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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SVEA WISCHHOEFER, NILS HOFFMANN,
SILKE WEYLAND, and JESSICA SCHAEFER¹

Appeal 2014-006956
Application 12/441,550
Technology Center 1600

Before ERIC B. GRIMES, JOHN G. NEW, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a cosmetic capsule which have been rejected based on obviousness and obviousness-type double patenting. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify the Real Party in Interest as Beiersdorf AG. (Appeal Br. 3.)

STATEMENT OF THE CASE

Claims 24–43 are on appeal. Claim 24 is illustrative and reads as follows:

24. A cosmetic capsule, wherein the capsule can be topically applied and rubbed in and comprises a casing material and a filling material enclosed by the casing material, the casing material being solid, semi-solid or stable in form at room temperature and being composed of an emulsion which comprises one or more waxes that are solid above 25°C, and the filling material comprising a preparation which has an abrasive effect and comprises one or more abrasive peeling agents in one of

- (i) an oil or lipid mixture having a viscosity of from 3 to 50,000 mPa*s at 25°C;
- (ii) a surfactant-containing preparation; and
- (iii) an emulsion.

The claims stand rejected as follows:²

Claims 24 and 28–43 under 35 U.S.C. § 103(a) as obvious based on Kallmayer³ and Vernice⁴ (Final Rej.⁵ 3);

Claims 24–43 under 35 U.S.C. § 103(a) as obvious based on Kallmayer, Vernice, and Wagner⁶ (Final Rej. 6); and

Claims 24–43, provisionally, for obviousness-type double patenting based on claims 10–29 of application 12/441,553 (Final Rej. 8).

² In addition to the above rejections, the Examiner provisionally rejected the claims for obviousness-type double patenting based on the claims of application 13/202,107. (Final Rej. 9.) The '107 application went abandoned Aug. 11, 2014, so this provisional rejection is moot.

³ Kallmayer et al., US 2008/0089913 A1, published Apr. 17, 2008.

⁴ Vernice et al., US 2006/0127427 A1, published Jun. 15, 2006.

⁵ Office Action mailed April 25, 2013.

⁶ Wagner et al., US 5,948,416, issued Sept. 7, 1999.

I

The Examiner has rejected claims 24 and 28–43 as obvious based on Kallmayer and Vernice, and has rejected claims 24–43 as obvious based on Kallmayer, Vernice, and Wagner. The same issue is dispositive for both rejections.

The Examiner finds that Kallmayer discloses cosmetic capsules meeting most of the limitations of claim 24 but “does not specifically disclose [an] abrasive peeling agent.” (Final Rej. 4.) The Examiner finds, however, that Kallmayer discloses that is capsules can “contain ‘particles which are insoluble in both phases’ including synthetic and inorganic particles such as polyethylene, silicates, and aluminosilicates.” (*Id.*)

The Examiner also finds that “Vernice teaches exfoliating products containing abrasive particles in a shell,” including “polyethylene powders and finely ground minerals such as silica, glacial limestone, aluminum oxide, or talc.” (*Id.*) The Examiner concludes that it would have been obvious to “prepare Kallmayer’s compositions to include the polyethylene, silicates, or aluminosilicate powders of sufficient size to have abrasive or peeling effects.” (*Id.* at 5.) The Examiner finds that the combination would have been obvious because:

- (i) both Kallmayer and Vernice are drawn to cosmetic topical compositions comprising a coated solid filling material, (ii) wherein the solid filling may be polyethylene, silicate, and/or aluminosilicate powder, (iii) Vernice teaches that polyethylene, silicate, and/or aluminosilicate powders having abrasive or peeling effect can be used, and (iv) the skilled person would have appreciated that providing exfoliation effect is beneficial to skin health and appearance.

(*Id.*)

We agree with the Examiner's findings of fact and conclusion that the claimed product would have been obvious based on Kallmayer and Vernice.

Appellants argue, however, that Kallmayer “indicates that instead of using emulsifiers or surfactants for stabilizing a corresponding emulsion one can use particles which are insoluble in both phases” and “even if the filling of the capsules of KALLMAYER were assumed to contain any particulate material, the corresponding particles would be sufficiently small to exhibit an emulsion-stabilizing effect and would thereby be too small to be able to exert an abrasive action.” (Appeal Br. 7–10.⁷) Appellants also argue that “one of the advantages of the capsules of KALLMAYER . . . is that they do not leave behind any perceptible residues on the skin and bring about a pleasant feel on the skin.” (*Id.* at 13.)

The Examiner responds to these arguments by pointing out that “Kallmayer also teaches cleansing or washing compositions that are washed or rinsed off.” (Ans. 5.)

Kallmayer discloses that its capsule “can also be used as a cleansing capsule.” (Kallmayer ¶ 199.) Kallmayer states that

[o]f advantage particularly when providing the capsules containing surfactants is the combination of the washing-active substances in the filling with the wax in the envelope. In this way, upon dissolution of the capsules during rubbing or under warm water, a formulation is obtained which foams and, as a

⁷ Appellants cite two references to support their position that Kallmayer would be understood to describe “Pickering emulsions.” (Appeal Br. 7–10.) However, Appellants have not pointed to any previous admission of these references into the record, and new evidence cannot be submitted with an appeal brief, with exceptions not relevant here. 37 C.F.R. § 41.33.

result of the wax content, is able to also remove water-resistant residues, such as, for example, make-up.

(*Id.* ¶ 202.)

Along the same line, Vernice states that “[n]umerous exfoliating abrasives have been known in the art, including . . . synthetic polymers such as polyethylene powders and granulated particles . . . and finely ground minerals such as silica, glacial limestone, aluminum oxide, or talc.”

(Vernice ¶ 4.) Vernice states that “water insoluble abrasive particles such as minerals and walnut shells have been used widely in water-based cosmetic products and they are generally expected to be removed from the skin by wiping or rinsing with water after application to the parts of the body to be cleaned.” (*Id.* ¶ 5.)

We agree with the Examiner that it would have been obvious to a person of ordinary skill in the art to include known exfoliating abrasives in Kallmayer’s cleansing capsules for their known use in providing “deep cleansing in order to remove . . . sebaceous secretions, soil deposits and dead skin resulting from desquamation of the epidermal tissue.” (Vernice ¶ 2.) Kallmayer discloses that the filling of its capsules can contain particles such as “natural or synthetic polymers (polyethylene, nylon, starch and its derivatives) or inorganic particles (TiO₂, Al₂O₃, BaSO₄, BN, silicates, aluminosilicates).” (Kallmayer ¶ 128.) The cited references therefore support a reasonable expectation of incorporating Vernice’s exfoliating agents (e.g., polyethylene powder or particles, silica, or aluminum oxide) into Kallmayer’s cleansing capsule embodiment.

We affirm the rejection of claim 24 under 35 U.S.C. § 103(a) based on Kallmayer and Vernice. Claims 28–43 have not been argued separately and therefore fall with claim 24. 37 C.F.R. § 41.37(c)(1)(iv).

With regard to the rejection of claims 24–43 under 35 U.S.C. § 103(a) based on Kallmayer, Vernice, and Wagner, Appellants argue only that Wagner does not cure the deficiencies of Kallmayer and Vernice. (Appeal Br. 15–16.) Because we agree with the Examiner that Kallmayer and Vernice support a prima facie case of obviousness, Appellants’ argument is unpersuasive.

II

The Examiner provisionally rejected claims 24–43 based on claims 10–29 of application 12/441,553. The ’553 application issued as US Patent 8,691,249 (April 8, 2014), so the rejection is no longer provisional.

The Examiner finds that the “primary difference between the claim sets is that the ’553 application’s claims do not require the capsule to be composed of an emulsion. However, the claims recite [] the capsule can comprise emulsifier which indicates that the capsules can be emulsions as in the present claims.” (Final Rej. 8.)

We agree with the Examiner that the claim 24 on appeal is directed to a product that is not patentably distinct from that of the ’249 patent. Claim 1 of the ’249 patent is directed to a “cosmetic peeling preparation comprising a plurality of capsules,” comprising a casing material that can be selected from waxes and emulsifiers or mixtures thereof, and a capsule filling comprising “an oil or lipid mixture having a viscosity of from 3 to 50,000 mPa*s at 25°C” and a solid substance having an abrasive effect. (’249

patent 10:2–20.) Thus, claim 1 of the '249 patent is directed to an invention that is encompassed by claim 24 on appeal. Claim 24 is therefore not patentably distinct from the invention claimed in the '249 patent.

Appellants argue that the instant application has an earlier effective filing date than the '553 application and, under MPEP § 804(I)(B)(1), the provisional rejection should be withdrawn in the earlier-filed application and maintained in the later-filed one. (Appeal Br. 16.)

That guidance, however, applies only when the two conflicting applications are co-pending. It does not apply where, as here, the later-filed application has already issued as a patent. The rejection of claim 24 for obviousness-type double patenting is affirmed.

Claims 25–43 have not been argued separately and therefore, fall with claim 24. 37 C.F.R. § 41.37(c)(1)(iv).

SUMMARY

We affirm all of the rejections on appeal.

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