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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
14/445,434 07/29/2014 Joseph HARRY JANSEN 13485 7085

27752 7590 06/02/2020
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Table with 1 column: EXAMINER

BASQUILL, SEAN M

Table with 2 columns: ART UNIT, PAPER NUMBER

1613

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

06/02/2020

ELECTRONIC

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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* JOSEPH HARRY JANSEN and PAUL ROBERT TANNER

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Appeal 2019-005728  
Application 14/445,434  
Technology Center 1600

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Before JEFFREY N. FREDMAN, JOHN G. NEW, and  
JAMES A. WORTH, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal<sup>1,2</sup> under 35 U.S.C. § 134 involving claims to a method of improving the look and feel of skin. The Examiner rejected the claims as failing to comply with the written description requirement and as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

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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 The Procter & Gamble Company (*see* App. Br. 1).

<sup>2</sup> We have considered and refer to the Specification of July 29, 2014 (“Spec.”); Final Action of Sept. 11, 2018 (“Final Act.”); Appeal Brief of Apr. 9, 2019 (“Appeal Br.”); Examiner’s Answer of May 23, 2019 (“Ans.”); and Reply Brief of July 23, 2019 (“Reply Br.”). We note the Examiner was affirmed in Appeal 2017-007345, the previous appeal in this application.

*Statement of the Case*

*Background*

Appellant's application "relates generally to a multi-step method of improving the appearance and feel of human skin." Spec. 1:1–2. "More specifically, the method includes applying a finisher composition that has a high powder content and a UV agent as an overlying top layer to an underlying layer of skin care composition, thereby improving the look and feel of the treated skin." *Id.* at 1:2–7.

According to the Specification, particulate materials have the benefit of acting as an opacifying agent with a masking effect, but high levels of powder can be difficult to spread on skin, can be noticeably white, and can flake off skin. *Id.* at 2:4–14. Humectants have the benefits of reducing visible texture and can improve skin strength and function but high levels of glycerin can make skin look shiny and greasy, and glycerin can be thick and slow to absorb into the skin. *Id.* at 2: 15–23. UV agents can protect the skin from sun damage but can have a heavy, oily skin feel. *Id.* at 3:1–3.

The Specification describes a method of skin care based on the application of an underlying layer and a finishing layer (powder layer), where the finishing layer includes an oil-in-water emulsion with a nonvolatile oil (a UV protectant) and spherical particles. *Id.* at 3:5–10, 7:24–8:2, 9:26–10:4. In some embodiments, the finishing composition is free or substantially free of glycerin or other humectants. *Id.* at 3:5–10. The Specification explains that powder may offset the undesirable greasiness associated with oils and may diffuse light. *Id.* at 11: 13–17. According to the Specification, it is important that the particles protrude from the dry film formed by the skin care product in order to create a "rough" film and to

diffuse light and reduce the surface area of the film contacted by the user's hand. *Id.* at 11:28–12:4.

*The Claims*

Claims 1, 20–24, and 26 are on appeal. Independent claim 1 is representative and read as follows:

1. A method of improving the look and feel of skin, comprising:
  - a. applying an underlying layer of a skin care composition to a target portion of skin; and
  - b. applying an overlying layer of a finisher composition on top of the underlying skin care composition layer, wherein the finisher composition is an oil-in-water emulsion comprising
    - i. a continuous aqueous phase that include about 20 to 85% by weight of the finisher composition of water,
    - ii. a dispersed oil phase comprising a non-volatile oil comprising a liquid UV agent, wherein the liquid UV agent is present at an amount of at least 50% by weight of the dispersed oil phase,
    - iii. 10 to 25%, by weight of substantially spherical particles selected from the group consisting of starch particles, silicone elastomer particles and combinations thereof, wherein the substantially spherical particles have a particle size of from about 2 to 40 microns, the substantially spherical particles being sized to protrude from the underlying skin care composition layer,
    - iv. a weight ratio of the non-volatile oil to the substantially spherical particles of about 1:4 to about 1:1,
    - v. optionally, about 1 to 20 wt% of a volatile oil, and
    - vi. wherein the finisher composition is substantially free of glycerin, and comprises less than 1 wt% of a pigment.

*The Issues*

- A. The Examiner rejected claim 24 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement (Final Act. 3).
- B. The Examiner rejected claims 1, 20–24, and 26 under 35 U.S.C. § 103(a) as obvious over Maitra<sup>3</sup> and Rosevear<sup>4</sup> (Final Act. 4–8).

A. *35 U.S.C. § 112(a)*

The Examiner finds “[c]laim 24 specifies that the ‘finisher composition comprises a chroma of less than about 10 according to the Chroma Method,’ which finds no support in the disclosure as originally filed, as the disclosure as originally filed mentions only a chroma value of the first or powder layer” (Final Act. 3).

Appellant contends<sup>5</sup> the Specification “discloses that ‘the chroma value for the first layer or the powder layer is less than about 10 . . . .’ Specification, page 25, lines 12 – 14.” (Appeal Br. 3). Appellant also cites a separate portion of the Specification that “discloses that ‘[t]he second step is applying a second layer, which is a finisher composition comprising high levels of particulate material to provide a suitable powder layer.’ Page 7, lines 25 – 27 of the specification (emphasis added)” (*id.*).

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<sup>3</sup> Maitra et al., US 2009/0148393 A1, published June 11, 2009.

<sup>4</sup> Rosevear et al., US 7,172,754 B1, issued Feb. 6, 2007.

<sup>5</sup> We note that this issue differs from the written description issue in our earlier decision in Appeal 2017-007345 because the claim is limited to a chroma “of less than about 10” here rather than “about 20” in the earlier decision and because Appellant challenges the rejection here and did not challenge the issue in the earlier appeal.

Appellant contends that based on these disclosures: “(i) the finisher composition provides the powder layer; (ii) the powder layer has a chroma of less than 10; and (iii) a method for measuring chroma called the Chroma Method, the amendment to claim 24 does not constitute new matter” (*id.*).

The issue with respect to this rejection is: Does a preponderance of the evidence of record support the Examiner’s finding that the Specification fails to provide descriptive support for the limitation of claim 24 “wherein the finisher composition further comprises a chroma of less than about 10 according to the Chroma Method?”

*Findings of Fact*

1. The Specification teaches “[t]he chroma for the individual layers of the present invention, that is the chroma value for the first layer or the powder layer is less than about 10, preferably less than about 6, and even more preferably less than about 3” (Spec. 25:11–14).

2. The Specification teaches regarding the layers that “[t]here is provided herein a multi-step process where the first step is applying a first layer, which is a skin care product. The second step is applying a second layer, which is a finisher composition comprising high levels of particulate material to provide a suitable powder layer” (Spec. 7:24–27).

*Principles of Law*

“[I]t is the specification itself that must demonstrate possession. And while the description requirement does not demand any particular form of disclosure . . . or that the specification recite the claimed invention in haec verba, a description that merely renders the invention obvious does not satisfy the requirement.” *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010).

*Analysis*

In this case, the Specification and claim 1 both teach a method that involves applying a first skin care product underlayer followed by applying a second finisher compound layer that provides “a suitable powder layer” (FF 2; claim 1). The Specification also explains that for either the first layer or the powder layer, the chroma value preferably “is less than about 10” (FF 1). Because the Specification states the finisher compound layer provides the powder level, we find that the ordinary artisan would have understood the Specification to teach that this finisher layer should have a chroma value “less than about 10” as desired for the powder layer (FF 1). We therefore agree with Appellant that the Specification demonstrates possession of the limitation of claim 24.

*Conclusion of Law*

A preponderance of the evidence of record does not support the Examiner’s finding that the Specification fails to provide descriptive support for the limitation of claim 24 “wherein the finisher composition further comprises a chroma of less than about 10 according to the Chroma Method.”

*B. 35 U.S.C. § 103(a)*

The issue with respect to this rejection is: Does a preponderance of the evidence of record support the Examiner’s conclusion that the combination of Maitra and Rosevear render claim 1 obvious?

*Findings of Fact*

3. Maitra teaches, regarding the preamble of claim 1 to improve the look and feel of skin, “a system of two cosmetic compositions: the first

composition provided to cover blemishes and the second composition to blur lines and wrinkles” (Maitra ¶ 9).

4. Maitra teaches, regarding step (a) of claim 1, “a method of first applying a composition to cover blemishes (basecoat) to a biological surface” (Maitra ¶ 9).

5. Maitra teaches, regarding step (b) of claim 1, “applying a composition to blur lines and wrinkles (topcoat) to the basecoat” where “compositions can be formulated as . . . oil-in-water” emulsions (Maitra ¶¶ 9, 61).

6. Maitra teaches, regarding step (b)(i), that the “aqueous phase may represent from about 0.5 weight% to about 99.99 weight%, based upon the total weight of the composition” (Maitra ¶ 63).

7. Maitra teaches, regarding step (b)(ii), that “sunscreen protects the skin from damaging ultraviolet rays. In an illustrative embodiment of the invention, the sunscreen would provide both UVA and UVB protection . . . The sunscreen may be present from about 1 weight% to about 30 weight% of the total weight of the composition” (Maitra ¶ 78).

8. Maitra teaches, regarding step (b)(iii), that “the diffused topcoat incorporates light diffusing particles made of silica beads having a refractive index of about 1.46” that “is preferably present from about 0.01 weight% to about 50 weight% of the total weight of the composition” (Maitra ¶¶ 28, 30).

9. Maitra teaches, regarding step (b)(iii), that “[p]referably, the total thickness of the topcoat and basecoat combined is less than approximately 20 microns, more preferably between 2.0 and 20 microns in thickness” (Maitra ¶ 35).

10. Maitra teaches, regarding step (b)(v), that the compositions may “comprise an oil phase containing” “silicone oils such as . . . non-volatile, linear or cyclic polydimethylsiloxanes” and “[t]hese oils are usually present in an amount of about 0 weight % to about 90 weight %, preferably from about 1.0 weight% to about 80 weight% by weight of the oil phase” (Maitra ¶¶ 66, 67).

11. Rosevear teaches, regarding the claim 1 preamble, “a cosmetic emulsion composition formulated to decrease facial shine known also as gloss” (Rosevear 1:8–9).

12. Rosevear teaches, regarding step (b)(iii), the use of particles in the cosmetic where “[m]ost preferred as the silicone elastomer is 9045 which has a D5 cyclomethicone swelled elastomer particle size (based on volume and calculated as spherical particles) which averages about 38 micron, and may range from about 25 to about 55 micron” (Rosevear 6:37–41).

13. Rosevear teaches, regarding steps (b)(i) and b(iii), an oil-in-water emulsion with 54% water, 20% silicone elastomer spherical particles with an average size of 38 microns as shown in the table reproduced below:



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Oil-In-Water Base Formula

Component	Weight %
Water	54.00
Elastomer (DC 9045 Silicone Gel)	20.00
Glycerin	9.00
Parsol MCX ® (EthylhexylMethoxyCinnamate)	6.00
Zinc Oxide Powder	2.10
Polysorbate 40	1.62
Cetyl Alcohol	1.55
Silicone Fluid 200/50 cts	1.00
Timiron ® MP-111	1.00
Aristoflex AVC ®	0.80
Glycerol Monostearate	0.78
DC 5225C	0.50
Ganspearl ® GMP 0820 (PMMA)	0.50
Phenoxyethanol	0.40
Fragrance	0.30
Methylparaben	0.20
Glycacil ® L	0.10
Propylparaben	0.10
Disodium EDTA	0.05

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The table above shows the base formula for an oil-in-water cosmetic emulsion (*see* Rosevear 15:5–26).

14. The Examiner calculates, regarding step (b)(ii), that “the liquid sunscreen ethylhexylmethoxycinnamate (synonymous with octyl methoxycinnamate) in concentrations of 6%, and the remainder of the non-volatile oils in the oil phase comprising 1% silicone fluid, 0.78% glycerol monostearate, and 0.5% DC5225, rendering the liquid sunscreen agent greater than 50% of the non-volatile oil phase” (Final Act. 6).

15. The Examiner calculates, regarding the ratio recited in step (b)(iv) of claim 1, that

the compositions of Appellants Claims now require, by calculating the concentration of non-volatile oil which must be present in the compositions on the basis of limitations "iii" and "iv," between 2.5-25% nonvolatile oil (looking to the limitations of the claims which requires that spherical particles present in concentrations of between 10-25% by weight, and non-volatile oil present in weight ratios of non-volatile oil to spherical particles of about I :4 to about I: 1). Concentrations of UV agent present in the composition must therefore fall within the range of at least 1.25 % of the composition as a whole, to at least 25% of the composition as a whole, a range which the 6% ethylhexylmethoxycinnamate of Rosevear falls within and therefore renders obvious.

(Ans. 9).

16. Rosevear teaches: “Humectant may be incorporated into compositions of the present invention. Humectants are normally polyols. Representative polyols include glycerin, diglycerin, polyalkylene glycols and more preferably alkylene polyols” (Rosevear 7:57–60).

17. Rosevear teaches, regarding step (b)(vi), that “examples of particulate materials include colored and uncolored pigments, interference pigments . . . Particulate materials may be present from about 0.01 % to about 20%” (Rosevear 10:62–67).

#### *Principles of Law*

“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). “If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417.

*Analysis*

*Prima facie obviousness*

We adopt the Examiner’s findings of fact and reasoning regarding the scope and content of the prior art (Ans. 4–8; FF 1–17) and agree that claim 1 is rendered obvious by Maitra and Rosevear. We address Appellant’s arguments below.

Appellant contends “[c]laim 1 recites, inter alia, that the liquid UV agent is present at an amount of at least 50% of the dispersed oil phase. The Final Rejection has not shown where this limitation is taught or suggested in Maitra and/or Rosevear” (Appeal Br. 4). Appellant contends that Example VI of Rosevear discloses “an oil-in-water emulsion comprising about 29.33% of an oil phase, which contains 6%, by weight of the composition, of a liquid UV agent . . . the liquid UV agent in Example VI of Rosevear is present at about 20.5% of the oil phase, which is substantially less than the at least 50% required by claim 1” (*id.*). Appellant contends Rosevear teaches “an oil-in-water emulsion comprising about 29.33% of an oil phase (i.e., 20% DC9045, 6% Parsol MCX, 1.55% Cetyl Alcohol, 1% 50 cSt Dimethicone and 0.78% GMS)” (Reply Br. 2–3).

We recognize that claim 1 recites the UV agent “is present in an amount of at least 50% by weight of the dispersed oil phase.” The Examiner also states that the dispersed oil phase components in the Example at issue (FF 13) in Rosevear are “ethylhexylmethoxycinnamate (synonymous with octyl methoxycinnamate) in concentrations of 6%, and the remainder of the non-volatile oils in the oil phase comprising 1% silicone fluid, 0.78% glycerol monostearate, and 0.5% DC5225, rendering the liquid sunscreen agent greater than 50% of the non-volatile oil phase” (FF 14).

While Appellant suggests that the 20% DC9045 should be included as a component of the oil phase, we find this argument unpersuasive. As a matter of claim interpretation, claim 1 differentiates between a “dispersed oil phase” in step (b)(ii) and the spherical particles in step (b)(iii). Because DC 9045 is relied upon for the spherical particle element of step (b)(iii), and Rosevear clearly teaches that DC 9045 is a spherical particle (FF 12), we are not persuaded by Appellant’s attempt to double count DC 9045 as both the oil phase and the spherical particle. Thus, the Examiner’s calculation showing that the ethylhexylmethoxycinnamate UV component at 6% represents more than 50% of the remaining oil phase components including silicone fluid, glycerol monostearate, and DC5225 is persuasive (*see* FF 14).

Appellant contends that it

appreciates that disclosure of overlapping ranges of particle sizes in Maitra and/or Rosevear may result in a finding of prima facie obviousness with regard to the limitation of a particle size of 2 - 40 microns. But the limitation of substantially spherical particles being sized to protrude from the underlying skin care composition layer is a separate element of the claim that must be considered in view of the prior art.

(Appeal. Br. 6). Appellant contends that “the Office must meet a high standard to rely on inherency to establish the existence of a claim limitation in the prior art in an obviousness analysis-the limitation at issue necessarily must be present” (*id.*).

We find this argument unpersuasive because Maitra teaches a preferred total thickness of “between 2.0 and 20 microns” (FF 9) and Rosevear teaches a most preferred particle of DC 9045 averages about 38 microns and may range from 25 to about 55 microns (FF 12). Inserting a 25 micron particle into a 20 micron thick layer is reasonably understood to

necessarily result in protrusion of the particle because the particle has a size larger than that of the layer (FF 9, 12). Having provided evidence that the preferred particles of Rosevear when used in the preferred thickness of layers of Maitra would have been expected to protrude, the burden now shifts to Appellant to demonstrate otherwise with evidence or persuasive argument. *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. . . . 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. . . . Whether the rejection is based on “inherency” under 35 U.S.C. § 102, on “prima facie obviousness” under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.”). Appellant has provided no such evidence or argument.

*Conclusion of Law*

A preponderance of the evidence of record support the Examiner’s conclusion that the combination of Maitra and Rosevear render claim 1 obvious.

CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 20–24, 26	103	1, 20–24, 26	1, 20–24, 26	
24	112(a), written description	24		24

Appeal 2019-005728  
Application 14/445,434

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
<b>Overall Outcome</b>			1, 20–24, 26	

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

AFFIRMED