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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/754,682	04/06/2010	Robert A. Predale	J&J5448USNP	7192

27777 7590 07/27/2016

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EXAMINER	
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ART UNIT	PAPER NUMBER
3689	

NOTIFICATION DATE	DELIVERY MODE
07/27/2016	ELECTRONIC

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT A. PREDALE,
RAYMOND SHARPLES,
and JENNIFER SAXE

Appeal 2014-001630
Application 12/754,682
Technology Center 3600

Before ANTON W. FETTING, PHILIP J. HOFFMANN, and AMEE A. SHAH, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE[1]

Robert A. Predale, Raymond Sharples, and Jennifer Saxe (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1, 3–5, 8, 9,

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[1] Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed June 19, 2013) and the Examiner's Answer ("Ans.," mailed September 12, 2013), and Final Action ("Final Act.," mailed January 22, 2013).

16, and 17, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

The Appellants invented a way of producing formulated products with reduced environmental impact. Specification 1:6–7.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below (bracketed matter and some paragraphing added).

> 1. A computer-implemented method for formulating and producing a product with environmentally preferred ingredients comprising;
>
> [1] – obtaining a preliminary formula for the product having a plurality of chemical ingredients,
>
> each chemical ingredient having a predefined functional category,
>
> [2] – determining at least one alternative chemical ingredient
>
> within the functional category
>
> that is suitable for use in the product,
>
> [3] – determining an environmental score for
>
> the chemical ingredient
>
> and
>
> the at least one alternative chemical ingredient;
>
> [4] wherein the environmental score for the chemical ingredient and the alternative chemical ingredient is based on
>
> environmental persistence,
>
> bioaccumulation through the food chain
>
> and
>
> direct toxicity to aquatic organisms;

[5] wherein the environmental score for the ingredient and the at least one alternative ingredient is determined

without regard to the functional use of the ingredient;

[6] wherein the presence of water in the formulation, if any, is not

included as either a chemical ingredient

or

used in determining the environmental score for the formulation;

[7] wherein the ingredient is assigned an environmental score ranging from zero to 100

and

[8] wherein

the environmental score of zero signifies that the ingredient has characteristics that could cause several different types of adverse environmental effects

and

an environmental score of 100 signifies that none of the characteristics evaluated suggests that the ingredient would pose an environmental concern when used in the personal care product;

[9] – wherein if the environmental score for said alternative ingredient is higher than the environmental score of said chemical ingredient,

then the alternative ingredient is incorporated into the product in place of said chemical ingredient.

The Examiner relies upon the following prior art:

Withiam	US 2004/0001794 A1	Jan. 1, 2004
Long '362	US 6,973,362 B2	Dec. 6, 2005
Long '084	US 7,096,084 B2	Aug. 22, 2006

Claims 1, 3–5, 8, 9, 16, and 17 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1, 3–5, 8, 9, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Long '362, Long '084, and Withiam.

ISSUES

The issues of statutory subject matter turn primarily on whether the claims are directed to abstract ideas. The issues of obviousness turn primarily on whether the art applied describes positively omitting any presence of water from determining an environmental score.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Long '362

01. Long '362 is directed to producing products with reduced environmental "footprints." Long '362 1:17–18.

Long '084

02. Long '084is directed to producing products with reduced environmental "footprints." Long '084 1:20–21.

Withiam

03. Withiam is directed to inhibiting body odor by applying to the skin an effective amount of a personal care composition

comprising calcium silicate capable of absorbing volatilized malodors. Withiam, para. 8.

ANALYSIS

Claims 1, 3–5, 8, 9, 16, and 17 rejected under 35 U.S.C. § 101 as directed to non–statutory subject matter

The Supreme Court

> set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, [] determine whether the claims at issue are directed to one of those patent-ineligible concepts. [] If so, we then ask, "[w]hat else is there in the claims before us? [] To answer that question, [] consider the elements of each claim both individually and "as an ordered combination" to determine whether the additional elements "transform the nature of the claim" into a patent-eligible application. [The Court] described step two of this analysis as a search for an "'inventive concept'"—i.e., an element or combination of elements that is "sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself."

Alice Corp., Pty. Ltd. v CLS Bank Intl, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept. We find that this case's claims themselves and the Specification provide enough information to inform one as to what they are directed to.

The preamble to claim 1 recites that it is a method of formulating and producing a product. The steps in claim 1 result in incorporating ingredients

into a product. The Specification at 1 recites that the invention relates to the producing of formulated products with reduced environmental impact. Thus, all this evidence shows that claim 1 is directed, not just to a computer implementation of deciding which ingredients to use, but further, to actually producing physical product incorporating those ingredients. The claims at issue here are directed to physical rather than abstract subject matter.

Claims 1, 3–5, 8, 9, 16, and 17 rejected under 35 U.S.C. § 103(a) as unpatentable over Long '362, Long '084, and Withiam

We are persuaded by Appellants' argument that

> [t]here is no relationship between Withiam's teaching regarding water (i.e., that a particular personal care product can be formulated with or without water and still remain effective) and that in the present invention (i.e., that environmental performance of a personal care product is governed by hazard properties of the non-water ingredients).

App. Br. 13. The Examiner finds that the limitation at issue, i.e. "wherein the presence of water in the formulation, if any, is not included as either a chemical ingredient or used in determining the environmental score for the formulation" only has effect when water is present and that Withiam describes ignoring the presence of water in a formation. Ans. 16. The limitation at issue requires a positive test for the presence of water in the formulation, and if any, not including such water as either a chemical ingredient or using it in any manner in determining the environmental score for the formulation. In the case that water is included, the Examiner further finds that Long provides the motivation to

> "evaluate each chemical component from the standpoint of its ultimate use". (Long '084 col. 5, lines 20-30) It would also have

> been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Long '362, Long '084 and Withiam because of the motivation to have well informed consumers and personal care products constructed in a manner that benefits the user. Long '362/Long '084 teach evaluating chemical components based on their function in the product. Withiam teaches the assessment of the ingredients of personal care products

Ans. 17; *see also* Final Act. 8. The Long citation follows a sentence describing that it is unnecessary that a chemical bear a "scarlet letter." Long '084, *id.* Thus, the cited part of Long '084 does not suggest ignoring the presence of water in determining a score, but only taking the use of an ingredient into account in scoring its environmental effect. Similarly, Withiam only describes evaluating the ingredients in products that may or may not contain water and the paragraphs the Examiner cites, *viz.* 10, 11, and 42–50, do not recite the word "water" at all. The Examiner makes no finding for a positive test for the presence of water in the formulation, and if any, not including such water as either a chemical ingredient or using it in any manner in determining the environmental score for the formulation.

CONCLUSIONS OF LAW

The rejection of claims 1, 3–5, 8, 9, 16, and 17 under 35 U.S.C. § 101 as directed to non–statutory subject matter is improper.

The rejection of claims 1, 3–5, 8, 9, 16, and 17 under 35 U.S.C. § 103(a) as unpatentable over Long '362, Long '084, and Withiam is improper.

DECISION

The rejection of claims 1, 3–5, 8, 9, 16, and 17 is reversed.

REVERSED