

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD D. LEVERE, NADAR G. ABRAHAM,
MICHAL L. SCHWARTZMAN and MICHAEL W. DUNN

Appeal No. 1996-2396
Application 08/285,873

ON BRIEF

Before WILLIAM F. SMITH, ELLIS and LORIN, **Administrative Patent Judges**.

ELLIS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 and 4 through 8, all the claims remaining in the application. Claims 2, 3 and 9 through 13 have been canceled.

Claims 1, 4 and 6 are illustrative of the subject matter on appeal and read as follows:

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1. Method for treating excessive scalp exfoliation or scalp hyperkeratinization in a subject comprising applying to the scalp of a subject with excessive scalp exfoliation or scalp hyperkeratization an amount of vitamin B12 sufficient to alleviate said excessive scalp exfoliation or scalp hyperkeratization.

4. The method of 1 wherein said exfoliation or hyperkeratization is dandruff.

6. The method of claim 1, wherein said subject is a non-human animal.

The reference relied upon by the examiner is:

Choay

3,876,765

Apr. 8, 1975

The claims stand rejected as follows:

Claims 1 and 4 through 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Choay.

Claims 1 and 4 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Choay.

We **reverse**.

Discussion

As indicated by the claims above, the present invention is directed to a method of treating humans and non-human animals suffering from excessive scalp exfoliation or hyperkeratization using vitamin B12. Such conditions of the scalp are said to include dandruff. Specification, p. 2, lines 8-10.

I.

In view of its brevity, we reproduce the examiners rejection under 35 U.S.C. § 102(b) in its entirety:

Choay teaches a method of treating excessive exfoliation of the skin which is encompassing of dandruff comprising the application of B₁₂ to the skin which is encompassing of the scalp. The method has utility in treating both human and non-human animals. (col. 5, lines 35-36; col. 9, lines 30-32; col. 10, lines 44-46; col. 13, lines 28-29; col. 14, lines 40-43 and table I) [Answer, p. 2].

We find the examiner's position untenable.

It is well established that anticipation requires that each and every element set forth in the claim be present, either expressly or inherently, in a single prior art reference. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051,1053 (Fed. Cir. 1987); *Lindemann Maschinenfabrik GMGH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). Thus, in order for the teachings of Choay to anticipate the method described in claim 1, for example, the patent must disclose a method of treating the **scalp** of a subject having excessive exfoliation or hyperkeratization thereof by applying vitamin B12 to said scalp in a manner such that the exfoliation or hyperkeratization is alleviated. To that end, the examiner directs us to consider the disclosure in the patent of the treatment of (i) an erythema-type solar burn of rats with a cream comprising vitamin B12 which resulted in diminished scaling of the rats'

skin (col. 9, lines 30-32); (ii) old rats with a cream comprising vitamin B12 which results in the thickening of the epidermis (col. 10, lines 44-46 and col. 13, lines 28-29); and (iii) solar burns on the skin of mountain climbers with a cream comprising vitamin B12 which in some cases resulted in the scaling of the skin being halted (col. 14, lines 40-43 and Table 1). The examiner has not pointed out, and we do not find, any disclosure in Choay of a method of treating the skin which covers the top of the head; i.e., the treatment of the scalp, with a composition comprising vitamin B12 to alleviate the conditions described in the claims. Thus, it follows that we do not find that the teachings of Choay anticipate the claimed method. Accordingly, the rejection is reversed.

II.

Turning to the rejection under 35 U.S.C. § 103, we find that the examiner acknowledges that Choay does not teach the application of vitamin B12 to the scalp. Nevertheless, the examiner argues that because the scalp is skin found on the top of the head, given the teachings of Choay as to the topical application of the vitamin for the treatment of dry scaly skin, “one skilled in the art would immediately envision the topical application of the taught composition to the skin of the head and alternatively, that one would be motivated to select the scalp within the general teaching of the skin (especially since the scalp is among the topical areas prone to scaling and dryness).” Answer, p. 2. We find the examiner’s arguments unpersuasive.

The examiner has the initial burden under § 103 to establish a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); **In re Piasecki**, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). It is the examiner's responsibility to show that some objective teaching or suggestion in the applied prior art, either explicitly or implicitly, would have led one of ordinary skill in the art to arrive at the claimed invention. **In re O'Farrell**, 853 F.2d 894, 907, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

Here, the examiner acknowledges that the Choay reference is deficient in that it fails to teach the treatment of the scalp. However, she has failed to provide any evidence to support her opinion that (i) one of ordinary skill in the art would "immediately envision" the topical application of vitamin B12 to the skin on the top of the head; i.e., to the scalp, or (ii) that the scalp has a tendency to scaling and dryness and, thus, such persons would be motivated to select the scalp for topical treatment with vitamin B12. We remind the examiner that a conclusion of obviousness is based on facts, and not on unsupported generalities. **In re Freed**, 425 F.2d 785, 788, 165 USPQ 570, 572 (CCPA 1970); **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Since the examiner has not clearly set forth on the record her findings of fact and reasons for concluding that the claimed method would have been obvious to one of ordinary skill in the art, we are constrained to reverse the rejection.

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The decision of the examiner is reversed.

REVERSED

William F. Smith)	
Administrative Patent Judge)	
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Joan Ellis)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
Hubert C. Lorin)	
Administrative Patent Judge)	

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