

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 SUBRAMANIAN RAGHUPATHI, ABDURI RAMAIAH,
GOVINDARAJAN RAMAN and SUSHAMA SHRIPAD WAGH

Appeal No. 2001-1025
Application No. 09/191,974

ON BRIEF

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

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 10-13 and 16-19. Claims 10-21 are pending in the application.

Claim 10 is illustrative of the subject matter on appeal and is reproduced below:

10. A cosmetic composition comprising:

- (i) From 0.1 to 10% by weight of a peptide having an isoelectric point ranging from 6 to 11;
- (ii) an effective amount for tanning of an agent selected from the group consisting of dihydroxy acetone, theophylline, copper gluconate, and natural actives obtained from Pterocarpus santalinus; and
- (iii) a cosmetically compatible carrier.

The references relied upon by the examiner are:

Hruby et al. (Hruby)	4,918,055	Apr. 17, 1990
Hubaud et al. (Hubaud)	5,075,102	Dec. 24, 1991
Takata et al. (Takata)	5,620,681	Apr. 15, 1997
Hadley et al. (Hadley)	5,683,981	Nov. 4, 1997

GROUND OF REJECTION¹

Claims 10-13 and 16-19 stand rejected under 35 U.S.C. § 103 as obvious over Hruby or Hadley in view of Takata and Hubaud.

We reverse.

DISCUSSION

In reaching our decision in this appeal, we considered appellants' specification and claims, in addition to the respective positions articulated by the appellants and the examiner. We make reference to the examiner's Answer² for

¹ We note the examiner did not repeat the objections of claims 14, 15, 20 and 21 as set forth in the Final Office Action. Therefore the objections of claims 14, 15, 20 and 21 have been withdrawn, as a matter of standard procedure. Cf. Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys., 804 F.2d 659, 663, 231 USPQ 649, 651-652 (Fed. Cir. 1986), cert. denied, 480 U.S. 933 (1987).

² Paper No. 17, mailed July 5, 2000.

the examiner's reasoning in support of the rejection. We further reference appellants' Brief³ for the appellants' arguments in favor of patentability.

THE REJECTION UNDER 35 U.S.C. § 103:

The examiner directs (Answer, page 3) our attention to Paper No. 10⁴ for the statement of the rejection. According to the examiner (Final Rejection, page 3) "Hruby discloses topical compositions comprising alpha-MSH⁵ peptide analogs, wherein said peptide analogues are useful in stimulating melanocyte production in adult humans so that darkening of the skin is achieved." The examiner finds (id.) that Hadley "teach topical compositions comprising cyclic peptide analogs of alpha-MSH, wherein said peptide analogs are useful in achieving darkening of the skin." However, the examiner recognizes (id.) that neither Hruby nor Hadley "disclose combining the skin darkening peptides with additional skin darkening compounds such as those claimed ... i.e. theophylline, dihydroxy acetone and copper gluconate."

To make up for the deficiencies of Hruby and Hadley, the examiner relies on Takata and Hubaud. According to the examiner (Final Rejection, page 3) Takata discloses "self-tanning cosmetic compositions comprising dihydroxy acetone and a polymer ... [and Hubaud], which discloses skin tanning

³ Paper No. 16, received April 24, 2000.

⁴ Final Rejection, mailed October 25, 1999.

⁵ Also known as alpha-melanotropin or alphanelanocyte stimulating hormone, a tridecapeptide of the formula: Ac-Ser-Tyr-Ser-Met-Glu-His-Phe-Arg-Trp-Gly-Lys-Pro-Val-NH₂. See Hruby column 1.

compositions containing theophylline and copper gluconate as sun tan accelerators....”

Therefore the examiner concludes (Final Rejection, page 3) that it would have been prima facie obvious to modify Hruby or Hadley with Takata and Hubaud, “because Hruby or Hadley and Takata and Hubaud establish that alpha-MSH peptide analogs and dihydroxy acetone, theophylline and copper gluconate are known in the art to be useful for effectively darkening the skin.” With reference to In re Susi, 440 F. 2d 442, 445, 169 USPQ 423, 426 (CCPA 1971) the examiner argues (Final Rejection, page 4) “that ‘it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose’....” The examiner further argues (id.) with reference to Akzo v. E.I. du Pont de Nemours, 810 F. 2d 1148, 1152, 1 USPQ2d 1704, 1708 (Fed. Cir. 1987), “[w]ith respect to the claimed concentration, it is held that ‘concentration limitations are obvious absent a showing of criticality’.”

With regard to the claimed isoelectric point and molecular weight, the examiner finds (Final Rejection, page 4) that “since the prior art discloses [a]pplicant’s claimed peptide analogs useful for the same purpose of darkening skin or hair, then the isoelectric point is obvious, if not inherent.” This statement, however, is unclear. Upon review of appellants’ specification, we find no disclosure of alpha-MSH peptide analogs, much less a disclosure of an alpha-MSH peptide analog with any of appellants’ claimed tanning agents. It appears that the examiner has merely asserted that the alpha-MSH peptide analogs are

the same as appellants' claimed peptide analogs, and therefore would necessarily have the same properties. On this record, we cannot agree with the examiner's assertion. We remind the examiner that "[t]he Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). As appellants explain (Brief, page 6) there is no suggestion in either Hadley or Hruby to select, from the plethora of peptides disclosed, only those peptides that have a pI in the range of 6-11 and combine them with "dihydroxy acetone or related tanning agents" as claimed.

As set forth in In re Antonie, 559 F.2d 618, 621, 195 USPQ 6, 8 (CCPA 1977), "[j]ust as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention as a whole, and not some part of it, which must be obvious under 35 USC [§]103. Cf. In re Papesch, 50 CCPA 1276, 315 F.2d 381, 137 USPQ 43 (1963)." On this record, the examiner failed to meet her burden⁶ of establishing that the peptide analogs taught by Hruby or Hadley have an isoelectric point ranging from 6 to 11 as required by appellants' claimed invention. The examiner has also failed to establish that there is some reason or suggestion in the art to select only those peptide analogs of Hruby or Hadley that have an isoelectric point ranging from 6 to 11. We remind the examiner "a rejection cannot be predicated on the mere

⁶ The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

identification ... of individual components of claimed limitations. Rather particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” Ecolochem Inc. v. Southern California Edison, 227, F.3d 1361, 1375, 56 USPQ2d 1065, 1075 (CAFC 2000).

In our opinion, the examiner has failed to provide the evidence necessary to support a prima facie case of obviousness. If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Accordingly, we reverse the rejection of claims 10-13 and 16-19 under 35 U.S.C. § 103 as obvious over Hruby or Hadley in view of Takata and Hubaud.

Having determined that the examiner has not established a prima facie case of obviousness, we find it unnecessary to discuss appellants’ “Declaration under Rule 132” (see Brief, page 7) or the evidence of unexpected results presented in appellants’ specification (see id.).

OTHER ISSUES

Patent applications that contain a disclosure of an unbranched sequence of four or more amino acids must comply with the requirements of 37 C.F.R. §§ 1.821-1.825. We note that an unbranched sequence of six amino acid is set forth on page 4 of appellants' specification. However, it does not appear that appellants have complied with the requirements of 37 C.F.R. §§ 1.821-1.825. Prior to any further action, the examiner and appellants should work together to insure that these requirements are met.

REVERSED

Sherman D. Winters)
Administrative Patent Judge)
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) BOARD OF PATENT
Toni R. Scheiner)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
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Donald E. Adams)
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