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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* UTE BREITENBACH, ANDREAS SCHEPKY,  
URSULA HOLTZMANN, and ALEXANDER FILBRY

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Appeal 2011-004735  
Application 11/573,327  
Technology Center 1600

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Before RICHARD M. LEBOVITZ, MELANIE L. McCOLLUM, and  
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges*.

McCOLLUM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a skin enzyme protection method. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Claims 28-43 are pending and on appeal (App. Br. 3). Claim 28 is illustrative and reads as follows:

28. A method of protecting skin enzymes against damage caused by cleansing, wherein the method comprises applying to skin a cosmetic preparation which comprises an active complex of panthenol, glycerol

and citrate, which preparation has a pH value of 5, a mass ratio of panthenol to citrate anion of from 25 : 1 to 5 : 1, and a mass ratio of glycerol to citrate anion of from 60 : 1 to 10 : 1, and provides an SCTE (Stratum Corneum Tryptic Enzyme) value of cleansed skin of from 120 to 170.

Independent claims 34 and 40 are similar to claim 28, but do not recite a mass ratio of glycerol to citrate anion and additionally recite, respectively, that the preparation comprises at least 3% by weight panthenol and that the preparation comprises at least 5% by weight glycerol.

Claims 28, 29, 32-35, and 38-41 stand rejected under 35 U.S.C. § 103(a) as obvious over Alban et al. (US 5,420,118, May 30, 1995) in view of Marion et al. (US 5,965,145, Oct. 12, 1999) (Ans. 4).

Claims 30, 31, 36, 37, 42, and 43 stand rejected under 35 U.S.C. § 103(a) as obvious over Alban in view of Marion and Finkel et al. (US 5,372,805, Dec. 13, 1994) (Ans. 7).

## I

The Examiner relies on Alban for teaching “skin care compositions comprising water-soluble humectants such as glycerin (i.e. glycerol), D-panthenol, or mixtures thereof, which when applied, provide improved protection from household irritants such as detergents” (Ans. 5). The Examiner finds:

Alban et al. teach that anionic surfactants and detergents penetrate the skin destroying its integrity and that the skin has a tendency to dry out when exposed to detergent solutions, and thus compositions that help maintain the barrier and water retention function of the skin are important in protecting the skin against the harmful effects of washing. . . . Alban et al. further teach the water-soluble humectants are present in the composition from 0.5 to 20% by weight of the compositions,

and that the pH of the composition is preferably from about 4 to 9, more preferably from about 4.5 to about 7. . . . In the examples, Alban et al. teach compositions comprising 3.0% (w/w) glycerin, 0.5% (w/w) panthenol or 2.0% (w/w) glycerin and 1.0% (w/w) panthenol. . . . Examples I and III also comprise 0.175% (w/w) NaOH, and 0.01 % (w/w) citric acid.

(*Id.*) The Examiner also finds that “the compositions taught by Alban et al. may contain keratolytics” (*id.* at 10).

The Examiner relies on Marion for teaching “cosmetic or dermatological compositions that contain a buffer at pH 5” and that “the buffered composition is obtained by adding a base to adjust the pH to 5, then adding a buffer such as a citrate buffer of pH 5 in 0.1 to 10% (w/w) of the composition” (*id.* at 6). The Examiner notes that “the compositions taught by Marion et al. are keratolytic compositions” (*id.* at 10).

The Examiner concludes that it would have been obvious “to add the citrate buffer taught by Marion et al. to the skin protecting composition containing glycerin and panthenol taught by Alban . . . to stabilize the pH of the composition” (*id.* at 6). The Examiner also concludes that, “while the references do not explicitly teach the claimed amounts of glycerin, panthenol, or mass ratio to citrate, the determination of optimal or workable amounts of glycerin, panthenol, and citrate . . . by routine experimentation is obvious absent showing of criticality of the claimed amounts” (*id.*). In addition, the Examiner concludes:

[W]hile Alban et al. do not teach applying the compositions to the skin to protect skin enzymes against damage caused by cleansing, Alban et al. clearly teach the compositions are intended to protect the skin against damage caused by cleansing. It is obvious to use a composition for its intended use, thus it would have been obvious to one of ordinary skill in

the art at the time of the invention to apply the compositions taught by Alban et al. to the skin for their intended use of protecting the skin from damage caused by cleansing.

(*Id.* at 7.)

*Findings of Fact*

1. Albans discloses “a skin care composition in the form of a substantially oil-free aqueous gel comprising . . . from 0.5% to 20% by weight of a water-soluble humectant” (Albans, col. 2, ll. 39-43).

2. Albans also discloses that “these compositions, when applied to the skin, provide the user with improved make-up application and protection from environmental factors (e.g., irritants such as wind, heat and cold) as well as protection from common household irritants (e.g., cleansers and the like)” (*id.* at col. 2, ll. 10-16).

3. In addition, Albans discloses that the most preferred water-soluble humectant “is glycerine (sometimes know[n] as glycerol or glycerin)” (*id.* at col. 3, ll. 3-8).

4. Albans also discloses that “[o]ther useful humectants include D-panthenol” and that “[m]ixtures of these water-soluble humectants can also be used” (*id.* at col. 3, ll. 12-17).

5. In the Examples, Albans specifically describes compositions including both glycerine and D-panthenol (*id.* at col. 10, l. 10, to col. 11, l. 40).

6. In most of these Examples, the compositions also contain citric acid (*id.* (Examples I & III-VI)).

7. Albans also discloses that a “number of additional water-soluble materials can be added to the composition,” including “keratolytic agents such as salicylic acid” (*id.* at col. 8, ll. 33-38, & col. 9, ll. 3-4).

8. In addition, Albans discloses that the “pH of the composition is preferably from about 4 to about 9, more preferably from about 4.5 to about 7” (*id.* at col. 9, ll. 67-68).

9. Marion discloses “a keratolytic composition, including: a keratolytic effective amount of honey; at least one acidic active agent selected from the group consisting of  $\alpha$ -hydroxy acid,  $\beta$ -hydroxy acid,  $\alpha$ -keto acid,  $\beta$ -keto acid, and a mixture thereof; a pH buffered to about 5; and a cosmetically acceptable medium” (Marion, col. 2, ll. 13-20).

10. As the acidic active agent, Marion mentions salicylic acid (*id.* at col. 3, ll. 34-35).

11. Marion also discloses that the buffer “is not particularly limited, but can be in particular a citrate buffer of pH 5” and that the “amount of buffer present in the composition can range, for example, from 0.1 to 10% and preferably from 0.5 to 3% of the total weight of the composition” (*id.* at col. 3, ll. 61-66).

12. In addition, Marion discloses “that such a composition reduces the irritant effect of the acidic active agent without decreasing the activity of these active agents” (*id.* at col. 3, ll. 12-16).

*Principles of Law*

“[W]here there is a range disclosed in the prior art, and the claimed invention falls within that range, there is a presumption of obviousness.”

*Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1322 (Fed. Cir. 2004).

“[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.”

*In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977) (quoting *In re Swinehart*, 439 F.2d 210, 212-13 (CCPA 1971)). “Whether the rejection is based on ‘inherency’ under 35 U.S.C. § 102, on ‘prima facie obviousness’ under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same.” *Id.* at 1252.

#### *Analysis*

Albans discloses applying to skin a cosmetic preparation comprising “from 0.5% to 20% by weight of a water-soluble humectant,” such as glycerol, D-panthenol, and a mixture thereof (Findings of Fact (FF) 1-5). We agree with the Examiner that a preparation comprising at least 5% by weight glycerol, as recited in claim 40, and/or at least 3% by weight panthenol, as recited in claim 34, would have been obvious (Ans. 6 & 15).

Albans also discloses including “keratolytic agents such as salicylic acid” in the composition (FF 7). Marion discloses a keratolytic composition including honey, at least one acidic active agent, such as salicylic acid, and a buffer, such as a citrate buffer of pH 5 (FF 9-11) Marion also discloses that

“such a composition reduces the irritant effect of the acidic active agent without decreasing the activity of these active agents” (FF 12). We agree with the Examiner that it would have been obvious to include Marion’s buffer, specifically a citrate buffer of pH 5, in Albans’ acid-containing keratolytic composition in order to reduce the irritant effect of the acidic active agent (Ans. 6 & 10).

In addition, Marion discloses that the “amount of buffer present in the composition can range, for example, from 0.1 to 10% and preferably from 0.5 to 3% of the total weight of the composition” (FF 11). Given this teaching, as well as the teaching in Albans of including water-soluble humectant in an amount of from 0.5% to 20% by weight, we agree with the Examiner that the applied references broadly suggest compositions that would have the ratios recited in claim 28 (Ans. 6 & 12).

With regard to the claimed SCTE value, we conclude that the Examiner has provided a reasonable basis to believe that “the application of the composition obvious over Alban et al. [in] view of Marion et al. would . . . result in a SCTE value of cleansed skin of from 120 to 170” (Ans. 14). Thus, the burden shifted to Appellants to prove that the suggested method does not possess this property. *In re Best*, 562 F.2d at 1254-55. Appellants have not adequately met this burden.

#### *Conclusion*

The evidence supports the Examiner’s conclusion that independent claims 28, 34, and 40 would have been obvious. Claims 29, 32, 33, 35, 38, 39, and 41 are not separately argued and therefore fall with claims 28, 34, and 40. 37 C.F.R. § 41.37(c)(1)(iv).

II

In rejecting claims 30, 31, 36, 37, 42, and 43, the Examiner additionally relies on Finkel for teaching UVA and UVB filter substances (Ans. 8). Appellants argue that these dependent claims are not obvious for the same reasons as the claims on which they depend, that is, claims 28, 34, and 40 (App. Br. 18). We are not persuaded by these arguments for the reasons discussed above. We therefore also affirm the obviousness rejection of claims 30, 31, 36, 37, 42, and 43.

TIME PERIOD FOR RESPONSE

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

AFFIRMED

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