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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LUDOVIC THEVENET

Appeal 2014-004213
Application 11/663,772
Technology Center 1600

Before JEFFREY N. FREDMAN, RICHARD J. SMITH, and
DAVID COTTA, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal¹ under 35 U.S.C. § 134 involving claims to a method of applying nail varnish to human nails. The Examiner rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Statement of the Case

Background

“The present invention relates to a method of applying makeup to a natural surface, such as the skin, the nails, hair, or the lips, or to an artificial

¹ Appellant identifies the Real Party in Interest as L’Oreal (*see* App. Br. 1).

surface, such as false nails, and it also relates to a kit for implementing such a method” (Spec. 1: 3–7).

The Claims

Claims 1, 3–12, 14, 16–22, and 33–39 are on appeal.² Claim 1 is representative and reads as follows:

1. A method of applying nail varnish to nails, comprising:
manually depositing, using a non-magnetic cosmetic applicator, at least nail varnish on a surface of a human nail, the nail varnish comprising:
magnetic bodies that are movable under the effect of a magnetic field; and
at least one interferential pigment; and
after the depositing, manually exposing at least part of nail varnish to a magnetic device producing a magnetic field, the magnetic device located above the nail varnish during the exposing, so as to modify the orientation and/or displace at least some of the magnetic bodies resulting in formation of a visible pattern on the nail varnish according to the magnetic field of the magnetic device, the magnetic bodies within the pattern being oriented and/or displaced differently than the magnetic bodies outside of the pattern.

The issues

A. The Examiner rejected claims 1, 3, 4, 8, 9, 12, 14, 16, 17, and 19–22 under 35 U.S.C. § 103(a) as obvious over Raksha,³ Harrison,⁴ Phillips,⁵ as evidenced by Kurtus⁶ and Roeben⁷ (Ans. 2–9).

² We note that Appellant acknowledged, in the oral hearing held on October 14, 2016, that inadvertent typographical errors in claim 33 regarding the phrase “such that neither a magnet of the magnetic device nor the engaged portion of the magnetic device does not contact the surface or the composition” were introduced in the claims filed Dec. 22, 2011.

B. The Examiner rejected claims 5–7, 10, and 11 under 35 U.S.C. § 103(a) as obvious over Raksha, Harrison, Phillips, and Lauterbach,⁸ as evidenced by Kurtus and Roeben (Ans. 9–11).

C. The Examiner rejected claim 18 under 35 U.S.C. § 103(a) as obvious over Raksha, Harrison, Phillips, and Gueret,⁹ as evidenced by Kurtus and Roeben, (Ans. 11–13).

D. The Examiner rejected claims 33–39 under 35 U.S.C. § 103(a) as obvious over Raksha, Harrison, Phillips, and Jenkins,¹⁰ as evidenced by Kurtus and Roeben, (Ans. 13–16).

Because all of the rejections rely upon the Raksha reference in combination with other references and utilize the same reasoning, we will consider the rejections together.

³ Raksha et al., US 2004/0009309 A1, published Jan. 15, 2004 (“Raksha”).

⁴ Harrison et al., US 6,209,548 B1, issued Apr. 3, 2001 (“Harrison”).

⁵ Phillips et al., US 2002/0182383 A1, published Dec. 5, 2002 (“Phillips”).

⁶ Kurtus, Ron, *Detection of a Magnetic Field*, [http://web.archive.org/20040604040622/http://www.school-for-champions \(2004\)](http://web.archive.org/20040604040622/http://www.school-for-champions (2004) (“Kurtus”).) (“Kurtus”).

⁷ Roeben, Scott, *Ferretting Out Funny Money: Fighting Counterfeiting*, (<web.archive.org>) on 03-FEB-2004 from <dribbleglass.com/subpages/counterfeit.htm>) (“Roeben”).

⁸ Lauterbach et al., US 5,562,706, issued Oct. 8, 1996 (“Lauterbach”).

⁹ Gueret, J., US 2002/0182409 A1, published Dec. 5, 2002 (“Gueret”).

¹⁰ Jenkins, N., US 5,316,026, issued May 31, 1994 (“Jenkins”).

The Examiner finds that “RAKSHA teaches a method of applying magnetic flake pigments in a fluid medium, aligning according to the magnetic field of a magnetic device and subsequently curing to fix the appearance such that a visual effect is achieved” (Ans. 5). The Examiner further finds that “[t]his method is taught as being broadly applicable to, among other fields, cosmetics; and RAKSHA clearly teaches that color shifting visual effect flake pigments, as utilized in their invention, are also utilized in fingernail polish” (*id.*).

The Examiner finds Harrison teaches “applying a cosmetic nail paint with a pen-like applicator” and a “pearlescent pigment” (Ans. 5–6). The Examiner finds Phillips teaches “three dimensional-like effects are produced by exposing the magnetic pigment coating to [an] external magnetic force” (Ans. 6, citing Phillips ¶ 51).

The Examiner finds that:

A person having ordinary skill in the art would have recognized that the method steps of (1) applying (manually depositing) a composition of magnetic pigment flakes in a fluid carrier to a substrate; (2) applying a magnetic field (i.e. manually exposing to a magnetic field) to the magnetic pigment flakes while the carrier is still fluid; and (3) curing (drying) to fix the alignment of the magnetic pigment flakes, having been taught as enhancing the visual appearance due to aggregate optical effects of the planarized pigment flakes, would have predictably functioned as enhancing the visual appearance due to aggregate optical effects of the planarized pigment flakes in a method of applying a fingernail polish (varnish).

(Ans. 8).

Appellant contends that “[n]one of the pigment flakes described in the background section of Raksha are explicitly magnetic, nor is there any

indication that pigments in nail varnish, which are well known, should be magnetically manipulated while on nails to produce a pattern” (App. Br. 8). Appellant contends that “Raksha provides no starting point or guidance to suggest that its methods are applicable in the field of cosmetics, and/or how to apply or adapt the teachings therein in order to practice Appellant’s claimed methods” (App. Br. 12). Appellant contends that “[a]bsent knowledge of Appellant’s invention, there would have been no reason to combine the applied references in the manner necessary to arrive at the claimed methods” (App. Br. 13).

The issue with respect to this rejection is: Does the evidence of record support the Examiner’s conclusion that the prior art renders the method of claim 1 obvious?

Findings of Fact

1. Raksha teaches a “magnetic field is applied to planarize magnetic pigment flakes relative to a surface. Pigment flakes, such as optically variable pigment flakes, are used in a variety of paints, inks, extrusions, powder coatings, and other forms for decorative and security applications” (Raksha, abstract).

2. Raksha teaches “[p]igment flakes are used in a variety of applications, such as paint, inks, textiles, cosmetics, extruded films, plastic castings, and powder coatings” (Raksha ¶ 5).

3. Raksha teaches “[e]xamples of such color-shifting images are used as security features on bank notes, like the U.S. 20-dollar bill, and for decorative purposes on and in a wide variety of consumer items, including vehicles, helmets, eye glass frames, fingernail polish, and cell-phone cases, to name a few” (Raksha ¶ 5).

4. Raksha teaches:

Magnetic pigment flakes in a fluid carrier are applied to a substrate (step 602). A magnetic field is applied to the magnetic pigment flakes to align the flakes in the plane of the substrate (step 604) while the carrier is still fluid. The carrier then typically dries, cures, or sets to fix the alignment of the flakes (step 606).

(Raksha ¶ 41).

5. Raksha teaches:

Factors such as the time available for planarization, viscosity of the carrier, size of the flake, and magnetic characteristics of the flake may affect the desired alignment of the flakes. Similarly, it is understood that even after magnetic planarization not all flakes are perfectly aligned in the plane of the substrate, and that improvement in the visual characteristics of the image formed with the magnetic pigment flakes is a matter of degree, the suitability of which might depend on the initial state flakes and the desired effect, for example.

(Raksha ¶ 34).

6. Harrison teaches a “method and apparatus for applying nail paint is disclosed. In a preferred embodiment a pen-like applicator is provided that comprises a barrel wherein nail paint is contained and a nib that is configured for applying nail paint to a nail” (Harrison, abstract).

7. Harrison teaches “nail polish is typically applied to finger and toe nails using a brush. Traditionally, nail polish is provided in jar containers, and a fiber brush that is attached to a plastic stick is used to apply the nail polish to nails” (Harrison 1:18–21).

8. Harrison teaches “[p]rior art nail polish is typically available in a variety of finishes, including matte, gloss, pearl, pearlescent, glitter, and protectant finishes” (Harrison 3:7–9).

9. Phillips teaches “producing coated articles having three dimensional-like images using magnetic pigment compositions” (Phillips ¶ 2).

10. Phillips teaches:

magnetic pigments have been developed for use in applications such as decorative cookware, creating patterned surfaces, and security devices. Similarly, color shifting or optically variable pigments have been developed for such uses as cosmetics, inks, coating materials, ornaments, ceramics, automobile paints, anti-counterfeiting hot stamps, and anti-counterfeiting inks for security documents and currency.

(Phillips ¶ 4).

11. Phillips teaches:

The three dimensional-like effects are produced by exposing the magnetic pigment coating to an external magnetic force, thereby orienting the major planar surfaces of some of the pigment flakes substantially normal to the surface of the coating. The unoriented pigment flakes lie with their major planar surfaces substantially parallel to the surface of the coating. The three dimensional-like effect is due to the alignment of the pigment flakes or particles such that the aspect ratio is oriented with the magnetic field, i.e., the longest part of the pigment flake or particle aligns itself along the magnetic field lines. Thus, colored faces of the pigment flakes that are magnetically reoriented are turned away from the observer to various extents depending on the magnitude of the magnetic force. In the region(s) of maximum reorientation (normal), the coating appears black in color due to light trapping.

(Phillips ¶ 51).

Principles of Law

To establish a prima facie case of obviousness, the Examiner must find “a reason that would have prompted a person of ordinary skill in the

relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Analysis

This is a very close case, where we view the evidence of record as almost in equipoise. However, we are persuaded by Appellant’s argument that the prior art provides no reason to apply Raksha’s magnetic aligning process to the specific process of claim 1 as applied to fingernail polishing (*see* App. Br. 13). “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. . . . [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 550 U.S. at 418.

Here, the Examiner’s reason for combining the elements within Raksha and the other cited references relies in part on the reasoning that “a person having ordinary skill in the art would have clearly recognized that the magnetic flake pigment containing composition would have functioned as a magnetic flake pigment containing composition functions when utilized in a cosmetic nail varnish method” (Ans. 8).

Raksha, however, while discussing general uses of pigment flakes that include cosmetics and fingernail polish (FF 2–3), and generally discussing aligning pigment flakes in a magnetic field for decorative purposes (FF 1), provides no reason to apply a magnetic field to the formation of patterns in nail polish. The other close reference, Phillips, also fails to provide a reason to perform the process of claim 1. Phillips does separately discuss magnetic

pigments and color shifting pigments for cosmetics (FF 10–11), but provides no reason to apply the process to the formation of patterns in nail polish.

We also find unpersuasive the Examiner’s finding of motivation to combine in the assertion that “a person having ordinary skill in the art to which the invention pertains would have recognized that magnetic flake pigments could have suitably been added to a nail polish base and aligned using an external magnetic field” (Ans. 19). This is not a reason to combine, simply a recognition that the basic elements necessary for performance of the claimed invention have been available in the prior art for a very long time. As the Examiner and Kurtus note, iron filings can be used to show magnetic fields (*see* Ans. 18–19; Kurtus 2), a discovery first made by Michael Faraday in the 1850s.

The instant fact pattern is dissimilar from those discussed in MPEP § 2143, where there was either a reason to make the combination in the prior art based on the nature of the problem being solved (*see* Examples 2, 5, 6) or where the combination was simply integrating known components already known to operate together (*see* Examples 1, 7).¹¹ We are not persuaded by the Examiner’s reasoning that there was a recognized problem being solved in pattern formation for fingernail polish, nor that painting fingernails with magnetic bodies in the polish and forming patterns using magnetic fields represents a simple integration of known components.

For these reasons, we reverse the rejections of record.

¹¹ The remaining examples refer to situations where the rejection was reversed.

Conclusion of Law

The evidence of record does not support the Examiner's conclusion that the prior art renders the method of claim 1 obvious.

SUMMARY

In summary, we reverse the rejection of claims 1, 3, 4, 8, 9, 12, 14, 16, 17, and 19–22 under 35 U.S.C. § 103(a) as obvious over Raksha, Harrison, Phillips, as evidenced by Kurtus and Roeben.

We reverse the rejection of claims 5–7, 10, and 11 under 35 U.S.C. § 103(a) as obvious over Raksha, Harrison, Phillips, Lauterbach, as evidenced by Kurtus and Roeben.

We reverse the rejection of claim 18 under 35 U.S.C. § 103(a) as obvious over Raksha, Harrison, Phillips, Gueret, as evidenced by Kurtus and Roeben.

We reverse the rejection of claims 33–39 under 35 U.S.C. § 103(a) as obvious over Raksha, Harrison, Phillips, Jenkins, as evidenced by Kurtus and Roeben.

REVERSED