

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte BURKHARD ROSE and JURGEN TENNIGKEIT

---

Appeal No. 1996-0454  
Application No. 08/195,374<sup>1</sup>

---

HEARD: September 13, 1999

---

Before GARRIS, WARREN and KRATZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal from the refusal of the examiner to allow claims 1 and 3 through 21 as amended

---

<sup>1</sup> Application for patent filed February 14, 1994.

Appeal No. 1996-0454  
Application No. 08/195,374

subsequent to the final rejection<sup>2</sup>. These are all of the claims remaining in the application.

The subject matter on appeal relates to a kit for preparing a ready-to-use composition for permanent waving of human hair which comprises two separate packages having therein a first composition and a second composition with particular pH ranges respectively associated therewith. Prior to application onto human hair, these first and second compositions are mixed to obtain the aforementioned ready-to-use composition with a pH value between 7 and 8. This appealed subject matter also relates to a method for the permanent waving of human hair using these first and second compositions. The subject matter before us is adequately illustrated by independent claim 1, a copy of which taken from the appellants' Brief is appended to this decision.

The references relied upon by the examiner as evidence of obviousness are:

---

<sup>2</sup> By an apparently inadvertent oversight, the above referenced amendment, which was filed June 12, 1995, has not been clerically entered notwithstanding the examiner's entry-authorization via the advisory action mailed June 26, 1995. This oversight should be rectified upon return of the application to the jurisdiction of the examiner.

Appeal No. 1996-0454  
Application No. 08/195,374

Yoshioka et al. (Yoshioka) 1992	5,116,608	May 26,
Kolc et al. (Kolc) 1993	5,223,252	Jun. 29,
British patent (Wella) 1983	2 108 163	May 11,

All of the claims on appeal are rejected under 35 U.S.C. § 103 as being unpatentable over Wella in view of Yoshioka or Kolc.

We refer to the Brief and to the Answer for a thorough discussion of the respective viewpoints expressed by the appellants and the examiner concerning the above noted rejection.

#### OPINION

This rejection cannot be sustained.

Wella discloses two separate compositions which are to be mixed in order to obtain a ready-to-use composition for permanent waving of human hair. However, these compositions do not at all correspond to the here claimed first and second compositions. More specifically, Wella's component one composition includes a thioglycolate and a carbonate in admixture whereas the corresponding ingredients of the

Appeal No. 1996-0454  
Application No. 08/195,374

appealed claims are separated into a first composition and a second composition respectively. Similarly, while the appellants' claimed first composition includes a thioglycolic acid or salt thereof in admixture with an amino acid hydrochloride, the only amino acid compound disclosed by Wella is in his component two composition rather than in admixture with the thioglycolate of his component one composition. Further, the pH values of Wella's respective compositions do not correspond to the pH values of the first and second compositions of the appealed claims.

Although the examiner seems to appreciate the above mentioned distinctions, she nevertheless concludes that "one skilled in the art would be motivated to separate the components [of Wella] into pH compatible packages to obtain enhanced shelf stability" (Answer, page "3" [sic, page 4]). Thus, it seems to be the examiner's position that an artisan with ordinary skill would have recombined the ingredients of Wella's component one composition and component two composition in such a manner as to result in a first composition and a second composition having the here claimed

Appeal No. 1996-0454  
Application No. 08/195,374

ingredients and pH values in order "to obtain enhanced shelf stability." We cannot agree.

The Wella reference contains no disclosure concerning "enhanced shelf stability." It follows that Wella would not have suggested somehow modifying his compositions in the manner proposed by the examiner in order to obtain "enhanced shelf stability." Further, we find no teaching or suggestion and the examiner points to none in either Yoshioka or Kolc regarding the feature of "enhanced shelf stability."<sup>3</sup> Instead, it is only the appellants' own disclosure which teaches enhancing the stability of a permanent waving composition by separating it into first and second compositions of the type here claimed (e.g., see the abstract and the last sentence on page 2 of the subject specification).

Under these circumstances, it is clear that the examiner's rejection is based upon impermissible hindsight derived from the appellants' own disclosure rather than some

---

<sup>3</sup> These secondary references are relied upon by the examiner for their teachings concerning amino acids and the salts thereof in permanent waving compositions.

Appeal No. 1996-0454  
Application No. 08/195,374

teaching, suggestion or incentive derived from the applied prior art. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983). As a consequence, we cannot sustain the examiner's § 103 rejection of claims 1 and 3 through 21 as being unpatentable over Wella in view of Yoshioka or Kolc.

Appeal No. 1996-0454  
Application No. 08/195,374

The decision of the examiner is reversed.

**REVERSED**

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES F. WARREN	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
PETER F. KRATZ	)	
Administrative Patent Judge	)	

bae

**APPENDIX**

1. A kit for preparing a ready-to-use composition for permanent waving of human hair, said kit comprising two separate packages,

a first package containing a first composition comprising thioglycolic acid or a salt thereof, at least one amino acid hydrochloride, and at least one compound chosen from the group consisting of polyol, and a methyl or ethyl ether thereof in an aqueous solution, said first composition having a pH-value of about 4.5 to 6.5, and

a second package containing a second composition comprising at least one compound chosen from the group consisting of ammonium carbonate, ammonium hydrogen carbonate and ammonium carbamate, said second composition having a pH-value of about between 8 and 9.5,

whereby when said first and second compositions are mixed before application onto human hair, a ready-to-use composition produced thereby has a pH-value between 7 and 8, the thioglycolic acid or salt thereof being present at between 4-12% by weight of the ready-to-use composition and the amino acid hydrochloride being present at between 0.5-5% by weight of the ready-to-use composition.

Appeal No. 1996-0454  
Application No. 08/195,374

Dvorak and Traub  
20 Exchange Place  
37th Floor  
New York, NY 10005