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THE ESTEE LAUDER COS, INC
155 PINELAWN ROAD
STE 345 S
MELVILLE, NY 11747

EXAMINER
CHICKOS, SARAH J

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIEL B. YAROSH[1]

Appeal 2016-008472
Application 13/022,990
Technology Center 1600

Before, JEFFREY N. FREDMAN, TAWEN CHANG
and JOHN E. SCHNEIDER, *Administrative Patent Judges*.

SCHNEIDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to composition for reducing the appearance of under-eye dark circles, which have been rejected as obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Under-eye dark circles are often the result on a combination of factors such as deep vascular congestion/superficial vascularity, hyperpigmentation, skin translucency, and structural shadowing. Spec., 1–2. "The present

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[1] Appellant identifies the Real Party in Interest as ELC Management LLC. Br. 1.

invention is based on the discovery that the combination of certain bicyclic monoterpene diols with certain skin lightening agents surprisingly and unexpectedly achieves synergistic reduction of the appearance of under-eye dark circles, by simultaneously targeting vascular congestion in the dermis layer and hyperpigmentation in the epidermis layer of the skin" Spec.4.

Claims 1–11 are on appeal. Claim 1 is the sole independent claim and reads as follows:

> 1. A cosmetic or dermatological composition for reducing appearance of under-eye dark circles, comprising at least one bicyclic monoterpene diol and at least one skin lightening agent in a cosmetically or pharmaceutically acceptable carrier.

The claims stand rejected as follows.

Claims 1, 2, and 4–7 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Brown '976[2] in view of Aoki.[3]

Claim 3 has been rejected under 35 U.S.C. § 103(a) as unpatentable over Brown '976 in view of Aoki in further view of Brown Article.[4]

Claims 8 and 9 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Brown '976 in view of Aoki and in further view of Yano.[5]

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[2] Brown et al., US 2006/0120976 A1, published June 8, 2006 ("Brown '976").
[3] Aoki et al., US 2007/0219158 A1, published Sept. 20, 2007 ("Aoki").
[4] Brown et al., *Bicyclic monoterpene diol stimulate release of nitric oxide from skin cells, increase microcirculation, and elevate skin temperature,* 15 Nitric Oxide 70 (2006) ("Brown Article").
[5] Yano et al., US 2005/0220810 A1, published Oct. 6, 2005 ("Yano").

Claims 10–11 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Brown '976 in view of Aoki in further view of Bissett.[6]

BROWN '976 COMBINED WITH AOKI

Issue

As seen above, all of the rejections are based on the combination of Brown '976 and Aoki and Appellant has only addressed the propriety of this combination of references. Appeal Br. 2–3. Thus, all the claims stand or fall based on the appropriateness of the combination of Brown '976 and Aoki. The issue before us, therefore, is whether a preponderance of evidence supports the Examiner's finding that the claims 1, 2, and 4–7 would have been obvious over Brown '976 combined with Aoki.

The Examiner finds that Brown '976 discloses a cosmetic composition for regulating pigment content and skin disorders using bicyclic monoterpene diols. Final Act. 4. The Examiner finds that Brown '976 discloses topical formulations. *Id.* The Examiner finds that while Brown '976 does not teach the use of the specific plant extracts recited as skin lightening agents in the claims, Aoki teaches the use of those extracts. *Id.* The Examiner finds that Aoki teaches the preparation of a skin preparation comprising an inositol derivative and the recited plant extracts. *Id.* The Examiner finds that Aoki teaches that the disclosed composition does not have a grainy feeling and gives a moist feel and promotes healthy skin. *Id.* The Examiner concludes that

> One of ordinary skill in the art would have been motivated to combine the teachings of Brown ['976] with Aoki to add the 1

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[6] Bissett, US 2006/0263400 A1, published Nov. 23, 2006 ("Bissett").

> % of the *Scutellaria baicalensis* root extract, *Pyrus malus* (apple) extract and *Cucumis sativus* (cucumber) extract to the composition of Brown because of the advantages that Brown and Aoki teach. Brown describes a cosmetic composition for regulating the pigment content in mammalian skin and treating various skin disorders including perturbations of the NO/cGMP/PKG pathway in a mammal. (See abstract and claim 44). Aoki teaches that its skin preparation has excellent sensory properties when spread over skin and keeps skin healthy. (See Abstract). A person of ordinary skill in the art would have been motivated by these advantages to combine the plant extracts *Scutellaria baicalensis* root extract, *Pyrus* malus ((apple) extract, and *Cucumis sativus* (cucumber) extract with 2,3-cis/exo-pinanediol and a pharmaceutically acceptable carrier to form a dermatological composition. Thus, the invention would have been prima facie obvious to one of ordinary skill in the art at the time of the invention as evidenced by the references.

Final Act. 5–6.

Appellant contends that there is no motivation to combine the references. Br. 2. Appellant argues that one skilled in the art would not be motivated to combine the compounds of Brown '976 which promotes melanogenesis with skin lightening agents such as the extracts disclosed in Aoki. Br. 3.

Findings of Fact

We adopt as our own the Examiner's findings and analysis. The following findings are included for emphasis and reference convenience.

FF1. Brown '976 discloses compositions for regulating melanin content. Brown '976, Abstract.

FF2. Among the active ingredients that can be used in the composition of Brown '976 are bicyclic monoterpene diols such as camphendiol. Brown '976 ¶ 158.

FF3. Brown '976 teaches that the active ingredients can be formulated with an acceptable carrier to form a topical formulation for dermatological uses. Brown '976 ¶ 172.

FF4. Brown '976 teaches that the disclosed "compositions of the present invention may also include other active ingredients, as well as inert or inactive ingredients." *Id.*

FF5. Aoki discloses cosmetic compositions that "can be spread over ski without causing grain[y] feeling and has excellent effects of giving sufficient moist feeling and keeping the skin heathy." Aoki, Abstract.

FF6. The composition of Aoki comprises an inositol derivative and a plant extract including extracts from *Scutellaria baicalensis*, *Pyrus malus*, and *Cucumis sativus*. Aoki, Abstract and ¶ 59.

Principles of Law

"In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. . . . [A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for

combining the elements in the manner claimed." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419–20 (2007).

Analysis

We agree with the Examiner that one skilled in the art would have been motivated to combine the teachings of Brown '976 with Aoki to produce the claimed composition. Brown '976 teaches that the active ingredients described therein can be formulated to produce a topical formulation for dermatological applications and that it may contain other active ingredients. FF3 and 4. Aoki discloses a cosmetic or dermatological composition which gives a moist feeling and keeps skin healthy. FF5. The composition contains plant extracts which are the same as recited in the instant claims. FF6. We agree with the Examiner's conclusion that one skilled in the cosmetic art would have been motivated to combine the active ingredients of Brown '976 with the composition of Aoki to combine the advantages of both products. Ans. 7–8. The resulting composition would have the same components as the claimed composition and would be expected to have the same properties. Ans. 8.

We have considered Appellant's argument that one killed in the art would not have been motivated to combine a skin lightening composition with one that regulate melanogenesis and find it unpersuasive. As the Examiner points out, under *KSR*, Appellant's avowed purpose is not controlling; rather, any known problem in the art can serve as motivation to combine the reference. *KSR Int'l Co.,* 550 U.S. at 419–20. *See In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996) ("[T]he motivation in the prior art to

combine the references does not have to be identical to that of the applicant to establish obviousness."). We agree with the Examiner that

> one of ordinary skill in the art would be motivated at the time the invention was made to combine these teachings to achieve a cosmetic composition that regulates the pigment content in mammalian skin and treats various skin disorders including perturbations of the NO/cGMP/PKG pathway and also has excellent sensory properties and keeps skin healthy.

Ans. 8–9.

Conclusion of Law

We conclude that a preponderance of the evidence of record supports the Examiner's conclusion that rejected claims would have been obvious over Brown '976 combined with Aoki under 35 U.S.C. § 103(a).

SUMMARY

We affirm the rejection under 35 U.S.C. § 103(a).

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