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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MUSTAFA GRIT and JONATHAN WOOD

Appeal 2015-004247
Application 13/512,930
Technology Center 1600

Before JEFFREY N. FREDMAN, JOHN G. NEW, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal¹ under 35 U.S.C. § 134 involving a styling composition. The Examiner rejected the claims as anticipated and as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Statement of the Case

Background

“Aerosol hair styling compositions have been widely used either as a spray, aerosol or non-aerosol, or as foam. In principal [sic], they comprise hair fixing polymers in an aqueous or aqueous alcoholic medium together

¹ Appellants identify the Real Party in Interest as KAO GERMANY GMBH (see Br. 2).

with a propellant in case of an aerosol composition” (Spec. 1). “The present inventors have surprisingly found out that a composition comprising at least one film forming polymer and at least one dipeptide in an aqueous, aqueous-alcoholic or alcoholic medium has excellent hair styling and restyling benefits together with excellent volumizing and bodifying effects.” (Spec. 1).

The Claims

Claims 1, 3–14, and 16–18 are on appeal. Claim 1 is representative and reads as follows:

1. A styling composition for keratin fibres for human hair comprising an aqueous, aqueous - alcoholic or alcoholic medium, at least one film forming polymer selected from the group consisting of vinylpyrrolidone [sic] polymers including homopolymers and copolymers, and acrylate copolymers, and at least one dipeptide.

The Issues

A. The Examiner rejected claims 1, 3–12, 14, and 16–18 under 35 U.S.C. § 102(b) as anticipated by Kiffel² as evidenced by Schuss³ (Ans. 2–4).

B. The Examiner rejected claims 1 and 13 under 35 U.S.C. § 103(a) as obvious over Kiffel as evidenced by Schuss and Liberty⁴ (Ans. 5).

A. *35 U.S.C. § 102(b) over Kiffel as evidenced by Schuss*

The Examiner finds

² Kiffel et al., US 4,837,012, issued June 6, 1989 (“Kiffel”).

³ Schuss et al., US 2007/0079935 A1, published Apr. 12, 2007 (“Schuss”).

⁴ Liberty et al., US 2008/0142032 A1, published June 19, 2008.

Kiffel discloses composition comprising about 0.1-3% film forming polymer such as polyvinylpyrrolidone, polyvinylpyrrolidone-quaternized amino acrylate or amino methacrylate copolymer, polyvinylpyrrolidone-vinyl acetate copolymer, linear polymers of 1-vinyl-2-pyrrolidone monomers, octylacrylamide/acrylates/ butylaminoethyl/ methacrylate copolymer (column 2, lines 67 to column 3, line 6; claim 12) with the 0.1-35 being a species of the claimed range of 0.1-25% in claim 9; amino acids such as L-carnosine (column 2, line 37; claim 1) . . . water or ethanol or isopropanol or mixtures are acceptable carrier vehicle (claim 2; column 2, lines 54-65)

(Ans. 3).

The issue with respect to this rejection is: Does the evidence of record support the Examiner's conclusion that Kiffel anticipates the claims?

Findings of Fact

1. Kiffel teaches that a "method of reviving unwashed, oily hair comprises applying to the hair, preferably via a spray mist, a composition consisting essentially of at least one film-forming amino acid metal salt in a cosmetically acceptable vehicle" (Kiffel 2:16–20).

2. Kiffel teaches "metal salts of amino acids have been surprisingly found to display film-forming properties. These amino acids include . . . L-carnosine" (Kiffel 2:33–37).

3. Kiffel teaches "[o]ther ingredients that may be added are conventional film-forming polymers, such as polyvinylpyrrolidone-quaternized amino acrylate or amino methacrylate copolymer, polyvinylpyrrolidone-vinyl acetate copolymer, linear polymers of 1-vinyl-2-pyrrolidone monomers, octylacrylamide/acrylates/ butylaminoethyl/

methacrylate copolymer, hydroxyethylcellulose and diallyldimethyl ammonium chloride copolymer and the like, and mixtures thereof” (Kiffel 2:66 to 3: 6).

Principles of Law

“A single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005).

“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000).

Analysis

We begin with claim interpretation, since before a claim is properly interpreted, its scope cannot be compared to the prior art. The limitations at issue are “at least one dipeptide” in claim 1 and “wherein at least one dipeptide is carnosine” in claim 6.

Appellants contend that a “metal salt of L-carnosine is a different species, and does not anticipate the amino acid ‘carnosine.’ Indeed, a ‘dipeptide’ or ‘carnosine’ as presently claimed in claims 1, 5 or 6 does not contain any metal compound” (App. Br. 6).

We first turn to the Specification to interpret the term “dipeptide.” The Specification teaches “[w]ith the term dipeptide, compounds with two amino acid moieties are meant. . . . The dipeptide compounds according to the present invention comprise two amino acid moieties. In principal, any dipeptide available either natural or synthetic is suitable for the purposes of the present invention. The synthetic ones are preferred” (Spec. 2). The

Specification teaches that the “most preferred is carnosine and is of β -alanin and L-histidine” (Spec. 3).

While the Specification discusses dipeptides, the Specification does not identify whether the dipeptides are in the acid or salt form. Claim 1 and the Specification teach an aqueous medium (*see* Spec. 1) that comprises other components with sodium salts (*see* Spec. 4, 10) and cations including “sodium, potassium, magnesium” (Spec. 10), recognizing that metals may be present in the aqueous medium.

The Specification and claim 1 do not contain any language, however, that excludes any form of dipeptide, whether a metal salt form, an acid form, or other forms, but broadly use the term “dipeptide.” Therefore, we agree with the Examiner that the broadest reasonable interpretation of the term “dipeptide” in the Specification encompasses metal salts of the dipeptides. Specifically, “if metal salt of carnosine is a species of carnosine, then carnosine is the genus of carnosine dipeptide that encompasses species such as metal salt. Metal salt of carnosine is still carnosine and still a dipeptide” (Ans. 8).

We recognize, but find unpersuasive, Appellants’ citation of *Pfizer, Inc. v. Ranbaxy Labs., Ltd.*, 457 F.3d 1284 (Fed. Cir. 2006) for the proposition that “a claim to an acid *cannot* be interpreted to include a salt of the claimed acid” (App. Br. 6). In *Pfizer*, claim 1 expressly listed acids or salts, claim 2 limited claim 1 to the acid form and claim 6 attempted to limit claim 2 to the salt form. *Pfizer*, 457 F.3d at 1288. The issue before the Court was not whether a general teaching of a compound, as in the instant case, encompasses both the acid and salt forms, but rather whether claim 6

was properly dependent, under 35 U.S.C. § 112, fourth paragraph, because the salt limitation in claim 6 to a salt was outside the “acid” requirement of claim 2.

The Court recognized that “claim 6 could have been properly drafted . . . as dependent from claim 1.” *Pfizer*, 457 F.3d at 1292. This situation is closer to the instant facts, because the instant claims 1 and 6 are drawn to dipeptides, but do not recite any specific form of the dipeptide, whether acid form or salt form. Thus, a salt form claim could be properly drafted as dependent from either of claims 1 or 6 because these claims are reasonably interpreted, consistent with the Specification, as encompassing any form of the dipeptide as discussed above.

We recognize, but find unpersuasive, Appellants argument that “nowhere does Kiffel disclose use of amino acid, not in metal salt form, in a hair composition” (Reply Br. 3). Not only do the claims lack any limitation that the dipeptide is “not in metal salt form,” but the Specification provides no suggestion to exclude metal salt forms of the dipeptide (*see* Spec. 2). *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (“[A]ppellant’s arguments fail from the outset because . . . they are not based on limitations appearing in the claims.”).

Conclusion of Law

The evidence of record supports the Examiner’s conclusion that Kiffel anticipates the claims.

B. 35 U.S.C. § 103(a) over Kiffel and Liberty, as evidenced by Schuss

Appellants contend that “Kiffel is directed to a composition comprising a *metal* salt of an amino acid, in particular a metal salt of L-

carnosine. The applicants further submit that it would not be obvious for a skilled artisan to modify Kiffel to include a dipeptide as claimed because a skilled artisan would have no reason to add a dipeptide to Kiffel's composition" (App. Br. 7–8).

We find this argument unpersuasive for the reasons already given. While Kiffel teaches dipeptides with metal salts (FF 1), claim 1 is reasonably interpreted, consistent with the Specification, as encompassing these metal salt containing dipeptides as discussed above. The Examiner rejected the claims under obviousness to address the limitations of claim 13, and did not separately rely upon Kiffel to demonstrate the obviousness of claim 1 without metal salts (*see* Final Act. 12; Ans. 5).

SUMMARY

In summary, we affirm the rejection of claims 1 and 6 under 35 U.S.C. § 102(b) as anticipated by Kiffel as evidenced by Schuss. Claims 3–5, 7–12, 14, and 16–18 fall with claims 1 and 6.

We affirm the rejection of claims 1 and 13 under 35 U.S.C. § 103(a) as obvious over Kiffel as evidenced by Schuss and Liberty.

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