

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLAND RAMIN

Appeal No. 2002-0526
Application No. 09/141,515

ON BRIEF

Before LORIN, MILLS, and GRIMES Administrative Patent Judges,

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-38, which are all the claims on appeal in this application.

Claims 1 and 23 are representative of the claims on appeal and read as follow:

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1. A nonaqueous composition comprising at least one film-forming polymer and an organic phase comprising at least one polysaccharide alkyl ether formed of units containing at least two different saccharide rings, wherein each unit contains at least one hydroxyl group substituted with a saturated hydrocarbon-based alkyl chain, and wherein said organic phase further comprises at least one medium which is a solvent for said polysaccharide alkyl ether; and

wherein said nonaqueous composition forms a shiny film when applied to a support.

23. A composition according to claim 1, wherein said solvent for said polysaccharide alkyl ether is an organic solvent.

The references relied upon by the examiner are:

Ramin 5,833,967 Nov. 10, 1998

Commander et al. (Commander) EP 0 708 114 A1 April 24, 1992

Clarke et al (Clarke), "Ethyl Galactomannan Film Properties for Use in Personal Care Applications," Research Disclosure 38413, XP-002067847, pp. 235-236 (1996)

References relied upon by the Appellant are:

"Flow and Consistency Index Dependence of Pseudoplastic Guar Gum Solutions," Drug Development and Industrial Pharmacy (Drug), Vol. 14, No. 7, pp. 905-914 (1988)

"Organic Rheological Additives," Manufacturing Chemist (Chemist), pp. 79-83 (1986)

Kirk-Othmer Encyclopedia of Chemical Technology (Kirk-Othmer), 4th ed. p. 855 (1994)

Grounds of Rejection

Claims 1-22 and 24-38 stands rejected under 35 U.S.C. § 103 as obvious over Clarke in combination with Ramin.

Claim 23 stands rejected under 35 U.S.C. § 103 as obvious over Clarke and Ramin in further view of Commander.

We affirm the rejection of claim 23, vacate the rejection of claims 1-22 and 24-38 under 35 U.S.C. § 103 and remand the application to the examiner for reconsideration of the issues discussed herein.

DISCUSSION

In reaching our decision in this appeal, we have given consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the noted rejection, we make reference to the examiner's Answer for the examiner's reasoning in support of the rejection, and to the appellant's Brief and Reply Brief for the appellant's arguments thereagainst. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 103

1. Claim 23 stands rejected under 35 U.S.C. § 103 as obvious over Clarke and Ramin in further view of Commander.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

According to the examiner (Answer, page 3), Ramin is relied on by the examiner for the disclosure of an organic solvent based nail varnish composition comprising a film forming polymer. The composition may also contain rheological agents such as guar, carob and xanthan gums and a plasticizer. Id. The composition of Ramin may further contain an oily medium, for example plant or mineral oils (column 2, line 54 to column 3, line 12). Id.

In one embodiment Ramin teaches a non-aqueous, solvent based nail varnish having improved sheen (i.e., shine). Example 3, columns 4-5.

Therefore, it would reasonably appear that Ramin teaches each of the claimed components, except for the specific claimed polysaccharide alkyl ether as the rheological agent.¹

The examiner relies on Commander for the disclosure that ethyl guar gum with the degree of substitution greater than 2.4 is useful as a thickener or rheology modification agent in organic solvent compositions that provide coatings/films. Answer, page 4; Commander, Abstract. Clarke teaches that ethyl guar with a degree of substitution greater than about 2.5 is useful in colored cosmetic compositions formed from a homogeneous single oil (organic) phase. The cosmetic compositions include lipstick, which is generally intended to form a shiny film when applied. Answer, page 3. The examiner suggests that one of ordinary skill in the art would have expected guar gum derivatives, such as ethyl guar gum, to provide thickening in the organic solvent based systems of Ramin. Answer, page 5.

We agree that the examiner has provided appropriate evidence to support a prima facie case of obviousness of the composition of claim 23. As stated in Pro-Mold

¹ According to appellant's specification the claimed polysaccharide alkyl ether functions as a thickener in the claimed composition. Specification, page 3.

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& Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629,

(Fed. Cir. 1996) (citation omitted):

It is well-established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references.

In the present case, we find the examiner has provided evidence of a reason, suggestion or motivation to lead one of ordinary skill in the art to combine the cited references in the manner claimed. In particular, the examiner provides evidence (Ramin) of a composition comprising an organic solvent such as that claimed, except for the particularly claimed thickening or rheological agent. The examiner provides evidence that one of ordinary skill in the art would be familiar with the use of ethyl guar gum as a thickener or rheological agent for use with organic solvents or the creation of coatings/film from organic solvents (Commander). Clarke further supports the compatible use of ethyl guar in cosmetic applications.

Where the prior art, as here, gives reason or motivation to make the claimed invention, the burden then falls on appellant to rebut that prima facie case. Such rebuttal or argument can consist of any other argument or presentation of evidence that is pertinent. In re Dillon, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Appellant argues that the disclosure of Ramin relies heavily on the use of water and that the present invention, by contrast, is directed to a nonaqueous composition.

Appellant further argues that Clarke fails to teach ethyl galactomannan in combination with a film forming polymer. Brief, page 5. We agree with the examiner, however, that Ramin clearly contemplates a composition comprising a film-forming polymer and a solvent which can be an organic solvent (i.e., nonaqueous). Column 1, line 65 to column 2, line 6.

Appellant argues that Drug, Chemist and Kirk-Othmer establish that “the natural gums disclosed in Ramin could not replace the polysaccharide alkyl ether component of the present claims because the natural gums therein are used to thicken aqueous phases, not organic phases...” Brief, page 7. Appellant argues that the references “fail to indicate why one of ordinary skill in the art would have been motivated to (1) select at least one of the specific polysaccharide alkyl ethers according to the present claims; and (2) select a nonaqueous solvent system so as to arrive at the claimed composition.” Brief, pages 7-8. We disagree. We find that Ramin's disclosure of the use of guar gum as a rheological agent and references indicating that guar gum is typically used in an aqueous system, to be of no consequence in rebuttal to the examiner's rejection. In our view, the examiner provides adequate evidence of a motivation to combine the cited references, particularly in view of Commander's disclosure of the use of ethyl guar as a thickener or rheological agent for use with organic solvents which would have

reasonably appeared to one of ordinary skill in the art to be readily substituted for the rheological agent in the composition of Ramin which comprises an organic solvent. In our view, the examiner has provided evidence of the requisite motivation to combine the cited references to arrive at the exact same composition, having the attendant properties, as that claimed.

Finally, appellant argues that the examiner misapplies the doctrine of inherency and the doctrine of intended use with respect to the claim limitation that the “composition forms a shiny film when applied to a support.” We agree with the appellant that the recitation that the “composition forms a shiny film when applied to a support” is a recited feature of the claim and should not be characterized as an “intended use”. We are also mindful that “obviousness is not inherent anticipation.” Trintec Industries Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1296; 63 USPQ2d 1597, 1600 (Fed. Cir. 2002); Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). The legal concepts of inherent anticipation and obviousness each have their own set of legal requirements.

For the reasons herein, we agree that the examiner has provided a prima facie case of obviousness for claim 23, which remains unrebutted by appellant with sufficient

evidence.

2. Claims 1-22 and 24-38 stand rejected under 35 U.S.C. § 103 as obvious over Clarke in combination with Ramin. We vacate this rejection and remand the application to the examiner for further consideration.

Upon our review of the record, it would appear that Clarke describes the use of ethyl galactomannan as a "fixative" for an active agent or other ingredient in a hair or skin care product..." and that this property greatly enhances the performance of water-proof or water-resistant products. Clarke, page 1. In our view, the disclosure of Clarke alone does not provide the requisite motivation for combination with the composition of Ramin.

Consistent with the above, however, we do believe that Commander would have supported and provided an appropriate reason, suggestion or motivation for one of ordinary skill in the art to substitute the rheological agent of Commander for the rheological agent in the composition of Ramin. The application is remanded to the examiner for reconsideration of the issue of obviousness of claims 1-22 and 24-38 in view of our discussion

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herein. If the examiner introduces a new rejection of these claims for obviousness, the appellant should be given a fair opportunity to address any such rejection. The examiner should clearly indicate how any such rejection applies to each of the claims rejected in the application.

CONCLUSION

The examiner's rejection of claims 1-22 and 24-38 under 35 U.S.C. § 103 as obvious over Clarke in combination with Ramin is vacated and remanded to the examiner for further consideration, consistent with the discussion herein. The rejection of claim 23 under 35 U.S.C. § 103 as obvious over Clarke and Ramin in further view of Commander is affirmed.

We emphasize that we are not authorizing a supplemental examiner's answer under 37 CFR § 1.193(b)(1).

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This application, by virtue of its “special” status, requires an IMMEDIATE action.
MPEP § 708.01(d). It is important that the Board be informed promptly of any action
affecting the appeal in this case.

AFFIRMED-IN-PART
AND VACATED AND REMANDED

HUBERT C. LORIN)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
DEMETRA J. MILLS)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
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