

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 CRAIG S. SLAVTCHEFF

Appeal No. 95-3981
Application 08/099,880¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge, and WINTERS and WILLIAM F. SMITH, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1, 4, 5, 7, and 8. Subsequently, the examiner withdrew the rejection of claims 4 and 5 indicating that these claims would be allowable if placed in independent form. This leaves claims 1, 7, and 8 for our consideration.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

¹ Application for patent filed July 30, 1993.

1. A composition for forming a peelable cosmetic mask comprising:

(i) a polyvinyl alcohol polymer having a number average molecular weight ranging from about 5,000 to about 200,000; and

(ii) a hydrophobically-modified acrylate or methacrylate polymer, the polyvinyl alcohol and hydrophobically-modified acrylate or methacrylate polymer being present in a relative weight ratio from about 20:1 to about 1:1, and the polymer being a copolymer formed from a monoolefinically unsaturated carboxylic acid or anhydride monomer of 3 to 6 carbon atoms in an amount from about 50 to 99% by weight and a C₁₀-C₃₀ alkyl acrylate ester in an amount from about 1 to about 50% by weight.

The references relied upon by the examiner are:

Gueret et al. (Gueret) 5,026,552 Jun. 25, 1991

UK Patent Application (Mahieu) 2,144,133A July 25, 1983

Noxzema® carton²

Claims 1, 7, and 8 stand rejected under 35 U.S.C. § 103 as unpatentable over Mahieu, Gueret, and/or the photocopy of the Noxzema® carton. We reverse and remand the application to the examiner for further consideration since, in our view, the examiner has premised the examination of this application upon an incorrect interpretation of the claims.

² The examiner has not determined the publication date of this carton. Thus, it is not apparent on what basis the examiner concluded it is prior art against the claims on appeal. Be that as it may, appellant has not disputed that the information contained on the carton which is relied upon by the examiner is prior art. For the purposes of this appeal, we have considered that information.

Rejection Under 35 U.S.C. § 103

The claims on appeal are directed to a composition for forming a peelable cosmetic mask which comprises a specified polyvinyl alcohol polymer and a specified hydrophobically-modified acrylate or methacrylate polymer. Appellant has not directly contested the examiner's determination that the three references relied upon establish a prima facie case of obviousness. Rather, appellant's position in this appeal is summarized at page 9 of the Appeal Brief as follows:

Appellant has provided comparative experiments to demonstrate the unexpectedly good results achieved by a combination of PVA and a hydrophobically-modified acrylate or methacrylate polymer. These comparative experiments (TABLE II and the Declaration) are considered by Appellants as overcoming any prima facie case of obviousness.

The examiner's response to this evidence of nonobviousness is set forth on pages 5-6 of the Examiner's Answer as follows:³

Then a declaration was filed under 37 CFR 1.132 on May 2, 1994. Appellant[']s position is that the declaration is commensurate with the scope of the claims. The examiner[']s position is that in the declaration the testing is very limited two PVA polymers, namely (i) polyvinyl alcohol polymer having an average molecular weight of 7000 and (ii) polyvinyl alcohol polymer having an average molecular weight of 186,000. However claim 1 is not limited to this [sic, these] specific polymers but a range of 5,000 to about 200,000.

³ The examiner cites the following case at the end of the second paragraph of this portion of the Examiner's Answer: "In re Kuelling 15 USPQ (2) 1056." We have been unable to locate a case by that name in volume 15 of the USPQ, second series.

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It is not apparent and appellants [sic] have [sic] not explained why one having ordinary skill in the art would have reasonably extrapolate [sic] the results obtained for two PVA polymers to the various of [sic] polymers belonging to the range 5,000-200,000. Accordingly it would not appear that the probative value of the evidence is commensurate in scope with the degree of protection sought.

Thus, the only objection raised by the examiner to the evidence relied upon by appellant is based upon the examiner's determination that the results obtained using two polyvinyl alcohol polymers having an average molecular weight of 7,000 and 186,000 cannot be extrapolated throughout the range of molecular weights required for this element of the claimed composition.

We are unaware of any hard and fast rules to be followed in determining whether evidence of nonobviousness offered in rebuttal of a prima facie case of obviousness is commensurate in scope with the claims under review. Rather, like so many other determinations in the field of patent law, this determination must be based upon the facts of the case. Here, the examiner has attempted to shift the burden to appellant to explain why the results should be extrapolated. However, in doing so, the examiner has lost sight of the strength of the evidence relied upon in support of the conclusion of prima facie obviousness. Gueret and the Noxzema® carton do describe the use of polyvinyl alcohol in a composition useful in forming a cosmetic mask. However, neither reference specifies the molecular weight of the polyvinyl alcohol. This can be seen as a weakness in the evidence supporting the conclusion of prima

facie obviousness. In other words, the prior art placed no significance on the molecular weight of the polyvinyl alcohol to be used for the purposes of the compositions disclosed in those references. Rather, it was only upon appellant's disclosure of this invention that the significance of the molecular weight of the polyvinyl alcohol became known. Appellant has tested near the outer extremes of the claimed range of molecular weights of polyvinyl alcohol. The examiner has not disputed that the results shown would have been considered unexpected by one of ordinary skill in the art. On this record, we see no reason why appellant should provide any further comparisons.

The rejection under 35 U.S.C. § 103 is reversed.

Remand

By its own terms, claim 1 is directed to a composition for forming a peelable cosmetic mask which comprises the two stated polymers. In rejecting the claims in the Examiner's Answer, the examiner states at page 3 that:

The instant application is claiming cosmetic mask comprising (i) polyvinyl alcohol (ii) hydrophobically modified acrylate or methacrylate copolymer (iii) C₁-C₃ monohydric alcohol (iv) water.

The examiner has misinterpreted the scope of claim 1 on appeal in two significant aspects. First, the examiner has interpreted the statement of intended use in claim 1 "for forming a peelable cosmetic mask" as meaning that the claim is directed to a

cosmetic mask. This is in error. It has long been held that statements of intended use in a composition claim “do not provide limitations by which the claimed composition is distinguished from those of the prior art.” In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Second, this statement indicates that the examiner has apparently interpreted claim 1 as requiring the presence of alcohol and water when these elements are only required by dependent claims 7 and 8.

Further evidence that the examiner has not appreciated the scope of claim 1 on appeal is seen from the entries in the administrative file in the boxes entitled “SEARCHED” and “SEARCH NOTES.” In the box entitled “SEARCHED,” the examiner has only searched subclasses in class 424 and class 514. In the “SEARCH NOTES” box, the examiner has not indicated that any of the computerized data bases available to the patent examiners were searched. Further, the two texts which are listed as being reviewed in the “SEARCH NOTES” box appear to be directed to cosmetic formulations.

All of these facts indicate that the examiner has searched for the claimed combination of polymers as if the claimed composition is limited to a cosmetic mask. It is not. It appears that relevant classes such as class 525 which is directed to mixtures of polymers regardless of their intended use have not been searched. Furthermore, it does not appear that the examiner has used the available computerized data bases.

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Upon return of the application, the examiner should determine the proper scope of all of the pending claims . At that point in time, the examiner should take a step back and ensure that the full scope of the claimed subject matter has been properly searched and evaluated.

In summary, we reverse the rejection under 35 U.S.C. § 103 and remand the application to the examiner for further consideration.

REVERSED and REMANDED

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Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
Sherman D. Winters)	APPEALS AND
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