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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* ROBERT WEBER and NISHITH PATEL

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Appeal 2012-002460  
Application 11/352,643  
Technology Center 1600

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Before DONALD E. ADAMS, LORA M. GREEN, and  
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*

DECISION ON APPEAL

This is an appeal<sup>1</sup> under 35 U.S.C. § 134(a) from the Final Rejection of claims 1-20.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> The Real Party in Interest is L'Oreal S.A.

<sup>2</sup> Claims 21-26 are also pending, but stand withdrawn from consideration. (App. Br. 2.)

STATEMENT OF THE CASE

*Appellants' Invention*

Appellants' invention relates to a process for making a nail polish varnish with a certain viscosity so that only one coat of polish is needed for nail coverage. (Spec. [0004] and [0005].)

*Exemplary Claim*

Claims 1 is independent and is representative of the invention.

Independent claim 1 is reproduced below with disputed limitations in italics:

1. A process for making a nail polish varnish comprising:
  - (a) providing *a gelled nail polish composition having a Brookfield viscosity of at least about 20 poise*, the composition containing:
    - (i) at least one gelling agent;
    - (ii) at least one film former;
    - (iii) at least one solvent; and
    - (iv) optionally, at least one colorant;
  - (b) providing at least one chemical viscosity reducing agent; and
  - (c) combining the gelled nail polish composition, and the at least one chemical viscosity reducing agent to form *a nail polish varnish having a Brookfield viscosity of at most about 30 poise*.

*Examiner's Rejections*

1. Claims 1-4, 6-17, 19, and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Busch, Jr. (US Patent 3,864,294, issued Feb. 4, 1975 (the '294patent)). (Ans. 4.)
2. Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the '294 patent. (Ans. 7.)

ISSUE 1

*§ 102(b) Rejection of Claims 1-4, 6-17, and 19-20*

Appellants contend that the claim limitations “a gelled nail polish composition having a Brookfield viscosity of at least about 20 poise” and “a nail polish varnish having a Brookfield viscosity of at most about 30 poise” are not disclosed in the ’294 patent. (App. Br. 5.)

*Issue 1:* Does the preponderance of the evidence of record support the Examiner’s finding that the ’294 patent discloses the claim limitations “a gelled nail polish composition having a Brookfield viscosity of at least about 20 poise” and “a nail polish varnish having a Brookfield viscosity of at most about 30 poise” as recited in independent claim 1?

ANALYSIS

We are unpersuaded by Appellants’ contention (App. Br. 5-7) that ’294 patent fails to inherently disclose the claim limitations “a gelled nail polish composition having a Brookfield viscosity of at least about 20 poise” and “a nail polish varnish having a Brookfield viscosity of at most about 30 poise.”

Appellants contend that the ’294 patent fails to disclose either of the two claimed Brookfield viscosities, and simply because the ’294 patent discloses generically, the use of the claimed ingredients, does not mean that the ’294 patent “inherently possess[es] BOTH the initial and final claimed Brookfield viscosities” as recited in claim 1. (App. Br. 5, emphasis in original.)

However, the Examiner specifically points to the location in the '294 patent where each claimed composition element recited in claim 1 is disclosed. (Ans. 10-11.) The Examiner correctly cites to MPEP 2112.01, which states that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). The composition elements disclosed in the '294 patent overlap with the concentration ranges (by weight) identified in Appellants' Specification. Specifically, Appellants' Specification teaches the use of a (i) gelling agent in a 1.0-5.0% range (para [0029]) and the '294 patent discloses a 0.5-5.0% range (col. 5 ll. 60-62), (ii) a film former in a 1.0-20% range (para [0039]) and the '294 patent discloses a 5.0-25% range (col. 6, ll. 33-35), (iii) a colorant in a 1.0-25% range (para [0056]) and the '294 patent discloses a 0.01-10% range (col. 7 ll. 1-2), (iv) a solvent in a 10-80% range (para [0045]) and the '294 patent discloses a 30-85% range (col. 6 ll. 45-46), and (v) a viscosity reducing agent in a 0.05-0.20% range (para [0064]) and the '294 patent discloses a 0.0001-.1% range (col. 6, ll 15-17.) Therefore, because the claimed composition elements, the combination of the claimed composition elements, and overlapping concentrations of composition elements are disclosed in the '294 patent, the Examiner finds that the limitation "20 poise viscosity" is inherently disclosed as an intrinsic property of the composition of the claimed elements. (Ans. 11-12.)

The Examiner also finds that the limitation "30 poise viscosity" of claim 1 is obtained by combining the gelled nail composition and chemical viscosity reducing agent. According to the Examiner, the '294 patent

discloses this limitation by adding paste composition B with pigmented Lacquer base B and then adding in orthophosphoric acid. (Ans. 12.) Orthophosphoric acid reads on “chemical viscosity reducing agent” because the chemical reducing agents can be “acids or bases” (claim 16). (*Id.*) Accordingly, the Examiner has established a *prima facie* of anticipation. Appellants have failed to rebut the *prima facie* case by providing evidence that the ’294 patent does not inherently possess the characteristics of the claimed invention.

Appellants also contend that the various compositions disclosed in the examples section of the ’294 patent contain numerous ingredients outside the scope of those that are claimed and Appellants have no idea what role said ingredients play in the initial and final Brookfield viscosities of the compositions in the ’294 patent. (App. Br. 5.) However, as the Appellants correctly noted, the use of the transitional phrase “comprising” does not exclude the presence of other elements. (*Id.*) Therefore, the Examiner finds that the ’294 patent renders claim 1 unpatentable. We agree. Accordingly, we affirm the rejection of claim 1 under 35 U.S.C. § 102(b).

Appellants have not presented any substantive arguments with respect to dependent claims 2-4, 6-17, and 19-20, thus, these claims fall with representative claim 1. Accordingly, we affirm the rejection of claims 2-4, 6-17, and 19-20 under 35 U.S.C. § 102(b).

## ISSUE 2

### *§ 103(a) Rejection of Claims 1-20*

Appellants contend that the claim limitations “a gelled nail polish composition having a Brookfield viscosity of at least about 20 poise” and “a

nail polish varnish having a Brookfield viscosity of at most about 30 poise” are not taught or suggested in the ’294 patent. (App. Br. 7.)

*Issue 2:* Does the preponderance of the evidence of record support the Examiner’s finding that the ’294 patent teaches or suggests the claim limitations “a gelled nail polish composition having a Brookfield viscosity of at least about 20 poise” and “a nail polish varnish having a Brookfield viscosity of at most about 30 poise” as recited in independent claim 1?

#### ANALYSIS

We are unpersuaded by Appellants’ contention (App. Br. 7-8) that the ’294 patent fails to teach or suggest the claim limitations “a gelled nail polish composition having a Brookfield viscosity of at least about 20 poise” and “a nail polish varnish having a Brookfield viscosity of at most about 30 poise.”

Appellants contend the Examiner has “failed to provide a basis in fact and/or technical reasoning to support a determination that the compositions of the ’294 [patent] inherently possesses the claimed Brookfield viscosities.” (App. Br. 7.) Appellants specifically contend that the composition of the ’294 patent is materially different in terms of its viscosity from the claimed invention, for the following reasons: (1) the gelled nail composition in the ’294 patent is such that its initial viscosity is reduced by virtue of the degree of shear applied to the composition during the composition’s application onto a nail using a brush while the “viscosity of the claimed invention is NOT reduced via shear, but rather, via the use of the claimed viscosity reducing agent.” (*Id.* at 8, emphasis in original; ’294

patent col. 5, lines 49-58); and (2) contrary to Examiner's position, the '294 patent does not disclose the use of a viscosity reducing agent because the orthophosphoric acid in Examples I and III is present in only trace amounts (0.02%) (*id.*).

However, as discussed above, the Examiner finds that the '294 patent discloses substantially similar chemical elements as recited in claim 1 in similar concentration ranges as disclosed by Appellants' Specification; thus, the properties Appellants are claiming regarding the viscosity are considered to be inherently present. (Ans. 14.) The Examiner also finds that the '294 patent does not teach that its initial viscosity is reduced by virtue of the degree of shear applied to the composition. (*Id.* at 15, citing '294 patent col.5, ll. 49-58.) The Examiner further finds that orthophosphoric acid reads on "**chemical viscosity reducing agent**" even if it is present in trace amounts, because the claims as currently recited do not require any weight percentage for the acidic compound (chemical reducing agent.) (Ans. 16, emphasis in original.) Further, the concentration range for the orthophosphoric acid disclosed in the '294 patent (col. 6, ll. 15-17) overlaps with the concentration range disclosed in Appellants' Specification (para [0064]). Therefore, the Examiner finds that the '294 patent renders claims 1 obvious. We agree with the Examiner's findings.

Accordingly, we affirm the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a). Claims 2-20 fall with claim 1.

Appeal 2012-002460  
Application 11/352,643

DECISION

The rejections of record are affirmed.

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)(iv).

AFFIRMED

cdc