



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/893,243	11/23/2015	Yasuko Nagamatsu	085507-536621	9554
30678	7590	09/12/2019	EXAMINER	
POL SINELLI PC (DC OFFICE) 1000 Louisiana Street Suite 6400 HOUSTON, TX 77002			CHANG, KYUNG SOOK	
			ART UNIT	PAPER NUMBER
			1613	
			NOTIFICATION DATE	DELIVERY MODE
			09/12/2019	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocketing@polsinelli.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YASUKO NAGAMATSU, DIDIER CANDAU,
BENJAMIN KEUFER, and CHONG WEI ZHANG
(APPLICANT: L'OREAL)

Appeal 2019-001760
Application 14/893,243¹
Technology Center 1600

Before DONALD E. ADAMS, FRANCISCO C. PRATS, and
JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This Appeal under 35 U.S.C. § 134(a) involves claims 1, 3–8, 10–15, 17, 18, and 20–22 (App. Br. 2). Examiner entered rejections under 35 U.S.C. § 102(a)(2) and 35 U.S.C. § 103. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Appellants identify “L'OREAL” as the real party in interest (Appellants’ August 22, 2018 Appeal Brief (App. Br.) 2).

STATEMENT OF THE CASE

Appellants' disclosure "relates to novel composite particles based on mineral UV-screening agent and perlite" (Spec.² 1: 4–5). Claims 1 and 4 are representative and reproduced below:

1. Composite particles for screening out UV radiation, containing at least:

i) a matrix comprising perlite particles, wherein the perlite particles have an untamped apparent density at 25°C ranging from 10 to 400 kg/m³ and

ii) mineral UV-screening agent particles with a mean elementary size of less than 0.1 μm,

wherein said particles of the mineral UV-screening agent are *included in said matrix*.

(App. Br. 16 (emphasis added).)

4. The particles according to claim 1, wherein the mineral UV-screening agent is titanium dioxide (TiO₂).

(*Id.*)

Grounds of rejection before this Panel for review:

Claims 1, 3, 4, 6, 10–13, and 15–18 stand rejected under 35 U.S.C. § 102(a)(2) as anticipated by Jones,³ as evidenced by Perlite.⁴

² Appellants' November 23, 2015 Specification.

³ Jones, US 8,585,818 B1, issued Nov. 19, 2013.

⁴ Perlite.info, *Basic Facts About Perlite*, available at <http://www.perlite.info/hbk/0031401.htm> (last accessed Sept. 29, 2017).

Claims 1, 3–8, 10–18, and 20–22 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of Jones, Perlite, Lemal,⁵ and Bujard.⁶

Anticipation:

ISSUE

Does the preponderance of evidence on this record support Examiner’s finding that Jones, as evidenced by Perlite, teaches Appellants’ claimed invention?

ANALYSIS

Examiner finds that Appellants’ claimed invention is anticipated by Jones, as evidenced by Perlite (Final Act.⁷ 3–5). We are not persuaded.

Appellants disclose that in “a first variant [of their disclosure], composite particles contain a matrix consisting of perlite particles, in which matrix particles of mineral UV-screening agent are included. According to this embodiment, the matrix has inclusions and particles of mineral UV-screening agent are placed *in* the inclusions of the matrix” (Spec. 4: 8–11; *cf. id.* at ll. 12–15 (“According to a second variant [of Appellants’ disclosure], the composite particles contain a matrix consisting of perlite particles, the said matrix being *partially or totally covered* with at least one layer of mineral UV-screening agent which may be connected to the matrix by means of a binder” (emphasis added))). Consistent with Appellants’ disclosed first embodiment, Appellants’ claims require, *inter alia*, that

⁵ Fageon et al., WO 2013/068236 A1, published May 16, 2013. Examiner and Appellants refer to this document as Lemal (*see* App. Br. 10), we do the same.

⁶ Bujard et al., US 2011/0269845 A1, published Nov. 3, 2011.

⁷ Examiner’s February 28, 2018 Final Office Action.

mineral UV-screening agent particles are *included in a matrix* comprising perlite particles (*see e.g.*, App. Br. 16).

Because Appellants' disclosure makes clear that the UV-screening agent is placed *in* the inclusions of the perlite particles, we are not persuaded by Examiner's assertion that Appellants' Specification "did not specifically define the term 'included in'" and "there seems to be no significant difference between 'included' and 'included in'" (Ans.⁸ 5; *see also* Final Act. 3 (Examiner finds that a "cosmetic composition comprising [] *coated* perlite flakes . . . reads on [Appellants'] claimed UV particles included in [a] matrix comprising perlite because 'include' generally means 'contained as part of whole being considered'" (emphasis added)); Final Act. 6 (Examiner finds that "regardless that the UV-screen particles are present inside and outside of the matrix, the recited term 'included' means 'the UV-screen particles are present with a matrix comprising perlite,' unless the applicant further defines the term"))).

Therefore, we are not persuaded by Examiner's finding that Jones' disclosure of "coated perlite particles" anticipates Appellants' claimed invention (*see* Final Act. 3–5; *see also id.* at 3 (Examiner finds that "Jones teaches [] coated perlite flakes (title) in which the coated perlite flakes comprise composite particles containing at least perlite flakes and [TiO₂] nanoparticles ([Jones,] col. 2, lines 3-6 and claim 9)" (emphasis omitted)); *cf.* App. Br. 6 ("Jones does not disclose or suggest a composition wherein mineral UV-screening agent particles are included **in** a matrix of perlite particles," as required by Appellants' claimed invention"); Jones 1: 5–8

⁸ Examiner's October 18, 2018 Answer.

(Jones “relates to effect pigments that are *coated* perlite flakes comprising perlite flakes with layer of tinc oxide, then a layer of titanium dioxide, and then a layer of iron oxide”) (emphasis added)).

We recognize Examiner’s discussion of Jones’ method of preparing coated perlite particles (*see* Ans. 4–5 (citing Jones’ Example 1 and Fig. 1)) and intimation that Jones’ preparation method is the same or similar to the preparation method exemplified in Example 4 of Appellants’ Specification. To the extent that the method of preparing coated perlite particles exemplified in Jones’ Example 1 relates to Appellants’ Example 4, we note that Appellants disclose, as an alternative embodiment of their disclosure, a “matrix [of perlite particles] being partially or totally covered[, i.e. coated,] with at least one layer of mineral UV-screening agent which may be connected to the matrix by means of a binder” (*see* Spec. 4: 13–15). Examiner failed to establish an evidentiary basis on this record to support a finding that Example 4 of Appellants’ Specification, as relied upon by Examiner, is an exemplification of their claimed invention as opposed to an exemplification of an alternative embodiment of their disclosure. Thus, Examiner failed to establish an evidentiary basis on this record to support a finding that Jones’ method of preparing coated perlite particles will necessarily result in Appellants’ claimed invention (*see* App. Br. 9 (Appellants contend “[t]o the extent inherency might be relied upon, . . . [i]nherency requires that the recited results or structure must necessarily be obtained not merely that it might be achieved.”)). *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citing *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991)) (Inherent anticipation

requires that the missing descriptive material is “necessarily present,” not merely probably or possibly present, in the prior art.).

Examiner’s reliance on Perlite to support a finding that Jones’ coated perlite particles will necessarily have an untamped apparent density at 25°C ranging from 10 to 400 kg/m³, as required by Appellants’ claimed invention, fails to make up for the foregoing deficiency in Jones, as relied upon by Examiner (*see* Final Act. 6).

For the reasons set forth above, Examiner failed to establish an evidentiary basis on this record to support a finding that Jones, as evidenced by Perlite, anticipates Appellants’ claimed invention.

CONCLUSION

The preponderance of evidence on this record fails to support Examiner’s finding that Jones, as evidenced by Perlite, teaches Appellants’ claimed invention. The rejection of claims 1, 3, 4, 6, 10–13, and 15–18 under 35 U.S.C. § 102(a)(2) as anticipated by Jones, as evidenced by Perlite is reversed.

Obviousness:

ISSUE

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

ANALYSIS

Examiner relies on Jones as discussed above (*see* Final Act. 8). Examiner finds that Jones does not disclose perlite particles in porous expanded form, perlite particles having D50 size of less than 20µm or D90 size of less than 55 µm, a cosmetic composition in the form of an oil-in-

water emulsion characterized by drops of 1 to 10 μm in size, or the treatment of signs of ageing of a keratin material, and relies on the combination of Lemal and Bujard to make up for these deficiencies in Jones (*see* Final Act. 8–11). Therefore, based on the combination of Jones, Perlite, Lemal, and Bujard, Examiner concludes that, at the time Appellants’ invention was made, it would have been *prima facie* obvious “to adjust or optimize the [mean diameter] D50 of Jones with the claimed D50 range of less than 20 microns” or to a “particle size [distribution such that 90% by weight of the particles are] . . . less than 55 microns,” “provide [Jones’ coated perlite particles in an] oil-in-water emulsion having drops 1-10 microns in size,” and “apply the composition of Jones to [Lemal’s] method of use, e.g., limiting the darkening of skin, treating signs of ageing” (Final Act. 12–13).

As Appellants explain, however, Lemal and Bujard do not overcome the deficiency in Jones, as evidenced by Perlite, discussed above (*see* App. Br. 12 (Appellants contend that “Lemal does not overcome the . . . deficiencies of Jones as evidence by Perlite”); *id.* at 13 (Appellants contend that “Bujard does not overcome the . . . deficiencies of Jones as evidence by Perlite in view of Lemal”); *cf.* Ans. 7 (“Regarding [Appellants’] arguments against Jones’ structure having no ‘included in’ feature, the Examiner responded as noted” in the response to the anticipation rejection)). On this record, we find that Examiner failed to establish an evidentiary basis to support a conclusion that the combination of Lemal and Bujard makes up for the deficiencies in the combination of Jones, as evidenced by Perlite.

CONCLUSION

The preponderance of evidence relied upon by Examiner fails to support a conclusion of obviousness. The rejection of claims 1, 3–8, 10–18,

Appeal 2019-001760
Application 14/893,243

and 20–22 under 35 U.S.C. § 103 as unpatentable over the combination of Jones, Perlite, Lemal, and Bujard is reversed.

REVERSED