The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINJI YANO,
TAKASHI KOMORI,
SHINJI ISHIKAWA,
KATSUMI KITA, and
TAKASHI MIZOOU

Appeal No. 1998-2543
Application 08/606,838

HEARD: April 3, 2001

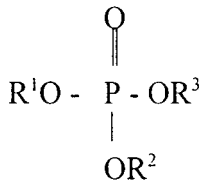
Before WINTERS, SCHEINER, and GRIMES, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 3, 6 through 8, and 12 through 24. Claims 9 through 11, which are the only other claims remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

The invention relates to phosphoric triesters having the formula (I):

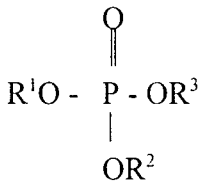


(I)

Where R^1 is a C13-C20 branched alkyl or linear alkenyl; R^2 is C11-C18 linear or branched alkyl or C11-18 linear alkenyl; and R^3 is C1-C6 linear, branched or cyclic alkyl. As explained in the Appeal Brief (Paper No. 13), page 4, applicants' phosphoric triesters are characterized by having two "R" groups which are long in carbon atom length (R^1 is C13-C20 and R^2 is C11-18), with a third "R" group being quite short in carbon atom length (R^3 is C1-C6). Accordingly, the present phosphoric triesters present an "asymmetric" configuration, i.e., R^1, R^2, and R^3 are long, long, and short, respectively. On combination with a suitable carrier, these triesters form an "external" composition, useful in the cosmetic industry and said to have excellent compatibility with the skin, good sensation or feel during use, and a high degree of safety.

Claims 12, 13, 7, and 8, which are illustrative of the subject matter on appeal, read as follows:

--12. A phosphoric triester having the formula (I):

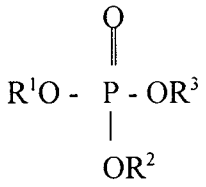


(I)

wherein R^1 is a C13-C20 branched alkyl or linear alkenyl, R^2 is C11-C18 linear or branched alkyl or C11-18 linear alkenyl, and R^3 is C1-C6 linear, branched or cyclic alkyl.

13. An external composition, comprising:

a) a phosphoric triester having the formula (I):



(I)

wherein R^1 is a C13-20 branched alkyl or linear alkenyl, R^2 is C11-C18 linear or branched alkyl or C11-C18 linear alkenyl, and R^3 is C1-C6 linear, branched or cyclic alkyl; and

b) a cosmetically acceptable carrier.

7. A skin or hair applying composition, comprising the external composition of Claim 13.

8. A skin or hair cosmetic composition, comprising the external composition of Claim 13.--

The sole prior art reference relied on by the examiner is:

Japanese Document (Fukazawa) 60163808 Aug. 26, 1985[1]

The issue presented for review is whether the examiner erred in rejecting claims 3, 6 through 8, and 12 through 24 under 35 U.S.C. § 102(b) as described by Fukazawa.

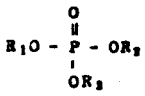
Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, and all of the claims on appeal; (2) the Appeal Brief (Paper No. 13) and the Reply Brief (Paper No. 16); (3) the Examiner's Answer (Paper No. 14); and (4) the above-cited Fukazawa reference.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection under 35 U.S.C. § 102(b).

Discussion

[1] The Japanese document was translated for the Patent and Trademark Office by Diplomatic Language Services, Inc. in December 1996. When we cite to a particular page

Fukazawa discloses compounds, suitable for use in the cosmetic industry, having the following formula:



where R_1 and R_2 indicate hydrogen atoms or alkyl groups with 1 to 36 carbon atoms, and R_3 indicates an alkyl group with 1 to 36 carbon atoms. See, for example, Fukazawa at page 2, claim 1; paragraph bridging pages 4 and 5; and page 5, first full paragraph. We think it clear, based on a review of this reference in its entirety, that Fukazawa <u>prefers</u> compounds where variable R_1 or R_2 is hydrogen. Again, see Fukazawa, page 5, first full paragraph; and see the compounds listed in Tables 1, 2, and 3 (pages 10, 11, and 12, respectively).

It cannot be gainsaid that Fukazawa specifically discloses one trialkyl phosphite, namely, tristearyl phosphite which is listed at the bottom of Tables 1 and 2. That compound, however, does not have an "asymmetric" configuration where, R^1, R^2, and R^3 are long, long, and short, respectively (applicants' nomenclature), but rather has a symmetric configuration where each R group is stearyl. Tristearyl phosphite or a composition containing tristearyl phosphite does <u>not</u> anticipate any of the appealed claims within the meaning of 35 U.S.C. § 102(b).

As best we can judge, the examiner's position is that Fukazawa generically

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of the document, this refers to pagination in the English translation.

discloses alkyl phosphites where each of R^1, R^2, and R^3 may be alkyl having 1 to 36 carbon atoms; that Fukazawa's generic disclosure embraces the subgenus of "asymmetric" compounds recited by appellants; that both Fukazawa and appellants describe compounds suitable for use in the cosmetic industry; and, therefore, that Fukazawa anticipates the appealed claims under 35 U.S.C. § 102(b) (Examiner's Answer, page 3, last paragraph). We disagree with this line of reasoning.

In a nutshell, the phosphoric triesters recited in applicants' claims require that R^1 is a C13-C20 branched alkyl or linear alkenyl; R^2 is C11-C18 linear or branched alkyl or C11-18 linear alkenyl; and R^3 is C1-C6 linear, branched or cyclic alkyl. Again, as explained in the Appeal Brief, page 4, these phosphoric triesters present an "asymmetric" configuration, i.e., R^1, R^2, and R^3 are long, long, and short, respectively. Having reviewed the Fukazawa reference in its entirety, we find that Fukazawa does <u>not</u> identically disclose or describe applicants' "asymmetric" phosphoric triesters. <u>See</u> <u>In re Arkley</u>, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972) (Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.) Fukazawa does not describe applicants' "asymmetric" phosphoric triesters with a reasonable degree of specificity. Apparently, the examiner would invoke a <u>per se</u> rule that a generic disclosure of prior art compounds is sufficient to anticipate a subgenus of those compounds having the same basic properties. However, the examiner does not cite any authority, and we are not aware of any, to support such a proposition. On the facts of this

case, we find that Fukazawa does not describe the subject matter sought to be patented in claims 3, 6 through 8, and 12 through 24 within the meaning of 35 U.S.C. § 102(b).

The examiner's decision is reversed.

REVERSED

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Sherman D. Winters	)
Administrative Patent Judge	)
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	) BOARD OF PATENT
Toni R. Scheiner	)
Administrative Patent Judge	) APPEALS AND
	)
	) INTERFERENCES
	)
Eric Grimes	)
Administrative Patent Judge	)

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