

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte HENRI SAMAIN  
and ISABELLE CRETOIS

---

Appeal No. 1997-4101  
Application 08/425,802

---

ON BRIEF

---

Before WINTERS, WILLIAM F. SMITH and MILLS, 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 through 3, 6 through 16 and 24 through 33, all the claims remaining in the application. Claims 1, 28, 30 and 31 are representative of the subject matter on appeal and read as follows:

1. A method for the temporary shaping of keratin fibres, which comprises:

(i) formulating a cosmetic composition, wherein said cosmetic composition contains a shaping or shape retaining agent consisting of at least one anionic or nonionic guar gum; and

(ii) applying said cosmetic composition to said keratin fibres.

28. The method according to Claim 1, wherein said keratin fibres are eyelashes or eyebrows.

30. A method for the temporary shaping of keratin fibres, which comprises the following steps:

(i) applying the wet or dry keratin fibres a cosmetic composition, said cosmetic composition containing a shaping or shape retaining agent consisting of at least one anionic or nonionic guar gum;

(ii) shaping the keratin fibres to which said cosmetic composition has been applied; and

(iii) allowing the shaped keratin fibres to dry.

31. The method of Claim 30, wherein said shaping of step (ii) is accomplished using a comb, a brush, or the fingers.

The references relied upon by the examiner are:

Bolich, Jr. et al. (Bolich)	4,472,297	Sep. 18, 1984
Deshpande et al. (Deshpande)	4,847,076	July 11, 1989
UK Patent App. (Czeh)	2 129 455	May 16, 1984

Appeal No. 1997-4101  
Application 08/425,802

Claims 1 through 3, 6 through 16 and 24 through 33 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Bolich, Czeh and Deshpande. We affirm the rejection of claims 1 through 3, 6 through 16, 24 through 27 and 30 through 33. We reverse the rejection of claims 28 and 29.

#### DISCUSSION

Appellants have argued the claims on appeal in four groups, i.e., claims 1 through 3, 6 through 16, 24 and 25; claims 30 through 33; claims 26 and 27; and claims 28 and 29.

1. Claims 1 through 3, 6 through 16, 24 and 25

Claim 1 is representative of this group and is directed to a method for the temporary shaping of keratin fibers. The method comprises formulating a cosmetic composition which contains a shaping or shape retaining agent consisting of at least one anionic or nonionic guar gum. The claim further requires that the cosmetic composition is applied to keratin fibers.

As can be seen, claim 1 requires two positive manipulative steps, i.e., formulating a specified cosmetic composition and applying the cosmetic composition to keratin fibers, e.g., hair. The purpose for performing this method is for the temporary shaping of keratin fibers. Bolich describes formulating a cosmetic composition which contains at least one anionic or nonanionic guar gum and applying that cosmetic

composition to hair. See, e.g., column 1, lines 58-column 2, line 24 and column 7, lines 8-10. In our view, Bolich anticipates claim 1 since it describes the two positive manipulative steps required by that claim. While Bolich does not explicitly state that the purpose of performing the method of that reference is for the “temporary shaping of keratin fibers” or that the guar gum is “a shaping or shape retaining agent,” it has long been held that “merely discovering and claiming a new benefit of an old process cannot render the process again patentable.” In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). As indicated in In re May, 574 F.2d 1082, 1089, 197 USPQ 601, 607 (CCPA 1978), our determination that Bolich anticipates claim 1 is not a new ground of rejection since anticipation is the epitome of obviousness.

2. Claims 30 through 33

Claim 30 is representative of this group. Claim 30 requires three positive manipulative steps, i.e., applying to wet or dry keratin fibers a cosmetic composition as in claim 1 on appeal, shaping the keratin fibers to which the cosmetic composition has been applied and allowing the shaped keratin fibers to dry.

As set forth above, Bolich describes a cosmetic composition as required by claim 30 to hair for the purpose of shampooing. Thus, Bolich describes the first step of claim 30. The question to be resolved is whether Bolich teaches or suggests the shaping and drying steps set forth in claim 30.

We answer the latter question in the positive. When it is considered that “shaping” according to the claims on appeal may be through the simple use of a comb, a brush, or the fingers, as set forth in claim 31 on appeal, it appears to us that Bolich at the least suggest the method set forth in claim 30 on appeal. This follows from a consideration of the normal steps one takes in shampooing ones hair.

We think it is beyond dispute that a person using any shampoo for its ordinary purpose would apply the shampoo composition to wet or dry hair and, at the least, run ones fingers through the hair once the shampoo has been applied. We believe it is truly beyond dispute that persons who have shampooed their hair will allow the hair to dry.

3. Claims 26 and 27

Claim 26 limits the keratin fibers of claim 1 to hair. Claim 27 indicates that the cosmetic composition of claim 1 is a “hair styling and/or fixing composition.” As to claim 26, Bolich clearly describes applying a cosmetic composition according to claim 1 to hair. As to claim 27, we find that this requirement does not substantively limit the method of claim 1 on appeal. Claim 27 does not add any further positive manipulative steps to those required by claim 1 on appeal.

4. Claims 28 and 29

Claim 28 limits the method of claim 1 to where the keratin fibers being treated are eyelashes or eyebrows while claim 29 limits the cosmetic composition used in claim 1 to a

Appeal No. 1997-4101  
Application 08/425,802

“make-up composition for the eyelashes or eyebrows.” The examiner's treatment of these claims as set forth at page 4 of the Examiner's Answer as “eyebrows and lashes are encompassed by the term 'hair.'” While no doubt the examiner is correct in her observation that eyelashes and eyebrows would be considered “hair,” this does not suffice as an explanation why it would have been obvious to one of ordinary skill in the art to apply the composition of Bolich to eyebrows and eyelashes. We note that Bolich states at column 7 lines 8-10 that the composition of that reference may also used “as a cleansing aid for the entire body” but the examiner has not established that one of ordinary skill in the art would have understood this to include application of that composition to eyelashes and eyebrows. Accordingly, we reverse the rejection of claims 28 and 29.

#### SUMMARY

We sustain the examiner's rejection of claims 1 through 3, 6 through 16, 24 through 27 and 30 through 33 and reverse the examiner's rejection as to claims 28 and 29.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Appeal No. 1997-4101  
Application 08/425,802

SHERMAN D. WINTERS  
Administrative Patent Judge

WILLIAM F. SMITH  
Administrative Patent Judge

DEMETRA J. MILLS  
Administrative Patent Judge

)  
)  
)  
)  
)  
) BOARD OF PATENT  
) APPEALS AND  
)  
) INTERFERENCES  
)  
)  
)

WFS/cam

Appeal No. 1997-4101  
Application 08/425,802

Finnegan, Henderson, Farabow  
Garrett and Dunner  
1300 I Street, N.W.  
Washington, DC 20005-3315