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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS BLATT, UTE BREITENBACH,
CHRISTOPHER MUMMERT, THOMAS RASCHKE,
CATHRIN SCHERNER, JENS SCHULZ,
and FRANZ STAEB

Appeal 2018-008763
Application 11/944,520
Technology Center 1600

Before JACQUELINE T. HARLOW, BRIAN D. RANGE, and JOHN E.
SCHNEIDER, *Administrative Patent Judges*.

RANGE, *Administrative Patent Judge*.

DECISION ON APPEAL

SUMMARY

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's
decision rejecting claims 47–66. We have jurisdiction. 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellants, the real party in interest is Beiersdorf AG.
Appeal Br. 3.

STATEMENT OF THE CASE²

Appellants describe the invention as relating to an active ingredient combination of glucosyl glycerides and surface-active glucose derivatives for use as a cosmetic or for dermatology. Spec. ¶ 1. Appellants indicate that the invention relates to cosmetic preparations having a content that increases moisture of the skin. *Id.* ¶ 3. Claim 47, reproduced below with emphasis added to certain key recitations, is illustrative of the claimed subject matter:

47. A cosmetic preparation, wherein the preparation comprises

- (i) **one or more glucosyl glycerides,**
- (ii) creatinine and one or more substances selected from creatine, creatine phosphate, creatine sulfate, creatine acetate, creatine ascorbate, and creatine derivatives whose carboxyl group is esterified by a mono- or polyfunctional alcohol,

a molar ratio (i) : (ii) being from 50:1 to 1:50.

Appeal Br. 16 (Claims App.).

Our prior decision in *Ex parte Blatt*, Appeal 2015-002387 (PTAB Feb. 10, 2017), involved the present patent application but different claims.

REFERENCES

The Examiner relies upon the prior art below in rejecting the claims on appeal:

Thiem et al.
("Thiem")

US 5,891,854

Apr. 6, 1999

² In this Decision, we refer to the Final Office Action dated October 18, 2017 ("Final Act."), the Appeal Brief filed May 15, 2018 ("Appeal Br."), the Examiner's Answer dated July 11, 2018 ("Ans."), and the Reply Brief filed September 10, 2018 ("Reply Br.").

REJECTIONS

On appeal, the Examiner maintains (Ans. 3) the following rejections:

Rejection 1. Claims 47–66 under 35 U.S.C. § 103 as unpatentable over Biergiesser in view of Thiem. Ans. 3.³

Rejection 2. Claims 47–66, provisionally, on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 99–141 of copending Application No. 10/995,203 in view of Thiem. *Id.* at 5–6.

Rejection 3. Claims 47–66, provisionally, on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 91–124 of copending Application No. 10/995,200 in view of Thiem. *Id.* at 6.

Rejection 4. Claims 47–66, provisionally, on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 98–143 of copending Application No. 10/995,208 in view of Thiem. *Id.* at 6.

³ The Examiner refers to claims 27–46. Ans. 3; Final Act. 2. This error is harmless because Appellants understand the Examiner's intention. Appeal Br. 7 ("presumably claims 47-66 were intended").

ANALYSIS

We review the appealed rejections for error based upon the issues identified by Appellants and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential), cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.”). After considering the evidence presented in this Appeal and each of Appellants’ arguments, we are not persuaded that Appellants identify reversible error. Thus, we affirm the Examiner’s rejections for the reasons expressed in the Final Office Action and the Answer. We add the following primarily for emphasis.

Rejection 1. The Examiner rejects claims 47–66 under 35 U.S.C. § 103 as unpatentable over Biergiesser in view of Thiem. Ans. 3. Appellants argue all claims as a group aside from presenting a separate argument for claims 56 and 60. Appeal Br. 7–13. Therefore, consistent with the provisions of 37 C.F.R. § 41.37(c)(1)(iv) (2013), we limit our discussion to claims 47, 56, and 60. All other claims on appeal stand or fall together with claim 47.

With respect to claim 47, the Examiner finds that Biergiesser teaches compositions containing creatine, creatinine, and glycerine. Ans. 3 (citing Biergiesser). The Examiner finds that the compositions are used to treat skin conditions. *Id.* The Examiner finds that Biergiesser teaches a molar ratio of glycerin to creatinine and other substances that falls within claim 47’s 50:1 to 1:50 recitation. *Id.* at 3–4. The Examiner finds that Biergiesser does not teach a glucosyl glyceride. *Id.* at 4. The Examiner finds, however, that Thiem teaches cosmetic formulations and teaches use of glucosyl glycerides

as superior to glycerol. *Id.* The Examiner determines that a person of ordinary skill in the art would have added glucosyl glycerides to Biergiesser's composition because, as Thiem teaches, glucosyl glycerides have good moisturizing properties and are more compatible with skin and mucous membranes than glycerol. *Id.*

Appellants argue that the Examiner has not adequately explained why a person of skill in the art would combine Thiem's glucosyl glycerides with Biergiesser's compositions. Appeal Br. 8–13. Appellants' arguments are similar to those raised in Appellants' prior appeal of similar claims drawn to this same patent application. For brevity, we incorporate the reasoning of the Board's decision in Appeal 2015-002387 (PTAB February 10, 2017) by reference in its entirety.

Appellants now emphasize that Thiem discloses that glycerol may cause irritation only when used “(i) at very high levels and (ii) with particularly sensitive individuals.” Appeal Br. 8 (Appellants' emphases). This argument does not persuade of us error in the Examiner's stated reason to combine because Appellants do not persuasively dispute that a person of skill in the art would have understood from Thiem that glucosyl glycerides have good moisturizing properties. *See* Ans. 4 (referencing “good moisturizing properties”), 9 (quoting Thiem 3:64–4:3 where Thiem states that formulations with glucosyl glycerides “act better as a moisturizing agent and act better against skin ageing than the active compounds, active-compound compositions and formulations of the prior art”). Use of the glucosyl glyceride in Biergiesser's composition would thus be no more than predictable use of a prior art element according to an established function. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

Appellants' argument is also unpersuasive because Appellants agree that Biergiesser teaches a glycerol composition as high as 7%. Appeal Br. 10 (citing Biergiesser ¶ 64). A desire to avoid any possible irritation among sensitive individuals at this high of a level (a level higher than any glycerol amount in a Thiem composition) provides a second reason to use glucosyl glyceride in Biergiesser's composition. Although Appellants argue that Biergiesser does not indicate that its composition is for sensitive individuals (Appeal Br. 9–10), a person of skill in the art would have understood that a person may not know whether they are sensitive prior to using a product; avoiding potential irritation, therefore, would have been desirable.

Appellants argue that Thiem does not indicate that glycerol is among the “prior art” that Thiem suggests glycosyl glyceride is superior to (“better moisturizing and anti-aging properties”) (Reply 2), but we disagree. When discussing prior art, Thiem focuses on compositions with glucose and glycerol. Thiem 1:54–59. Thiem is, therefore, best understood as referencing glycerol based prior art among its referenced and inferior “active-compound combinations and formulations of the prior art.” *Id.* at 3:61–4:3.

Appellants also argue that Biergiesser includes a retinoid which may cause side effects. Appeal Br. 10–11. Even if we accepted Appellants' position on this point as true, it does not weigh against a person of skill in the art wanting to avoid additional side effects from glycerol. Indeed, the portion of Biergiesser discussing retinoid side effects (Biergiesser ¶ 18–19) establishes that Biergiesser is concerned with minimizing skin irritation; this weighs in favor of using glucosyl glyceride in view of Thiem's teachings. Ans. 9.

Appellants further argue that the Biergiesser inventors did not mention glucosyl glycerides in Biergiesser and argue that many cosmetics available today contain glycerol despite Thiem being published 19 years ago. Appeal Br. 8, 11; Reply Br. 3–5. This argument is not persuasive. The Examiner correctly cites *In re Wright*, which states that “mere age of the references is not persuasive of the unobviousness of the combination of their teachings, absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem.” Ans. 11 (citing *In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977)). Moreover, Appellants previously argued that relatively higher cost of glucosyl glyceride might be a reason to use glycerol (Appeal 2015-002387, at 6–7), and a person of skill in the art would have been able to weigh considerations such as price against the Thiem’s stated advantages of glucosyl glyceride. *Cf. Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“a given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine”). We further emphasize that Appellants’ argument concerning Biergiesser failing to reference glucosyl glycerides (*see, e.g.*, Reply Br. 3–4) is unpersuasive because the argument attacks only the Biergiesser reference rather than the combined teachings of Biergiesser and Thiel. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”).

Because Appellants have not identified harmful error in the Examiner’s rejection, we sustain the Examiner’s rejection of claims 47–55, 57–59, and 61–66.

Dependent claims 56 and 60 recite a preparation that “comprises at least 3 % by weight of glycerin.” Appeal Br. 17–18. Appellants argue that the Examiner has not explained why a person of skill in the art would have used both glycerin and glucosyl glycerides as these two claims require. Appeal Br. 13. This argument is unpersuasive because the Examiner finds that Thiem teaches preparing compositions that contain both glycerin and glucosyl glyceride (Ans. 10), and Appellants do not persuasively dispute this finding. Applying a mixture of both glycerin and glucosyl glyceride to the Biergiesser composition would be a predictable use of prior art elements according to established function. *KSR Int’l Co.*, 550 U.S. at 417. We therefore sustain the Examiner’s rejection of claims 56 and 60.

Rejections 2–4. The Examiner rejects claims 47–66, provisionally, on the ground of nonstatutory obviousness-type double patenting. Ans. 6–7. Appellants present, substantively, the same arguments addressed above. Appeal Br. 14. We, therefore, sustain these provisional rejections for the reasons explained above.

DECISION

For the above reasons, we affirm the Examiner’s rejections of claims 47–66.

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