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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/966,373	12/13/2010	Martin Josso	16403-00033-US1	8614
30678	7590	12/02/2016	EXAMINER	
POL SINELLI PC (DC OFFICE) 1000 Louisiana Street Fifty-Third Floor HOUSTON, TX 77002			ROSENTHAL, ANDREW S	
			ART UNIT	PAPER NUMBER
			1613	
			NOTIFICATION DATE	DELIVERY MODE
			12/02/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MARTIN JOSSO<sup>1</sup>

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Appeal 2015-005327  
Application 12/966,373  
Technology Center 1600

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Before ERIC B. GRIMES, RICHARD J. SMITH, and  
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

NEWMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a sunscreen composition for topical application. The Examiner entered final rejections for obviousness. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

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<sup>1</sup> Appellants identify the Real Party in Interest as L'OREAL. Br. 2.

## STATEMENT OF THE CASE

### *Background*

“To provide protection of the skin and keratinous materials against UV radiation, sunscreen compositions are generally used, comprising organic filters, active in the UV-A range and active in the UV-B range.”

Spec. 2:3–8. “The present invention relates to an anhydrous fluid composition comprising, in a cosmetically acceptable medium:

a) at least one oily phase and  
b) at least one particular triazine UV filter of formula (I) and  
c) at least one rheological agent for thickening or gelling the oily phase.” *Id.* at 1:6–13. The Specification discloses that the invention overcomes drawbacks of the prior art by providing “new anhydrous fluid sunscreen compositions” that are “stable over time” and provides “higher sun protection factors” while still being easy to apply. *Id.* at 4:12–15.

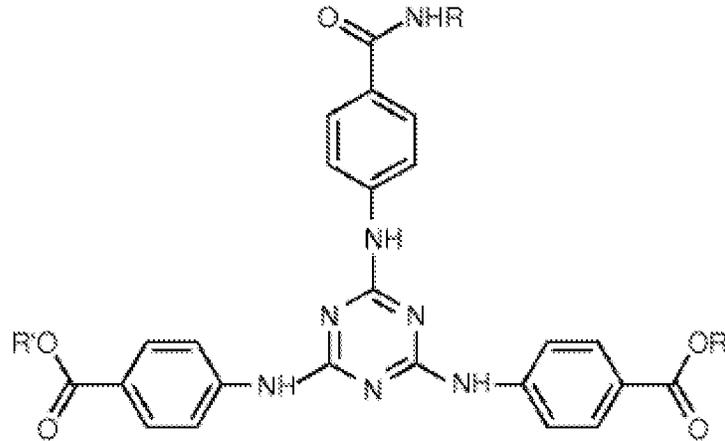
Claims 21 and 23–28 are on appeal. Claim 21 is illustrative and reads as follows:

21. A transparent, fluid, anhydrous sunscreen composition for application to the skin, nails, hair, eyelashes, eyebrows and/or scalp comprising:

an oily phase, wherein the oily phase comprises:

a) at least one hydrocarbon or silicone oil;

b) 0.1 to 10 wt.% relative to the total weight of the compositions, of at least one triazine UV filter selected from the group consisting of 2-[(p-(tert-butylamido)anilino)]-4,6-bis-[(p-(2'-ethylhexyl-1'-oxycarbonyl)anilino)]-1,3,5-triazine or “Diethylhexyl Butamido Triazone” corresponding to the following formula:



in which R' denotes an ethyl-2-hexyl radical and R denotes a tert-butyl radical; and

c) 0.1 to 10 wt.%, relative to the total weight of the composition of a lipophilic polyamide polycondensate rheological agent for thickening or gelling the hydrocarbon or silicone oil; and

a anhydrous cosmetically acceptable medium for the oily phase comprising at least one C<sub>1</sub>-C<sub>3</sub> monohydric alcohol;

wherein the composition is a transparent, fluid, anhydrous sunscreen composition for application in its anhydrous form to the skin, nails, hair, eyelashes, eyebrows and/or scalp, has a turbidity less than 1000 NTU at 25°C and a viscosity of less than 0.5 Pa·s at a rotary speed of 200 RPM after 30 seconds of rotation, and contains less than 1% water.

The Examiner states that “[b]ased upon the elected species, claim 1 recites an anhydrous fluid comprising (a) triglycerides of caprylic/capric acid (oily phase), (b) diethylhexyl butamido triazone (triazine UV filter), and (c) lipophilic polyamide polycondensates (rheological agent).” Ans. 4. Appellant’s Specification defines “hydrocarbon oils” as including triglycerides of caprylic/capric acids. Spec. 126–127.

Claims 21 and 23–28 are rejected under 35 U.S.C. § 103(a) as obvious based on Biatry<sup>2</sup> and Candau<sup>3</sup> (Ans. 3).

#### DISCUSSION

The Examiner finds that Biatry “teaches a composition comprising an oily phase and at least one hydrophobic sunscreen, wherein the oily phase comprises at least one gelling polymer.” Ans. 5. The Examiner further finds “Biatry teaches that the composition comprises an aqueous or water-soluble phase . . . and that the water-soluble solvent may be, for example ethanol . . . and that the particles may be prepared [] and then dispersed” in the solvent. *Id.* The Examiner finds that the composition disclosed by Biatry is anhydrous when the particles are dispersed in ethanol. *Id.* at 5–6.

With regard to the claim limitation “fluid,” the Examiner looks to Appellant’s Specification for its disclosure that the “rheological agent [is] for thickening or gelling the oily phase” and finds that “the instant specification treats a gelled composition as a fluid.” Thus, the Examiner finds the “gelled oil particles” disclosed in Biatry teach the “fluid” element of claim 21 (Ans. 6).

The Examiner finds Biatry discloses a composition comprising “caprylic/capric triglycerides [] as a component of the oily phase . . . triazine derivatives as hydrophobic sunscreen components [] including the elected species diethylhexylbutamidotriazone . . . [and] teaches that diethylhexylbutamidotriazone (e.g. Uvasorb HEB) is a preferred species of

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<sup>2</sup> US 2006/0292095 A1, published Dec. 28, 2006 (“Biatry”)

<sup>3</sup> US 2005/0065251 A1, published Mar. 24, 2005 (“Candau”)

hydrophobic organic UV-screening agents.” *Id.* The Examiner finds Biatry discloses “a specific example composition comprising a sunscreen agent, a silicone oil (dimethicone), and lipophilic polyamide condensates (e.g. Uniclear 100).” *Id.* The Examiner finds Biatry discloses the range of the sunscreen agent as “from 0.05%-80 wt.% relative to the total weight of the composition” and teaches “the rheological agent to be present in amounts in the range from 1-80 wt.% [] relative to the total weight of the composition.”

*Id.* The Examiner finds that

the invention of Biatry is taught as being useful for application to “any part of the skin of the human or animal body ... including the lips and the scalp.” [] Furthermore, the invention is taught as being used in a cosmetic or dermatological composition that can be applied to skin and hair or any keratinous material [], thus the intended use is addressed by the art.

*Id.* at 7.

The Examiner finds Biatry “does not teach the required viscosity or turbidity of the claimed invention.” *Id.*

The Examiner finds that

Candau teaches a cosmetic composition comprising a triazine UV filter (UVINUL T150 - 5 wt%), a rheological agent (UNICLEAR 100V 1.8 wt%), and an oil (2-octyldodecanol - 42.2 wt%) . . . The composition can further comprise a lower alcohol, as required in instant claim 21 []. The invention, as taught by Candau, may be manufactured in a way such that a clear transparent solution is obtained that can be cast directly into packaging materials []. In particular, the anti-sun compositions can be obtained in the form of an anhydrous composition that has “noteworthy transparency ... properties” []. Candau further teaches that their transparent, fluid composition has a viscosity of between 0.01-60 poise (0.001-6

Pa-s) after a 30 second rotation at a speed of 200 RPM, as required in instant claim 21 [ ]. Candau does not teach a value for turbidity, but does teach the composition to be transparent, thus a very low or non-existent turbidity would be necessary and would read on the requirement of claim 21 [ ] . . . Therefore, Candau teaches the claimed invention minus the elected species of oil (triglycerides of caprylic/capric acid).

*Id.* at 7–8.

We agree with the Examiner that Biatry and Candau support a prima facie case of obviousness. Biatry discloses “oily particles comprising at least one hydrophobic sunscreen and comprising at least one oily phase structured with at least one gelling polymer.” (Biatry: Abstract). The composition is described as “intended to be applied to any part of the skin of the human or animal body, particularly any part of the skin, including the lips and the scalp.” *Id.* at ¶ 37.

Biatry describes the oily particles as “gelled” when a gelling polymer (rheological agent) is added to “structure” the oily particles, and discloses that the rheological agent is to be used in amounts in the range from 1–80 wt%. *Id.* at ¶¶ 42, 105. Biatry discloses that suitable gelling polymers include polyamides such as Uniclear 100. *Id.* at ¶¶ 103, 180. Biatry discloses that the oily particles may be prepared and then dispersed into a solvent that is water-soluble, and that the solvent may be ethanol. *Id.* at ¶¶ 490, 494. Biatry discloses caprylic/capric acid triglycerides as a component of the oily phase. *Id.* at ¶ 75. Biatry discloses hydrophobic sunscreens for use in the composition, including triazone derivatives, and lists diethylhexylbutamidotriazone among the “preferred species” of hydrophobic

UV-screening agents. *Id.* at ¶¶ 368, 379. Biatry teaches the range of the sunscreen agent as “from 0.05%-80 wt% relative to the total weight of the composition.” *Id.* at ¶ 420.

Candau discloses a cosmetic composition comprising a triazine UV filter (UVINUL T150 at 5 wt%), a rheological agent (UNICLEAR 100V at 1.8 wt%), and an oil (2-octyldodecanol at 42.2 wt%). Candau ¶ 169. Candau discloses that solvents for use in its composition include “lower alcohols.” *Id.* at ¶ 137. Candau discloses methods of manufacture to obtain a “clear transparent solution” that may be subsequently packaged for use and observes that anhydrous embodiments display “noteworthy transparency and translucency properties.” *Id.* at ¶¶ 147, 167. Candau discloses the composition has a viscosity of between 0.01-60 poise after a 30 second rotation at a speed of 200 RPM. *Id.* at ¶ 11. The Examiner finds that 0.01-60 poise is the same as 0.001-6 Pa·s. Ans. 7. Appellant does not dispute this finding. *See* Br. 10–13.

We agree with the Examiner that the composition of claim 21 would have been obvious based on Biatry and Candau. Biatry suggests a sunscreen composition that meets all of the limitations of claim 21 except that it does not expressly disclose the required viscosity or turbidity in the claimed range of “turbidity less than 1000 NTU at 25°C and a viscosity of less than 0.5 Pa·s at a rotary speed of 200 RPM after 30 seconds of rotation.” However, Candau discloses a composition with viscosity in the disclosed range that is clear and transparent, indicating it likewise has a very low turbidity. Candau at ¶ 11. Candau also teaches the sunscreen, rheological agent, and anhydrous composition elements of claim 21. *Id.* at ¶¶ 137 169. Thus, it

would have been obvious to one of skill in the art at the time of the instant invention to have selected from the teachings of Biatry and Candau to arrive at the composition of claim 21, by including triglycerides of caprylic/capric acid in Biatry's composition and making it using Candau's method in order to produce a transparent, gelled composition having the viscosity and turbidity required by claim 21. "The 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). "If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 417.

Appellant argues that "[d]eriving what is claimed from Biatry and Candau requires picking and choosing the claimed components from various embodiments and combining them in contradiction to what the references reasonabl[y] suggest to one of ordinary skill in the art." Br. 6. Appellant argues that the Examiner "points to intermediate oily compositions of Biatry that form small spherical oily particles of aqueous emulsions . . . that are further processed into sunscreen emulsions" and are "not themselves 'for application to the skin, nails, hair, eyelashes, eyebrows, and/or scalp.'" *Id.* at 6–7. According to Appellant, to derive the composition from Biatry requires "picking out the intermediate oily compositions (and further modifying them to meet the elements of the claims); or (2) combining the intermediate oily particles of Biatry with a water-soluble continuous phase that excludes water (even though Biatry does not include such a composition)." *Id.* at 7.

The Examiner responds that “the fact that the composition of Biatry is an intermediate is not relevant because any anhydrous fluid composition can be applied anywhere, including the intermediate composition of Biatry” (Ans. 12) and that “although Biatry does not exclude water, Biatry does not require water. As such, the skilled artisan would have found it obvious to select an alcohol, such as ethanol, as the solvent without having a requirement for including water.” *Id.* at 12–13.

Appellant’s argument on this point is not persuasive. We agree with the Examiner that claim 21’s recitation “for application to the skin, nails, hair, eyelashes, eyebrows, and/or scalp” is an intended use and that Biatry’s teaching that its composition is suitable for use on “any part of the skin of the human or animal body ... including the lips and the scalp” would motivate one of skill in the art to use the disclosures of Biatry to make compositions that are suitable for use as recited in claim 21. In addition, Biatry discloses oily particles for purification that may be prepared and then dispersed in a solvent, and teaches ethanol as a non-aqueous solvent. Given these disclosures, we are not persuaded that Biatry’s lack of a specific example formed with a water-soluble phase excluding water would have failed to prompt an ordinary artisan to attempt to purify the intermediate composition of Biatry with ethanol as a solvent, thereby resulting in an anhydrous composition. Moreover, “[o]bviousness does not require absolute predictability of success. . . . For obviousness under § 103, all that is required is a reasonable expectation of success.” *In re O’Farrell*, 853 F.2d 894, 903–04 (Fed. Cir. 1988).

Appellant also argues that “Biatry describes huge lists of UV screening agents” with “[d]iethylhexyl butamido triazone [being] mentioned only twice, each time in a long list of other possible sunscreen agents” and never “exemplified or otherwise described as preferred.” Br. 8. Similarly, Appellant argues that “none of the actual compositions [of] Biatry and Candau include a C<sub>1</sub>-C<sub>3</sub> monohydric alcohol” and that the Examiner’s selection of ethanol must be selected “from amongst the list of solvents” disclosed. *Id.*

We are not persuaded by Appellant’s arguments. Biatry identifies “[d]iethylhexylbutanlidotriazone” as one of “[t]he preferred hydrophobic organic UV-screening agents.” Biatry, ¶¶ 368, 379. Moreover, our reviewing court has “reject[ed] the notion that one of these ingredients cannot anticipate because it appears without special emphasis in a longer list. To the contrary, the disclosure is prior art to the extent of its enabling disclosure.” *See, e.g., Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1376 (Fed. Cir. 2005). Biatry and Candau, respectively, enable use of diethylhexylbutanlidotriazone and ethanol in their compositions and absent evidence that the references are not enabling, Appellants’ attorney argument is not persuasive. *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (“Attorney’s argument in a brief cannot take the place of evidence.”).

Appellant next argues that to make the claimed composition, one of skill in the art “must choose to use far less diethylhexyl butamido triazone than the amounts suggested by Biatry” and claim 21 “requires using it in much lower amounts that suggested by Biatry (about one-third the amount).” Br. 9. Similarly, Appellant argues “deriving what is claimed further requires

choosing to use less lipophilic polyamide polycondensate than the amounts used in Biatry.” *Id.* This argument is not persuasive because Biatry discloses ranges for sunscreen agents and gelling polymers that encompass or overlap the ranges recited in claim 21. Biatry, ¶¶ 105, 420. Our reviewing court has held that “the existence of overlapping or encompassing ranges shifts the burden to the applicant to show that his invention would not have been obvious.” *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003).

Appellant next argues that because “Biatry does not describe a transparent sunscreen composition” and “[t]here is no evidence of record suggesting that the transparency of Candau's compositions would correlate to the compositions of Biatry,” one of skill in the art would need to “look beyond the compositions of Biatry to second reference directed to different compositions (Candau) and correlate the physical properties of these different compositions to the compositions of Biatry.” Br. 9–10.

This argument is unpersuasive attorney argument. “An examiner bears the initial burden of presenting a prima facie case of obviousness. Once the examiner establishes a prima facie case of obviousness, the burden shifts to the applicant to rebut that case. . . . However, once the applicant has come forward with rebuttal evidence, the examiner must consider the totality of the evidence to determine whether the obviousness rejection should stand.” *In re Huai-Hung Kao*, 639 F.3d 1057, 1066 (Fed. Cir. 2011) (citations omitted). Appellant has presented no evidence in support of this attorney argument.

Appellant next argues the claims provide for a turbidity less than 1000 NTU at 25°C and a viscosity of less than 0.5 Pa·s. None of the references cited

against the claims refer to these elements of the claims. Therefore, to account for these elements of the claims, the Examiner improperly relies on inherency (or alternatively fails to account for these elements of the claims).

Br. 10.

The Examiner responds that

Candau teaches their compositions as being transparent and possessing a viscosity that overlaps with that required by the instant claims (0.001-6 Pa-s). The fact that the composition is transparent means that it has a very low, if not 0, value for turbidity, which is essentially a measure of how clear or transparent a solution is . . . the Examiner, in the rejection above, does not argue inherency or result-effective variables to address the viscosity and turbidity properties. Instead, Candau is referenced as teaching the viscosity of the claimed invention in a transparent solution.

Ans. 16.

We agree with the Examiner that inherency is not at issue. Candau teaches a viscosity of between 0.01–60 poise (which the Examiner finds equivalent to 0.001–6 Pa-s) after a 30 second rotation at a speed of 200 RPM (Candau ¶ 11), which overlaps with the range disclosed in claim 21 (“viscosity of less than 0.5 Pa-s at a rotary speed of 200 RPM after 30 seconds of rotation”). Accordingly, Candau teaches this element.

Finally, Appellant argues that evidence of unexpected results would rebut any prima facie case of obviousness. Br. 13. Appellant cites Examples 2 and 3 of the Specification as disclosing compositions made with and without the claim element “0.1 to 10 wt.%, relative to the total weight of the composition of a lipophilic polyamide polycondensate rheological agent for thickening or gelling the hydrocarbon or silicone oil.” *Id.* at 14. The

Table below from the Specification discloses the components of the compositions and results of a mean SPF in vitro measurement value calculated for the two compositions:

Ingredients	Ex2 wt. %	Ex3 (outside of the inversion) wt. %
ETHYLENEDIAMINE/STEARYL DIMER DILINOLEATE COPOLYMER (UNICLEAR 100 VG - ARIZONA CHEMICAL)	6.0	-
CAPRYLIC/CAPRIC TRIGLYCERIDE (80/40) (MYRITOL 318- COGNIS)	33.0	33.0
BUTYL METHOXYDIBENZOYLMETHANE	3.5	3.5
OCTOCRYLENE	5.0	5.0
ETHYLHEXYL SALICYLATE	5.0	5.0
DROMETRIZOLE TRISILOXANE	1.0	1.0
DIETHYLHEXYL BUTAMIDO TRIAZONE	3.0	3.0
C12-15 alkyl benzate (TEGOSOFT TN from EVONIK GOLDSCHMIDT)	13.0	13.0
Ethanol	3.0	3.0
OCTYL-2-DODECANOL	q.s. 100	q.s. 100
<b>SPF in vitro</b>	<b>100.6</b>	<b>36.2</b>

Br. 14.

Appellant argues the above results show “the addition of a rheological agent resulted in a dramatic and surprising increase in SPF (from 36.2 to 100.6).” *Id.* Appellant argues that the Examiner’s rejection was based on an “independently draw[n] conclusion” that Biatry teaches that Uniclear 100 is an SPF booster and therefore, one of skill in the art “would expect that Uniclear 100 would triple the SPF of the sunscreen composition.” *Id.* Appellant argues that Biatry “does not teach that Uniclear 100 is an SPF booster” but instead teaches that “‘fatty-phase-gelling polymers’ that behave as SPF boosters make it ‘impossible to obtain fluid and vaporizable suspensions.’” *Id.* at 15. According to Appellant, “Biatry does not suggest [ ]the gelling polymers described for use in fluid sunscreens as SPF boosters” and that Biatry likewise does not contain evidence that Uniclear 100 or any SPF booster “would triple the SPF of a sunscreen composition.” *Id.*

We agree with the Appellant that Biatry does not directly teach that Uniclear 100 is an SPF booster or describe its use in fluid sunscreens as an SPF booster. However, use of identical terminology is not necessary for a reference to teach the identical subject matter as a claim. *See In re Schaumann*, 572 F.2d 312, 317 (CCPA 1978) (“[A]lthough appellants would have us hold that Hildebrandt fails as an anticipation because it does not contain a description of the subject matter of the appealed claims, *ipsisimis verbis*, we cannot countenance a result which so obviously exalts [sic] form over substance.”).

Biatry teaches that prior art use of “fatty-phase-gelling polymers” as “SPF boosters” resulted in “increase[d] viscosity of the fatty phase as a whole and, as a result, that of the final emulsion,” rendering it “impossible to obtain fluid [] suspensions.” Biatry ¶ 8. Biatry discloses oily particles comprising “at least one oily phase structured with at least one gelling polymer.” *Id.* at Abstract. Biatry discloses that polyamides are a suitable gelling polymer (*id.* at ¶ 103) and discloses Uniclear 100 as a suitable structuring polyamide. *Id.* at ¶ 180. The Examiner concludes that, based on these teachings, a person of ordinary skill in the art would have expected that Uniclear 100 (a fatty-phase-gelling polymer) would act as an SPF booster. Ans. 17. We agree.

In addition, the Examiner points out that unexpected results must be shown by comparison to the closest prior art. Ans. 18. Here, both Biatry and Candau exemplify sunscreen compositions that include Uniclear 100. *See* Biatry ¶ 553, Candau ¶ 169. Thus, Appellant’s comparison to a

composition lacking Uniclear 100 does not represent a comparison to the closest prior art.

Finally, the Examiner cited Saint Louis<sup>4</sup> as evidence that an increase in SPF from 30 to 100 does not actually represent a three-fold increase in activity. Saint Louis states that “[t]he difference in UVB protection between an SPF 100 and SPF 50 is marginal. Far from offering double the blockage, SPF 100 blocks 99 percent of UVB rays, while SPF 50 blocks 98 percent. (SPF 30, that old-timer, holds its own, deflecting 96.7 percent.)” Saint Louis, pages 1–2. Thus, the evidence cited by the Examiner supports his position that an increase of SPF from 36.2 to 100.6 does not represent a three-fold increase in effectiveness, but rather a 2–3% increase. In short, absent evidence from Appellant that the increase in SPF obtained through the use of Uniclear 100 is beyond what would be expected due to its known properties as an SPF booster, we do not find Appellant’s argument that the results are unexpected persuasive in light of our findings regarding the teachings of the prior art or in light of the data itself.

Claims 23–28 have not been argued separately and therefore fall with claim 21. 37 C.F.R. § 41.37(c)(1)(iv).

#### SUMMARY

We affirm the rejection on appeal.

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<sup>4</sup> Catherine Saint Louis, “Confused by SPF? Take a Number,” New York Times, May 14, 2009. Saint Louis was made of record Oct. 24, 2013.

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Application 12/966,373

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