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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANK PFLUECKER, BERND MUELLER,
GABRIELLE WITTE, and VALERIE ANDRE¹

Appeal 2015-005427
Application 12/670,442
Technology Center 1600

Before ERIC B. GRIMES, RYAN H. FLAX, and DEVON ZASTROW
NEWMAN, *Administrative Patent Judges*.

NEWMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims to a UV filter capsule including a polymeric shell enclosing a core mixture. The Examiner entered final rejections for obviousness.

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

STATEMENT OF THE CASE

Background

The Specification discloses: “[t]he present invention relates to UV filter capsules, to the use thereof for the preparation of cosmetic or

¹ Appellants identify the Real Party in Interest as BASF SE. App. Br. 1.

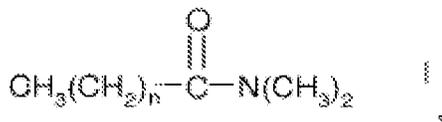
dermatological formulations or dispersions, and to cosmetic or dermatological formulations which comprise the capsules, and to a process for the preparation thereof.” Spec. 1:4–7.

“The present invention therefore relates firstly to UV filter capsules comprising a polymeric shell and a) at least one low-solubility organic UV filter and b) an emollient which is capable of dissolving more than 40% by weight of the low-solubility organic UV filter at room temperature (20°C to 25°C).” *Id.* at 3:5–10.

The Claims

Claims 1, 3–5, and 21 are on appeal. Claim 1, the sole independent claim, is illustrative and reads as follows:

1. UV filter capsule comprising
a polymeric shell encapsulating a core mixture of:
 - a) 1 - 90% by weight, based on the core mixture, of at least one low-solubility organic UV filter and
 - b) an emollient compound of the formula I



where n corresponds to an integer from 2 to 12, which is capable of dissolving more than 40% by weight of the low-solubility organic UV filter at room temperature.

App. Br. 7, Claim Appendix.

“In a preferred embodiment, the compound of the general formula I is N,N-dimethyldecanamide.” (Spec. 8:30 to 9:1.)

The Issue

The Examiner rejected claims 1, 3–5, and 21 under 35 U.S.C. § 103(a) as obvious over Traynor², Bonda I³, and Bonda II⁴ (Ans. 2).

The issue presented is: Does a preponderance of the evidence of record support the Examiner’s conclusion that Traynor, Bonda I, and Bonda II suggest the composition of claim 1?

Findings of Fact

FF 1. Traynor teaches “compositions containing one or more active ingredients (also referred to herein as ‘actives’) that may be added to a body wash composition to provide an active/body wash combination. The invention also encompasses a body wash containing such an active ingredient. In some embodiments, the active ingredient is one or more sunscreens.” Traynor 3:64–4:3.

FF 2. Traynor teaches:

The sunscreen additives and sunscreen/bodywashes of the invention contain at least one sunscreen. In some embodiments, the sunscreen additives of the invention contain one, two, three, four, or more than four sunscreens. In preferred embodiments, the sunscreen additives of the invention include three sunscreens. In other preferred embodiments, the sunscreen additives of the invention include four sunscreens. The sunscreens may be organic or inorganic. The sunscreens

² Daniel Henry Traynor et al., U.S. Pat. No. 7,001,592 B1, issued Feb. 21, 2006 (“Traynor”)

³ Craig A. Bonda et al., U.S. Pat. No. 6,485,713 B1, issued Nov. 26, 2002 (“Bonda I”)

⁴ Craig A. Bonda et al., US 2003/0215472 A1, published Nov. 20, 2003 (“Bonda II”)

may be a UVA absorber, a UVB absorber, physical blocker, or any combination thereof. In some embodiments one or more of the sunscreens is encapsulated. A number of types of encapsulation may be employed as described herein.

Id. at 5:59–6:4.

FF 3. Traynor teaches “preferred cosmetically-acceptable photoactive compounds and concentrations (reported as a percentage by weight of the total cosmetic sunscreen composition, and referring to the final percentage of the sunscreen after addition to the body wash) include: PABA (5% or less) . . . ethylhexyl triazone (5% or less) . . . ” *Id.* at 8:40–56.

FF 4. Traynor teaches:

The additives, e.g., sunscreen additives, of the invention may be combined with any conventional bodywash. The bodywash composition with which the additive, e.g., sunscreen additive is combined may be any bodywash known in the art or apparent to one of skill in the art, as described above. In embodiments where the additive is a non-sunscreen active, the additive may be combined with any composition intended for topical application. In these embodiments, the additive is often encapsulated, e.g., in sol-gel microcapsules.

Id. at 6:28–38.

FF 5. Traynor teaches “[a] particularly preferred method of encapsulation is sol-gel encapsulation. This technique is described in, e.g., U.S. Pat. Nos. 6,238,650, 6,436,375, 6,303,149, and 6,468,509. Any or all of the sunscreens and/or other active ingredients of the compositions of the invention may be encapsulated by such sol-gel encapsulation.” *Id.* 11:47–52.

FF 6. Bonda I teaches “preferred cosmetically-acceptable photoactive compounds and concentrations (reported as a percentage by weight of the total cosmetic sunscreen composition) include . . . ethylhexyl triazone (5% or less).” Bonda I 6:8–22.

FF 7. Bonda I teaches N,N-dimethyldecanamide as a “preferred solvent compound” with 37% solvency for octyl triazone (i.e., ethylhexyl triazone⁵). *Id.* at 7:24–43, 14:3–7.

FF 8. Bonda II teaches:

The invention includes a deodorant composition containing a dialkyl amide and method of suppressing body odor by the topical application of a deodorant composition containing a dialkyl amide in a dermatologically acceptable carrier. The invention also includes an anti-acne composition containing a dialkyl amide and a method of suppressing acne by the topical application of an anti-acne composition containing a dialkyl amide in a dermatologically acceptable carrier.

Bonda II ¶ 15.

FF 9. Bonda II teaches:

The dialkyl amide preferably is derived from a C₈-C₁₈ monocarboxylic acid, and more preferably is a N,N-dimethyl amide . . . Examples of amides include N,N-dimethyldecanamide (dimethyl capramide), N,N-dimethylundecanamide, N,N-dimethyl lauramide, N,N-dimethyltridecanamide, N,N-dimethylmyristamide, N,N-dimethylmyristoleylamide, N,N-dimethylpentadecanamide, and N,N-dimethylpalmitamide. Preferably, the dialkyl amide will suppress or inhibit the growth of axillary bacteria.

⁵ See Fin. Act. 4 “octyl triazone . . . (i.e., ethylhexyl triazone – sold under the trade name UVINUL T-150 by BASF Corporation)”

Id. at ¶ 16.

Principles of Law

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“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.

“Under the proper legal standard, a reference will teach away when it suggests that the developments flowing from its disclosures are unlikely to produce the objective of the applicant’s invention. A statement that a particular combination is not a preferred embodiment does not teach away absent clear discouragement of that combination.” *Syntex (U.S.A.) LLC v. Apotex, Inc.*, 407 F.3d 1371, 1380 (Fed. Cir. 2005) (citations omitted).

Analysis

We adopt the Examiner’s fact finding and reasoning regarding the scope and content of the prior art (Fin. Act. 3–6⁶; FF 1–9) and agree that claim 1 is rendered obvious by Traynor, Bonda I, and Bonda II. We address Appellants’ arguments below.

⁶ Final Office Action, mailed December 20, 2013.

Appellants argue “the claims specifically require co-encapsulation within a polymeric shell of a mixture of components A (organic UV filter) and B (emollient compound of the formula I) [however] [n]one of the cited references teach or provide any reason for such co-encapsulation.” App. Br. 3. Appellants acknowledge that “Traynor teaches that non-sunscreen actives including antimicrobial agents can be encapsulated,” but argue Traynor “discourages []co-encapsulations” as required by claim 1 because Traynor “discusses co-encapsulation only once” in reference only to “sunscreen actives” and “teaches that [] non-sunscreen actives can be encapsulated and combined with the sunscreens above, but does not teach that they can be co-encapsulated with the sunscreens.” *Id.*

Appellants contend that Traynor recognizes the difference between “encapsulated together” and “mere combination of one element with another,” and specifically excludes non-sunscreen actives from the items that can be encapsulated together, “listing only ‘sunscreen actives’ as being encapsulated together.” *Id.* at 3–4. Furthermore, Appellants argue that where Traynor’s disclosure teaches encapsulation of non-sunscreen actives, it “conspicuously fails to teach” co-encapsulation, as does the patent it references (U.S. Pat. No. 6,238,650). *Id.* at 4. According to Appellants, “[o]ne skilled in the art would therefore have no reason to co-encapsulate a non-sunscreen active together with a sunscreen active when the teachings of Traynor clearly omit such a combination from its teachings of what components can be combined together.” *Id.*

Appellants further argue that the Examiner failed to articulate a reason to combine the teachings of Traynor and Bonda II, and that even if so

combined, neither Bonda I nor Bonda II teaches co-encapsulation because both are “silent regarding the co-encapsulation of dialkyl amide N,N-dimethyldecanamide with other components, particularly for use with sunscreen actives.” *Id.* at 5. Finally, Appellants argue that even if one of skill in the art combined the teachings as suggested by the Examiner, “the result would not include co-encapsulation of the components as teaching in the prior art or reason so do so.” *Id.*

We are not persuaded that the Examiner erred in rejecting claim 1 over Traynor, Bonda I, and Bonda II. As stated by the Examiner, Traynor teaches a composition containing sunscreen actives as well as non-sunscreen actives in which “[a]ny or all of the sunscreens and/or other active ingredients” can be encapsulated. Fin. Act. 3; Ans. 2–4; FF 1–5. Traynor’s broad disclosure regarding encapsulation does not expressly discourage co-encapsulation of sunscreen actives with non-sunscreen actives.

Accordingly, Traynor does not teach away from co-encapsulation. *See Syntex*, 407 F.3d at 1380 (“Under the proper legal standard, a reference will teach away when it suggests that the developments flowing from its disclosures are unlikely to produce the objective of the applicant’s invention. A statement that a particular combination is not a preferred embodiment does not teach away absent clear discouragement of that combination”) (citations omitted). In addition, Appellants have provided no evidence in support of their position, only attorney argument, which is insufficient to overcome the Examiner’s prima facie case. *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) (“[A]ttorney argument [is] not the kind of factual evidence that is required to rebut a prima facie case of obviousness”).

With regard to reason to combine the references, we find that the Examiner provided “articulated reasoning with rational underpinning” to support the legal conclusion of obviousness from the combination of Traynor, Bonda I, and Bonda II. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Traynor and Bonda I are both directed to compositions containing sunscreen. FF 1–6. Bonda I teaches use of N,N-dimethyldecanamide as a “preferred solvent compound” (FF 7), and Bonda II – which is also related to preparations for use on the skin – provides additional teachings on uses of compositions employing a dialkyl amide (FF 8–9). Appellants provide no evidence or expert declaration explaining why one of skill in the art would not be motivated to combine these references. Indeed, the claimed composition appears to be a “combination of familiar elements [made] according to known methods [that is] likely to be obvious [because] it does no more than yield predictable results.” *KSR*, 550 U.S. at 416.

The Examiner sufficiently establishes that an ordinary artisan reading Traynor, Bonda I, and Bonda II would have reasonably been led to incorporate N,N-dimethyldecanamide into the composition of Traynor in order to provide solubilizing ability to Traynor’s sunscreen formulation as taught by Bonda I (FF 7) and further as an antimicrobial agent as taught by Bonda II (FF 9). Accordingly, we affirm the rejection of claim 1 over Traynor, Bonda I, and Bonda II.

Conclusion of Law

The preponderance of evidence of record supports the Examiner’s rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Traynor,

Bonda I, and Bonda II. Claims 3–5 and 21⁷ have not been argued separately and therefore fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

SUMMARY

We affirm the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Traynor, Bonda I, and Bonda II.

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

⁷ Appellants argue the rejection of claims 1, 7, and 10 on App. Br. 2, which we believe is in error based on Appellants' statement on App. Br. 1 that claims 7 and 10 were withdrawn from examination. We express no opinion regarding the patentability of restricted claims 7 and 10. *See Ex parte Ohsaka*, 2 USPQ2d 1460, 1461 (BPAI 1987).