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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LAETITIA CATTUZZATO, NATHALIE CHEVROT, SANDY
DUMONT, and CORINNE STOLTZ¹

Appeal 2015-004706
Application 13/383,934
Technology Center 1600

Before DONALD E. ADAMS, RICHARD J. SMITH, and KRISTI L. R.
SAWERT, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a
cosmetic treatment process. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

¹ According to Appellants, the real party in interest is SOCIETE
D'EXPLOITATION DE PRODUITS POUR LES INDUSTRIES
CHIMIQUES SEPPIC. (Appeal Br. 2.)

STATEMENT OF THE CASE

Background

“The present invention falls within [the] context of the search for new molecules or compositions which, when applied to the skin, produce, by virtue of their own activity, a ‘plumping’ effect on the skin and/or . . . ‘volumizing’ effect on the skin.” (Spec. 1, ll. 26–31.)

Claims on Appeal

Claims 1–4 are on appeal. (Claims Appendix, Appeal Br. 21.) Claim 1 is illustrative and reads as follows:

1. A cosmetic treatment process comprising applying to human skin N-hexadecanoyl isoleucine of formula (I):



as a “volumizing” agent and/or as a “plumping” agent for human skin.

Examiner’s Rejection

Claims 1–4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Godtfredsen² and Yukio.³ (Ans. 4.)

FINDINGS OF FACT

FF 1. The Examiner finds that Godtfredsen teaches Appellants’ claimed compound (N-hexadecanoyl isoleucine) for use as a personal care composition, including as a skin cream, body lotion, soap, or shaving cream,

² Godtfredsen et al., WO 90/14429, published Nov. 29, 1990 (“Godtfredsen”).

³ Yukio et al., FR 2,873,575 A1, published Feb. 3, 2006, machine translation of record (“Yukio”).

to be applied to the skin. (Ans. 4, citing Godtfredsen Abstract; 9, l. 35; 6, ll. 1–3; claim 7.)

FF 2. The Examiner finds that since the same composition is taught by Godtfredsen as claimed by Appellants, “it will inherently produce a ‘volumizing’ and/or ‘plumping’ effect on the skin.” (Ans. 5.)

FF 3. Godtfredsen teaches that a skin cream or body lotion may contain 0.1%–10% by weight of the claimed compound (N-hexadecanoyl isoleucine). (Godtfredsen 19, ll. 12–13.)

ISSUE

Whether a preponderance of evidence of record supports the Examiner’s conclusion of obviousness under 35 U.S.C. § 103(a).

Analysis

As to claims 1–3, we adopt the Examiner’s findings and analysis, and agree with the Examiner’s conclusion that claims 1–3 would have been obvious to a person of ordinary skill in the art at the time of the invention. (Ans. 4–19; FF 1–3.) Moreover, as to claims 1–3, we rely on Godtfredsen alone. *See In re Bush*, 296 F.2d 491, 496 (CCPA 1961) (holding that the Board may rely on fewer references than relied upon by the Examiner without designating it as a new ground of rejection).

Appellants separately argue claims 1–4. (Appeal Br. 4–19.) We address Appellants’ arguments below.⁴

⁴ While Appellants make several arguments regarding Yukio in the Appeal Brief and Reply Brief, including its combination with Godtfredsen, we do not address those arguments in connection with claims 1–3 due to our reliance on Godtfredsen alone.

Claim 1

Appellants argue that claim 1 describes a process that has an effect on the adipose tissue of the hypodermis. (Appeal Br. 4–5.) In contrast, according to Appellants, the compounds of Godtfredsen are “surface active agents” that have a different effect than claim 1.⁵ (*Id.*) We are not persuaded. The claimed plumping or volumizing effect is an inherent result of using the same compound as claimed on the skin. (FF 2.) Moreover, the mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991).

Appellants argue that N-hexadecanoyl isoleucine is “mentioned as merely one of 118 possible surface-active agents” in Godtfredsen, with Godtfredsen showing no preference for that compound. (Appeal Br. 5.) We are not persuaded. Godtfredsen teaches the practice of Appellants’ claimed method “with respect to any one of all of the N-acyl amino acids disclosed.” (Ans. 8, citing Godtfredsen 17, ll. 26–29.) *See also Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989).

Appellants argue that Example 9 of Godtfredsen teaches that the claimed N-hexadecanoyl isoleucine “is one of the underperforming compounds.” (Appeal Br. 5.) We are not persuaded. Even if Godtfredsen teaches that the claimed compound is somewhat inferior to other compounds for the same use, such teaching does not impart patentability to the claimed compound. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

⁵ We understand Appellants’ argument to be that Godtfredsen is directed to treatment at the epidermis rather than a treatment that affects the hypodermis. (*See* Appeal Br. 10; Reply Br. 3–5.)

Claim 2

Claim 2 is similar to claim 1, but includes the “volumizing” and/or “plumping” effect as an intended use or result in the preamble, and the application of “an effective amount of N-hexadecanoyl isoleucine.” (Appeal Br. 21.) However, we find this claim language to be a non-limiting expression of a purpose or intended result that is achieved by an “effective amount.” See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories*, 246 F.3d 1368, 1375–76 (Fed. Cir. 2001). Appellants’ arguments regarding claim 2 are otherwise similar to those advanced in connection with claim 1, and are unpersuasive for the reasons set forth above.

Claim 3

Claim 3 depends from claim 2 and further recites that the effective amount of N-hexadecanoyl isoleucine “is between 0.000001% and 0.5% by weight.” (Appeal Br. 21.) Appellants argue that this range is not taught by Godtfredsen or Yukio. (*Id.* at 13–16.) We are not persuaded. Godtfredsen teaches that the claimed compound may be present in an amount of 0.1%–10% by weight. (FF 3.) Thus, the claimed concentration range overlaps the range disclosed in Godtfredsen, and the resulting prima facie case of obviousness has not been sufficiently rebutted by Appellants, such as by a showing of criticality of the claimed range. See *In re Peterson*, 315 F.3d 1325, 1329–31 (Fed. Cir. 2003); *In re Geisler*, 116 F.3d 1465, 1469–70 (Fed. Cir. 1997). Accordingly, for these reasons and the reasons set forth above in connection with claim 2, we affirm the rejection of claim 3.

Claim 4

Claim 4 depends on claim 3 and further limits the effective amount of N-hexadecanoyl isoleucine to “between 0.000001% and 0.05% by weight.”

(Appeal Br. 21.) The Examiner found that claim 4 would have been obvious based on mere optimization of ranges, citing *In re Aller*, 220 F.2d 454, 456 (CCPA 1955.) (Ans. 6, 15–17.) Appellants argue that this range is not suggested by Godtfredsen or Yukio. (Appeal Br. 16–19.)

Based on the record before us, we agree with Appellants. The claimed range does not overlap the range taught by Godtfredsen. (*See* FF 3.) Moreover, while Yukio teaches cosmetic compositions using N-acyl amino acids, Yukio also teaches that “[i]f the amount [of lipoamino acids] is less than 0.1%, it does not get the desired beneficial effects.” (Yukio 6, ll. 3–6.) Thus, the art teaches against any motivation or desirability to optimize the range below 0.1% of N-hexadecanoyl isoleucine.

Conclusion of Law

A preponderance of evidence of record supports the Examiner’s conclusion that claims 1–3 are obvious under 35 U.S.C. § 103(a).

A preponderance of evidence of record fails to support the Examiner’s conclusion that claim 4 is obvious under 35 U.S.C. § 103(a).

SUMMARY

We affirm the rejection of claims 1–3 and reverse the rejection of claim 4.

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-IN-PART