPDM rubber, polyester elastomer, or SBS. Such a modification of the brushes of Cole, which, as discussed above, are disclosed

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as usable for applying mascara, would have been readily suggested by the teaching of Gueret '011 that bristles made of such materials should be used when applying mascara in order to avoid irritating contact with the eye. Although the brush disclosed by Gueret '011 has radially-extending bristles, the teachings of this reference concerning the desirability of using soft bristles to apply mascara would be equally applicable to a mascara brush (such as Cole's) with axially-extending bristles.

Newell is considered to be essentially superfluous to the rejection of claim 1.

Accordingly, the rejection of claim 1 will be sustained, as will the rejection of claims 10 to 22, which appellant has grouped with claim 1 (Brief, page 3, section VII).

Claim 2 recites:

The brush of claim 1, wherein at least a proportion, of the bristles are comprised of a combination of at least one non-elastomeric thermoplastic polymer with at least one material selected from the group consisting of an elastomeric thermoplastic, a vulcanized material and a mixture thereof.

Claim 7 is similar, but is more specific as to the non-elastomeric thermoplastic polymer and does not recite "a

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vulcanized material and a mixture thereof." The only such combination composition we find disclosed in any of the applied references is in Pihl at, e.g., col. 8, lines 45 to 48. However, Pihl's disclosure concerns the structure of abrasive filaments, such as are used in power brushes and the like for abrading metal, plastic, etc. (col. 21, line 61, to col. 22, line 10). We agree with appellant to the extent that we do not consider that one of ordinary skill in the art would have found in Pihl's disclosure of the use of a thermoplastic polymer/thermoplastic elastomer (elastomeric thermoplastic) combination or blend for abrasive filaments any suggestion to employ such a combination for the bristles of a brush used to apply cosmetics; while both types of bristles are used in brushes, their functions are antithetical, in that abrasive filaments are used to remove material from a substrate, while the cosmetic brush is used to apply a material to a substrate.

We therefore will not sustain the rejection of claims 2 and 7, nor of claims 8 and 9, dependent on claim 7.

The rejection of claims 3, 4, 6 and 25 will be sustained on the same basis as claim 1. As to claims 4 and 6, the recited hardness would have been obvious in view of the

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disclosure of a Shore hardness of 20A to 40D at col. 3, line 11 of Gueret '011.

Claim 5 recites:

The brush of claim 1, wherein said material is a vulcanized material selected from the group consisting of a silicone rubber, rubbers with a nitrile function, EPDMs (terpolymers of ethylene, propylene and a diene), natural rubbers, polynorbordenes, and butyl rubbers.

Claims 26 is narrower than claim 5 in that the bristle material is recited as "a vulcanized rubber material." We take official notice³ of the fact that natural and synthetic rubbers generally must be vulcanized in order to have useful properties,⁴ and conclude that one of ordinary skill would interpret the Cole and Gueret '011 disclosures of rubber and synthetic rubber (elastomer) bristles as referring to vulcanized rubber, since bristles made of unvulcanized rubber

³ See In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420-21 (CCPA 1970).

⁴ See 15 McGraw-Hill Encyclopedia of Science & Technology 589 (1992) (copy enclosed). This reference also shows that, contrary to appellant's assertion at page 5 of the brief (last paragraph), vulcanization is not limited to cross-linking by sulfur bonds; see the first paragraph under "Curatives and vulcanization."

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would in all likelihood stick together and generally be unusable for their intended purpose. The brushes claimed in claims 5 and 26 therefore would have been obvious for the same reasons as discussed above with regard to claim 1, and the rejection of claims 5 and 26 will be sustained.

Claims 23 and 24 are specific to the application of nail varnish, claim 23 being essentially drawn to a method for applying nail varnish with a brush as defined in claim 1, and claim 24 to a unit for applying nail varnish comprising a container containing nail varnish and a stopper joined to a brush as defined in claim 1. As noted previously, the Newell brush is disclosed as being utilized as an applicator for applying cosmetics to the hands (col. 1, lines 23 to 25), and since nail varnish is one, if not virtually the only, cosmetic normally applied to the hands, we conclude that it would have been obvious to utilize the brush of Newell for applying nail varnish. With regard to claim 24, Newell shows the brush 11 attached to a sealing cap 14 for a container (col. 3, line 55, to col. 4, line 6). Newell differs from claims 23 and 24 in that it only indicates that the bristles are made of plastic, rather than

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any specific materials. However, the Cole reference suggests that the brushes disclosed therein may be used to apply liquid cosmetic material (page 1, line 65), which would include nail varnish, and in connection with its disclosure that the bristles may be made of rubber or plastic materials, states that "The applicator can thus be made very much more cheaply than a conventional bristle brush" (page 1, lines 46 to 48). In view of this teaching of Cole, we consider that it would have been obvious to one of ordinary skill in the art to make the bristles of the Newell brush of vulcanized rubber in order to reduce the cost of the brush. While this may not be the reason why appellant uses vulcanized rubber bristles, "the law does not require that the references be combined for the reasons contemplated by the inventor." In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

We will accordingly sustain the rejection of claims 23 and 24.

Conclusion

The examiner's decision to reject claims 1 to 26 is affirmed as to claims 1, 3 to 6 and 10 to 26, and reversed as to claims 2 and 7 to 9.

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No period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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CHARLES E. FRANKFORT)	APPEALS
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