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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GAELLE SAINTIGNY and
ABDELOUAHAB ELGHALBZOURI

Appeal 2019-005944
Application 14/359,385
Technology Center 1600

Before JEFFREY N. FREDMAN, ELIZABETH A. LAVIER,
and MICHAEL A. VALEK, *Administrative Patent Judges*.

LAVIER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claim 1. An oral hearing took place on June 2, 2020. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word Appellant to refer to "applicant" as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Chanel Parfums Beaute. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claim is directed to a method for screening compounds for possible incorporation into cosmetics:

1. *In vitro* method for screening for compounds that activate PDPN gene expression in papillary fibroblasts, the method comprising the following steps:
 - (a) preparing a first and a second sample of papillary fibroblasts *in vitro*;
 - (b) bringing a compound into contact with the first sample of papillary fibroblasts, and leaving the second sample of papillary fibroblasts untreated, wherein the compound is a botanical extract;
 - (c) measuring the expression of a single gene consisting of the PDPN gene in said first and second samples of papillary fibroblasts, by performing PCR with primers of SEQ ID NO: 9 and SEQ ID NO: 10; and
 - (d) selecting the compound for possible incorporation into a cosmetic composition when an activation of at least 1.5 fold of the expression of said PDPN gene is measured in the first sample of papillary fibroblasts compared with the second sample of papillary fibroblasts.

Appeal Br. 14 (Claims Appendix).

REFERENCES

The Examiner relies on the following references:

Name	Reference	Date
Liu	US 2003/0152647 A1	Aug. 14, 2003
Paufique	US 2010/0291250 A1	Nov. 18, 2010
Binder	US 2012/0283112 A1	Nov. 8, 2012
Affymetrix HG-U133A 2.0 Annotation File (filtered excerpt), ">http://www.affymetrix.com/estore/support/file_download.affx?onloadforward=/analysis/downloads/na35/ivt/HG-U133A_2.na35.annot.csv.zip&_requestid=1267754#> (last accessed on Aug. 1, 2016).		
G.A. Buck et al., <i>Design Strategies and Performance of Custom DNA Sequencing Primers</i> , 27 <i>BIO TECHNIQUES</i> 528–36 (1999).		
Steve Rozen & Helen Skaletsky, <i>Primer3 on the WWW for General Users and for Biologist Programmers</i> , 132 <i>METHODS IN MOLECULAR BIOLOGY</i> 365–86 (2000).		
Yukinari Kato et al., <i>Molecular analysis of the pathophysiological binding of the platelet aggregation-inducing factor podoplanin to the C-type lectin-like receptor CLEC-2</i> , 99 <i>CANCER SCI.</i> 54–61 (2008).		
Moritz Durchdewald et al., <i>Podoplanin Is a Novel Fos Target Gene in Skin Carcinogenesis</i> , 68 <i>CANCER RES.</i> 6877–83 (2008).		

REJECTION

Claim 1 stands rejected under 35 U.S.C. § 103 as unpatentable over Binder, Durchdewald, Liu, Kato, Paufique, Buck, and Rozen, as evidenced by Affymetrix. Final Action 3.

OPINION

In rejecting claim 1, the Examiner interprets the “selecting” step (step (d)) as “requiring merely acknowledging when PDPN gene expression level was increased at least 1.5 fold by a test compound.” Final Action 7. Further, the Examiner finds that the phrase “for possible incorporation into a

cosmetic composition” in step (d) is an intended use, such that a compound so selected “is not patentably distinct from a step in which the compound is selected for a different purpose because nothing more is required by the recitation ‘for possible incorporation into a cosmetic composition’ beyond the step of ‘selecting’.” *Id.* at 8. In other words, Examiner interpreted step (d) such that the phrase “for possible incorporation in a cosmetic compound” was not given weight in assessing whether the prior art taught that step.

We disagree with Examiner’s claim interpretation. The key to understanding step (d) as it relates to the present rejection is the unassuming preposition “for.” In the phrase “selecting the compound *for* possible incorporation into a cosmetic composition” (emphasis added), “for” means “in favor of.” If a compound activates PDPN expression to the claimed degree, then it is considered as a potential candidate in a cosmetic. If the compound does not so activate PDPN expression, then it receives no further consideration. As such, “for” carries meaning in claim 1 that must not be ignored. *See In re Skvorecz*, 580 F.3d 1262, 1267 (Fed. Cir. 2009) (“The protocol of giving claims their broadest reasonable interpretation during examination does not include giving claims a legally incorrect interpretation.”).

Once “for” is given its proper due, the rejection cannot be sustained. The rejection relies in part on Durchdewald, as teaching or suggesting the claimed PDPN expression-based selection even though “Durchdewald explains that PDPN is a marker for skin cancer and can induce tumor growth and metastasis.” Final Action 6. In other words, the Examiner relies on Durchdewald as teaching selection *against* considering using a compound that activates the claimed higher level of PDPN expression, rather than *in favor of* doing so. *See* Ans. 10 (“In view of the prior art teachings as a

Appeal 2019-005944
Application 14/359,385

whole, one of ordinary skill in the art would have been motivated to have selected a compound that induced PDPN expression for the advantage of avoiding manufacturing cosmetic compositions that contains compounds that can activate the expression of this skin cancer marker”).

CONCLUSION

The Examiner’s rejection is reversed.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1	103	Binder, Durchdewald, Liu, Kato, Paufique, Buck, Rozen, Affymetrix		1

REVERSED