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MCDERMOTT WILL & EMERY LLP
The McDermott Building
500 North Capitol Street, N.W.
WASHINGTON, DC 20001

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MIYUKI SEKINE and HIROYASU KUMAMOTO

Appeal 2011-012583
Application 12/786,059
Technology Center 1700

Before CATHERINE Q. TIMM, BEVERLY A. FRANKLIN, and
DEBORAH KATZ, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision to reject claims 8-13. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on January 16, 2013.

We AFFIRM.

The Examiner rejects claims 8-10 under 35 U.S.C. § 103(a) as obvious over Ogino¹, Niemiec², or Wetzel³, all in view of Watson⁴. To reject claims 11-13, the Examiner adds Shiroyama⁵.

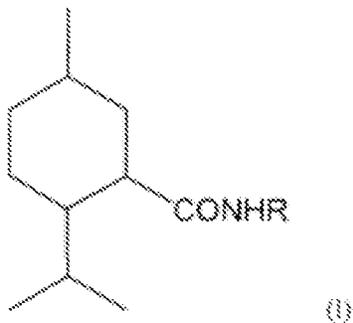
Appellants do not separately argue the patentability of any of the dependent claims (Br. 3). Therefore, we confine our review to claim 8, the only independent claim.

Claim 8 reads as follows:

8. A process for improving a cool and refreshing feeling on a shampoo or body detergent composition, the process comprising a step of formulating a mixture comprising following components (A), (B), (C) and (D);

(A) one or more cool and refreshing feeling substances selected from the group which consists of menthol, menthone, camphor, pulegol, isopulegol, cineol, Japanese peppermint oil, peppermint oil, spearmint oil, and eucalyptus oil,

(B) one or more cool feeling substances selected from the N-substituted-p-menthane-3-carboxamide derivatives represented by the following general formula (I):



¹ Ogino et al., US 4,678,598, patented Jul. 7, 1987.

² Niemiec et al., US 6,495,498 B2, patented Dec. 17, 2002.

³ Wetzel, US 4,885,107, patented Dec. 5, 1989.

⁴ Watson et al., US 4,136,163, patented Jan. 23, 1979.

⁵ Shiroyama et al., US 6,328,982 B1, patented Dec. 11, 2001.

wherein R represents an alkyl group or alkenyl group having 1 to 10 carbon atoms,

(C) one or more components selected from anionic surfactants, and

(D) one or more components selected from water-soluble high-molecular-weight polymers and/or polyhydric alcohols,

wherein the ratio of the cool and refreshing feeling substance of the component (A) to the cool feeling substance of the component (B) is (70:30) to (99: 1) by weight.

(Claims App'x. at Br. 15.)

OPINION

The Examiner relies upon Ogino, Niemeic, and Wetzel as evidence that it was known in the art to use the component (A) substances of claim 8 in shampoos (Ans. 4-5). The Examiner recognizes that these references do not disclose adding a N-substituted-p-menthane-3-carboxamide derivative of the type listed as component (B) in claim 8 (Ans. 5). However, the Examiner cites Watson as disclosing that these derivatives were known cooling agents for use in personal cleansing compositions (Ans. 6-7). According to the Examiner, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a N-substituted-p-menthane-3-carboxamide derivative (component (B)) in the composition taught by Ogino, Niemiec, or Wetzel, with a reasonable expectation of success, because Watson teaches that a N-substituted-p-menthane-3-carboxamide derivative produces a desirable cold sensation in a similar topical cleaning composition (Ans. 6).

Appellants contend that the Examiner has failed to establish a prima facie case of obviousness because Watson teaches away from using menthol

(a component (A) substance of claim 8) in personal care formulations, and there is no suggestion to add menthol to a composition containing N-substituted-p-menthane-3-carboxamide derivatives (Br. 4-6).

The issue is: Have Appellants identified a reversible error in the Examiner's finding of a reason to combine the cooling agents of component (A) with those of component (B) or established that Watson's teaching of disadvantages for menthol is a teaching away sufficient to render the combination nonobvious?

We answer this question in the negative.

Appellants' invention is a shampoo or body detergent combining a component (A) substance such as menthol together with a component (B) substance, which is selected from the N-substituted-p-menthane-3-carboxamide derivatives recited in claim 8 (Spec. ¶ [0010]; Claim 8). The result is said to be an improved cool and refreshing feeling at hair or body washing with an effectively lasting cool feeling effect (Spec. ¶ [0010]).

There can be no real dispute that the group of substances Appellants list as component (A) substances in Claim 8 (menthol, menthone, camphor, pulegol, etc.) were conventional additives for imparting a cool and refreshing feeling to shampoos and other toiletries (Spec. ¶ [0003]; Ogino, col. 1, ll. 15-33; Watson, col. 1, ll. 20-28). Nor is there any dispute that these substances had some known disadvantages (Spec. ¶ [0003]; Watson, col. 1, ll. 37-40). For instance, these substances are volatile and their cooling effect is lost over time as the substance evaporates from the product (Spec. ¶ [0003]). Evaporation also causes a strong stimulus for the eyes and nose (*id.*). For instance, menthol was known to have a strong minty odor (Watson, col. 1, ll. 37-40). However, while menthol was known to have

some disadvantages, it was still extensively used in topical compositions (Watson, col. 2, ll. 1-4).

The claimed component (B) substances were also known in the art (Spec. ¶ [0003]; Watson, col. 2, ll. 29-57). Watson discloses using these compounds as cooling agents in toiletries including in shampoos (Watson, col. 3, ll. 43-49 and Ex. 5 at col. 11, 36-45).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). Therefore, “[i]t is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose.” *In re Kerkhoven*, 626 F.2d 846, 850 (CCPA 1980). In the present case, the substances of components (A) and (B) are taught as useful for the same purpose of providing a cooling effect to shampoos and other toiletries. This supports the obviousness of their combination.

“[I]n general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). For instance, a reference will teach away if it leaves the impression that the product would not have the property sought by the applicant. *Gurley*, 27 F.3d at 552-53 (citing *In re Caldwell*, 319 F.2d 254, 256 (CCPA 1963)). However, a composition does not become patentable simply because it has been described as somewhat inferior to some other composition for the same use. *Id.*; see also *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012) (“[J]ust because better alternatives exist in the prior

art does not mean that an inferior combination is inapt for obviousness purposes.”).

Because the component (A) substances and component (B) substances were known in the art to provide cooling effects to personal care compositions such as shampoos, a preponderance of the evidence supports the Examiner’s finding of a reason to combine those substances to obtain a cooling effect in shampoos and other toiletries notwithstanding that some disadvantages were known with regard to menthol. The evidence does not support a finding of a “teaching away” sufficient to render the combination non-obvious.

Appellants further contend that their process exhibits unexpected results as shown by the data presented in Tables 1-12 of their Specification (Br. 7; Spec. 22-33). However, as pointed out by the Examiner, the data presented in Tables 1-12 shows results only for embodiments containing the combination of menthol and N-ethyl-p-menthane-3-carboxamide (Ans. 13).

The claim encompasses many component (A) compounds. Moreover, the claim encompasses a genus of compounds (B).

Watson states that the cooling sensation created by the compounds of that reference, which include the claimed component (B) genus, varies both in intensity and longevity from compound to compound (Watson, col. 4, ll. 28-31). Appellants’ own Specification states that “[e]very N-substituted-p-menthane-3-carboxamide derivatives [sic] shows a cooling effect, even though their effects are different each other by the difference of their geometric or optical structures.” (Spec. ¶ [0020].)

Appellants contend that the ethyl species they tested is representative of the genus of N-substituted-p-menthane-3-carboxamide derivatives, a

genus they contend amounts to “a couple dozen homologs, all having an identical structure except for the length of the alkyl or alkenyl chain R” (Reply Br. 4). However, Appellants do not account for the differences between the substances of component (A) which include menthol, menthone, camphor, etc. Moreover there is some evidence of differences in activity between the different species of the substances of component (B) (Watson, col. 4, ll. 28-31; Spec ¶ [0020]). Appellants have not provided the kind of factual basis necessary to establish that all of the substances of component (A) in combination with all the substances of component (B) would have the unexpected synergistic cooling effect they argue is obtained for the menthol/N-ethyl-p-menthane-3-carboxamide combination tested.

CONCLUSION

We sustain the Examiner’s rejections.

DECISION

The Examiner’s decision is affirmed.

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)(1).

AFFIRMED

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