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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* RITA EL-KHOURI

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Appeal 2019-001534  
Application 15/144,622<sup>1</sup>  
Technology Center 1600

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Before RYAN H. FLAX, DAVID COTTA, and  
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims relating to liquid lipstick compositions capable of forming a multilayer structure after application to lips. The Examiner rejected the claims on appeal as anticipated under 35 U.S.C. § 102(a)(1), as obvious under 35 U.S.C. § 103(a), and under 35 U.S.C. § 112 as failing to comply with the written description requirement.

We reverse.

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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. According to Appellant, the real party in interest is L’Oreal. Appeal Br. 1.

## STATEMENT OF THE CASE

The Specification discloses that “[m]any cosmetic compositions . . . have been formulated in an attempt to possess long wearing properties upon application,” but “many of these compositions do not generally possess both good long-wear/transfer-resistance properties as well as good application properties, good comfort properties and/or good appearance properties (for example, shine, gloss or matte properties).” Spec. ¶ 3. For example, the Specification explains that silicone resins were “known to provide good long wear properties and/or transfer-resistance,” but products containing such resins “possess poor application properties, poor feel upon application (for example, feel rough) and poor shine or gloss.” *Id.* ¶ 4. To address this problem, previously, “a second composition (topcoat) [was] separately applied to such products to improve poor properties of the compositions to make the products acceptable to consumers.” *Id.* However, such a “topcoat composition [had to] be reapplied continually . . . meaning that the products are effectively not ‘long-wearing’ as they require constant maintenance and reapplication.” *Id.* Thus, according to the Specification, “there remains a need for improved ‘single step’ liquid lipstick compositions having improved cosmetic properties, particularly good wear, feel, shine, gloss and/or matte characteristics upon application.” *Id.* ¶ 6.

The Specification discloses “a care and/or makeup and/or treatment composition for lips which has good cosmetic properties such as, for example, good adhesion, transfer-resistance, feel, gloss (or shine), and/or matte upon application, and which can be applied to lips without having to engage in a multi-step application process.” *Id.* ¶ 7. The disclosed compositions are “capable of forming a multilayer structure after application

to lips,” which “allow[s] for benefits associated with multilayer liquid lipstick products without having to engage in a multi-step application process.” *Id.* ¶ 2.

Claims 1, 2, and 4–20 are on appeal. Claim 1 is representative and reads as follows:

1. A liquid lipstick composition capable of forming a multilayer structure after application to lips,  
wherein the liquid lipstick composition comprises at least two immiscible components prior to application,  
wherein the at least two immiscible components are:  
Component A which comprises 15% to 60% by weight with respect to the total weight of the composition of at least one film forming agent having at least one glass transition temperature which is lower than normal human body temperature; and  
Component B which comprises 0.01% to about 80% by weight with respect to the total weight of the composition of one or more silicone compounds in amounts sufficient to achieve a viscosity of 1000 cSt to 900,000 cSt,  
wherein the weight ratio of film forming agent(s) in Component A to silicone compound(s) in Component B is from 50:1 to 1:2.  
wherein Component A and Component B are separated in the liquid lipstick composition, and  
wherein the liquid lipstick composition contains no fluorinated compound.

Appeal Br. 14 (Claims App.).

The claims stand rejected as follows:<sup>2</sup>

Claims 1, 2 and 4–20 were rejected under 35 U.S.C. § 112 for failure to comply with the written description requirement.

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<sup>2</sup> In the Examiner’s Answer, the Examiner withdrew the obviousness-type double patenting rejections over Application Nos. 15/144,698, 15/144,716, 15/253,071, and 15/253,114. Ans. 3.

Claims 1, 2, 4, 5, and 7–12 were rejected under 35 U.S.C. § 102(a)(1) as anticipated by Lu.<sup>3</sup>

Claims 1, 2, 4–20 were rejected under 35 U.S.C. § 103 as obvious over the combination of Lu and Mendoza.<sup>4</sup>

#### CLAIM CONSTRUCTION

We begin our analysis by construing the claims. Each of the pending claims requires that the liquid lipstick composition comprises “at least two immiscible components.” Appellant contends that the ordinary meaning of immiscible, as reflected in the Merriam-Webster online dictionary, is “incapable of mixing or attaining homogeneity.” App. Br. 7. This definition is consistent with the usage of immiscible in the Specification, which teaches that immiscible components have characteristics that render them incompatible. Spec. ¶ 9 (“Preferably, immiscibility of the immiscible components results from an incompatibility between the two components . . . .”); *id.* ¶¶ 42–44 (identifying characteristics which can cause components to be immiscible). However, the “immiscible” components may, under some circumstances, be capable of “mixing or attaining homogeneity.” The Specification teaches that the immiscible components can be mixed temporarily. Spec. ¶ 45 (“Immediately prior to application and/or during application to a lip, the composition of the present invention is mixed or blended such that Component A and Component B are temporarily miscible . . . .”). Similarly, the Examiner finds that immiscible components can be present in a homogenous mixture when stabilizers are added to the

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<sup>3</sup> Lu et al., US Patent Publication No. 2005/0201961 A1, published Sept. 15, 2005 (“Lu”).

<sup>4</sup> Mendoza, US Patent Publication No. 2013/0164229 A1, published June 27, 2013 (“Mendoza”).

mixture. Ans. 5 (finding that Lu discloses an emulsion comprised of two immiscible components whose “homogeneity is due to the presence of stabilizers, such as surfactants” and noting that “without stabilizers the two phases would separate out”). Accordingly, we construe the term “immiscible components” to refer to components that, in the absence of stabilizers, are incapable of forming a stable homogeneous mixture.

Each of the pending claims also requires that the “at least two components” are “separated in the liquid lipstick composition.” We understand the term “separated” as used in this limitation to require that the two components are distinct from each other and not intermingled or mixed together. This is consistent with the ordinary meaning of “separate” and with how the term “separate” is used in the Specification. *Id.* ¶¶ 46–47 (describing how the Component A “separates from” Component B to form a multilayer structure comprising Layer A and Layer B).

The Examiner contends that the requirement that the two components be “separated” must mean more than that the components are separated based on the immiscibility of two components in the same container because otherwise the “separated” limitation would be redundant of the “immiscible” limitation. Ans. 4. Accordingly, the Examiner contends that the “separated” limitation “reads on a physical separation, such as two separate containers.” Ans. 4. We are not persuaded.

Each of the claims at issue requires that the at least two components be separated “in the liquid lipstick composition.” If the components were separated in two different containers, they would not be “in the liquid lipstick composition.” Moreover, the “separated” limitation need not be interpreted to encompass separation in two different containers to avoid

redundancy. The Specification makes clear that the immiscible components can be temporarily mixed. Spec. ¶ 45 (disclosing that Components A and B may be “temporarily miscible”). Such temporarily mixed components are not “separated,” i.e., distinct from each other and not intermingled or mixed together. Additionally, the prior art teaches that immiscible components can form a homogeneous mixture when stabilizers are added. Ans. 5 (discussing Lu’s disclosure of a homogenous emulsion containing two immiscible components and stabilizers). Such mixtures of immiscible components would not meet the “separated” limitation. Thus, the “separated” limitation is not redundant of the “immiscible” limitation.

#### ANTICIPATION

“[U]nless a prior art reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). 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.” Appellant has persuaded us that the Examiner has not carried the burden of establishing that the claimed invention was anticipated by the cited art.

Lu discloses compositions comprising at least one silicone resin film former and at least one copolymer. Lu, Abstract. These compositions may be used as “lip compositions.” *Id.* ¶¶ 2, 9. In finding that Lu anticipates claims 1, 2, 4, 5, and 7–12, the Examiner found that Lu’s compositions include two immiscible components. Ans. 4 (finding that Lu disclosed a

formulation in the form of “an emulsion, meaning droplets dispersed in a fluid, i.e., two immiscible components”). However, the Examiner does not explain how those two components meet the requirement of claim 1 that they be “separated in the liquid lipstick composition.” Ans. 4–5. Indeed, the Examiner characterizes Lu’s immiscible components as forming a homogeneous emulsion. *Id.* (finding that Lu was “directed to a homogenous formulation” and stating that “[t]he Examples of Lu et al. show that the components are combined together and homogenized, i.e., mixed.”). As the components of a homogeneous composition are not “separated,” the Examiner has not carried the burden to establish that Lu discloses at least two immiscible components that are “separated in the lipstick composition.” Accordingly, we reverse the Examiner’s rejection of claims 1, 2, 4, 5, and 7–12 as anticipated by Lu.

#### OBVIOUSNESS

The Examiner finds 1, 2, and 4–20 obvious over the combination of Lu and Mendoza. In finding claims 1, 2, and 4–20 obvious, the Examiner applied Lu as discussed in connection with the anticipation rejection and did not rely upon Mendoza to address the deficiencies discussed above. Final Act. 7–9.<sup>5</sup> Accordingly, we reverse the Examiner’s rejection of claims 1, 2, and 4–20 as obvious over the combination of Lu and Mendoza for the reasons discussed in connection with the Examiner’s anticipation rejection.

#### WRITTEN DESCRIPTION

The Examiner found that claims 1, 2, and 4–20 fail to comply with the written description requirement because “there is no recitation [in the Specification] that the components are separated in the liquid lipstick

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<sup>5</sup> Office Action mailed December 11, 2017 (“Final Act.”).

composition.” Final Act. 3. The Examiner found that the disclosure of immiscible components in the Specification was not sufficient to support claims to separated components. *Id.* The Examiner acknowledged that the Specification discloses “phase separated bulk,” but found this phrase ambiguous, concluding that “at best” it “mean[s] that the composition has phase separation.” Ans. 3. We are not persuaded.

A description adequate to satisfy 35 U.S.C. § 112, first paragraph, must “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (internal quotation omitted, alteration in original). “[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* “If . . . the specification contains a description of the claimed invention, albeit not *in ipsius verbis* (in the identical words), then the examiner . . . , in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient.” *In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996).

Here, the Specification discloses various characteristics that may cause the two immiscible components to be incompatible with each other. Spec. ¶¶ 42–44. The Specification then states “it is believed that interfacial tension of Components A and B affects phase separation (in particular, the rate at which the Components A and B separate after application).” *Id.* ¶ 53. By singling out post-application separation with the words “in particular,” this sentence supports that phase separation may also occur in other circumstances, e.g., before application. Consistent with this interpretation,

the Specification also discloses that “[i]mmediately prior to application and/or during application to a lip, the composition of the present invention is mixed or blended such that Component A and Component B are temporarily miscible.” *Id.* ¶ 45. This also supports that the components are separate prior to application of the formulation to the lip because there would be no need to mix or blend the components if they were already mixed. Finally, the Specification discloses that the compositions were “visually assessed for homogeneity, phase separation, and any additional visual attributes” and that the “inventive samples . . . had a phase separated bulk.” *Id.* ¶¶ 251–254. This supports compositions in which the components are phase separated. Taken together, these disclosures are sufficient to convey to those of skill in the art that the inventors had possession of compositions in which the two immiscible components were “separated.” Accordingly, we reverse the Examiner’s rejection of claims 1, 2, and 4–20 for failure to comply with the written description requirement.

### CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 2, 4, 5, 7–12	102(a)	Lu		1, 2, 4, 5, 7–12
1, 2, 4–20	103(a)	Lu, Mendoza		1, 2, 4–20
1, 2, 4–20	112	Written description		1, 2, 4–20
<b>Overall Outcome</b>				1, 2, 4–20

REVERSED