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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* EURIEL CLAVEL and PASCAL ARNAUD

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Appeal 2018-006676  
Application 12/062,640  
Technology Center 1600

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Before FRANCISCO C. PRATS, ULRIKE W. JENKS, and JOHN G. NEW,  
*Administrative Patent Judges.*

PRATS, *Administrative Patent Judge.*

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1, 2, 7, 8, 12, 13, 18, and 22–29. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

The Specification discloses that a need exists for makeup or skin care compositions that “satisfactorily hide the colour and/or relief imperfections

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as L’Oréal of Paris, France. Appeal Br. 1.

of the skin, and to obtain good absor[b]tion of sebum, without however drying out skin or, conversely, giving the user a greasy or even tacky feeling on application or during the day.” Spec. 2–3.

The Specification discloses that the inventors discovered that “it is possible to provide such a composition by combining particles of poly(methyl methacrylate) and dipentaerythritol ester oil in a composition comprising an oily continuous phase. The compositions obtained have, moreover, beneficial properties of being soft and easy to spread when they are applied to the skin.” *Id.* at 3.

Claim 1 is representative and reads as follows:

1. A composition comprising
  - 1 to 60% by weight of water, relative to the total weight of the composition,
  - an oily continuous phase, and
  - a particulate phase,
  - wherein the oily continuous phase comprises dipentaerythrityl hexacaprylate/caprate, and
  - wherein the particulate phase comprises:
    - (a) at least one of the following particles of acrylic polymer selected from the group consisting of:
      - particles of crosslinked or noncrosslinked polymethyl methacrylate,
      - particles of methyl methacrylate/ethylene glycol dimethacrylate crosslinked copolymer,
      - mixtures thereof, and
    - (b) at least one dyestuff selected from the group consisting of pigments, pearlescent agents, and mixtures thereof,

wherein the dipentaerythrityl hexacaprylate/caprate is present in an amount of 0.1 % to 30% by weight, relative to the total weight of the composition,

wherein the particles of acrylic polymer are present in an amount of 0.1 % to 10% by weight, relative to the total weight of the composition,

wherein the oily continuous phase further comprises at least one non-volatile oil different from dipentaerythrityl hexacaprylate/caprate, said non-volatile oil comprising at least one fatty acid ester and being present in an amount of 0.1 % to 30% by weight relative to the total weight of the composition, and

wherein the composition is devoid of a film-forming agent.

Appeal Br. 11–12.

The sole rejection before us for review is the Examiner's rejection of claims 1, 2, 7, 8, 12, 13, 18, and 22–29, under 35 U.S.C. § 103(a) as being unpatentable over Filippi,<sup>2</sup> Delacour,<sup>3</sup> Hansenne,<sup>4</sup> and Frischling<sup>5</sup> (Final Act. 2–6 (entered May 19, 2017)).

## OBVIOUSNESS

### *The Examiner's Prima Facie Case*

The Examiner cited Filippi as disclosing cosmetic compositions having nearly all of the features required by the rejected claims, including a continuous oily phase containing esters of dipentaerythritol, as well as a particulate phase composed of acrylate particles. Final Act. 3 (citing

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<sup>2</sup> US 2006/0013788 A1 (published Jan. 19, 2006).

<sup>3</sup> US 2004/0071648 A1 (published Apr. 15, 2004).

<sup>4</sup> US 6,432,389 B1 (issued Aug. 13, 2002).

<sup>5</sup> US 4,659,573 (issued Apr. 21, 1987).

Delacour as evidence that exemplified particles in Filippi are acrylate polymers).

The Examiner conceded that Filippi's compositions differed from Appellant's claimed compositions in that, although "Filippi teaches the use of spherical fillers including methacrylates wherein the particles having overlapping size ranges, [Filippi] does not expressly teach spherical methyl methacrylate/ethylene glycol dimethacrylate particles." *Id.* at 4.

The Examiner cited Hansenne as teaching that particles encompassed by Appellant's claims were known in the art to be useful in cosmetic formulations. *See id.* ("The methacrylate crosspolymer particulates of Hansenne act to reduce the tacky/greasy/waxy feel of the cosmetic composition, [and] thus provide a product with pleasant feel, see column 2, lines 30-36."). The Examiner reasoned, therefore, that a skilled artisan would have been motivated to use Hansenne's particles in the particulate phase of Filippi's compositions. *Id.*

The Examiner conceded that Filippi's compositions also differed from Appellant's claimed compositions in that Filippi "does not expressly teach wherein the esters include dipentaerythryl hexacaprylate/caprate (also known as dipentaerythritol hexacaprylate/hexacaprate)." *Id.* at 5

The Examiner cited Frischling as teaching that the dipentaerythritol hexacaprylate/hexacaprate ester recited in Appellant's claims "is useful for cosmetics as it is odorless, and leaves the skin feeling soft, see column 2 lines 22-30." *Id.* The Examiner reasoned, therefore, that a skilled artisan would have considered it obvious to "substitute the esters (oil) of Filippi et al. for dipentaerythritol hexacaprylate/hexacaprate (ester oil)." *Id.*

Lastly, the Examiner reasoned that because the cited references suggested the use of the prior art ingredients in concentration ranges overlapping those recited in Appellant's claims, the claimed concentration ranges of those ingredients would have been obvious. *Id.* at 5–6.

*Analysis*

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.

We select claim 1 as representative of the rejected claims. *See* 37 C.F.R. § 41.37(c)(1)(iv). Having carefully considered the arguments and evidence advanced by Appellant and the Examiner, Appellant does not persuade us that the preponderance of the evidence fails to support the Examiner's conclusion of obviousness as to claim 1. To the contrary, we adopt as our own the Examiner's findings of fact as to the teachings of the cited references, as well as the Examiner's reasoning and conclusion of obviousness based on those teachings. We provide the following discussion for emphasis.

Appellant's claim 1 recites a composition that differs from the cosmetic compositions described in Filippi in that, although Filippi's compositions include a particulate phase that may be composed of polymeric particles, Filippi does not teach using the specific methyl methacrylate/ethylene glycol dimethacrylate crosslinked copolymer recited in claim 1. *See* Filippi ¶¶ 146–159.

Hansenne, however, discloses incorporating into sunscreen compositions “a synthetic copolymer of methyl methacrylate crosslinked with glycol dimethacrylate” undisputedly encompassed by Appellant’s claim 1. Hansenne 2:41–43; *see also id.* at 3:3–5 (“Characteristically, the particulates of methyl methacrylate crosspolymers according to this invention have a particle size of less than 20  $\mu\text{m}$ , preferably less than 10  $\mu\text{m}$ .”).

Hansenne discloses, moreover, that “formulating particulates of methyl methacrylate crosspolymers into UV-photoprotecting sunscreen compositions significantly reduces diffusion of the product and also reduces the tacky/greasy/waxy feel thereof, making it dry and pleasant on application to human skin, hair and/or scalp.” *Id.* at 2:30–34.

Hansenne also teaches that, in addition to sunscreen compositions, its particulate methyl methacrylate crosspolymers also improve the feeling on the skin of cosmetic compositions in general. *See id.* at 3:6–12 (“Consistent herewith, dry, nongreasy, nontacky and nonwaxy sunscreen formulations are provided by the addition of methyl methacrylate crosspolymer into a wide variety of sunscreen compositions, ***and formulated into conventional topically applicable, cosmetically/dermatologically acceptable vehicles, diluents or carriers therefor.***”) (emphasis added).

Given Hansenne’s teachings that particulate methyl methacrylate crosspolymers improve the feeling of compositions applied to the skin, we agree with the Examiner that a skilled artisan had a good reason for, and a reasonable expectation of success in, using Hansenne’s crosspolymers in the particulate phase of Filippi’s cosmetic compositions.

We acknowledge the following passage in Hansenne, cited by Appellant (*see* Appeal Br. 5–6; Reply Br. 2), suggesting that not all compounds described in the art as oil absorbers function equivalently in sunscreen compositions:

While not wishing to be bound to or by any particular theory, it is believed that the methyl methacrylate crosspolymer serves/acts as an oil absorber, reducing the greasiness of the final product.

Nonetheless, methyl methacrylate crosspolymer is a totally different material than those “oil absorbers” heretofore known to this art, for example the commercially available sport sunscreens indicated above containing hydrophobic silica. ***Indeed, various diverse materials that are claimed to be “oil absorbers” behave/function quite differently when formulated into sunscreen compositions. As one example, polymethyl methacrylate (Micropearl M100 marketed by Seppic Inc.) was otherwise formulated. It is designated an oil absorber by its supplier, but does not disperse easily into the oil phase of the formulation, resulting in the final composition having an unpleasant, grainy texture.***

Hansenne, 3:18–35 (emphasis added).

As discussed above, however, Hansenne expressly discloses that methyl methacrylate crosslinked polymers undisputedly encompassed by claim 1 impart pleasant skin feel to sunscreen and cosmetic compositions. *See id.* at 2:30-50; 3:6–12. Thus, the fact that other particulates might not necessarily provide the same advantageous properties does not persuade us that Hansenne failed to provide a reason for, and a reasonable expectation of success in, using its advantageous crosspolymer particles in the particulate phase of Filippi’s cosmetic compositions. *See In re Kubin*, 561 F.3d 1351, 1360 (Fed. Cir. 2009) (“Obviousness does not require absolute predictability

of success. . . . For obviousness under § 103, all that is required is a reasonable expectation of success.”).

We acknowledge the disclosure in Appellant’s Specification that the methyl methacrylate/ethylene glycol dimethacrylate crosslinked copolymers recited in Appellant’s claim 1 function somewhat better in the particulate phase than other particles. *See Spec. 25–26.*

In particular, the Specification describes a comparison between foundation compositions containing claim 1’s particles of methyl methacrylate/ethylene glycol dimethacrylate copolymer sold as Techpolymer MBP-8 by the company Sekisui Plastics, and non-inventive comparative compositions containing Nylon 12, polymethylsilsesquioxane, and silica. *See id.*

The Specification discusses the test conditions and results as follows:

The cosmetic properties of the compositions obtained were compared by a panel of 5 experts.

For each test, half the face was made up with an amount of 0.15 g of foundation according to Example 1 (invention) and the other half of the face was made up with a composition according to Examples 2, 3 or 4 (not part of the invention).

Example 1 (according to the invention), in comparison with the foundation according to Example 2 (not part of the invention) forms a film that is less tacky once applied to the skin.

In comparison with Examples 3 and 4 (not part of the invention), the foundation the foundation according to Example 1 (invention) gives a less greasy make-up result.

*Id.*

As is evident, rather than showing that it was unpredictable whether certain known particulate materials would be useful in cosmetic

compositions, or that any of the compared particles produced unsuitable compositions, the evidence advanced by Appellant merely shows that one known cosmetically-acceptable type of particle, the particle described in Hansenne, works somewhat better than others. Indeed, the comparison advanced by Appellant confirms the teaching in Hansenne, discussed above, that its particles impart an improved skin feel to cosmetic compositions. Appellant does not persuade us, therefore, that a skilled artisan lacked a reasonable expectation of success in including Hansenne's particles in the particulate phase of Filippi's compositions.

Appellant also does not persuade us that a skilled artisan lacked a reason for, or a reasonable expectation of success in, including the dipentaerythrityl hexacaprylate/caprate esters recited in Appellant's claim 1 in the oily phase of Filippi's cosmetic compositions. Although Filippi does not include dipentaerythrityl hexacaprylate/caprate esters in its compositions, Filippi discloses that the oily phase of its compositions may contain any of a variety of esters, including fatty acid esters of dipentaerythritol. Filippi ¶¶ 17–20.

Frischling is directed to preparing a “substitute for mineral oil in toiletry and cosmetic compositions.” Frischling 1:6–7. Frischling teaches that dipentaerythrityl hexacaprylate/caprate (“DPHC”) is among the ingredients useful in its compositions, and describes that ester as a “medium to heavy viscosity, odorless liquid which leaves the skin feeling emollient soft and slightly oily.” *Id.* at 2:26–28.

Given Filippi's teaching that fatty acid esters of dipentaerythritol were useful in the oily phase of its cosmetic compositions, and given Frischling's teaching that dipentaerythrityl hexacaprylate/caprate was known in the art to

be a cosmetically acceptable fatty acid ester of dipentaerythritol that provided an emollient soft skin feeling, we agree with the Examiner that a skilled artisan had a good reason for, and a reasonable expectation of success in, including Frischling's dipentaerythrityl hexacaprylate/caprate in the oil phase of Filippi's cosmetic compositions. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.”) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976)). Moreover, because the suggestion to use Frischling's esters in Filippi's compositions comes from the teachings of the references, we are not persuaded that the Examiner's determination is based on hindsight. *See Appeal Br. 8.*

We acknowledge the disclosure in Appellant's Specification that the dipentaerythrityl hexacaprylate/caprate esters recited in Appellant's claim 1 function better in the oil phase than other esters. *See Spec. 26–27.*

In particular, the Specification describes a comparison between foundation compositions containing the inventive dipentaerythrityl hexacaprylate/caprate esters of Appellant's claim 1 (Example 1), and foundation compositions with an oil phase containing pentaerythrityl fatty acid esters (Examples 5–8) or glyceryl fatty acid esters (Examples 9 and 10). *See id.*

The Specification discusses the test conditions and results as follows:

The cosmetic properties of the compositions obtained were compared by a panel of 5 experts.

For each test, half the face was made up with an amount of 0.15 g of foundation according to Example 1

(invention) and the other half of the face was made up with a composition according Examples 5 to 10 (not part of the invention)[].

The foundation according to the Example 1 (invention), compared with the foundations according to Examples 5 to 10 (not part of the invention), forms a film that is less greasy once applied to the skin. The make-up finish is more powdery.

In comparison with Examples 5 and 9 (not part of the invention), Example 1 makes it possible to form a makeup film that is less tacky once applied to the skin.

*Id.*

As is evident, rather than showing that it was unpredictable whether certain known esters would be useful, or even functional, in in the oil phase of oil-containing cosmetic compositions, the evidence advanced by Appellant merely shows that one known cosmetically-acceptable type of ester, the dipentaerythrityl hexacaprylate/caprate ester described in Frischling, works better than others. Indeed, the comparison advanced by Appellant confirms the teaching in Frischling, discussed above, that dipentaerythrityl hexacaprylate/caprate esters are useful in the oil phase of oil-containing cosmetic compositions, such as the compositions taught in Filippi. Appellant does not persuade us, therefore, that a skilled artisan lacked a reasonable expectation of success in including Frischling's esters in the oil phase of Filippi's compositions.

In sum, for the reasons discussed, Appellant does not persuade us that the Examiner erred in determining that the cited combination of references would have rendered the composition recited in Appellant's claim 1 prima facie obvious to a skilled artisan. We are not persuaded, moreover, that Appellant has advanced evidence of unexpected results sufficient to

outweigh the evidence of prima facie obviousness advanced by the Examiner. *See* Appeal Br. 9–10; Reply Br. 2–3.

As our reviewing court has explained, “[m]ere improvement in properties does not always suffice to show unexpected results. . . . [W]hen an applicant demonstrates *substantially* improved results . . . and *states* that the results were *unexpected*, this should suffice to establish unexpected results *in the absence of* evidence to the contrary.” *In re Soni*, 54 F.3d 746, 751 (Fed. Cir. 1995); *see also Galderma Labs., L.P. v. Tolmar, Inc.*, 737 F.3d 731,739 (Fed. Cir. 2013) (“Unexpected results that are probative of nonobviousness are those that are different in kind and not merely in degree from the results of the prior art.”) (internal quotations omitted).

In the present case, we are not persuaded that Appellant has shown that the compositions of claim 1 exhibit *substantially* improved results. Nor are we persuaded that any differences exhibited by the claimed compositions are differences in kind, as opposed to degree.

Specifically, as noted above, Appellant’s Specification discloses that when comparing different particulate phases, the composition of Example 1 (corresponding to Appellant’s claim 1) “forms a film that is less tacky once applied to the skin” as compared to the non-inventive composition of Example 2. Spec. 26. Similarly, the composition of Example 1 “gives a less greasy make-up result” in comparison with the compositions of non-inventive Examples 3 and 4. *Id.*

As also noted above, Appellant’s Specification discloses that when comparing the use of different esters in the oil phase, the composition of Example 1 “forms a film that is less greasy once applied to the skin,” and provides a “make-up finish [that] is more powdery,” as compared to the non-

inventive compositions of Examples 5–10. Spec. 27. Similarly, the composition of Example 1 “makes it possible to form a makeup film that is less tacky once applied to the skin” in comparison with the compositions of non-inventive Examples 3 and 4. *Id.*

Thus, rather than providing evidence that the composition of Appellant’s claim 1 exhibits properties that are different in kind to those exhibited by the comparative compositions, the Specification merely discloses improvement, to an unspecified degree, in the same properties (tackiness, greasiness, powderiness) already exhibited by the comparative compositions. Moreover, the Specification does not articulate the actual degree of the improvement exhibited by the compositions of claim 1, but instead states only that the claimed compositions are less tacky, less greasy, and more powdery, with no specific assertion of a *substantial* improvement as to those properties.

Appellant does not persuade us, therefore, that the comparative evidence presented in the Specification is adequate to show that a composition encompassed by Appellant’s claim 1 exhibits unexpected properties sufficient to establish nonobviousness. This is particularly true given that the composition of Appellant’s Example 1 includes the particles disclosed in Hansenne, which Hansenne discloses as “reduc[ing] the tacky/greasy/waxy feel” of compositions containing the particles. Hansenne 2:34.

We note, moreover, that the discussion in Appellant’s Specification regarding the comparison between Example 1 and the other examples does not actually state that the unspecified degree of superiority in properties exhibited by Example 1’s composition was surprising or unexpected. *See*

Spec. 23–37. The assertion in Appellant’s briefs of unexpectedness in relation to the results shown in the Specification, therefore, does not find objective support in the record. It is well settled that argument by counsel is not an adequate substitute for actual evidence that the results presented constitute an unexpected result over the prior art. *See In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

It is also well settled that “[e]vidence of secondary considerations must be reasonably commensurate with the scope of the claims.” *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011).

In the present case, the composition of Appellant’s Example 1, asserted as demonstrating unexpected results, has 10.00% by weight of the dipentaerythryl hexacaprylate/caprate ester and 5.00% by weight of the methyl methacrylate/ethylene glycol dimethacrylate copolymer. *See Spec. 23–26.*

Appellant’s claim 1, in contrast, recites broad ranges for both ingredients: 0.1 % to 30% by weight for the dipentaerythryl hexacaprylate/caprate, and 0.1 % to 10% for the copolymer. *See Appeal Br. 11.* Given that claim 1 encompasses compositions that contain ester and copolymer amounts at least ten times less than the amounts used in Appellant’s Example 1, the only example alleged to have improved properties, we are not persuaded that Appellant’s claim 1 is commensurate in scope with any showing of unexpectedness Appellant might have made.

In sum, for the reasons discussed, Appellant does not persuade us that the Examiner failed to make out a prima facie case of obviousness as to claim 1 based on the cited references. Because, for the reasons discussed, we are not persuaded that Appellant has advanced evidence of unexpected

results sufficient to outweigh the evidence of prima facie obviousness advanced by the Examiner, we affirm the Examiner's obviousness rejection of claim 1.

Because they were not argued separately, claims 2, 7, 8, 12, 13, 18, and 22–29 fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv). In particular, although we acknowledge Appellant's separate mention of claims 22–29 in its arguments (*see* Appeal Br. 6, 9, 10), merely stating what a claim recites does not constitute separate argument for that claim. *See* 37 C.F.R. § 41.37(c)(1)(iv). Moreover, to argue claims separately, the argument must be presented under a separate heading identifying the claims argued. *See id.*

### CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 2, 7, 8, 12, 13, 18, and 22–29	§ 103(a) over Filippi, Delacour, Hansenne, and Frischling	1, 2, 7, 8, 12, 13, 18, and 22–29	none
<b>Overall Outcome</b>		1, 2, 7, 8, 12, 13, 18, and 22–29	

### TIME PERIOD

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