

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

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THEKLA KURZ, SABINE HITZEL, ROLAND MARTIN and RALF EMMERT

Appeal No. 2001-0441
Application No. 08/779,219

ON BRIEF

Before WILLIAM F. SMITH, ELLIS and ROBINSON, Administrative Patent Judges.
ELLIS, Administrative Patent Judge.

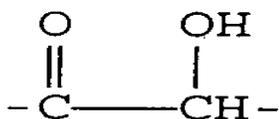
DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 of the examiner's final rejection of claims 1-2 and 7-17. Claims 3-6 are also pending; however, the examiner has only objected to these claims as being dependent on a rejected base claim. Answer, p. 2. According to the examiner, these claims would be allowable if re-written in an independent form which includes all of the limitations of the base claim and any intervening claims. Id. Claims 18-27 have been canceled.

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Claims 1 and 2 are illustrative of the claims on appeal and read as follows:

1. A powder mixture comprising a compound having skin-tanning properties and releasing at least one of formaldehyde or formic acid, a source of sulphite ions and, optionally, a stabilizer.
2. A mixture according to claim 1, wherein the compound having skin-tanning properties contains a ketol group of the formula



The references relied upon by the examiner are:

Andreadis et al. (Andreadis)	2,949,403	Aug. 16, 1960
Schultz et al. (Schultz)	5,049,381	Sep. 17, 1991
Ziegler et al. (Ziegler)	5,232,688	Aug. 3, 1993

Claims 1-2 and 7-17 are rejected under 35 U.S.C. § 103 as being unpatentable over Andreadis and Ziegler in view of Schultz.¹

We reverse.

Background and Discussion

As indicated by claims 1 and 2, above, the present invention is directed to a cosmetic composition which is capable of imparting a tan coloration to the skin.

¹ The claims 1 and 2 were finally rejected under 35 U.S.C. § 112, first paragraph (Paper No. 9); however, that rejection was withdrawn in the Examiner's Answer. Answer, p. 2.

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Specification, p. 1. The composition comprises a skin-coloring compound which releases formaldehyde and/or formic acid, such as dihydroxyacetone (DHA), and sulphite ions. Id., pp. 1-2. The sulfite ions are said to suppress the formation of formaldehyde and formic acid in said compositions. Id., p. 2.

The examiner's conclusion of obviousness is based on the teachings of Andreadis and Schultz.² Answer, p. 4. The examiner argues that Andreadis discloses tanning compositions which comprise DHA, a stearate stabilizer, and conventional adjuvants. Id. The examiner acknowledges that Andreadis does not disclose the use of a sulfite ion, or a cellulose derivative as the stabilizer. Id. To that end the examiner relies on Schultz which discloses cosmetic tanning compositions which comprise certain indoles and a quaternary ammonium halide. Schultz, col. 1, lines 7-10. Schultz further discloses that it may be useful to incorporate an antioxidant, such as an inorganic sulfite, into said compositions in order to prolong the shelf life. Id., col. 4, lines 21-26 and col. 6, lines 25-33. The examiner concludes on page 4 of the Answer that:

... it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions by using the known DHA and combine it with the antioxidants of '381 [Schultz] and use the conventional adjuvants and stabilizers which have been used in the same field of endeavor expecting the same beneficial effect. The idea of combining the ingredients flows logically from the art for having been used for the same purpose. This is a prima facie case of obviousness.

² The examiner relies on Ziegler for teaching a tanning composition which comprises DHA and a stearate stabilizer. Answer, p. 4. However, because these teachings are also provided by Andreadis, we find this reference to be merely cumulative in the context of the rejection.

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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). It is the examiner's responsibility to show 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., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). This the examiner has not done.

Here, we find that the examiner has assumed that because the DHA-based compositions disclosed by Andreadis (and Ziegler) and the indole/quaternary ammonium halide-based compositions disclosed by Schultz are used for the same purpose, i.e., imparting a tan coloration to the skin without prolonged exposure to the sun, that the additives employed in said compositions are interchangeable and will provide the same effect in either context. However, the examiner has not pointed to any evidence of record which supports this assumption. That is, the examiner has not provided any evidence which demonstrates that antioxidants, in general, and sulfite ions, in particular, which are used in indole/quaternary ammonium halide-based skin tanning compositions are also used in DHA-based skin tanning compositions, and that such compounds are used for the

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same purpose. To the contrary, as pointed out by the appellants, the evidence of record shows that the DHA- and indole- based compositions are so different chemically from each other that they are unstable when both are present at the same time. Ziegler, col. 1, lines 52-55. Thus, we find the examiner's sweeping generalizations as to why the the claimed subject matter would have been obvious over the applied prior art to be unsubstantiated and inconsistent with the evidence of record. We remind the examiner that a conclusion of obviousness must be based on fact and not unsupported generalities. In re Freed, 425 F.2d 785, 787, 165 USPQ 570, 571 (CCPA 1970); In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1957 (1968).

Since the examiner has not pointed to any teaching(s) or suggestion(s) in either Andreadis or Schultz that antioxidants, of any kind, are even used in skin tanning compositions comprising DHA, we find that he has engaged in impermissible hindsight in making his determination of obviousness. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)("It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps"); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (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

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record 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”).

Therefore, on this record, we reverse the rejection.

The decision of the examiner is reversed.

REVERSED

WILLIAM F. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOAN ELLIS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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DOUGLAS W. ROBINSON)	
Administrative Patent Judge)	

JE/ki

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Millen, White, Zelano and Branigan
Arlington Courthouse Plaza I
2200 Clarendon Boulevard, Suite 1400
Arlington, VA 22201