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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* STEPHANIE VON DER FECHT,  
SVENJA LENA MOELLGAARD, PETRA KOCH, and ISABEL BALCKE

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Appeal 2019-003580  
Application 14/376,977  
Technology Center 1600

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Before JEFFREY N. FREDMAN, DEBORAH KATZ, and  
JOHN G. NEW, *Administrative Patent Judges*.

KATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

*Introduction*

Appellant<sup>1</sup> seeks our review, under 35 U.S.C. § 134(a), of the Examiner’s decision to reject claims 40–59 (Appeal Brief filed October 19, 2018 (“App. Br.”) 6, 10.)

We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

*Introduction*

Appellant’s Specification provides a water-in-oil (W/O) emulsion comprising at least two W/O emulsifiers and at least one oil with a spreadability value greater than 600 mm<sup>2</sup>/10 min. (Specification dated August 6, 2014 (“Spec.”) 1:3–5.) The Specification discloses that polyethylene glycol (“PEG”) based emulsifiers are known for stabilizing W/O emulsions and are commonly used in cosmetic products. (*See* Spec. 2:5–11.) However, consumers desire products that are free of PEG-based emulsifiers, due PEG’s lack of photo-stability and concerns about increased skin permeability to harmful substances. (*See* Spec. 2:13–23.) The Specification discloses that “[s]urprisingly, by using two W/O emulsifiers according to the invention in combination with the readily spreadable oils, it has been possible to” provide readily distributable lotions without using PEG emulsifiers. (Spec. 6:24–7:3.)

Appellant’s claim 40 recites:

A cosmetic and/or dermatological preparation,  
  
wherein the preparation is flowable at room temperature  
and is a water-in-oil emulsion comprising

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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. Appellant identifies the Real Party in Interest as Beiersdorf AG. (*See* App. Br. 3.)

(i) at least two W /O emulsifiers

and from 5 % to 30 % by weight, based on a total weight of the preparation, of (ii) two or more oils having a spreadability value greater than 600 mm<sup>2</sup>/10 min. and/or at least one oil having a spreadability value greater than 1000 mm<sup>2</sup>/10 min.

(App. Br. 15.) Appellant's independent claim 57 is substantially similar to claim 40, and includes the limitations that the W/O emulsifiers differ in their HLB value by at most 0.5, at least one oil having a spreadability value greater than 1000 mm<sup>2</sup>/10 min., and from 10% to 15% by weight glycerol.

(App. Br. 17–18.) Appellant separately argues dependent claims 46, 52, and 59, which we address below. (App. Br. 9, 11.)

The Examiner rejects the claims<sup>2</sup> under 35 U.S.C. § 103(a)(pre-AIA) as follows (Final Office Action mailed March 22, 2018 (“Final Act.”) 5, 8):

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<sup>2</sup> The Examiner withdrew a rejection under 35 U.S.C. § 112, fourth paragraph, in view of the After-Final Amendment dated May 21, 2018. (Advisory Action mailed June 5, 2018.)

<b>Claims</b>	<b>References</b>	<b>Final Office Action Citation</b>
40, 42–45, and 47–55	Bleckmann <sup>3</sup>	5–8
41, 46, and 56–59	Bleckmann, Suzuki, <sup>4</sup> and Degussa <sup>5</sup>	8–10

### *Analysis*

#### *Claims 40, 42–45, and 47–55*

The Examiner finds that Bleckmann teaches water-in-silicone emulsions used for flowable lotions, comprising two emulsifiers and a lipid phase. (Final Act. 5–6, citing Bleckmann ¶¶ 17, 18, 64–66.) The Examiner finds Bleckmann teaches the lipid phase includes a silicone oil, e.g., cyclomethicone, and additional oils, e.g., isopropyl palmitate, isopropyl myristate, dicaprylyl carbonate, isopropyl stearate, isohexadecane, and dicaprylyl ether, and mixtures thereof. (*Id.*, citing Bleckmann ¶¶ 21–34, 66.) The Examiner finds that Appellant’s Specification discloses that the oils taught by Bleckmann have spreadability of greater than 600 mm<sup>2</sup>/10 min., or greater than 1000 mm<sup>2</sup>/10 min. (*Id.* at 6, citing Spec. 10, Table 1.) For example, cyclomethicone has a spreadability of 804–845 mm<sup>2</sup>/10 min.,

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<sup>3</sup> Bleckmann et al., US 2005/0002888 A1, published January 6, 2005.

<sup>4</sup> David Suzuki Foundation, *The Dirty Dozen: PEG Compounds and their Contaminants* (2018), available at: <https://david Suzuki.org/queen-of-green/dirty-dozen-peg-compounds-contaminants/> (accessed September 20, 2019).

<sup>5</sup> Degussa, *ISOLAN GPS Technical Datasheet* (2003), also available at: [http://glenncorp.com/wp-content/uploads/2013/11/DS\\_ISOLAN\\_GPS\\_e.pdf](http://glenncorp.com/wp-content/uploads/2013/11/DS_ISOLAN_GPS_e.pdf) (accessed September 20, 2019).

isopropyl palmitate has a spreadability of 625 mm<sup>2</sup>/10 min., and dicaprylyl ether has a spreadability of 1020 mm<sup>2</sup>/10 min. (Spec. 10, Table 1.)

The Examiner finds Bleckmann teaches the oils are present at 20% to 35% based on the total emulsion, which overlaps the claimed range of 5% to 30%. (Final Act. 6, citing Bleckmann ¶ 47.) As to claim 52, which recites that the two or more oils comprise isopropyl palmitate and C<sub>13-16</sub> isoparaffin, the Examiner finds isohexadecane is an adjacent homolog of C<sub>13-16</sub> isoparaffin. (*Id.* at 7.) The Examiner finds that one of ordinary skill in the art would have expected the two oils to have similar emulsion properties, and therefore the use of C<sub>13-16</sub> isoparaffin would have been *prima facie* obvious. (*Id.*)

Appellant argues that Bleckmann's emulsions are water-in-silicone ("W/S") emulsions and not ordinary W/O emulsions. (App. Br. 7.) Appellant argues that the Bleckmann's emulsifiers are suitable for W/S emulsions only. (*See id.*) Appellant argues further that Bleckmann's W/S emulsions require at least 50% by weight silicone in the lipid phase and Bleckmann does not teach combinations of silicone with other oils having the claimed spreadability values. (*See id.* at 7-8.) Appellant generally argues that the exemplified compositions of Bleckmann do not teach a second oil in the lipid phase, or a combination of two emulsifiers. (*See id.* at 7-8.)

We are not persuaded by Appellant's arguments. First, we begin with the alleged distinction between the claimed W/O emulsion and Bleckmann's W/S emulsion. Appellant's Specification discloses cyclomethicone, a silicon oil, as an oil having a spreadability value greater than 600 mm<sup>2</sup>/10

min. Therefore, the broadest reasonable interpretation of the claims, in view of the Specification, encompasses a W/O emulsion containing a silicon oil in the lipid phase, i.e., a W/S emulsion. Additionally, prior art references may be indicative of what those skilled in the art generally believe a certain term means and can often help to demonstrate how a disputed term is used by those skilled in the art. *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999) (internal citations omitted). Degussa refers to “W/O emulsions having high contents of silicon oils (e.g., cyclopentasiloxane).” Degussa 2. Therefore, the prior art supports that a person of ordinary skill in the art would have considered Bleckmann’s W/S emulsions to be a species of a W/O emulsion. “It is well settled that a generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus.” *In re Slayter*, 276 F.2d 408, 411 (CCPA 1960).

Second, we address Appellant’s arguments that Bleckmann’s exemplified compositions do not include a second oil in the lipid phase, or a combination of two emulsifiers. In other words, Appellant seeks to limit Bleckmann’s teachings to the preferred embodiments. However, a reference must be considered for everything that it teaches, not simply the described invention or a preferred embodiment. *In re Applied Materials, Inc.*, 692 F.3d 1289, 1298 (Fed. Cir. 2012). Bleckmann teaches the silicon oil content of the lipid phase can be 50 to 100% by weight. (Bleckmann ¶ 34.) Accordingly, up to 50% of the lipid phase may include other oils, including those having a spreadability value greater than 600 mm<sup>2</sup>/10 min. and greater than 1000 mm<sup>2</sup>/10 min. The additional oils taught by Bleckmann include those encompassed by the claims. Although Bleckmann discloses numerous

potential combinations for preparing flowable cosmetic lotions, “disclos[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.” *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989). Likewise, Bleckmann expressly teaches any desired mixtures of two emulsifiers for the compositions, and is not limited to only one emulsifier as disclosed in some of the exemplified compositions. (Bleckmann ¶ 17.) Accordingly, we are not persuaded that the Examiner erred.

Appellant argues further that the Examiner has not provided a motivation to select the specific oils of claim 52, isopropyl palmitate and C<sub>13-16</sub> isoparaffin, from the “virtually infinite number of combinations” taught by Bleckmann. (App. Br. 9.) As discussed above, Bleckmann teaches compositions for preparing flowable cosmetic lotions, i.e., the identical purpose of the claimed invention. Therefore, disclosing a multitude of effective combinations does not render any particular formulation taught by Bleckmann less obvious. *Merck*, 874 F.2d at 804. Moreover, the “combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). The Examiner has shown that Bleckmann would have motivated one of ordinary skill in the art prepare flowable cosmetic lotions by combining familiar elements according to known methods. Therefore, we are not persuaded that the Examiner erred.

*Claims 41, 46, and 56–59*

Independent claim 57 includes the limitations that: 1) the emulsifiers differ in their HLB value by at most 0.5; 2) at least one of the oils has a spreadability value greater than 1000 mm<sup>2</sup>/min.; and 3) that the preparation includes from 10% to 15% by weight glycerol. (App. Br. 17–18.) Claims 46 and 59 recite a combination of diisostearoyl polyglyceryl-3 dimer dilinoleate and polyglyceryl-4 diisostearate polyhydroxystearate sebecate as W/O emulsifiers. (App. Br. 16, 18.)

The Examiner finds that Bleckmann teaches compositions including moisturizers, e.g., glycerol at 5% to 25% (Final Act. 8, citing Bleckmann ¶¶ 44–46, 66.) The Examiner finds Bleckmann teaches oils having spreadability greater than 1000 mm<sup>2</sup>/10 min., e.g., dicaprylyl ether. (*See above.*) The Examiner finds Bleckmann does not teach that the emulsifiers differ in their HLB by at most 0.5. (Final Act. 8.)

The Examiner finds that Suzuki teaches PEG containing compounds may act as penetration enhancers allowing for absorption of harmful ingredients, and may be contaminated with carcinogens. (*Id.* at 9, citing Suzuki 1.) The Examiner finds Degussa teaches that polyglyceryl-4 diisostearate/ polyhydroxystearate/sebecate (“ISOLAN GPS”) is a PEG-free W/O emulsifier. (*Id.* at 9, citing Degussa 1.) Degussa teaches ISOLAN GPS can be used for the formulation of light W/O emulsions having high contents of silicone oils. (Examiner’s Ans. mailed February 4, 2019 (“Ans.”) 7, citing Degussa 1.) The Examiner finds that Degussa teaches ISOLAN GPS may be combined with distearoyl polyglyceryl-3 dimer dilinoleate (“ISOLAN PDI”) to obtain W/O emulsions with lower viscosity,

and that the HLB values of both of these emulsifiers is about 5. (Final Act. 9, citing Degussa 1.) The Examiner determines it would have been obvious to use the PEG-free emulsifiers in Bleckmann's W/O emulsions to avoid the disadvantages of PEG emulsifiers taught by Suzuki. (*Id.*)

Appellant argues that the two ISOLAN emulsifiers having an HLB of about 5, i.e., polyglyceryl-4 diisostearate/polyhydroxystearate/sebecate and distearoyl polyglyceryl-3 dimer dilinoleate, are structurally completely different from the silicon-containing emulsifiers taught by Bleckmann. (App. Br. 11.) Appellant argues that because the ISOLAN emulsifiers do not contain silicon, there is no reasonable expectation of success in combining the emulsifiers with Bleckmann's W/S emulsions. (App. Br. 12.) Appellant argues further that none of the "exemplified formulations of ISOLAN [Degussa] contain any silicone" and that "only one of the five exemplified compositions of Bleckmann contains more than one emulsifier." (*Id.*) Finally, Appellant argues that Bleckmann's W/S emulsifiers are already PEG-free and therefore, there is no reason for one of ordinary skill in the art to replace these emulsifiers with other PEG-free emulsifiers. (Reply Brief filed April 3, 2019 ("Reply Br.") 5.)

We are not persuaded by Appellant's arguments. Degussa expressly teaches using ISOLAN GPS to formulate W/O emulsions having high contents of silicone oils, as well as lotions with an oil phase contents of 18% to 30%. (Degussa 2.) Bleckmann teaches lotion formulations having high contents of silicone oils and oil phase contents of 20% to 35%. Therefore, Degussa provides express motivation to combine the emulsifiers with Bleckmann's formulations, wherein a person of ordinary skill in the art

would have had a reasonable expectation of success. That both references are directed to formulating PEG-free lotions confirms the Examiner's obviousness determination. "If a person of ordinary skill can implement a predictable variation [of a known work], § 103 likely bars its patentability." *KSR*, 550 U.S. at 417. Accordingly, we sustain the Examiner rejection of claims 40–59 as obvious over the prior art.

### CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
40, 42–45, and 47–55	Bleckmann	40, 42–45, and 47–55	
41, 46, and 56–59	Bleckmann, Suzuki, and Degussa	41, 46, and 56–59	
<b>Overall Outcome</b>		40–59	

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136.

AFFIRMED