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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEFAN BRACHT

Appeal 2018-008833
Application 10/553,708
Technology Center 1600

Before DONALD E. ADAMS, FRANCISCO C. PRATS, and JOHN G. NEW, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from Examiner's decision to reject claims 1–3, 9, 10, 12–14, 17–20, 22–25, 27, and 29.[2] We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

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[1] 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 "LTS Lohmann Therapie-Systeme AG" (Appellant's January 21, 2018 Appeal Brief (Appeal Br.) 3).

[2] Claims 5–8, 11, 15, and 28 stand withdrawn from consideration (*see* Appeal Br. 5).

STATEMENT OF THE CASE

Appellant's disclosure "relates to medical active substance patches, particularly to transdermal therapeutic systems, comprising a mono layer or multilayer, active substance-containing matrix and a backing layer connected with the matrix, the active substance patches being distinguished by an improved optical appearance when being worn on the skin." (Spec.[3] ¶ 2). Claims 1, 22, and 23 are representative and reproduced below:

> 1. A medica1 active substance patch that is optically inconspicuous when worn on the skin, independent of whether the patch is attached to a light-skinned person or a dark-skinned person, comprising a mono layer or multilayer matrix and a backing layer connected with said matrix, said backing layer having one side averted from the skin, wherein at least one layer of the matrix contains a pharmaceutically active substance, and wherein at least one layer of the matrix contains an ingredient selected from the group consisting of at least one coloured ingredient and at least one colourless ingredient being in an initial state and tending to discolour or to discolour(s) during storage or to discolour during the application period, and wherein said at least one coloured ingredient and said at least one colourless ingredient are selected from the group consisting of a pharmaceutically active substance and an auxiliary agent;
>
> wherein said active substance patch comprises at least one pigment admixed into a coating on the backing layer to impart a lightness colour value L_1 that renders the patch optically inconspicuous on a first person's skin,
>
> in the state of having been applied to the first person's skin said patch, at a place of the skin covered with the patch, the lightness colour value L_1 is not 1ess than 50% and not more than 200% of a lightness colour value L_2, with L_2 being the lightness value of the region of the skin of the same person which surrounds the app1ied patch,

[3] Appellant's October 17, 2005 Specification.

that the same applies in respect of the skin of a second or any other person, provided that L_2 is in the range from 5° to 100º and the *pigments admixed into the coating on the backing layer* range in an amount from 0.25 to 0.5 wt% and *deviate from the color tone of the skin underlying the patch* and the lightness colour values L_1 and L_2 are determined via a tristimulus colorimeter,

wherein said patch is transparent or translucent.

(Appeal Br. 49–50 (emphasis added).)

22. A medical active substance patch comprising a monolayer or multilayer matrix and a backing layer connected with said matrix, said backing layer having one side averted from the skin, wherein at least one layer of the matrix contains a pharmaceutically active substance, and wherein at least one layer of the matrix contains a pharmaceutically active substance, and wherein at least one layer of the matrix contains an ingredient selected from the group consisting of at least one coloured ingredient, and at least one colourless ingredient being colourless in an initial state and tending to discolour or to discolour(s) during storage or to discolour during the application period, and wherein said at least one coloured ingredient and said at least one colourless ingredient are selected from the group consisting of a pharmaceutically active substance and an auxiliary agent;

wherein said active substance patch con1pnses at least one substance selected from the group consisting of *skin tone dyes and pigments*, wherein said at least one layer of the matrix contains said at least one substance selected from the group consisting of dyes and pigments and/or said at least one substance selected from the group consisting of dyes and pigments is coated onto said backing layer on the side averted from the skin; wherein in the state of having been applied to a first person's skin said patch, at a place of the skin covered with the patch, has a lightness colour value L_1 which is not less than 50% and not more than 200% of a lightness colour value L_2, with L_2 being the lightness value of the region of the skin of the same person which surrounds the applied patch, and the

lightness colour values L_1 and L_2 determined via a tristimulus colorimeter;

wherein said pharmaceutical active substance is nicotine and said patch optically masks discolouration due to decomposition promoted by light that begins and intensifies after the patch has been manufactured,

and the pigments admixed into the coating on the backing layer range in an amount from 0.25 to 0.5 wt%,

and said patch is translucent.

(*Id.* at 55–57 (emphasis added).)

23. A medical active substance patch comprising a monolayer or

multilayer matrix and a backing layer connected with said matrix, said hacking layer having one side averted from the skin, wherein at least one layer of the matrix contains a pharmaceutically active substance, and wherein at least one layer of the matrix contains an ingredient selected from the group consisting of at least one coloured ingredient, and at least one colourless ingredient being colourless in an initial state and tending to discolour or to discolour(s) during storage or to discolour during the application period, and wherein said at least one coloured ingredient and said at least one colourless ingredient are selected from the group consisting of a pharmaceutically active substance and an auxiliary agent;

wherein said active substance patch cornprises at least one substance selected from the group consisting of dyes and pigments, wherein said at least one layer of the matrix contains said at least one substance selected from the group consisting of *skin tone dyes and pigments*; and

a coating covering said backing layer on the side averted from the skin, wherein said coating contains said at least one *skin tone colored substance* selected from the group consisting of at least one dye and at least one pigment;

wherein in the state of having been applied to a first person's skin said patch, at a place of the skin covered with the patch, has a lightness colour value L_1 which is not less than

> 50% and not more than 200% of a lightness colour value L_2, with L_2 being the 1ightness value of the region of the skin of the same person which surrounds the applied patch, and the lightness color values L_1 and L_2 determined via a tristimulus colorimeter; said pharmaceutical active substance is nicotine;
>
> the pigments admixed into the coating on the backing layer range in an amount from 0.25 to 0.5 wt% and
>
> said patch optically masks discolouration that begins and intensifies
>
> after the patch has been manufactured,
>
> and said patch is transparent or translucent.

(*id.* at 57–58 (emphasis added).)

Ground of rejection before this Panel for review:

Claims 1–3, 9, 10, 12–14, 17–20, 22–25, 27, and 29 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gale,[4] Berthold,[5] Dow,[6] and Wick.[7]

ISSUE

Does the preponderance of evidence relied upon by Examiner support a conclusion of obviousness?

FACTUAL FINDINGS (FF)

FF 1. Gale discloses "[a] transparent transdermal delivery device for delivering nicotine which has an Opacity Index of less than 48.6 %" (Gale, Abstract; *see also id.* at 3:22–26 (Gale "relates to transparent transdermal delivery devices for the transdermal administration of nicotine, either alone or in combination with other agents," wherein "[s]uch devices should be

[4] Gale, WO 00/37058, published June 29, 2000.
[5] Berthold, CA 2 366 859 A1, published Sept. 28, 2000.
[6] Dow, Jr., US 5,120,325, issued June 9, 1992.
[7] Wick et al., US 5,676,969, issued Oct. 14, 1997.

sufficiently transparent so that the subject's skin can be clearly visible through the device when it is placed on the skin"); *id.* at ll. 27–29 (Gale discloses that "[i]dentifying indicia can be printed on the device in light colored or white ink in a manner which is not noticeable from a short distance, but is readable on close inspection"); *see* Ans.[8] 3–4).

FF 2. Gale discloses:

> transdermal drug delivery devices of the prior art utilize an impermeable backing on the skin distal surface of the device to protect the device from damage and to prevent loss of the active ingredient(s). In order to improve user satisfaction, these backing layers are often tinted to a color similar to skin tones. However, as can be readily appreciated, it is not commercially practical to provide pigmented backing layers for transdermal systems which approximate all skin colors.
>
> Another approach that has been taken is to provide transparent transdermal systems in which all elements forming a device are sufficiently transparent to permit the natural skin color to be visible through the device. Marketed products which take this approach include the Alora® and Climara® estrogen replacement patches and the Duragesic® transdermal fentanyl delivery system. When these devices are applied to the skin, the patient's natural skin color is visible through the patch, making the presence of the patch extremely inconspicuous.

(Gale 2:8–22; *see* Ans. 3–4.)

FF 3. Gale's device comprises a transparent polymeric film backing layer that has a permeability to nicotine in combination

> with one or more of the conventional elements of a transdermal device (other than the removable release liner) such as the drug reservoir, adhesive and rate controlling membranes, which must also be sufficiently transparent as to permit the natural skin color to be clearly visible through the assembled device after placement on the skin. The finished product should have an

[8] Examiner's July 11, 2018 Answer.

> Opacity Index of less than about 48.6%, preferably less than about 35.55% and more preferably less than 20%.
>
> . . .
>
> The preferred form, however, comprises a laminate of the backing layer, a nicotine reservoir layer which contains nicotine dissolved in a carrier at a concentration below the saturation concentration of nicotine in the carrier. If the drug reservoir component is self adhesive, a simple monolithic device could be employed. However, in many cases it is desirable to include additional components such as rate controlling membranes, and a separate adhesive layer for maintaining the devices on the skin.

(Gale 4:4–15; *id.* at 5:10–18; *see also id.* at 9:4–9; Ans. 3–4.)

FF 4. Examiner finds that Gale does not disclose that "the matrix may contain pigment instead of the backing and/or coating of the pigment on the backing layer" or "the lightness color values" recited in Appellant's claimed invention (Ans. 4–5).

FF 5. Berthold discloses

> A process for increasing the stability during storage and/or application of light-sensitive therapeutic systems and/or components thereof, such as active substances or auxiliary substances, using light-stability agents absorbing or reflecting electromagnetic waves, is characterized in that absorption or reflection agents are used whose absorption or reflection spectrum comprises that wavelength range which is responsible for the instability of the light-sensitive material or the components thereof.

(Berthold, Abstract; *see* Ans. 5.)

FF 6. Examiner finds that Berthold discloses "a method for improving stability of stored and/or used light sensitive active agents (such as nicotine) in a transdermal therapeutic system by including color in the system as a light barrier," wherein "[c]olors can be included in the backing layer or in

polymer layers containing the light sensitive active agent" (Ans. 5 (citing Berthold, Title, Abstract, 4:20–5:12, 8:5–14, and claims 1, 2, 8, and 9).

FF 7. Dow discloses:

> A sterile bandage suitable for external application to a wound or injury of the human skin comprising a backing layer, a non-toxic pigmented composition coated onto or embedded into the top side of said backing layer, wherein said pigmented composition comprises one or more pigments having a melanin likeness in appearance *so as to substantially match the appearance of said human skin*.

(Dow, Abstract (emphasis added).)

FF 8. Dow discloses the use of "[m]elanin-like pigment(s)," i.e. "one or more pigments which have the substantial appearance and color of melanin," wherein "[t]he pigment or mixtures thereof are preferably selected such that they have a brownish-black or reddish-brown appearance or combinations thereof. These pigments are preferably used at concentrations of about 0.5% to about 98% by solid weight of the pigmented composition" (Dow 3:45–49; *id.* at ll. 63–68; *cf. id.* at ll. 36–41 (Dow discloses that when "melanin pigment" is used "the pigmented composition comprises from about 1% to about 50% by solid weight of the melanin pigment"); *see* Ans. 5).

FF 9. Examiner finds that Wick discloses "transdermal patches to deliver [an] active substance such as nicotine," wherein "[t]he patches comprise a clear backing layer that may be flesh colored for cosmetic reasons and may be dyed to various colors or include printed matter thereon" (Ans. 5 (citing Wick, Title, Abstract, and 14:5–14)).

ANALYSIS

Based on the combination of Gale, Berthold, Dow, and Wick, Examiner concludes that, at the time Appellant's invention was made, it

would have been prima facie obvious "to provide a transparent transdermal device to deliver nicotine comprising a nicotine-containing layer and backing layer comprising ink (pigment) indicia as taught by Gale, and further include a flesh-colored pigment in . . . either backing layer or in the nicotine containing layer as taught by Berthold" (Ans. 5–6). According to Examiner:

> One would have been motivated to do so because Berthold teaches that colors act as a light barrier to improve the stability of stored light sensitive active agents (such as nicotine) in a transdermal therapeutic system. One would reasonably expect that formulating a transparent transdermal device to deliver nicotine comprising a nicotine containing layer and backing layer comprising color in the backing layer or in the nicotine containing layer would result in a patch wherein the color acts as light barrier to improve stability of the nicotine during storage and use of the transdermal patch. One would also expect a flesh-colored pigment to improve user satisfaction, and would understand a transparent patch having an Opacity Index of less than 48.6% would allow the skin color of a user to show through the patch.

(Ans. 5–6.) In this regard, Examiner reasons that one of ordinary skill in this art would have been motivated to coat the transdermal patch suggested "by the combination of Gale and Berthold with pigmented coating having melanin likeness in appearance so as to match the appearance of the user skin as taught by Dow because Dow teaches that such a pigmented coating provides a cosmetic benefit to the user" (Ans. 6; *see id.* (Examiner further reasons that "one having ordinary skill in the art would have been motivated to dye the backing layer to various colors including flesh color as taught by Wick for cosmetic reasons")).

Examiner finds that in selecting "the pigment used in the backing layer to be similar to the skin color of the user, as suggested by the

combination of Gale, Berthold, Dow, and Wick, to arrive at a patch that is inconspicuous on a user's skin, "one having ordinary skill in the art would have optimized the amount of pigments based on its type and color and skin color" (Ans. 7). We agree. *See In re Aller*, 220 F.2d 454, 456 (CCPA 1955) ("[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.").

Examiner further finds that the tristimulus colorimeter, recited in Appellant's claimed invention to determine L_1 and L_2 color values, is not "part of the claimed transdermal patch" and "does not impart patentability to claims directed to transdermal device because the claims are to the patch itself, not a method of making or testing said patch" (Ans. 7). We agree. *See In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.").

Claims 22 and 23:

Appellant's claims 1, 22 and 23 are reproduced above. In contrast to Appellant's claim 1, the medical active substance patches of Appellant's claims 22 and 23 comprise skin tone dyes and pigments (*see* Appeal Br. 56 and 57–58). Appellant's claim 24 depend from and further limits Appellant's claim 22 to "further compris[e] a coating covering said backing layer on the side averted from the skin for containing said at least one

substance selected from the group consisting of dyes and pigments" (*see id.* at 58–59).

Dow discloses the use of about 0.5% to about 98% melanin-like pigment (FF 8). Therefore, we are not persuaded by Appellant's contentions regarding pigment concentration (*see* Appeal Br. 16–17). More specifically, we are not persuaded by Appellant's contention that "one skilled in the art would have considered Dow for all that it teaches and incorporated its minimum of 1 % [melanin] pigment," which is at least twice the amount required by Appellant's claimed invention (*see* Appeal Br. 16; *see also id.* at 33–34 and 38; *cf.* FF 8).

In addition, a person of ordinary skill in this art would have recognized that Dow's use of the term "about 0.5% to about 98%" provides some flexibility around the endpoints of the range of melanin-like pigment (*see* FF 8). *See Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217 (Fed.Cir.1995) (holding that "the use of the word 'about,' avoids a strict numerical boundary to the specified parameter. Its range must be interpreted in its technologic and stylistic context"). Therefore, we are not persuaded by Appellant's contention that a person of ordinary skill in this art would not have optimized the pigment concentration "about" the lower limit set forth in Dow, particularly in light of Dow in combination with Gale, Berthold, and Wick (*see* Appeal Br. 18–19; *see also id.* at 38–39 (Appellant contends "if one skilled in the art had added the pigment of Dow to protect the nicotine of Gale's patches from light degradation . . . one would have been inclined to include more pigment than recommended rather than less pigment, as Berthold seeks to altogether avoid degradation" (emphasis omitted)); *cf.* FF 9; *see* FF 1–8). *See In re Brandt*, 886 F.3d 1171, 1177 (Fed. Cir. 2018)

("*prima facie* rejections may be appropriate 'where there is a teaching in the prior art that the end points of the prior art range are approximate, or can be flexibly applied'") (citing *In re Patel*, 566 Fed. Appx. 1005, 1010 (Fed. Cir. 2014)).

We find no evidence on this record to support Appellant's unsupported contention that the concentration of pigment suggested by the combination of Gale, Berthold, Dow, and Wick would not mask nicotine discoloration that occurs due to degradation (*see* Appeal Br. 19; *see also id.* at 29–30; Reply Br. 12–14). Therefore, we are not persuaded by Appellant's contention that "the optical masking of nicotine by incorporation of a minimal pigment loading is at odds with existing patch technology that instead teaches opaque layers to eliminate nicotine degradation" (Appeal Br. 44–45).

For the foregoing reasons, we are not persuaded by Appellant's contentions regarding unexpected results as they apply to Appellant's claims 22 and 23 (*see* Appeal Br. 42–45). Similarly, we are not persuaded by Appellant's contention that Examiner relied upon impermissible hindsight (Appeal Br. 19, 38, and 42).

There is no requirement in Appellant's claims 22 and 23 that the patch is optically inconspicuous (*see* Appeal Br., 55–58). Therefore, we are not persuaded by Appellant's contentions regarding a patch that is optically inconspicuous or Gale's disclosure that "it is not commercially practical to provide pigmented backing layers for transdermal systems which approximate all skin colors" (*see* Appeal Br. 19–20; FF 2; *see also* Appeal Br. 16, 19, 22–24, 26–29, 32, 34, 37, 40–41, and 43–44).

In addition, we are not persuaded by Appellant's contention that Gale's disclosure that "it is not commercially practical to provide pigmented backing layers for transdermal systems which approximate all skin colors" teaches away from its combination with Berthold, Dow, and Wick (*see* Appeal Br. 25–26; *see also id.* at 27–29 and 38; FF 2). The fact that "a given combination would not be made by businessmen for economic reasons does not mean that persons skilled in the art would not make the combination because of some technological incompatibility. Only the latter fact would be relevant" in an obviousness analysis. *In re Farrenkopf*, 713 F.2d 714, 718 (Fed. Cir. 1983).

On this record, Appellant failed to establish an evidentiary basis that supports a finding that the color of their patch, or the patch suggested by the combination of prior art relied upon by Examiner, affects the transdermal delivery of an active. We are, therefore, not persuaded by Appellant's contention that modifying Gale's patch to include a pigment will change Gale's principle of operation (*see* Appeal Br. 24; *see also id.* at 29–30). To the contrary, we find that a person of ordinary skill in this art would have found it prima facie obvious to produce a transdermal delivery device, i.e. patch, that is colored, for cosmetic reasons, as suggested by the combination of Gale, Berthold, Dow, and Wick, wherein such colored patch will operate to transdermally deliver an active in the same manner set forth in Gale (*see* FF 1–9). *Cf.*, *In re Mouttet*, 686 F.3d 1322, 1332–33 (Fed. Cir. 2012) (finding that "a "difference in the circuitry—electrical versus optical—does not affect the overall principle of operation of a programmable arithmetic processor").

We are not persuaded by Appellant's contention that Berthold's disclosure of "nicotine patches [that] include a light impermeable carrier film, likewise fails to teach or suggest inventive transparent or translucent patches in which pigments are present in an amount ranging from 0.25 to 0.5% as recited in [Appellant'] claimed invention," which fails account for Berthold in combination with Gale, Dow, and Wick (Appeal Br. 31–32 (emphasis omitted); FF 1–10; Ans. 5–7).

We are also not persuaded by Appellant's contention that Berthold "does not teach or suggest that translucent patches containing the recited minimal amount of pigment would optically mask the discoloration of nicotine due to decomposition promoted by light," but instead "teaches that nicotine patches should include a carrier film that is 'impermeable' to light (i.e. is opaque) in order to altogether avoid nicotine degradation and associated discoloration" (Appeal Br. 32 (emphasis omitted); *see also id.* at 41–42). Notwithstanding Appellant's contention to the contrary, Berthold discloses the use of "absorption or reflection agents . . . whose absorption or reflection spectrum comprises that wavelength range which is responsible for the instability of the light-sensitive material or the components thereof" (FF 5). Contrary to Appellant's contention, we find no disclosure in Berthold relating to an "opaque" patch or coating. In addition, Appellant fails to provide an evidentiary basis on this record to support a conclusion that the incorporation of an absorption or reflection agent, which absorbs or reflects a spectrum of the wavelength range responsible for degradation of nicotine, into a patch will necessarily result in an opaque patch. Therefore, we are not persuaded by Appellant's contention that combining Gale, Dow,

and Wick with Berthold "would render Berthold unfit for its intended purpose" (Appeal Br. 32–33; *cf.* FF 1–10).

We are not persuaded by Appellant's contention that "Dow, merely directed to bandages designed to match the appearance of skin, most certainly does not teach or suggest that translucent nicotine patches containing the recited minimal pigment loading would optically mask the discoloration of nicotine due to decomposition promoted by light, as recited in [Appellant's] Claims 22 and 23," which fails account for Dow in combination with Gale, Berthold, and Wick (Appeal Br. 35 (emphasis omitted); *see* FF 1–10; Ans. 5–7).

We are not persuaded by Appellant's contention that Wick "fails to teach or suggest inventive patches in which pigments are present in an amount ranging from 0.25 to 0.5 wt%" or "that translucent nicotine patches containing the recited minimal amount of pigment would optically mask the discoloration of nicotine due to decomposition promoted by light," which fails to account for Wick in combination with Gale, Berthold, and Dow (Appeal Br. 36–37; *see* FF 1–10; Ans. 5–7).

Appellant contends:

> That the incorporation of the recited minimal amount of pigment having essentially the same lightness colour value (L_1) as the skin which surrounds the applied patch (L_2) within translucent or transparent patches readily masks the discoloration imparted by nicotine during storage or application . . . [and] address a longfelt but unmet need, as evidenced by the current provision of either colorless transparent patches or skin-colored opaque patches by major suppliers in the marketplace. Applicants further respectfully submit that the failure of those highly skilled in the art of nicotine patches, extremely skilled artisans in an over $ 800 million dollar market to apply minimally pigmented coatings to

> their transparent/translucent patches to address a known deficiency in their colorless nicotine patches, although nicotine patches have been known for 30 years, clearly evidences the patentability of the advantageous embodiments of Claims 22 and 23.

(Appeal Br. 47.) We are not persuaded.

Establishing long-felt need requires objective evidence. *See In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2009) ("our precedent requires that the applicant submit actual evidence of long-felt need, as opposed to argument. This is because '[a]bsent a showing of long-felt need or the failure of others, the mere passage of time without the claimed invention is not evidence of nonobviousness'" (alteration original)). On this record, Appellant's contentions rely on attorney argument. "Attorney's argument in a brief cannot take the place of evidence." *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

Furthermore, to establish long-felt need, Appellant must show: (1) a need has been a persistent one that was recognized by ordinarily skilled artisans; (2) the long-felt need must not have been satisfied by another before Appellant's invention; and (3) the invention must, in fact, satisfy the long-felt need. *In re Gershon*, 372 F.2d 535, 538 (CCPA 1967); *Newell Co. v. Kenney Mfg. Cos.*, 864 F.2d 757, 768 (Fed. Cir. 1988); *In re Cavanagh*, 436 F.2d 491, 496 (CCPA 1971). Because Appellant failed to identify an evidentiary basis establishing the foregoing, Appellant's contentions regarding long-felt need are not persuasive on this record.

Claim 1:

Appellant's claim 1 is reproduced above. The medical active substance patch of Appellant's claim 1 comprises "pigments admixed into

the coating on the backing layer . . . [that] *deviate from the color tone of the skin underlying the patch*" (Appeal Br. 50 (emphasis added)). Appellant's claims 2, 3, 9, 10, 12–14, 17–20, 25, 27, and 29 depend directly or indirectly from Appellant's claim 1 (*see id.* at 50–59).

Although we agree with Examiner that the combination of Gale, Berthold, Dow, and Wick suggests the addition of a dye or pigment to the backing layer of a medical active substance patch, this prior art suggests that a person of ordinary skill in this art would select a dye or pigment "having a melanin likeness in appearance so as to substantially match the appearance of . . . human skin" (*see* FF 10; *see also* FF 9 (Wick discloses that its "transdermal patches to deliver [an] active substance such as nicotine . . . comprise a clear backing layer that may be flesh colored for cosmetic reasons); FF 2 (Gale discloses prior art patches with "backing layers . . . tinted to a color similar to skin tones" "[i]n order to improve user satisfaction")).

As Appellant explains, "none of the myriad of cited references teaches or suggests the formation of inconspicuous patches incorporating pigment whose color deviates from the color of the underlying skin" (Reply Br. 10; *see also* Appeal Br. 43 ("imparting an optically inconspicuous appearance to an object by incorporating a color tone that deviates from the color tone of its background is contrary to science in general . . . conventional wisdom indicat[es] that identical or substantially identical colors blend in better than differing colors")).

For the foregoing reasons we find that the weight of the evidence on this record falls in favor of Appellant with respect to Appellant's claim 1 and its dependents.

CONCLUSION

The preponderance of evidence relied upon by Examiner supports a conclusion of obviousness with respect to Appellant's claims 22 and 23. The rejection of claims 22 and 23 under 35 U.S.C. § 103(a) as unpatentable over the combination of Gale, Berthold, Dow, and Wick is affirmed. Claim 24 is not separately argued and falls with claim 22.

The preponderance of evidence relied upon by Examiner fails to support a conclusion of obviousness with respect to Appellant's claims 1–3, 9, 10, 12–14, 17–20, 25, 27, and 29. The rejection of claims 1–3, 9, 10, 12–14, 17–20, 25, 27, and 29 under 35 U.S.C. § 103(a) as unpatentable over the combination of Gale, Berthold, Dow, and Wick is reversed.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–3, 9, 10, 12–14, 17–20, 22–25, 27, 29	103	Gale, Berthold, Dow, Wick	1–3, 9, 10, 12–14, 17–20, 25, 27, 29	22, 23, 24

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)(1)(iv).

AFFIRMED-IN-PART