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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANCIS PRUCHE and PATRICK CHOISY¹

Appeal 2014-009589
Application 12/216,693
Technology Center 1600

Before FRANCISCO C. PRATS, MELANIE L. McCOLLUM, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134(a) involves claims to methods of artificially coloring the skin. The Examiner rejected the claims for obviousness.

We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

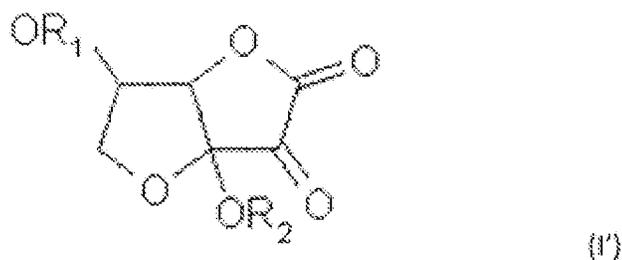
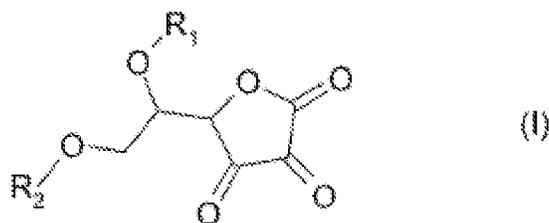
STATEMENT OF THE CASE

The sole rejection before for review is the Examiner's rejection of claims 1–6, 11, 14, and 15, under 35 U.S.C. § 103(a), for obviousness over Möller,² Stroud,³ and Pastore.⁴ Ans. 2–9.

¹ Appellants state that “L’Oreal is the real party in interest and is the assignee of the instant application.” App. Br. 2.

Claim 1, the sole independent claim on appeal, illustrates the appealed subject matter and reads as follows (App. Br., Claims App'x 1–2 (emphasis added)):

1. A regime or regimen for artificially coloring the skin, comprising topically applying *onto the skin of an individual seeking such treatment*, a composition containing a thus effective amount of dehydroascorbic acid and/or a monomeric derivative thereof of formula (I) below and/or an isomer thereof of formula (I') below and/or a polymer derivative thereof:



² Dr. Hinrich Möller and Dr. Horst Höffkes, DE 197 45 354 A1 (published April 15, 1999) (translation entered by Appellants June 15, 2011). The translation does not include page numbers. Accordingly, we cite to the first page following the cover sheet as page 1, and to the remaining pages as if numbered consecutively.

³ Eric. M. Stroud and John A. Scott, U.S. Patent No. 6,231,837 B1 (issued May 15, 2001).

⁴ Paolo Pastore et al., *Characterization of dehydroascorbic acid solutions by liquid chromatography/mass spectrometry*, 15 Rapid Commun. Mass Spectrom. 2051–2057 (2001).

in which OR₁ and OR₂, which may be identical or different, are each OH; a linear or branched, saturated or unsaturated C₁–C₃₀ alkoxy radical; a glycoside; a linear or branched, saturated or unsaturated C₁–C₃₀ aliphatic carboxylic acid ester, which may be substituted with an aryl group or a heterocycle; an aryl or heterocyclic carboxylic acid ester which may be substituted with at least one linear or branched, saturated or unsaturated C₁–C₃₀ alkyl radical; a phosphate group; a sulfate group, and also polymeric derivatives thereof, formulated into a topically applicable physiologically acceptable medium therefor; wherein the dehydroascorbic acid and/or a monomeric derivative thereof of formula (I) and/or an isomer thereof of formula (I') and/or a polymer derivative thereof is combined with ascorbic acid or a derivative or salt thereof.

OBVIOUSNESS

The Examiner found that Möller describes a method of using an aqueous composition containing dehydroascorbic acid to artificially color skin, the method differing from the claimed methods in that Möller does not “explicitly disclose that the aqueous composition comprises ascorbic acid, and/or the monomeric and/or dimeric dehydroascorbic acid derivatives having structural formula *II*) and *III*), respectively; and also contains exfoliant agents.” Ans. 8.

Despite those differences, the Examiner concluded that the claimed methods would have been obvious to an ordinary artisan when the teachings of Möller were combined with the teachings in Stroud and Pastore. *Id.* at 8. The Examiner reasoned as follows:

Möller et al. disclose a regime or regimen for artificially coloring keratinous fibers (i.e. skin, hair or nails), comprising topically applying onto the keratinous fibers of an individual an aqueous composition containing an effective amount of dehydroascorbic acid having structural formula *I*). Since

“keratinous fibers” is a term recognized by one of skill in the art to encompass the skin (as well as hair and nails); and since Stroud et al. disclose that an effective regime or regimen for artificially coloring the skin comprises topically applying onto the skin of an individual an aqueous composition containing dihydroxyacetone (an artificial coloring agent) as well as acidifying agents, wherein the aqueous composition is maintained at an acidic pH of about 4; and further since Pastore et al. disclose that in acidic aqueous solution, dehydroascorbic acid is naturally present in the stable hydrated form of the bicyclic hemiketal having structural formula *II*), which is its biologically active form of dehydroascorbic acid, and which is produced “in situ” not only from dehydroascorbic acid, but also just as well from spontaneous ascorbic acid oxidation and/or by hydration and breakdown of dimeric derivatives having structural formula *III*), one of ordinary skill in the art would be motivated to employ in the Möller et al. method an acidic aqueous composition[]in which dehydroascorbic acid is provided as any one or a combination of compounds *I*), *II*), and/or *III*), and ascorbic acid, with the reasonable expectation that the resulting method will utilize an acidic aqueous composition comprising the bicyclic hemiketal having structural formula *II*), which is the biologically active form of dehydroascorbic acid, and will thus successfully artificially color the skin of an individual.

Ans. 8–9.

As stated in *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992):

[T]he examiner bears the initial burden . . . of presenting a *prima facie* case of unpatentability. . . .

After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.

In *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007), the Supreme Court emphasized “an expansive and flexible approach” to the

obviousness question, but also reaffirmed the importance of determining “whether there was an apparent reason to combine the known elements *in the fashion claimed* by the patent at issue.” *Id.* at 418 (emphasis added).

Ultimately, therefore, “[i]n determining whether obviousness is established by combining the teachings of the prior art, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re GPAC Inc.*, 57 F.3d 1573, 1581 (Fed. Cir. 1995) (internal quotations omitted).

We agree with Appellants that a preponderance of the evidence does not support the Examiner’s contention that the cited references would have suggested performing the process recited in claim 1, in the fashion recited by the claim. Specifically, claim 1 recites a method for artificially coloring the skin, which is performed by “topically applying onto the skin of an individual seeking such treatment” dehydroascorbic acid or the named derivatives, in combination with ascorbic acid or a derivative thereof. App. Br., Claims App’x 1–2.

As the Examiner contends, Möller describes its invention as “an agent for dyeing keratin fibers containing . . . dehydroascorbic acid.” Möller 2.

As Appellants point out, however, Möller states expressly that “[s]taining of the skin should be avoided.” *Id.* (emphasis removed). Thus, rather than suggesting the step recited in claim 1, application of a dehydroascorbic acid-containing dyeing agent to the skin of an individual desirous of artificially coloring his or her skin, Möller expressly teaches that application to the skin should be avoided. Accordingly, we agree with Appellants that Möller would not have suggested applying Möller’s dyeing

agent to the skin of an individual seeking to artificially color his or her skin, as claim 1 requires.

Moreover, given Möller's teaching that staining skin with its dyeing agent should be avoided, we also agree with Appellants that the cited references would not have suggested including Möller's dyeing agent in Stroud's self-tanning compositions. We, therefore, further agree with Appellants that an ordinary artisan would not have combined the teachings of Möller and Stroud in the manner posited by the Examiner.

The Examiner's arguments do not persuade us to the contrary.

In particular, we are not persuaded that artificially coloring skin is an unpreferred embodiment suggested by Möller, as the Examiner contends. *See* Ans. 10–11. Although Möller generically describes “dyeing keratin fibers,” the sole mention of skin in Möller identified by either the Examiner or Appellants is the statement that “[s]taining of the skin should be avoided.” Möller 2.

Moreover, as Appellants point out, when explaining keratin fibers that should be dyed, Möller uniformly refers to hair or hair-like fibers, with no mention of skin. *See id.* (“The object of the present invention is a colorant for keratin fibers, particularly human hair In keratin fibers are wool, to understand fur, feathers, and in particular human hair.”); *id.* at 8 (discussing examples of cationic surfactants “suitable for use in the inventive hair treatment”); *id.* at 9 (discussing inclusion of suitable “[h]air conditioning compounds”); *id.* at 11 (discussing application to human hair).

We, therefore, agree with Appellants that, reading the reference as a whole, an ordinary artisan would not have understood skin as a less preferred keratinous tissue (or fiber) that Möller suggested should be dyed.

We acknowledge, but are not persuaded by, the Examiner's contention that "Möller clearly discloses by the statement 'staining of the skin' that their method does in fact artificially color the skin." Ans. 11. That an ordinary artisan might have understood that Möller's dyeing agent would inadvertently stain skin does not persuade us that Möller would have suggested the method step recited in claim 1: applying that dyeing agent to the skin of an individual desirous of artificial skin coloration. Indeed, given Möller's direct teaching that staining of the skin should be avoided, we are not persuaded that an ordinary artisan would have practiced the process recited in Appellants' claim 1 based on the teachings of cited references, without having first consulted Appellants' disclosure. As our reviewing court has noted, such hindsight is an improper foundation for an obviousness analysis. *See Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008).

In sum, for the reasons discussed, we agree with Appellants that the combination of Möller, Stroud, and Pastore does not suggest the process recited in claim 1. Accordingly, we reverse the Examiner's rejection of that claim, and its dependent claims, over those references.

REVERSED