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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/935,246	09/08/2004	Heiko Mielke	3321-P25912	2076
13897	7590	12/13/2016	EXAMINER	
Abel Law Group, LLP 8911 N. Capital of Texas Hwy Bldg 4, Suite 4200 Austin, TX 78759			SASAN, ARADHANA	
			ART UNIT	PAPER NUMBER
			1615	
			NOTIFICATION DATE	DELIVERY MODE
			12/13/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HEIKO MIELKE, SOREN JASPERS, GUNHILD HAMER,
CHRISTOPHER MUMMERT, JENS SCHULZ, STEFAN GALLINAT,
KIRSTEN VENZKE, and FRANK SCHWANKE

Appeal 2015-002755
Application 10/935,246
Technology Center 1600

Before DONALD E. ADAMS, ERIC B. GRIMES, and RYAN H. FLAX,
Administrative Patent Judges.

ADAMS, *Administrative Patent Judge.*

DECISION ON APPEAL¹

This appeal under 35 U.S.C. § 134(a) involves claims 84–117 (Final Act. 1). Examiner entered rejections under 35 U.S.C. § 103(a). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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

STATEMENT OF THE CASE

Appellants disclose that their

invention relates to cosmetic or dermatological preparations containing active substances for the care and protection of the skin, in particular sensitive skin and very particularly skin aged or aging by intrinsic and/or extrinsic factors and the use of such active substances and combinations of such active substances in the field of cosmetic and dermatological skin care.

(Spec. 1.)

Claims 84, 92, 98, and 99 are representative and reproduced below:

84. A dermatological or cosmetic O/W emulsion, wherein the emulsion comprises one or more bioquinones and a soy extract that comprises one or more isoflavonoids.

92. The emulsion of claim 84, wherein the soy extract further comprises from 5 % to 20 % by weight of saponins, based on a total weight of the soy extract.

98. The emulsion of claim 84, wherein the emulsion is a foaming emulsion.

99. The emulsion of claim 84, wherein the emulsion has a pH of from 5.0 to 7.5.

(App. Br. 25–27.)

The claims stand rejected as follows:

Claims 84–91, 96, and 97 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent² and Allec.³

Claims 92–95, 100–109, 112–114, and 117 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent, Allec, and Heyda.⁴

Claim 99 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent, Allec, and François.⁵

Claim 98 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent, Allec, and Roulier.⁶

Claims 110 and 115 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent, Allec, Heyda, and Roulier.

Claims 111 and 116 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent, Allec, Heyda, and François.

ISSUE

Does the preponderance of evidence relied upon by Examiner support a conclusion of obviousness?

² Gervasio-Nugent et al., WO 2004/000242 A1, published Dec. 31, 2003.

³ Allec et al., US 2002/0064540 A1, published May 30, 2002.

⁴ Alessandro Heyda, EP 1 321 149 A1, published June 25, 2003.

⁵ François et al., US 5,654,293, issued Aug. 5, 1997.

⁶ Roulier et al., US 6,251,954 B1, issued June 26, 2001.

FACTUAL FINDINGS (FF)

FF 1. Appellants disclose that “[u]biquinones . . . represent the most widespread and thus most investigated bioquinones,” wherein “[i]n the case of most mammals, including humans, Q10 predominates” (Spec. 3–4).

FF 2. Appellants disclose that coenzyme Q10 is the preferred bioquinone for their invention (Spec. 5).

FF 3. Appellants disclose that “[s]ome of the better known isoflavones are[, *inter alia*,] daidzein . . . genistein . . . [and] biochanin A,” wherein “preference is given to genistein” (Spec. 5–7).

FF 4. Examiner finds that Gervasio-Nugent discloses “topical cosmetic compositions including emulsions . . . of the oil-in-water type” (Final Act. 3, citing Gervasio-Nugent 7: 30–34 and 19: 7–9).

FF 5. Gervasio-Nugent discloses that “for the purposes of [Gervasio-Nugent’s] invention a cosmetic agent may preferably be selected from one or more of: anti-ageing agents, anti-wrinkle agents, antioxidants, anti-scarring agents, phytoestrogens, isoflavones, coumarins, lip balms and antiseptic anti-acne agents” (Gervasio-Nugent 4: 7–10).

FF 6. Gervasio-Nugent discloses that “[a]nti-ageing agents include agents for treating wrinkles or preventing development thereof,” wherein, “[e]xamples of antiwrinkle and anti-skin atrophy actives include,” *inter alia*, ubiquinones, particularly coenzymes Q9 and Q10, soya extracts, and isoflavones, such as “one or more [selected from] the list consisting of[, *inter alia*,] genistein, daidzein, [and] biochanin A” (Gervasio-Nugent 8: 4–9: 31; *see generally* Ans. 3–4).

FF 7. Gervasio-Nugent exemplifies compositions comprising oil, water, genistein and coenzyme Q10 (Gervasio-Nugent 21: Example 2 and 27: Example 11; Ans. 3).

FF 8. Gervasio-Nugent discloses that “[t]he compositions of [Gervasio-Nugent’s] invention can optionally contain materials which are conventionally used in cosmetic compositions[, such as,] soybean saponins” (Gervasio-Nugent 19: 30–34).

FF 9. Gervasio-Nugent discloses cosmetic compositions that comprise sebum stimulators and discloses that “[t]hese skin care actives are especially useful for post-menopausal women who are sebum deficient” (Gervasio-Nugent 15: 6–7).

FF 10. Examiner finds that Gervasio-Nugent “does not expressly teach that the soy extract comprises one or more isoflavonoids,” and relies on Allec to disclose oil-in-water emulsions and exemplify “an emulsion in cream form” that comprises an isoflavone-rich extract of soybean (Final Act. 4, citing Allec ¶¶ 31 and 41).

FF 11. Allec discloses that “the signs of ageing of the skin arise not only from chronological causes . . . , but also are caused by . . . hormonal deficiencies arising during menopause” (Allec ¶ 4).

FF 12. Examiner finds that while the combination of Gervasio-Nugent and Allec suggests a composition comprising soybean saponins, the combination does “not expressly teach the percent by weight of saponins in the composition” (Final Act. 10).

FF 13. Heyda discloses cosmetic compositions containing soy isoflavones (Heyda Abstract and ¶ 1; *see* Final Act. 10).

FF 14. Heyda discloses

that oriental women, whose diet is rich in soy, . . . infrequently suffer from the typical post-menopausal symptoms, especially nocturnal hot flushes, has led to the discovery that the isoflavones contained in soy, namely genistein and daidzein . . . act as bland agonists of the oestrogen receptor. Supplementation of the diet with soy derivatives or administration of the phytoestrogens deriving therefrom consequently represents a promising alternative to oestrogen administration.

(Heyda ¶ 3.)

FF 15. Heyda discloses “[s]oy extracts with an isoflavone and saponin content of 5 to 90% each” (Heyda ¶ 9; Ans. 10).

FF 16. Examiner finds that the combination of Gervasio-Nugent and Allec fails to disclose “a foaming emulsion” and relies on Roulier to disclose “an emulsion which has the appearance of a foam” (Ans. 16, citing Roulier 1: 53–56 and 2: 27–36 and 47–52).

FF 17. Examiner finds that the combination of Gervasio-Nugent and Allec fails to disclose an “emulsion [that] has a pH of from 5.0 to 7.5” and relies on François to disclose “topical oil-in-water emulsions characterized by a pH above 2.5 and below 6” (Ans. 17, citing François Abstract and claim 1).

ANALYSIS

The rejection over the combination of Gervasio-Nugent and Allec:

Based on the combination of Gervasio-Nugent and Allec, Examiner concludes that, at the time Appellants’ invention was made, it would have been prima facie obvious “to make a cosmetic emulsion with coenzyme Q10, genistein and [a soy extract that comprises at least one] isoflavone[.]” (Final Act. 4).

We are not persuaded by Appellants' contention that Gervasio-Nugent "encompasses thousands, if not millions . . . of different topical cosmetic compositions" and that "'soya extracts' mentioned in [Gervasio-Nugent] are buried in [a] laundry list of exemplary anti-ageing agents" (App. Br. 6–8 and 14). "Disclos[ure of] a multitude of effective combinations does not render any particular formulation less obvious." *Merck & Co. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989).

Nevertheless, notwithstanding Appellants' contention to the contrary, the combination of Gervasio-Nugent and Allec suggests a composition comprising coenzyme Q10 and isoflavone, such as an isoflavone from an isoflavone-rich extract of soybean (FF 4–7 and 10; *see also* Ans. 3–4). Therefore, we are not persuaded by Appellants' contention that "the anti-ageing agents which are preferred according to [Gervasio-Nugent] are ubiquinone, enzyme Q-10, alpha lipoic acid, lycopene and kinetin . . . , i.e., substances that [are] not related at all to soya extracts" (App. Br. 8; *see also id.* at 9 (soya extracts are merely one of hundreds of compounds that may be included in Gervasio-Nugent's composition)). A reference disclosure is not limited only to its preferred embodiments, but is available for all that it discloses and suggests to one of ordinary skill in the art. *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976). Therefore, we are not persuaded by Appellants' contentions regarding preferred and/or exemplified components of the composition suggested by the combination of Gervasio-Nugent and Allec (*see* App. Br. 8–10; Reply Br. 2–3).

For the foregoing reasons, we are not persuaded by Appellants' contentions regarding the presence or absence of genistein together with an isoflavone-rich extract of soybean (*see* App. Br. 9–12; Reply Br. 2–3).

Gervasio-Nugent discloses a composition comprising “actives includ[ing] those selected from one or more of the list consisting of,” *inter alia*, ubiquinones, particularly coenzymes Q9 and Q10, soya extracts, and isoflavones (FF 6). Allec discloses soy extracts that are rich in isoflavones (FF 10). Thus, a person of ordinary skill in this art would have included Allec’s isoflavone rich soy extract to Gervasio-Nugent, because Gervasio-Nugent suggests a composition comprising isoflavone and soy extract (FF 6; *see* FF 4–8; *cf.* Reply Br. 2 (“the relevant question here is whether in view of the disclosure of ALLEC one o[f] ordinary skill in the art would be prompted to add an isoflavone-rich extract of soybean to” a composition suggested by Gervasio-Nugent); *see* App. Br. 11–13).

Examiner relies on Allec to disclose that soybean extract, as disclosed by Gervasio-Nugent, is rich in isoflavonoids (FF 10). Therefore, we are not persuaded by Appellants’ contentions regarding optional components that may be present in Allec’s composition (App. Br. 14).

For the foregoing reasons we are not persuaded by Appellants’ contention that “there is no apparent reason” for a person of ordinary skill in this art to combine Gervasio-Nugent and Allec (App. Br. 15; *see* Reply Br. 2–3)

The rejection over the combination of Gervasio-Nugent, Allec, and Heyda:

Based on the combination of Gervasio-Nugent, Allec, and Heyda, Examiner concludes that, at the time Appellants’ invention was made, it would have been *prima facie* obvious to prepare compositions as suggested by the combination of Gervasio-Nugent and Allec that comprise “soy

extracts with an isoflavone[] and saponin content of 5 to 90% each, as taught by Heyda” (Final Act. 10).

Gervasio-Nugent expressly discloses that soybean saponins are conventionally used in cosmetic compositions (FF 8). Allec discloses that soybean extract, as disclosed by Gervasio-Nugent, is rich in isoflavonoids and comprises saponins (FF 6, 10, and 12). Heyda discloses a cosmetic composition comprising soy isoflavones (FF 13). Therefore, we are not persuaded by Appellants’ contention that “there is clearly no apparent reason for one of ordinary skill in the art to pay particular attention to the presence of soybean saponins, let alone the concentration thereof, in a cosmetic composition according to Gervasio[-Nugent]” (App. Br. 16; *see also* Reply Br. 4 (“It is not seen that HEYDA could make it any clearer that the compositions disclosed therein are not at all suitable for a cosmetic or dermatological application”); *cf.* FF 13).

Gervasio-Nugent, Allec, and Heyda all discuss “the relie[f] of menopausal sy[mptoms],” therefore, we are not persuaded by Appellants’ contention that the references are unrelated (App. Br. 16–17; Reply Br. 3–4 *see, e.g.*, FF 9, 11, and 14). Nevertheless, notwithstanding Appellants’ contentions to the contrary, Heyda discloses that it would have been *prima facie* obvious to include soy extract, as suggested by Gervasio-Nugent, which Allec discloses is rich in isoflavones, in a cosmetic composition as suggested by the combination of Gervasio-Nugent, Allec, and Heyda (*see* FF 13–14; *see also* FF 4–15; *cf.* Ap. Br. 16–17; Reply Br. 3–4).

For the foregoing reasons, we are not persuaded by Appellants’ contentions regarding “suitable concentrations of saponins in a cosmetic skin care composition” relative to a “composition for relieving menopausal

sy[mptoms]” (App. Br. 18; *see* Reply Br. 3–4). In this regard, we find that Appellants failed to provide persuasive evidence or argument to support a conclusion that the saponin concentration disclosed by Heyda would not be useful in a skin care composition as disclosed by the combination of Gervasio-Nugent and Allec and/or that such a concentration would not provide at least some degree of relief from at least one menopausal symptom.

We are not persuaded by Appellants’ assertion that “it is reasonable to assume that the isoflavone and saponin[] concentrations of commercial soy extracts mentioned in . . . HEYDA are simply based on information provided by the manufacturers of these extractions, i.e., have not independently been verified by the inventor of HEYDA” (App. Br. 18–19). Appellants failed to provide persuasive evidence or argument to support a conclusion that Heyda’s disclosure of “[s]oy extracts with an isoflavone and saponin content of 5 to 90% each” is not a factual disclosure. In this regard, we are not persuaded by Appellants’ contention that Setchell’s⁷ disclosure relating to commercially available “supplements” is analogous to Heyda’s disclosure relating specifically to “[s]oy extracts” (*see* App. Br. 19, citing Setchell 1368S; *cf.* FF 15).

For the foregoing reasons, we are not persuaded by Appellants’ contentions regarding the replacement of genistein with an “[i]soflavone-rich extract of soybean” (App. Br. 20).

⁷ Setchell et al., *Bioavailability of Pure Isoflavones in Healthy Humans and Analysis of Commercial Soy Isoflavone Supplements*, 131 J. NUTR. 1362S-1375S (2001).

The rejection over the combination of Gervasio-Nugent, Allec, and Roulier:

Based on the combination of Gervasio-Nugent, Allec, and Roulier, Examiner concludes that, at the time Appellants' invention was made, it would have been prima facie obvious to prepare a composition as suggested by the combination of Gervasio-Nugent and Allec, "the emulsion having a foamy appearance, as taught by Roulier" (Final Act. 16).

We recognize, but are not persuaded by, Appellants' contention that "ROULIER relates to 'aerated' compositions" and, therefore, "[i]t is not seen that [Gervasio-Nugent] teaches or suggests that the compositions disclosed therein should be present in 'aerated' form and for this reason alone, there is no motivation for one of ordinary skill in the art to combine the teachings of [Gervasio-Nugent] and ROULIER" (App. Br. 21). To the contrary, we find no error in Examiner's conclusion that a person of ordinary skill in this art would have found it prima facie obvious to prepare the composition of Gervasio-Nugent and Allec in the form of a foamy emulsion by following the guidance provided by Roulier (*see* Ans. 8–9; FF 16).

We are not persuaded by Appellants' contention that the combination of Roulier with Gervasio-Nugent and Allec is based in hindsight (App. Br. 23). To the contrary, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

The rejection over the combination of Gervasio-Nugent, Allec, and François:

Based on the combination of Gervasio-Nugent, Allec, and François, Examiner concludes that at the time Appellants' invention was made, it would have been prima facie obvious to formulate the composition suggested by the combination of Gervasio-Nugent and Allec to have a pH above 2.5 and below 6 (Final Act. 17). As Examiner explains, "the pH disclosed by [François] is dermatologically acceptable" (Ans. 9). Thus, notwithstanding Appellants' contentions to the contrary, we find no error in Examiner's conclusion that a person of ordinary skill in this art would have found it prima facie obvious to formulate the composition suggested by the combination of Gervasio-Nugent and Allec with a dermatologically acceptable pH as disclosed by François (*cf.* App. Br. 21–23; Reply Br. 4–5). Overlapping ranges support a prima facie case of obviousness. *See In re Geisler*, 116 F.3d 1465, 1468 (Fed. Cir. 1997). In this regard, we are not persuaded by Appellants' contentions regarding the "most preferred pH range [disclosed by François]" (App. Br. 23). *See Lamberti*, 545 F.2d at 750.

The rejection over the combination of Gervasio-Nugent, Allec, Heyda, and Roulier:

Based on the combination of Gervasio-Nugent, Allec, Heyda, and Roulier, Examiner concludes that, at the time Appellants' invention was made, it would have been prima facie obvious to formulate a composition as suggested by the combination of Gervasio-Nugent and Allec, that comprises a "soy extract[] with an isoflavone[] and saponin content of 5 to 90% each,

as taught by Heyda” and “a foamy appearance, as taught by Roulier” (Final Act. 18).

Having found no deficiency in the combination of Gervasio-Nugent, Allec, and Heyda, we are not persuaded by Appellants’ contention that Roulier “does not cure the deficiencies set forth above” with respect to the combination of Gervasio-Nugent, Allec, and Heyda (App. Br. 23).

The rejection over the combination of Gervasio-Nugent, Allec, Heyda, and François:

Based on the combination of Gervasio-Nugent, Allec, Heyda, and François, Examiner concludes that, at the time Appellants’ invention was made, it would have been prima facie obvious to formulate a composition as suggested by the combination of Gervasio-Nugent and Allec, that comprises a “soy extract[] with an isoflavone[] and saponin content of 5 to 90% each, as taught by Heyda” and “a pH above 2.5 and below 6, as taught by François” (Final Act. 19–20).

Having found no deficiency in the combination of Gervasio-Nugent, Allec, and Heyda, we are not persuaded by Appellants’ contention that François “does not cure the deficiencies set forth above” with respect to the combination of Gervasio-Nugent, Allec, and Heyda (App. Br. 24).

CONCLUSION OF LAW

The preponderance of evidence relied upon by Examiner supports a conclusion of obviousness.

The rejection of claim 84 under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent and Allec is affirmed. Claims 85–91, 96, and 97 are not separately argued and fall with claim 84.

The rejection of claim 92 under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent, Allec, and Heyda is affirmed. Claims 93–95, 100–109, 112–114, and 117 are not separately argued and fall with claim 92.

The rejection of claim 99 under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent, Allec, and François is affirmed.

The rejection of claim 98 under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent, Allec, and Roulier is affirmed.

The rejection of claim 110 under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent, Allec, Heyda, and Roulier is affirmed. Claim 115 is not separately argued and falls with claim 110.

The rejection of claim 111 under 35 U.S.C. § 103(a) as unpatentable over the combination of Gervasio-Nugent, Allec, Heyda, and François is affirmed. Claim 116 is not separately argued and falls with claim 111.

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