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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RYAN BRADLEY CAMERON,
RAVI SUBRAMANYAM, HARSH TRIVEDI,
and CORTNEY WORRELL

Appeal 2015-003506
Application 12/185,585¹
Technology Center 1600

Before FRANCISCO C. PRATS, JOHN E. SCHNEIDER, 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 oral compositions and methods of treating inflammation of an oral cavity. The Examiner rejected the claims for obviousness.

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

STATEMENT OF THE CASE

The sole rejection before us for review is the Examiner's rejection of claims 1–3, 14, 15, 17, 18, 23, 24, 26 and 27, under 35 U.S.C. § 103(a), for

¹ Appellants state that the “real party in interest in this appeal is Colgate-Palmolive Company by virtue of an assignment.” Br. 3.

obviousness over Waterfield.² Final Action 2–3 (entered January 30, 2012).

Claims 1 and 17, the independent claims on appeal, illustrate the claimed subject matter and read as follows (Br. 14, 15 (emphasis added)):

1. An oral composition ***consisting essentially of***
an anti-oxidatively effective amount of morin;
an anti-bacterially effective amount of triclosan;
a fluoride ion source, wherein the fluoride ion source is selected from sodium fluoride, potassium fluoride, sodium fluorosilicate, sodium monofluorophosphate, and aluminum fluorosilicate;
an ingredient selected from the group consisting of a solubilizing agent, a polishing agent, a surfactant, a flavoring agent, a sweetener, a synthetic anionic polycarboxylate, and combinations of two or more thereof; and
and a water-humectant phase.

17. A method of treating an inflammatory condition of the oral cavity, ***comprising*** administering to the oral cavity of a human or animal subject an antioxidatively effective amount of a composition ***comprising*** triclosan, morin and a water-humectant phase.

OBVIOUSNESS

The Examiner's Prima Facie Case

The Examiner's rationale for rejecting claims 1–3, 14, 15, 17, 18, 23, 24, 26 and 27 for obviousness over Waterfield appears in the Final Action entered January 6, 2011 ("First Final Action").

² US 5,258,173 (issued Nov. 2, 1993).

The Examiner concluded that the claimed compositions and methods would have been obvious because Waterfield discloses the suitability of formulating toothpaste compositions having each of the ingredients required by the rejected claims, in the amounts required by the claims, the compositions including a stannous salt that provides anti-gingivitis activity, thereby meeting the requirement in claim 17 for treating an inflammatory condition of the oral cavity. First Final Action 2–3.

Analysis

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.

Appellants do not argue the claims subject to this ground of rejection separately. We select claim 1 as representative of the rejected claims. 37 C.F.R. § 41(c)(1)(iv). Appellants do not persuade us that a preponderance of the evidence fails to support the Examiner’s conclusion that the composition recited in claim 1 would have been obvious to an ordinary artisan in view of Waterfield.

Waterfield discloses that, although stannous compounds were known in the art to be useful in dentifrices, “for the purpose of achieving particular clinical benefits such as caries prevention, plaque control or the reduction of gingivitis . . . , the active stannous ion is particularly prone to oxidation, e.g. by air or an oxidizing agent, the stannous ion being converted thereby into the inactive stannic form.” Waterfield 1:11–26.

In order to avoid oxidation of the stannous ions, Waterfield discloses including antioxidants in its dentifrice compositions, including the antioxidant morin, recited in Appellants' claim 1. Waterfield 1:54–61, 2:37–43.

As also required by Appellants' claim 1, Waterfield discloses that its compositions can contain triclosan as an antibacterial (*id.* at 3:32–34), a fluoride source which may be sodium fluoride or sodium monofluorophosphate (*id.* at 3:38–39), a variety of conventional ingredients including surfactants, flavoring agents, and sweeteners (*id.* at 3:16–26), and a humectant phase (*id.* at 3:3–9).

Thus, contrary to Appellants' argument that it “was previously not taught that there was any benefit to combining these ingredients” (Br. 13), Waterfield discloses the suitability of including all of the ingredients recited in claim 1, in the amounts required by the claim.

We are also unpersuaded by Appellants' contention that the “consisting essentially of” language in claim 1 excludes the stannous ions taught by Waterfield as being present in its compositions.³

As our reviewing court has explained, “[b]y using the term ‘consisting essentially of,’ the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention.” *PPG Indus. Inc. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1354 (Fed. Cir. 1998).

³ Appellants assert that the “pending claims are directed to oral care compositions ‘consisting essentially of’ particular ingredients” Br. 10. Contrary to that assertion, however, independent claim 17 uses the transitional phrase “comprising” to describe the process and composition recited therein, as noted above. *See* Br. 15.

On the present record, Appellants do not persuade us that the stannous ions in Waterfield's compositions would affect the basic and novel properties of Appellants' invention, such that Waterfield's stannous ions are excluded by the "consisting essentially of" language in claim 1.

Appellants contend initially that Waterfield's stannous ions are "excluded by the 'consisting essentially of' transitional language because these anti-bacterial compounds would necessarily affect a specific and essential element of the claim, the anti-bacterially effective amount of triclosan." Br. 10. Appellants do not, however, direct us to any persuasive evidence in either the prior art or in the Specification suggesting that stannous ions would affect the antibacterial properties of triclosan.

Nor do Appellants identify teachings in the Specification explaining what the basic and novel properties of the claimed invention are, such that inclusion of stannous ions in the composition would materially affect those properties. In that regard, Appellants direct us (Br. 12) to the Specification's "Background of the Invention," and ¶ 3 in particular, which reads:

Dentifrices comprising an effective amount of a stannous compound capable of yielding stannous ions upon association with water, and an effective amount of a compound that is a radical inhibitor capable of reducing or preventing the conversion of the stannous ions in the dentifrice composition into stannic ions, wherein the antioxidant is morin. However, this publication does not disclose use of an antibacterial enhancing agent in a dentifrice to prevent or reduce an inflammatory process.

Spec. ¶ 3 (omitting capitalization).

As is evident, ¶ 3 of Appellants' Specification does discuss the presence of stannous compounds in (apparently prior art) dentifrice compositions that also contain morin. As is also evident, however, this

disclosure includes no clear suggestion that stannous ions would be detrimental to, or excluded from, Appellants' invention.

Rather, the alleged difference between the compositions described in ¶ 3 and Appellants' invention is that "this publication does not disclose use of an antibacterial enhancing agent in a dentifrice to prevent or reduce an inflammatory process." Spec. ¶ 3. Contrary to that assertion, however, Waterfield expressly teaches that triclosan (the same anti-bacterial agent recited in Appellants' claim 1) is an antibacterial agent and can be included in its compositions, as discussed above. *See* Waterfield 3:32–34.

As the Examiner found, moreover, Appellants' original claims 7 and 13 recite using stannous fluoride, among others, as the fluoride source of Appellants' invention. Spec. pp. 10, 11. Appellants do not persuade us, therefore, that the Specification demonstrates that stannous ions would affect the basic and novel properties of their invention.

We acknowledge Appellants' contention that their cancellation of claims 7 and 13, and decision not to prosecute those claims, equates to a surrender of the claimed subject matter. Br. 12–13 (citing *Honeywell Int'l., Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131 (Fed. Cir. 2004)).

Nonetheless, Appellants do not identify, nor do we discern, authority holding that, when interpreting the scope of claims during prosecution before the PTO, surrender of claimed subject matter equates to a showing that the surrendered subject matter would affect the basic and novel properties of the disclosed invention, to the extent that the surrendered subject matter would be excluded from claims including the "consisting essentially of" transitional phrase. Different from the situation here, *Honeywell* considered the issue of whether, for the purposes of determining

infringement under the doctrine of equivalents, a narrowing amendment to a patent claim adding an additional claim limitation created a presumptive surrender of equivalents. *Honeywell*, 370 F.3d at 1139–1144. Surrendered or not, the language of the original claims in this appeal, at minimum, suggests the presence of stannous compounds/ions does not materially affect basic and novel characteristics of the invention. And Appellants provided no persuasive evidence to the contrary.

The Examiner concluded that the “consisting essentially of” language in claim 1 does not exclude stannous compounds that appear in Waterfield’s compositions. Appellants do not persuade us (*see* Br. 10–12) that *PPG v. Guardian* demonstrates error in the Examiner’s conclusion. In *PPG*, the court held that the patentee, like Appellants here, had not explained adequately in its specification what the basic and novel properties of its invention were. *PPG*, 156 F.3d at 1355–56. The court held, nonetheless, that the “consisting essentially of” language in the claims at issue excluded certain allegedly infringing compositions, based on a showing by the alleged infringer that additional ingredients in the allegedly infringing products materially affected the basic and novel properties of the invention as described in the specification. *Id.* at 1356–57.

As discussed above, however, and in contrast to the situation in *PPG*, Appellants do not explain sufficiently why, or direct us to persuasive evidence demonstrating how, the stannous ions in Waterfield’s compositions would materially affect the basic and novel properties of Appellants’ invention. Appellants do not, therefore, persuade us that the stannous ion-containing compositions suggested by Waterfield are excluded from claim 1 by virtue of the transitional phrase “consisting essentially of.”

In sum, for the reasons discussed, Appellants do not persuade us that the Examiner failed to make out a prima facie case of obviousness as to claim 1. Because Appellants do not advance objective evidence of nonobviousness that might outweigh the evidence of prima facie obviousness, we affirm the Examiner's rejection of claim 1 over the cited references. Because they were not argued separately, the remaining claims fall with claim 1. 37 C.F.R. § 41(c)(1)(iv).

SUMMARY

We affirm the Examiner's obviousness rejection.

TIME PERIOD

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