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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAGMAR ZELLE, ALEXANDER FILBRY, and
RAINER KROEPKE¹

Appeal 2018-009072
Application 12/347,241
Technology Center 1600

Before DONALD E. ADAMS, ERIC B. GRIMES, and
RACHEL H. TOWNSEND. *Administrative Patent Judges.*

GRIMES, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to a topical preparation, which have been rejected as obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant identifies the real party in interest as Beiersdorf AG. Appeal Br. 3. We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a).

STATEMENT OF THE CASE

Claims 21–30 and 32–41 are on appeal. Claims 21 and 37, reproduced below, are illustrative:

21. A topical cosmetic or dermatological preparation, wherein the preparation is effective for treating a pruritic condition, is present as a non-ionic O/W emulsion, and comprises (i) water, (ii) from 1 to 40 w/w % of one or more oil phases, (iii) at least one of PEG 12 cetearylether and PEG 40 monostearate, (iv) from 0.5 to 10 w/w % of polidocanol, (v) from 0.01 to 1 w/w % of an essential oil which comprises menthol, and (vi) one or more O/W emulsifiers or co-emulsifiers.

37. A topical cosmetic or dermatological preparation, wherein the preparation is effective for treating a pruritic condition, is present as a non-ionic O/W emulsion and comprises (i) water, (ii) from 1 to 40 w/w % of one or more oil phases, (iii) PEG 12 cetearylether, (iv) from 1 to 10 w/w % of polidocanol, (v) menthol, (vi) glyceryl stearate, and (vii) at least one of glycerin, sorbitol, butylene glycol and urea.

The claims stand rejected as follows:

Claims 21, 23–25, 27, 30, 32, 33, and 36 under 35 U.S.C. § 103(a) as obvious based on Röder,² Klein,³ Bazin,⁴ Cohen,⁵ and Lapidus⁶ (Final Action⁷ 3);

² Röder et al., US 6,217,885 B1, issued Apr. 17, 2001.

³ Klein, US 4,305,936, issued Dec. 15, 1981.

⁴ Bazin et al., US 6,001,367, issued Dec. 14, 1999.

⁵ Cohen et al., US 5,558,914, issued Sept. 24, 1996.

⁶ Lapidus, US 5,543,148, issued Aug. 6, 1996.

⁷ Office Action mailed June 23, 2017.

Claims 22, 34, 35, 37, 38, and 40 under 35 U.S.C. § 103(a) as obvious based on Röder, Klein, Bazin, Cohen, Lapidus, and Flick⁸ (Final Action 6–7);

Claims 39 and 41 under 35 U.S.C. § 103(a) as obvious based on Röder, Klein, Bazin, Cohen, Lapidus, Flick, and Herstein⁹ (Final Action 8, Ans. 3); and

Claims 26, 28, 29, and 41 under 35 U.S.C. § 103(a) as obvious based on Röder, Klein, Bazin, Cohen, Lapidus, and Herstein (Final Action 9, Ans. 4).

OPINION

Obviousness: Röder, Klein, Bazin, Cohen, and Lapidus

The Examiner has rejected claims 21, 23–25, 27, 30, 32, 33, and 36 as obvious based on Röder, Klein, Bazin, Cohen, and Lapidus. The Examiner finds that “Röder teaches antipruritic compositions that alleviate itching and also prevent reddening of skin after excessive sun exposure.” Final Action 3. The Examiner finds that “the formulation may be in the form of O/W emulsion,” comprising 0.01–30 wt% polidocanol (a.k.a. laureth-9). *Id.* The Examiner also finds that Röder teaches that “[o]ils may be used in the amount of 0.5–50 wt %. Emulsifiers such as glycerol sorbitan fatty acid esters, polyoxyethylene fatty acid esters, . . . are used.” *Id.* at 4. The Examiner finds that Röder also teaches “[u]sing humectants such as glycerol.” *Id.*

⁸ Flick, E. W., *Emulsifying agents – an industrial guide*, William Andrews Publishing/Noyes, pp. 104, 164 (1990).

⁹ Herstein, US 5,902,591, issued May 11, 1999.

The Examiner finds that Röder does not specifically teach including PEG 40 monostearate, glycerin stearate, or an essential oil comprising menthol in its composition. *Id.* The Examiner finds that Klein teaches “a topical corticosteroid formulation . . . using pharmaceutically acceptable, non-toxic surfactants, . . . such as glyceryl stearate and polyethylene 40 stearate [a.k.a. PEG 40 monostearate].” *Id.* “Bazin also teaches using conventional emulsifiers and co-emulsifiers . . . to make dermatological emulsions. . . . Examples 4 and 5 illustrate oil-in-water emulsion cream comprising PEG-40 stearate, glyceryl stearate.” *Id.*

The Examiner concludes that it would have been obvious to include PEG 40 monostearate and glyceryl stearate in Röder’s composition “because Klein teaches these are among the non-toxic surfactants suitable for anti-inflammatory pharmaceutical formulations.” *Id.* at 5. The Examiner finds that a skilled artisan would have had a reasonable expectation of success because Röder teaches that its composition can be an oil-in-water (O/W) emulsion and Bazin exemplifies O/W emulsions comprising PEG 40 monostearate and glyceryl stearate. *Id.*

Regarding the requirement for menthol in the claimed composition, the Examiner finds that “Cohen discloses compositions for treating sunburn, which include a local anesthetic and tea tree oil, and preferably, spearmint oil” to provide an enhanced cooling effect. *Id.* The Examiner finds that “Lapidus also teaches menthol is a preferred antipruritic agent when used at a level of 0.9–1.1 wt% due to its medicinal odor.” *Id.* at 6. The Examiner concludes that it would have been obvious “to modify the teachings of

Röder by incorporating to the composition additional antipruritic agent such as menthol as motivated by Cohen and Lapidus.” *Id.*

The skilled artisan would have been motivated to do so because Cohen and Lapidus are directed to topical compositions for similar purposes (treating itching conditions and/or treating sunburn); Cohen teaches using mentholated products with essential oils as a cooling agent; and Lapidus teaches menthol is a preferred antipruritic agent due to its medicinal odor.

Id.

We agree with the Examiner that the composition of claim 21 would have been obvious based on the cited references. Röder discloses “antipruritic cosmetic and/or pharmaceutical compositions.” Röder 1:7–8. Röder teaches that its compositions are “outstandingly suitable for alleviating itching,” “counteract reddening of the skin,” and “display a potent action against development of erythema after excessive UV irradiation.” *Id.* at 2:6–15. Röder teaches that its composition comprises 0.1–30% of a local anesthetic such as laureth-9 (polydocanol). *Id.* at 2:16–20, 2:54–55, 5:60–65.

Röder teaches that its compositions “can be in various forms, such as are usually employed,” including oil-in-water (O/W) emulsions. *Id.* at 4:34–39. Röder states that its compositions “are preferably in the form of a solution or emulsion (cream or milk), which can be an oil-in-water or water-in-oil emulsion.” *Id.* at 7:3–5.

Röder states that the compositions can comprise up to 70% water and 0.5–50% “fatty substances, such as mineral, animal, or vegetable oils.” *Id.* at 6:14–25. “If appropriate, the compositions according to the invention comprise emulsifiers . . . such as are usually used in cosmetics.” *Id.* at 6:26–

29. “Examples of these are glycerol sorbitan fatty acid esters [and] polyoxyethylene fatty acid esters.” *Id.* at 6:34–35.

In light of Röder’s teachings, one of ordinary skill in the art would have found a topical antipruritic composition in the form of an O/W emulsion, comprising (i) water, (ii) 0.5–50% of an oil phase, (iii) an emulsifier such as a polyoxyethylene fatty acid ester, (iv) 0.1–30% laureth-9 (polidocanol), and an additional emulsifier such as those that are usually used in cosmetics to be obvious.

As the Examiner noted, Röder does not specifically suggest including PEG 40 monostearate in its composition. Klein, however, discloses a topical composition that contains, among other things, a surfactant. Klein 1:5–7, 3:1–2. Klein states that “pharmaceutically acceptable, nontoxic, non-ionic, anionic and cationic surfactants” include glycerol monostearate and “polyoxyethylene fatty acid esters such as polyoxyethylene (40) stearate,” a.k.a. PEG 40 monostearate.¹⁰ *Id.* at 3:10–18.

Bazin also discloses a composition for application to skin; specifically, an anti-wrinkle composition for cosmetic or dermatological use. Bazin 1:6–12. Bazin states that, when its composition is an emulsion, “the emulsifiers and the co-emulsifiers . . . are chosen from those used conventionally in the field.” *Id.* at 6:18–24. Such emulsifiers and co-emulsifiers include PEG-40 stearate and glyceryl stearate. *Id.* at 6:37–41.

¹⁰ Appellant’s Specification states that PEG-40 stearate is also referred to as “monostearate polyoxyethylene (40),” among other names. Spec. 6:33 to 7:1. Appellant does not dispute that Klein’s polyoxyethylene (40) stearate is the same compound as the PEG 40 monostearate recited in claim 21. *See* Appeal Br. 19–20 (discussing Klein and Bazin).

Bazin exemplifies two anti-wrinkle creams that include both PEG-40 stearate and glyceryl stearate. *Id.* at 7:42 to 8:12.

Based on these teachings, it would have been obvious to use PEG 40 monostearate and glyceryl stearate as emulsifiers in Röder's composition. Specifically, Röder teaches that an emulsion is a preferred form of its composition, and suggests including emulsifiers when appropriate (e.g., for an emulsion). Röder also suggests polyoxyethylene fatty acid esters as emulsifiers, and Klein teaches that PEG 40 monostearate (polyoxyethylene (40) stearate) is a pharmaceutically acceptable, nontoxic surfactant for use in topical compositions. In addition, Bazin discloses that PEG-40 monostearate and glyceryl stearate are among the emulsifiers and co-emulsifiers conventionally used in the field of cosmetic and dermatological compositions. PEG 40 monostearate and glyceryl stearate thus would have been obvious choices to those skilled in the art for use in Röder's O/W emulsion composition.

Röder does not specifically suggest including menthol in its composition. However, Cohen discloses a water-based composition comprising a topical anesthetic and tea tree oil for treating sunburn. Cohen 1:61–67. Cohen discloses that its composition preferably contains a fragrance-producing component, and that spearmint oil and peppermint oil are preferred fragrance oils. *Id.* at 5:59–64. “The preferred fragrance-producing component is spearmint oil. Not only does the spearmint oil tend to mask the odor of tea tree oil, or of a tea tree oil blend, it also produces its own characteristic pleasant odor.” *Id.* at 6:1–5.

Lapidus discloses a “stick delivery system effective for the topical application of a treatment agent selected from the group consisting of a topical anesthetic, an antihistamine, an anti-inflammatory agent, an antifungal agent, and mixtures thereof.” Lapidus 1:59–63. Lapidus discloses that its system includes a solvent, a gelling agent, a treatment agent, and water. *Id.* at 2:1–5. “In addition, an antipruritic agent, at a level of about 0.25% to about 5%, more preferably about 0.5% to about 1.5%, by weight, can be included when its combination with the treatment agent employed is acceptable.” *Id.* at 2:5–9.

Lapidus states that the antipruritic agent should be one that is effective to relieve itching when topically applied, such as menthol. *Id.* at 2:60–66. “Menthol is preferred . . . because, in addition to its antipruritic activity, menthol imparts a desirable ‘medicinal’ odor to the stick delivery system.” *Id.* at 2:67 to 3:5.

Based on the teachings of Cohen and Lapidus, it would have been obvious to modify Röder’s composition to comprise spearmint oil (an essential oil comprising menthol) or menthol. Röder suggests including “cosmetic auxiliaries such as are usually used in such formulations,” including perfumes, in its compositions. Röder 4:42–45; *see also id.* at 6:46–47 (“perfume oils in amounts of 0.01 to 5.0%”). Thus, it would have been obvious to include spearmint oil in Röder’s composition, because Cohen teaches that it has a characteristic pleasant odor and is suitable for use in topical compositions. Alternatively, it would have been obvious to include menthol in Röder’s composition based on Lapidus’ teaching that menthol has a desirable medicinal odor and additionally has antipruritic activity.

In summary, Röder, Klein, Bazin, Cohen, and Lapidus disclose all of the components of the composition of claim 21 and provide adequate reason to combine those components in the manner claimed. Claim 21 therefore would have been obvious based on the cited references.

Appellant argues that “none of the compositions which are exemplified in RODER is an emulsion, which is an indication that emulsions are not preferred embodiments of the antipruritic compositions of RODER.” Appeal Br. 18. This argument is unpersuasive, because Röder expressly states that emulsions are a preferred form of its compositions. Röder 7:3–5 (“The compositions . . . are preferably in the form of a solution or emulsion (cream or milk), which can be an oil-in-water or water-in-oil emulsion.”).

Appellant also argues that “RODER already discloses emulsifiers that may be used for making emulsions. . . . There is no indication in any of RODER, KLEIN and BAZIN that any of the emulsifiers picked by the Examiner from the disclosures of KLEIN and BAZIN would result in a better product.” Appeal Br. 19. Appellant also argues that “KLEIN and BAZIN are but two of probably thousands of documents which disclose a host of O/W emulsifiers which may be expected to be successfully employable in making an O/W emulsion of the type disclosed by RODER.” *Id.*

These arguments are also unpersuasive. The fact that a host of known emulsifiers would have been expected to work in Röder’s O/W emulsion composition does not make the choice of any specific, known emulsifier any less obvious. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“The combination of familiar elements according to known methods is

likely to be obvious when it does no more than yield predictable results.”); *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (“[D]isclos[ing] a multitude of effective combinations does not render any particular formulation less obvious. This is especially true because the claimed composition is used for the identical purpose taught by the prior art.”). And a modification of the prior art does not need to improve the prior art’s function in order to be obvious; substitution of one known equivalent for another is an obvious modification. *See In re Omeprazole Patent Litig.*, 483 F.3d 1364, 1374 (Fed. Cir. 2007) (“[T]his court finds no . . . error in [the] conclusion that it would have been obvious to one skilled in the art to substitute one ARC [alkaline reactive compound] for another.”). Thus, using the known emulsifiers disclosed by Klein and Bazin, including PEG 40 monostearate and glyceryl stearate, would have been obvious to a person of ordinary skill in the art.

Appellant also argues that it would not have been obvious to combine Röder with either Cohen or Lapidus. Appeal Br. 8. Appellant argues that “RODER relates to antipruritic cosmetic and/or pharmaceutical compositions,” *id.* at 9, and “mentions merely in passing (i.e., in a single sentence of the entire document) that these compositions can additionally prevent or inhibit the development of erythema after excessive UV irradiation, without providing any further discussion, let alone corresponding experimental evidence.” *Id.* at 10.

Appellant argues that “COHEN, on the other hand, does not even mention antipruritic compositions, let alone disclose[] compositions similar to those taught by RODER, but is directed exclusively to a (water-based)

formulation for the treatment and care of sunburn.” *Id.* Appellant argues that “RODER discloses compositions for the prevention of erythema (sunburn) . . . , whereas COHEN discloses compositions for the treatment of (already developed) erythema.” *Id.* at 11. Appellant argues that Cohen’s suggestion to add “other cooling or numbing agents, such as mentholated or camphor-based products,” to its composition would not “have prompted one of ordinary skill in the art to add menthol or an essential oil comprising menthol to the compositions of RÖDER.” *Id.* Similarly, Appellant argues that Röder teaches that the active agents in its composition do not have a pronounced intrinsic smell, “which clearly is a disincentive rather than a motivation to incorporate a compound with a pronounced intrinsic smell such as menthol.” *Id.* at 12.

These arguments are unpersuasive. Röder expressly states that, in addition to its antipruritic effect, its composition has a potent action against the development of sunburn. Röder 2:14–15. Cohen discloses that its formulation relieves pain and promotes healing of sunburned skin. Cohen 1:61–64. Appellant has not persuasively explained why these uses would be considered mutually exclusive, and it would seem desirable to prevent further sunburn (per Röder) when treating skin that has already been sunburned (per Cohen).

In addition, Röder expressly suggests including perfumes or perfume oils in its composition. Röder 4:45; 6:46–47. In addition to suggesting mentholated cooling agents, Cohen also suggests including “fragrance oils such as spearmint oil, peppermint oil,” etc. in its composition. Cohen 5:60–63. Thus, it would have been obvious to use spearmint oil or peppermint oil

as the perfume oil in Röder's composition, because Cohen suggests using them as fragrance oils in its skin-care composition.

Regarding Lapidus, Appellant argues that, “[w]hile LAPIDUS also relates to antipruritic compositions for alleviating the itching caused by, *inter alia*, insect bites and the like, the compositions of LAPIDUS which are intended for this purpose do not contain menthol in combination with a typical anesthetic such as lidocaine but instead contain an antihistamine.” Appeal Br. 14–15. Appellant argues that “[m]enthol is mentioned in LAPIDUS solely and exclusively in the context of compositions for addressing razor burn (in combination with a typical anesthetic such as lidocaine . . .).” *Id.* at 15–16. “[F]or relieving itching caused by insect bites, allergic reactions and the like, . . . LAPIDUS recommends antihistamines (not menthol).” *Id.* at 16.

These arguments are not persuasive. Lapidus describes its invention as a stick delivery system for topical application of a treatment agent that can be a topical anesthetic, an antihistamine, an anti-inflammatory agent, or an antifungal agent. Lapidus 1:58–63. Lapidus states that, “[i]n addition, an antipruritic agent . . . can be included when its combination *with the treatment agent* employed is acceptable.” *Id.* at 2:5–9 (emphasis added). Thus, Lapidus suggests combining an antipruritic agent with a “treatment agent” generally, not solely with a topical anesthetic. *See also id.* at 4:5–8 (“[A] combination of components must be provided such that the antipruritic agent and treatment agent are ‘carried’ in an aesthetically desirable, non-messy vehicle.”); 5:50–63 (claim 1, which includes menthol and any of the treatment agents described by Lapidus).

It is true that Lapidus also specifically suggests including an antipruritic agent “when the treatment agent is a typical [sic, topical] anesthetic.” *Id.* at 2:58–59. However, when the reference is read as a whole, its teachings are not limited to combining an antipruritic agent, such as menthol (*id.* at 2:64–66), with topical anesthetics, but with any of the treatment agents where alleviation of itching would be desirable.

Appellant also argues that “[t]he fact that menthol has a medicinal odor . . . is also not indicative of an apparent reason for one of ordinary skill in the art to include menthol in a composition according to RÖDER,” because Röder discloses that the active compounds in its composition do not have a pronounced intrinsic smell. Appeal Br. 17.

This argument is also unpersuasive because, as discussed above, Röder expressly suggests including perfumes or perfume oils in its composition. Thus, Lapidus’ disclosure that “menthol imparts a desirable ‘medicinal’ odor” to its composition would provide a reason for a skilled artisan to include menthol as the perfume in Röder’s composition, where a medicinal odor was considered desirable.

Obviousness: Röder, Klein, Bazin, Cohen, Lapidus, and Flick

Claims 22, 34, 35, 37, 38, and 40 stand rejected as obvious based on Röder, Klein, Bazin, Cohen, Lapidus, and Flick. The Examiner relies on Röder, Klein, Bazin, Cohen, and Lapidus for the disclosures discussed above with regard to claim 21, and finds that Flick teaches that PEG 12 cetearylether, as recited in claim 22, is a known emulsifier for O/W lotions. Final Action 7. The Examiner concludes that it would have been obvious to modify Röder’s composition by including PEG 12 cetearylether for the

desirable properties, as disclosed by Flick. *Id.* We agree with and adopt the Examiner's fact-finding and conclusion.

Appellant argues that "FLICK is unable to cure any of the deficiencies of RODER, COHEN and LAPIDUS set forth above." Appeal Br. 21. This argument is unpersuasive because, for the reasons discussed above, we conclude that Röder, Klein, Bazin, Cohen, and Lapidus would have made obvious the composition of claim 21.

Appellant also argues that (a) "emulsions are less desirable embodiments of the compositions of RODER," (b) "[t]here is no indication . . . that any of the emulsifiers picked by the Examiner from the disclosure of FLICK would result in a better product than that which can be obtained by using the emulsifiers disclosed in RODER," and (c) "FLICK is but one of probably thousands of documents which disclose a host of O/W emulsifiers which may be expected to be successfully employable in making an O/W emulsion of the type disclosed by RODER." Appeal Br. 21.

These arguments are unpersuasive here for the reasons explained above with respect to Klein and Bazin: The fact that a host of known emulsifiers would have been expected to work in Röder's O/W emulsion composition does not make a specific choice from among the known emulsifiers any less obvious, and substitution of known equivalents for each other is an obvious modification even if it would not have been expected to provide an improvement.

We therefore affirm the rejection of claim 22 under 35 U.S.C. § 103(a) based on Röder, Klein, Bazin, Cohen, Lapidus, and Flick. Claims

34, 35, 37, 38, and 40 fall with claim 22 because they were not argued separately. 37 C.F.R. § 41.37(c)(1)(iv).

Obviousness: Röder, Klein, Bazin, Cohen, Lapidus, Flick, and Herstein

Claims 39 and 41 stand rejected as obvious based on Röder, Klein, Bazin, Cohen, Lapidus, Flick, and Herstein. The Examiner relies on Röder, Klein, Bazin, Cohen, Lapidus, and Flick for the disclosures discussed above, and finds that Herstein teaches that octyldodecanol, as recited in claim 39, is a known emollient for use in skin care compositions for treating sunburn. Final Action 8. The Examiner concludes that it would have been obvious to modify Röder's composition, which is applied to the skin, by including octyldodecanol as an emollient to condition the skin, in order to "produc[e] an improved antipruritic composition with skin conditioning effects." *Id.* at 8–9. We agree with and adopt the Examiner's fact-finding and conclusion.

Appellant argues that "octyldodecanol is only one of hundreds of useful emollients (according to HERSTEIN materials for the relief of dryness, as well as for the protection of the skin) which may optionally be present in the ascorbic acid containing compositions of HERSTEIN."

Appeal Br. 22. Appellant argues that "[t]here is no statement in HERSTEIN which would motivate one of ordinary skill in the art to incorporate an emollient and, specifically, octyldodecanol, in a composition according to RODER." *Id.*

These arguments are unpersuasive. Herstein discloses topical cosmetic or pharmaceutical emulsion compositions. Herstein 2:66–67. Herstein states that emollients are used for "prevention or relief of dryness, as well as for the protection of the skin." *Id.* at 7:48–50. Herstein also states that "[a] wide

variety of suitable emollients are known,” including 2-octyl dodecanol. *Id.* at 8:50–51, 9:21. Thus, as the Examiner found, it would have been obvious to include octyldodecanol in Röder’s composition for its known functions of preventing or relieving dryness and protecting skin. The fact that many other emollients might also have been suitable for inclusion in Röder’s composition does not make octyldodecanol a nonobvious choice.

With regard to claim 41, Appellant argues that the emollients disclosed by Herstein include glycerol, which “appears to be the only emollient which is employed in the Examples of HERSTEIN.” Reply Br. 5.¹¹ Appellant points out that “claim 33, from which newly rejected claim 41 depends, already contains glycerin” and “it is not seen that [one of ordinary skill in the art] would have added not only glycerin, i.e., one of the preferred emollients of HERSTEIN, but additionally also a less preferred emollient and in particular, octyldodecanol, to the compositions of RODER.” *Id.*

This argument is unpersuasive. Herstein suggests using “at least one pharmaceutically/cosmetically acceptable emollient,” and thus expressly contemplates using two or more emollients together. Herstein 7:43–44. In addition, Appellant’s argument that glycerin is the only emollient used in Herstein’s exemplary compositions does not appear to be supported by the reference. Herstein discloses that emollients include dimethicone and trimethicone, vegetable oils, C₁–C₂₀-alkyl esters of fatty acids having 10 to 20 carbons such as stearates, and lecithin. *Id.* at 7:66–67, 8:1–2, 8:7–8, 8:51. Herstein’s Example 2 composition contains lecithin, octyl stearate,

¹¹ The separate argument with respect to claim 41 in the Reply Brief is in response to new grounds of rejection of claim 41 in the Answer.

hydrogenated vegetable oil, phenyl trimethicone, and dimethicone 200. *Id.* at 12:30, 31, 33, 35, 36. Thus, Appellant's position that Herstein would not have made obvious the use of more than one emollient is unpersuasive.

Obviousness: Röder, Klein, Bazin, Cohen, Lapidus, and Herstein

Claims 26, 28, 29, and 41 stand rejected as obvious based on Röder, Klein, Bazin, Cohen, Lapidus, and Herstein. The Examiner finds that "Herstein teaches using antioxidants to treat various skin conditions including sunburn. Herstein teaches coenzyme Q10 [as recited in claim 28] is a preferred antioxidant. See Example 2, which is in the form of O/W emulsion which also contains glycerin, butylene glycol, glyceryl stearate, PEG-1000 stearate and UV filters [as recited in claim 29]." Final Action 9. The Examiner concludes that it would have been obvious "to modify the teachings of the references by incorporating to the antipruritic compositions coenzyme Q10 and UV filters as motivated by Herstein." *Id.* at 10. Specifically, Herstein "teaches coenzyme Q10 is a well-known antioxidant useful in topical skin protection compositions," and suggests using UV filters to protect the skin from sunburn. *Id.*

We agree with the Examiner's fact-finding and conclusion. As the Examiner found Herstein suggests including sunscreens (i.e., UV-A or UV-B filters) in its composition, as well as antioxidants such as coenzyme Q10. Herstein 9:19–35, 9:65 to 10:5. Herstein also exemplifies a composition comprising coenzyme Q10 and the sunscreens benzophenone-3 and octyl methoxycinnamate. *Id.* at 12:10–50, 11:32–35. Therefore, it would have been obvious to include coenzyme Q10 and a UV-A or UV-B filter in

the composition made obvious by Röder, Klein, Bazin, Cohen, and Lapidus for their known functions in skin care compositions.

Appellant argues that “the Examiner has failed to provide any explanation as to what would have prompted one of ordinary skill in the art to include coenzyme Q10 and/or UV-A or UV-B filters and/or octyldodecanol into an antipruritic composition according to RÖDER.” Appeal Br. 23.

This argument is not persuasive. As discussed previously, Herstein discloses that octyldodecanol is an emollient known to be suitable in skin care compositions, and therefore it would have been obvious to include it in Röder’s composition for its known function of preventing or treating skin dryness. Likewise, Herstein discloses that coenzyme Q10 is an antioxidant known to be useful in skin care compositions, making its inclusion in Röder’s composition obvious for its known function of preventing oxidative reactions.

In addition, while Appellant focuses on the antipruritic activity of Röder’s composition, Röder discloses that its composition also prevents development of erythema (sunburn) after UV exposure. Röder 2:14–15. Thus, it would have been obvious to include a UV-A or UV-B filter (i.e., sunscreen) in Röder’s composition for its known property of preventing sunburn after UV exposure.

Appellant argues that “[o]ne must also take into consideration here that one of ordinary skill in the art would clearly not expect an acid such as ascorbic acid to have any favorable effect on itching skin (but rather the opposite).” Appeal Br. 24.

This argument is unpersuasive because the rejection is not based on combining Herstein’s entire composition with Röder’s; rather the Examiner cites Herstein as evidence that coenzyme Q10 and UV-A/UV-B filters were known in the art for use in skin care compositions, and therefore would have been obvious to include in Röder’s composition for their known functions.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
21, 23–25, 27, 30, 32, 33, 36	103(a)	Röder, Klein, Bazin, Cohen, Lapidus	21, 23–25, 27, 30, 32, 33, 36	
22, 34, 35, 37, 38, 40	103(a)	Röder, Klein, Bazin, Cohen, Lapidus, Flick	22, 34, 35, 37, 38, 40	
26, 28, 29, 41	103(a)	Röder, Klein, Bazin, Cohen, Lapidus, Herstein	26, 28, 29, 41	
39, 41	103(a)	Röder, Klein, Bazin, Cohen, Lapidus, Flick, Herstein	39, 41	
Overall Outcome			21–30, 32–41	

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED