

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte WALLACE ROGOZINSKI

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Appeal No. 2002-0663  
Application No. 09/504,963

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ON BRIEF

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Before WILLIAM F. SMITH, ADAMS, and MILLS, 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 1-8, which are all the claims pending in the application.

Claims 1 and 5 are illustrative of the subject matter on appeal and are reproduced below:

1. An odor-eliminating air-freshener composition comprising a water-based deodorizing agent having semi-rigid, concave molecular structures which capture odor-causing molecules, soyaethyl morpholinium ethosulfate, and benzethonium chloride.
5. A composition according to claim 1, further comprising volatile and non-volatile solvents, solubilizing agents, chemical carriers, chelators, fragrances, and colorants.

The references relied upon by the examiner are:

Walters et al. (Walters)	4,851,214	Jul. 25, 1989
Eigen et al. (Eigen)	5,676,937	Oct. 14, 1997

European Patent Application Kuhns	0 288 633	Nov. 2, 1988
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Belle-Aire<sup>1</sup>, "New Fragrance Material for Personal Care Products," DCI, pp. 48-49 (1996)

### GROUND OF REJECTION

Claims 1-4 and 6-8 stand rejected under 35 U.S.C. § 103 as obvious over Walters, Belle-Aire and Kuhns.

Claim 5 stands rejected under 35 U.S.C. § 103 as obvious over Walters, Belle-Aire and Kuhns further in view of Eigen.

We reverse.

### CLAIM CONSTRUCTION

The composition of claim 1 is identified as an "odor-eliminating air-freshener." We recognize the arguments of record relating to whether the deodorants taught by the prior art relied upon by the examiner are "equivalent" to an "odor-eliminating air-freshener." For example, appellant argues (Brief, page 6), Walters "cannot render obvious the present claims because the reference is directed to a different field of endeavor." As we understand the claimed invention, the preamble of claim 1 which refers to an "odor-eliminating air-freshener" is simply the intended use of the claimed composition. As set forth in In re Zierden, 411 F.2d 1325, 1329, 162 USPQ 102, 104 (CCPA 1969):

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<sup>1</sup> We note the examiner identifies this reference as Belle-Aire in his listing of "Prior Art of Record." Answer, pages 2-3. However, both the examiner and appellants also refer to this reference as "DCI." See, e.g., Answer, page 11 and Brief, page 7. For consistency we refer to this reference as "Belle-Aire."

A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable. As we said in In re Lemin, 51 CCPA 942, 326 F.2d 437, 140 USPQ 273, 276 (1964),

Appellants are clearly correct in demanding that the subject matter as a whole must be considered under 35 U.S.C. 103. But in applying the statutory test, the differences over the prior art must be more substantial than a statement of the intended use of an old composition. ... It seems to us that the composition ... would be exactly the same whether the user were told to cure pneumonia in animals with it ... or to promote plant growth with it (as here). The directions on the label will not change the composition....

Therefore, we will not entertain any further discussion regarding the intended use of the claimed composition.

In addition, the claimed composition requires the presence of “a water-based deodorizing agent having semi-rigid, concave molecular structures which capture odor-causing molecules.” As set forth in appellant’s specification (page 2-3), this deodorizing agent is Ordenone®.

#### DISCUSSION

##### Claims 1-4 and 6-8:

According to the examiner (Answer, pages 3-4), Walters disclose a “working deodorant comprising ethyl alcohol (volatile solvent or carrier), water (non-volatile solvent and/or carrier), sodium stearate (solubilizing agent), propylene glycol (solubilizing agent) and soyaethyl morpholinium ethosulfate....” The examiner finds that the reference differs from the claimed invention in that Walters does not teach a composition comprising Ordenone® or benzethonium chloride. Answer, page 4.

The examiner relies on Belle-Aire to teach Ordenone®. Answer, pages

4-5. We note that Belle-Aire teaches (page 48, second column, lines 4-8), “[a]ll personal care products – including soaps, creams and lotions, deodorants, foot care, baby care and hair care – can be improved by incorporating this new technology.” Therefore, in our opinion, it would have been prima facie obvious to a person of ordinary skill in the art at the time the invention was made to improve the composition disclosed by Walters by incorporating Ordenone® as taught by Belle-Aire. However, as the examiner points out (Answer, page 5), the combination of Walters with Belle-Aire does not teach benzethonium chloride.

The examiner relies on Kuhns to teach a deodorant composition that includes benzethonium chloride, carriers and colorants. Answer, page 6.

According to the examiner,

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add Kuhns’ composition to the combined composition [of Walters and Belle-Aire] to arrive at a new composition to be applied to humans comprising said soya, benzethonium chloride, and Ordenone[®]. One having ordinary skill in the art would have been motivated to do this because all three prior art references individually disclose a composition that can be employed as a human deodorant and because each prior art reference teaches its composition reacting directly with malodor compounds (amines, sulfides, mercaptans) secreted by the body to reduce or eliminate malodor.

We cannot agree with the examiner's conclusion. Prima facie obviousness based on a combination of references requires that the prior art provide "a reason, suggestion, or motivation to lead an inventor to combine those references." Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

[E]vidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. . . . The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.

In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted). The suggestion to combine prior art references must come from the cited references, not from the application's disclosure. See In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

The deodorant sticks of Walters "are made by amending aqueous alcohol solutions containing the morpholinium ethosulfate with thickening agents such as sodium stearate and the like. Such formulations may contain perfume, medications, coloring agents, fungicides, germicides and drying agents, as well as other preservatives." Walters, column 2, lines 26-31. Walters, however, does not identify which medications, fungicides or germicides can be included in the morpholinium ethosulfate composition disclosed. In contrast to Walters' morpholinium ethosulfate deodorant composition, Kuhns teaches an alkali metal

formaldehydebisulfite deodorant composition. See, e.g., Kuhns, page 4, lines 3-5. According to Kuhns, “[s]uitable disinfectants for use with alkali metal formaldehydebisulfites include ... benzethonium chloride....” Id. at lines 45-48. While the examiner has identified that the compound “benzethonium chloride” can be added to an alkali metal formaldehydebisulfite deodorant composition, there is no evidence on this record that “benzethonium chloride” would be a suitable additive to the morpholinium ethosulfate deodorant composition of Walters, or of the claimed invention.

We are not persuaded by the examiner’s reliance on In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980). As appellant explains (Brief, page 10), in Kerkhoven, “the compositions of the prior art and of slurries A and B of Kerkhoven [sic] were not only useful for the same purpose, they were in fact composed of the same ingredients.” As discussed supra, while the prior art deodorant compositions are useful for the same purpose (as deodorants), they are based on different formulations. There is no evidence on this record to suggest that the prior art deodorant compositions should be combined, nor is there any evidence suggesting that a single component (benzethonium chloride) can be extracted from one prior art deodorant composition for addition into another prior art deodorant composition. In this regard, we remind the examiner that “it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference

fairly suggests to one skilled in the art.” In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also In re Mercer, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975).

Therefore, it is our opinion that the examiner failed to meet his burden<sup>2</sup> of providing the evidence necessary to establish a prima facie case of obviousness. Accordingly we reverse the rejection of claims 1-4 and 6-8 under 35 U.S.C. § 103 as obvious over Walters, Belle-Aire and Kuhns.

Claim 5:

The examiner relies on Walters, Belle-Aire and Kuhns as discussed above. According to the examiner (Answer, page 7), “[t]he new composition resulting from the combination of Walters et al[.], Belle-Aire, and Kuhns includes all that is recited in claim 5 except for the new composition comprising a chelator such as EDTA. However, Eigen et al[.] disclose a personal deodorant composition comprising EDTA.”

In response, appellant argues (Brief, page 15), “[f]or the reasons discussed above, Walters, [Belle-Aire] ..., and Kuhns fail to make obvious the claimed air freshener composition. Eigen fails to remedy the defects of those cited references. Therefore, a prima facie case of obviousness has not been made out with respect to [c]laim 5....” We agree, accordingly, we reverse the

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<sup>2</sup> 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).

rejection of claim 5 under 35 U.S.C. § 103 as obvious over Walters, Belle-Aire  
and Kuhns further in view of Eigen.

REVERSED

William F. Smith )  
Administrative Patent Judge )  
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) BOARD OF PATENT  
Donald E. Adams )  
Administrative Patent Judge ) APPEALS AND  
)  
) INTERFERENCES  
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Demetra J. Mills )  
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Appeal No. 2002-0663  
Application No. 09/504,963

Page 9

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