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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THERESA CHEN, CHRISTINA IRENE LEE,
JIPSHA THAKRAR, ANNE-SOPHIE BRILLOUET, and
MARISA DEVITA DUFORT

Appeal 2017-000249
Application 13/738,001¹
Technology Center 1600

Before FRANCISCO C. PRATS, 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 composition for cosmetic use. The Examiner entered final rejections for obviousness.

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

We AFFIRM.

¹ Appellants identify the real party in interest as Johnson & Johnson Consumer Inc. App. Br. 2.

STATEMENT OF THE CASE

Background

Wrinkles, puffiness, and sagging, particularly related to skin under the eyes are problematic signs of aging. While it is known to apply various compositions to skin under the eyes, various drawbacks still remain. In particular, the inventors have recognized that it would be desirable to reduce the appearance of the above signs of under eye skin aging in a manner that provides a pleasant tightening sensation to skin under the eyes. Even more importantly, the inventors have recognized that it is important to provide these benefits without introducing negative perceptions, such as *over*-tightening or undesirable flaking of the composition.

Spec. 1:10–17. The Specification discloses a composition that “provides an improved appearance in a comfortable manner with reduced flaking.” *Id.* at 1:22–23.

Claims 1–15, 17, and 19 are on appeal.² Claim 1 is illustrative and reads as follows:

1. A composition, comprising:
 - water;
 - about 0.75% to about 1.25% by weight of a clay portion, wherein the clay portion comprises bentonite; and
 - polymer particles having an average particle size of less than about 20 microns and a refractive index of about 1.3 to about 1.4;wherein the composition is completely free of hydrophobic compounds.

App. Br. 8 (Claims Appendix).

² Claims 16 and 18 are cancelled. App. Br. 9–10 (Claims Appendix).

Claim 14, the only other independent claim, recites that the composition includes “about 70% to about 90% by weight of water” and “an additional polymer having a weight average molecular weight of about 1000 to about 750,000.” *Id.* at 9.

Appellants seek our review of the rejection of claims 1–11, 14, 15, 17, and 19 under pre-AIA 35 U.S.C. § 103(a) as obvious over Harding,³ Centerchem,⁴ and Maitra⁵ and the rejection of claims 12 and 13 under pre-AIA 35 U.S.C. § 103(a) as obvious over Harding, Centerchem, Maitra, and Spiegel.⁶ The same issues are dispositive as to the appeal of each rejection, as Appellants concede.⁷ We select claim 1 as representative of the claims on appeal. 37 C.F.R. § 41.37(c)(1)(iv).

OBVIOUSNESS

In rejecting claims 1–11, 14, 15, 17, and 19, the Examiner cites Harding as teaching “a personal care product for topical use on the skin, and for purposes of controlling the signs of aging” which include “fine lines, wrinkles, hyperpigmentation, sagging skin, lack of radiance, dark under-eye circles, puffy eyes, sallowness, spider veins, appearance of cellulite and combinations thereof.” Ans. 4. The Examiner finds Harding teaches “a cosmetically acceptable carrier that may be aqueous, anhydrous or an emulsion” in an amount ranging from “about 1 to about 99.9%” and including water as a useful carrier. *Id.* The Examiner further finds Harding

³ U.S. 2006/0089277 A1, published Apr. 27, 2006 (“Harding”).

⁴ *AuraSphere N*, Centerchem Inc., Product Bulletin (2008) (“Centerchem”).

⁵ U.S. 2010/0266649 A1, published Oct. 21, 2010 (“Maitra”).

⁶ U.S. 5,045,308, issued Sept. 3, 1991 (“Spiegel”).

⁷ *See* App. Br. 6 (“The arguments set forth above govern here.”)

teaches that “thickeners can be utilized as part of a cosmetically acceptable carrier of compositions” and that inorganics may be thickeners. *Id.* The Examiner finds that Harding teaches “clays such as bentonites and hectorites among inorganics that may be used as thickeners.” *Id.* The Examiner finds that Harding “clearly teaches an aqueous anti-aging composition (Harding, par. [0068], Ex. 1 and Tab. 1), which may be prepared, according to Harding's direct teachings, to include clays, such as bentonites and hectorites, as thickeners.” *Id.* at 5.

The Examiner finds that because Harding teaches that the carrier of the disclosed compositions “‘MAY be aqueous, anhydrous or an emulsion,’ and ‘[a]mounts of the carrier MAY range from about 1 to about 99.9%,’” that the skilled artisan could have followed these teachings to make a composition “completely free of hydrophobic compounds” as required by claims 1 and 14. *Id.* Thus, the Examiner concludes that the skilled artisan would have found it obvious to make the claimed compositions, including “to have modified [the composition] to be free of hydrophobic components.” *Id.* at 6.

The Examiner finds that Harding does not expressly teach the recited polymer particles. *Id.* However, the Examiner finds Centerchem teaches “Aurasphere N” is “a particulate suspension that is used as a visual/tactile modifier . . . for minimizing the appearance of lines and wrinkles, protecting the skin barrier, and firming the skin” and its use on the skin “results in a fine powdery film that appears virtually wrinkle free with a smooth and silky feel.” *Id.* The Examiner finds Centerchem teaches the claim element “polymer particles having an average particle size of less than about 20 microns and a refractive index of about 1.3 to about 1.4.” *Id.*

The Examiner concludes that the ordinarily skilled artisan would have found it obvious to incorporate “Aurasphere N” as taught by Centerchem in the “anti-aging/anti-wrinkle composition” of Harding to obtain the advantages of “minimizing the appearance of lines and wrinkles, protecting the skin barrier, and firming the skin.” *Id.* at 7.

The Examiner finds Maitra teaches a “‘gel system comprising a fractal network of nanoparticles and macroscopic particles,’ which is ‘capable of forming an ‘optical gel’ effective to blurr [] fine lines and wrinkles as a consequence of the size domain differences between the fractal particles and the macroscopic particles.’” *Id.* The Examiner further finds Maitra discloses “macroscopic organic particles [] of a size ranging from 1-200 microns . . . which reasonably encompasses the polyester particles of ‘Aurasphere N’ per Centerchem” and metal oxide nanoparticles that are neither hydrophobic compounds nor polysaccharide gums. *Id.* at 7–8. The Examiner finds Maitra discloses that “fractal networks of nanoparticles wrap around the macroscopic particles and increases the interfacial area over which lateral light diffusion occurs, which causes the appearance of wrinkles, fine lines, pores and skin imperfections to vanish while allowing the skin to appear natural and flawless.” *Id.* at 8.

The Examiner concludes that the skilled artisan would have been further motivated to incorporate the Aurasphere N microparticulate suspension with Maitra’s macroscopic organic particles and Maitra’s nanoparticulate metal oxide particles “to obtain the further advantage of a fractal network that increases the interfacial area over which lateral light diffusion occurs, thus causing the appearance of wrinkles, fine lines, pores and skin imperfections to vanish while allowing the skin to appear natural

and flawless.” *Id.* The Examiner further concludes that the weight ranges of the clay and water components and the polymer particle size, molecular weights, and weight ratios of the polymer particles to the clay portions that are taught by the references overlap with the claimed ranges and render the ranges of those claims obvious. *Id.* at 8–10.

Appellants contend that “the claimed invention is patentable over the cited references” because the references do not suggest the claimed composition and because the claimed composition “provides unexpected improvements in consumer acceptability.” Appeal Br. 4–6.

As stated in *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992):

[T]he examiner bears the initial burden . . . of presenting a *prima facie* case of unpatentability. . . .

After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.

Here, Appellants do not persuade us that a preponderance of the evidence fails to support the Examiner’s conclusion that the cosmetic composition of claim 1 would have been obvious to an ordinary artisan. Unless otherwise indicated herein, we adopt the Examiner’s findings of fact, reasoning on scope and content of the claims and prior art, and conclusions set out in the Final Action and Answer. Final Act. 2–15, Ans. 3–22. Only those arguments made by Appellants in the Appeal Brief and properly presented in the Reply Brief have been considered in this Decision. Arguments not so presented in the Briefs are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015); *see also Ex parte Borden*, 93 USPQ2d 1473 (BPAI 2010) (informative) (“Any bases for asserting error, whether factual or legal, that are not raised in the principal brief are waived.”).

As required by claim 1, Harding discloses a composition (personal care product) comprising water in an amount of 1 to 99.9% by weight of the composition, and bentonite clay in an amount of 0.0001 to 10% by weight. Harding Abstract, ¶¶ 29, 44. Harding teaches that the composition may contain, but does not require hydrophobic compounds. *Id.* at ¶ 29. Centerchem discloses a particulate suspension for use in improving the visual appearance of the skin and in which the average size of the particles has the claimed size and refractive index. Centerchem 1–2. *See also* Spec. 4:15–20, discussing characteristics of commercially available “AURASPHERE” product. Maitra discloses macroscopic organic particles within the claimed size range and metal oxide nanopartricles used in combination to diffuse light in order to improve the visible appearance of skin. Maitra Abstract, ¶¶ 8, 60, 73, 74.

We agree with the Examiner (*see, e.g.*, Ans. 9–10) that the skilled artisan would have been motivated to combine the teachings of Harding, Centerchem, and Maitra to make the claimed composition for the purpose of improving the visible appearance of skin. We are not persuaded by Appellants’ argument that the Examiner’s proffered motivation for making the claimed composition “is not relevant to the claimed under eye composition or the unique stability achieved with the claimed composition that is completely free of hydrophobic compounds.” App. Br. 4. As the Supreme Court has stated, “neither the particular motivation nor the avowed purpose of the patentee controls” in determining whether a claim is obvious. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419–20 (2007). The Examiner has articulated a fact-based reason for a skilled artisan to have included polymer particles having an average particle size of less than about 20

microns and a refractive index of about 1.3 to about 1.4 with the teachings of Harding to make the claimed composition. *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.”).

Appellants further argue the compositions “do not suggest an under eye composition containing both a clay portion including bentonite combined with polymer particles having an average particle size of less than about 20 microns and a refractive index of about 1.3 to about 1.4.” App. Br. 4.

We are not persuaded. Appellants have not argued that Harding, Centerchem, or Maitra do not teach what the Examiner has determined they teach. Rather, Appellants argue the precise composition is not taught by the references. *Id.* But the rejection is for obviousness, not anticipation.

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416. “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious,” the answer depends on “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417. Furthermore, “a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests.” *In re Baird*, 16 F.3d 380, 383 (Fed. Cir. 1994) (quoting *In re Burckel*, 592 F.2d 1175, 1179 (CCPA 1979)).

As discussed above, we agree with the Examiner that Harding, Centerchem, and Maitra teach the elements of the claimed composition, and that the skilled artisan would have been motivated to combine the teachings

of these references to obtain a composition that minimizes the appearance of lines and wrinkles, protects the skin, and has light diffusion properties; doing so would combine “familiar elements according to known methods” and would be likely to “yield predictable results.” *KSR*, 550 U.S. at 416. Appellants have not provided evidence or persuasive evidence to the contrary.

Appellants next argue that the claimed composition is not obvious because it demonstrates unexpectedly superior results in relation to compositions containing hydrophobic compounds. App. Br. 4–5. Appellants argue that the superior results are demonstrated by 1) Example E1 of the Specification, and 2) the results of testing a composition comparative to E1 as discussed in the Thaknar Declaration.⁸ *Id.*

Appellants argue that the comparative composition “was the same as Example E1 according to the present invention . . . except it contained 3% by weight FINSOLV TN (C12-15 alkyl benzoate), a hydrophobic compound (replacing 3% by weight of the water).” Thakrar Decl. ¶ 3. Appellants argue the stability of the comparative composition was tested as described in the Thaknar Declaration, which details storage of samples in jars at varying temperatures for defined periods, subjecting them to freeze/thaw cycles, inspection of the contents, and evaluation of application to the skin. Thaknar Decl. ¶ 4. Appellants argue that the comparative composition did not share the “unique stability achieved with the claimed composition that is completely free of hydrophobic compounds.” App. Br. 4–5.

⁸ Declaration of Jipsha Thakrar under 37 C.F.R. § 1.132, executed April 21, 2014. Jipsha Thakrar is an employee of the assignee and inventor of the subject application. Thakrar ¶¶ 1, 2.

The Examiner responds:

the alleged improved characteristics for Example E1 . . . in terms of skin application versus the stability tested comparative formulation . . . are attributed to the absence of a hydropho[b]ic compound [FINSOLV] However, it is noted that the stability test described in par. 4 of the Declaration was only performed for the comparative formulation, and not the inventive composition, Example E1.

Ans. 17–18. The Examiner further finds that the comparative composition E1 tested only a single concentration of one type hydrophobic compound despite that the claim is generic to all such compounds, and does not even test the effect of hydrophobic compounds from the various definitional categories listed in Appellants’ Specification. *Id.* at 18–19. The Examiner further finds that no comparison was made to the closest prior art, Harding. *Id.* From this, the Examiner concludes the testing is not commensurate in scope, does not show that the differences observed are in fact unexpected, and does not overcome the prima facie case of obviousness. *Id.*

We agree. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991) (“[W]hen unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared with the closest prior art.”). *See also Bristol-Myers Squibb Co. v. Teva Pharms. USA, Inc.*, 752 F.3d 967, 977 (Fed. Cir. 2014) (“To be particularly probative, evidence of unexpected results must establish that there is a difference between the results obtained and those of the closest prior art, and that the difference would not have been expected by one of ordinary skill in the art at the time of the invention.”).

We acknowledge, but are not persuaded by Appellants’ argument that the comparative composition in the DECLARATION, not the composition of Harding, is the closest comparator to the

claimed invention to show the criticality of freedom from hydrophobic compounds. Harding is a very different formulation from the claimed composition, one based on quaternary ammonium compounds, clays not being the primary ingredient. What could be closer than two compositions, one with and one without a hydrophobic compound?

App. Br. 5. As discussed above, the results of the testing of a single comparative composition E1 are insufficient to overcome the strong case of prima facie obviousness, which precedent establishes requires sufficient comparative data to show that the unexpected results are valid over the entire breadth of the claim to prove the subject claims are patentable over the prior art. *See Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1372 (Fed. Cir. 2007) (secondary consideration of unexpected results “does not overcome the strong showing of obviousness in this case.”).

In sum, for the reasons discussed, Appellants do not persuade us that a preponderance of the evidence fails to support the Examiner’s conclusion that the claimed composition would have been prima facie obvious to an ordinary artisan. We, therefore, affirm the Examiner’s rejection of obviousness of claim 1 over Harding, Centerchem, and Maitra. Because they were not argued separately, claims 2–11, 14, 15, 17, and 19 fall with claim 1. Because, as noted above, Appellants rely on the arguments addressed above as to the rejection of claims 12 and 13 over Harding, Centerchem, Maitra, and Spiegel, we likewise affirm that rejection.

SUMMARY

For the reasons discussed, we affirm the rejection of claims 1–11, 14, 15, 17, and 19 under pre-AIA 35 U.S.C. § 103(a) as obvious over Harding, Centerchem, and Maitra, and the rejection of claims 12 and 13 under pre-

Appeal 2017-000249
Application 13/738,001

AIA 35 U.S.C. § 103(a) as obvious over Harding, Centerchem, Maitra, and Spiegel.

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