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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEWART PATON GRANGER, IAN RICHARD SCOTT,
ROBERT MARK DONOVAN, SUSANNE TEKITS LOBST,
and LISA LICAMELI¹

Appeal 2017-004553
Application 13/764,090
Technology Center 1600

Before ULRIKE W. JENKS, JOHN G. NEW, and RYAN H. FLAX,
Administrative Patent Judges.

FLAX, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) involving claims directed to a method for treating skin. Claims 8, 9, 11–14, and 21–23 are on appeal as rejected under 35 U.S.C. § 103(a).² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify the Real Party in Interest as “Conopco, Inc., d/b/a UNILEVER.” Appeal Br. 3.

² Claims 10 and 15–20 stand withdrawn from consideration. Appeal Br. 3.

STATEMENT OF THE CASE

Claim 8 is representative and is reproduced below:

8. A method for treating skin comprising the steps of:

(i) applying to the skin a composition comprising:

(d) [*sic*] from 0.01 % to 10% of a retinoid;

(e) a booster compound comprising damascone and hexanoyl sphingosine;

(f) a cosmetically acceptable vehicle, and

(ii) treating the skin for wrinkles, psoriasis, age spots and/or discoloration

wherein booster compound potentiates activity of the retinoid, and optionally, further comprises quercetin, coumarin, vanillin, oleyl betaine, arachidonic acid or a mixture thereof.

Appeal Br. 17.

The following rejections are appealed:

Claims 8, 9, 11, 13, 14, and 21 stand rejected under 35 U.S.C.

§ 103(a) over Pillai,³ Sigma-Aldrich,⁴ Burger '556,⁵ and Ando.⁶ Final Action 4.

³ US 5,476,661 (issued Dec. 19, 1995) (“Pillai”).

⁴ Sigma-Aldrich, N-Hexanoyl-D-sphingosine $\geq 98\%$ (TLC), synthetic, <http://www.sigmaaldrich.com/catalog/product/sigma/h6524?lang=en®ion=US#>, Sept. 11, 2015 (“Sigma-Aldrich”).

⁵ US 5,759,556 (issued June 2, 1998) (“Burger '556”).

⁶ Hideya Ando et al., *Linoleic acid and α -linolenic acid lightens ultraviolet-induced hyperpigmentation of the skin*, 290 ARCH DERMATOL RES 375–81 (1998) (“Ando”).

Claim 12 stands rejected under 35 U.S.C. § 103(a) over Pillai, Sigma-Aldrich, Burger '556, Ando, and Cauwenbergh.⁷ *Id.* at 7.

Claim 22 stands rejected under 35 U.S.C. § 103(a) over Pillai, Sigma-Aldrich, Burger '556, Ando, and Nakayama.⁸ *Id.* at 8–9.

Claim 23 stands rejected under 35 U.S.C. § 103(a) over Pillai, Sigma-Aldrich, Burger '556, Ando, and Burger '367.⁹ *Id.* at 10.

DISCUSSION

“[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). Arguments made by Appellants in the Appeal Brief (no Reply Brief was submitted) have been considered; arguments not so-presented in the Brief are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015); *see also Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (“Any bases for asserting error, whether factual or legal, that are not raised in the principal brief are waived.”).

“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). “[W]hen a patent claims a structure [or method] already known in the prior art that is altered by the mere substitution of one element [or step] for another known in the field, the combination must do more than yield a predictable result.” *Id.*

⁷ US 5,476,852 (issued Dec. 19, 1995) (“Cauwenbergh”).

⁸ US 5,853,705 (issued Dec. 29, 1998) (“Nakayama”).

⁹ US 5,665,367 (issued Sept. 9, 1997) (“Burger '367”).

(citing *United States v. Adams*, 383 U.S. 39, 50–51 (1966)). “In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *Id.* at 419.

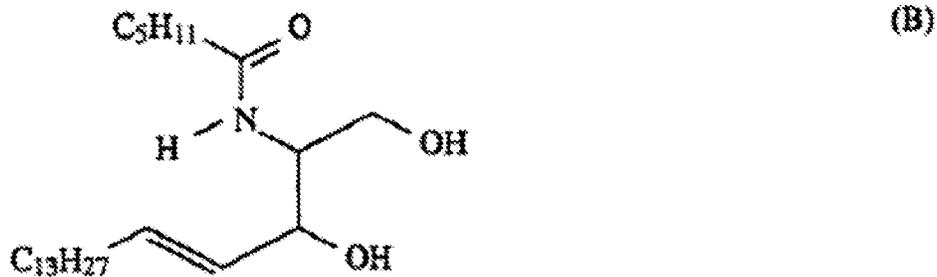
“[T]he question is whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination, not whether there is something in the prior art as a whole to suggest that the combination is the *most desirable* combination available.” *In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004) (citation omitted). “[I]f a technique has been used to improve one device [or method], and a person of ordinary skill in the art would recognize that it would improve similar devices [or methods] in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR*, 550 U.S. at 417. “[T]he test of obviousness is not express suggestion of the claimed invention in any or all of the references but rather what the references taken collectively would suggest to those of ordinary skill in the art *presumed* to be familiar with them.” *In re Rosselet*, 347 F.2d 847, 851 (CCPA 1965) (emphasis in original).

Findings of Fact (FF)

We adopt the Examiner’s findings of fact and rationale on obviousness as set forth in the Final Action and Answer. Final Action 4–12; Answer 3–6. The following findings of fact highlight certain evidence:

FF1. Pillai discloses “[c]ompositions for treating skin” and “a method of improving or preventing the appearance of wrinkled, flaky, aged, [or] photodamaged skin.” Pillai Abstract, 15:24–40.

FF2. Further to the preceding finding of fact, Pillai discloses applying compositions including a ceramide component, such as a preferred compound having the following structure:



Pillai 8:56–9:9. The Examiner determined, and Appellants do not dispute, that Sigma-Aldrich evidences that this ceramide compound is hexanoyl sphingosine. Final Action 5 (citing Sigma-Aldrich).

FF3. Pillai discloses using a cosmetically acceptable vehicle for formulating a composition with a ceramide component. Pillai 11:63–12:21.

FF4. Pillai discloses including a retinoid component in formulations with ceramides. Pillai 13:1–8, 14:65–15:1 (identifying vitamin A palmitate to be retinyl palmitate).

FF5. Pillai discloses an example skin care treatment composition including, inter alia, 1% the ceramide of Formula B (hexanoyl sphingosine) and 0.5% vitamin A palmitate (the retinoid retinyl palmitate).

FF6. Burger '556, like Pillai, discloses compositions for skin care, e.g., to treat dry skin, photodamaged skin, wrinkles, age spots, dark skin. Burger '556 title, 1:6–9, 2:13–18.

FF7. Burger '556 discloses skin care compositions having 0.001%–10% retinol (vitamin A) or a retinyl ester (e.g., retinyl palmitate), 0.0001%–50% cyclic aliphatic unsaturated compound (e.g., preferably a damascone), and a cosmetically acceptable vehicle. Burger '556 1:66–2:8, 2:32–65, 3:43–5:28, claims 1 and 4.

FF8. Burger '556 discloses “that while α -Damascone alone and retinol alone were not very effective, the combination of the two attained synergistic reduction in transglutamine mimicking the effect of retinoic acid on keratinocyte differentiation.” Burger '556 14:9–13 (damascone is a booster/enhancer for retinol in skin treatment composition).

FF9. Burger '556 discloses an example skin care composition including, inter alia, 0.15% retinyl palmitate and 1% α -damascone. Burger '556 29–45.

Analysis

The Examiner concluded that:

it would have been obvious to one of ordinary skill in the art to combine the skin care compositions of Pillai et al. and Burger et al. As both the compositions of Pillai and Burger are useful for treating of wrinkles, age spots, and discoloration and both comprise a retinoid, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the elements as claimed by known methods with no change in their respective functions, and the combination yielding nothing more than predictable results. “It is *prima facie*

obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose [T]he idea of combining them flows logically from their having been individually taught in the prior art.” *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) (MPEP 2144.06.I). In addition, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to select damascone as taught by Burger et al. for inclusion in the composition of Pillai et al. Pillai et al. teach the inclusion of additional skin benefit materials and cosmetic adjuncts (e.g.,] column 14, line 45-column 15, line 24). One of ordinary skill in the art would have recognized that damascone is within the genus of additives taught by Pillai et al. and would have been motivated to select it in order to improve the performance of retinal or a retinyl ester, as taught by Burger et al.

Final Action 6.

Further to the Examiner’s determinations, we compare Pillai’s Example 6 (left) and Burger ’556’s Example 10 (right) formulations below:

SKINCARE TREATMENT			
INGREDIENT	% w/w		% w/w
Silicone Gum SE-30	10.000	Retinyl palmitate	0.15
Silicone Fluid 345	20.000	α-Damascone	1
Silicone Fluid 344	57.490	Silicone gum SE-30 ¹	10
Squalene	5.975	Silicone fluid 345 ²	20
Ceramide of Formula B	1	Silicone fluid 344 ³	55.79
25-OH---D ₃	0.01	Squalene	10
Wheat Germ Oil	2.000	Linoleic acid	0.01
Sesame Oil	0.500	Cholesterol	0.03
Jojoba Oil	2.000	2-hydroxy-n-octanoic acid	0.7
Vitamin E Linoleate	0.500	Vitamin E linoleate	0.5
Herbal Oil	0.500	Herbal oil	0.5
Ceramide 1	0.025	Ethanol	2
Vitamin A Palmitate	0.5		

Pillai 22:64–23:17; Burger ’556 15:29–45. As can be seen from the above-reproduced lists of ingredients/components, Pillai’s Example 6 and Burger ’556’s Example 10 include significantly overlapping ingredients, e.g., the

silicone gums/fluids, squalene, herbal oil, vitamin E linoleate, and retinyl/vitamin A palmitate. Pillai adds a ceramide of its disclosed Formula B, i.e., hexanoyl sphingosine, which is a lipid component, and Burger '556 adds α -damascone, which is a retinol booster/enhancer, among a few other minor differences. *See* FF2, FF4, FF5, FF7, FF9. Pillai's and Burger '556's compositions are used for the same purpose, i.e., treating cosmetic skin conditions. FF1, FF6. Because Pillai's formulation includes the retinol vitamin A palmitate, and because Burger '556 includes damascone with its vitamin A palmitate to enhance this retinol's performance in its formulation, it would have been obvious to add damascone to Pillai's formulation for the same reason. *See* FF5, FF8.

Regarding claim 8, Appellants argue “[n]othing in the [Pillai] reference even remotely suggests that hexanoyl sphingosine should be used to boost the activity of retinoid in a method to treat skin” and the Burger '556 reference describes skin care formulations with retinol and another compound selected from “a multitude of possibilities of which damascone is only one.” Appeal Br. 10.

This argument is not persuasive. “Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. . . . [The reference] must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Appellants' argument overlooks that the Examiner's rejection is over a combination of references. Appellants' argument attacking the alleged shortcomings of Pillai and Burger '556, individually, is not persuasive.

Further, the Examiner has identified ample reason the skilled artisan would have combined the references and added Burger '556's damascone to Pillai's compositions, e.g., that of Example 10, as discussed above. Once damascone was added to Pillai's formulation containing a retinol, it would have been a booster for the retinol. Thus, the prior art combination teaches and suggests the claimed method and composition thereof.

We agree with the Examiner that it would have been obvious to have both damascone and hexanoyl sphingosine in a skin care composition with retinol; whether the skilled artisan would have recognized that both of these components, rather than just damascone, would have synergistically boosted the retinol is not determinative on obviousness.

Regarding claims 12, 22, and 23, Appellants argue "the combination of references relied on by the Examiner does not, even remotely, describe a method to treat skin with compositions comprising retinoid, damascone and hexanoyl sphingosine," as argued for claim 8. Appeal Br. 12, 13, 14. This adds no new or different arguments for these claims not argued over the rejection of claim 8. Therefore, these claims fall with independent claim 8 for the reasons discussed above.

SUMMARY

The obviousness rejections are each affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED