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THE PROCTER & GAMBLE COMPANY
GLOBAL IP SERVICES
CENTRAL BUILDING, C9
ONE PROCTER AND GAMBLE PLAZA
CINCINNATI, OH 45202

EXAMINER

OLIVER, BRADLEY S

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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* GORDON GERALD GUAY, JOSEPH MICHAEL ZUKOWSKI,  
LAURIE ELLEN BREYFOGLE, AMANDA LEIGH NEWMAN,  
DAVID EDWARD WILSON, and JAMES FRANKLIN JOA

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Appeal 2019-006366  
Application 14/331,420  
Technology Center 3700

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Before JOHN C. KERINS, EDWARD A. BROWN, and  
BRETT C. MARTIN, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1, 2, 4, 12, 13, and 15. Pending claims 3, 5–8, 11, 14, and 16–30 are withdrawn from consideration. Claims 9 and 10 are canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> The term “Appellant” is used herein to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies The Proctor & Gamble Company, as the real party in interest. Appeal Br. 1.

### THE CLAIMED SUBJECT MATTER

Appellant's invention relates to an applicator for applying a skin smoothing composition. Claim 1 is illustrative, and is reproduced below:

1. An applicator for applying a skin smoothing composition comprising a head and a body, the head comprising an underlayment which is a gradient foam and an outer layer, said outer layer having at least a portion of its surface coated with flock fibers, wherein the flock fibers have a Denier from about 10.0 dtex to about 0.1 dtex and a flock fiber length of from about 5.0mm to about 0.3mm.

### THE REJECTIONS

The Examiner rejects:

(i) claims 1 and 4 under 35 U.S.C. § 103 as being unpatentable over Gueret (US 2007/0277844 A1, published Dec. 6, 2007) in view of Guay (US 2009/0180826 A1, published Jul. 16, 2009);

(ii) claim 2 under 35 U.S.C. § 103 as being unpatentable over Gueret in view of Guay and Roeder (US 2007/0186950 A1, published Aug. 16, 2007);

(iii) claims 12 and 13 under 35 U.S.C. § 103 as being unpatentable over Gueret in view of Guay and Kligman (EP 0 244 859 A2, published Nov. 11, 1987); and

(iv) claim 15 under 35 U.S.C. § 103 as being unpatentable over Gueret in view of Guay, Kligman, and Roeder.

## ANALYSIS

### *Claims 1 and 4--Unpatentability over Gueret and Guay*

The Examiner finds that Gueret discloses an applicator having all limitations appearing in claim 1, with the exception of the underlayment portion of the head in Gueret being a gradient foam. Final Act. 3. The Examiner identifies Guay as disclosing a gradient foam 20 that acts as a reservoir that provides a precise and consistent delivery of fluid to an outer layer, and concludes that it would have been obvious to form the underlayment of Gueret of a gradient foam, to provide these same benefits to Gueret. *Id.*, citing Guay ¶ 60.

Appellant first directs our attention to the fact that claim 1 requires the outer layer of the head of the applicator to have a portion of its surface coated with flock fibers, whereas the Roeder disclosure, cited in rejecting other claims on appeal, teaches that flocked applicators may not uniformly apply or distribute cosmetic compositions. Appeal Br. 5. Appellant argues that because Roeder “avoids” flocked applicators, whereas the claimed applicator is flocked, “[t]his is the antithesis of obviousness.” *Id.* Appellant additionally maintains that its reported results of obtaining uniformly thick application of a composition with its applicator is “surprising and unexpected in view of the teachings of Roeder, which supports unobviousness.” *Id.*

The Examiner responds by pointing out that the Gueret reference, which, unlike Roeder, is cited in rejecting claim 1, teaches that flocking improves the evenness of the application of a cosmetic. Ans. 7. Indeed, Gueret, which is essentially a contemporaneous disclosure to Roeder,

acknowledges that certain known applicators that employ flocking have exhibited problems in delivering the cosmetic composition to the skin. Gueret ¶¶ 5, 6. Gueret indicates that the applicator that is the subject of that reference meets a need for “an application device . . . capable of depositing the desired quantity of product onto the skin,” and does so using a different configuration of a surface of a foam covered by a flock coating. *Id.* ¶¶ 7, 8.

As such, a person of ordinary skill in the art considering the teachings of Gueret and Roeder would be apprised that the use of flocking fibers was understood to potentially present issues relative to application of a cosmetic composition, and that, whereas Roeder proceeded in a direction different from using flocking fibers, Gueret took an alternative approach, that of improving the performance of an applicator that continued to use flocking fibers. Accordingly, Roeder’s avoidance of using a flocked-fiber applicator is of no great moment in determining the patentability of the present invention in view of the teachings of Gueret.

Appellant argues that neither Gueret nor Guay, nor any of the additional references relied on, evidence an appreciation of so-called “special problems associated with the common ‘finger’ mode of applying silicate wrinkle smoothing compositions,” and that “there is no appreciation that the problems are associated with the lack of uniformity/thickness of the finger-applied wrinkle smoothers.” Appeal Br. 7. Appellant, noting that a “patentable invention may lie in the discovery of the source of a problem,” asserts that “ignoring the problem recognition element injects an improper obvious-to-try consideration.” *Id.*

We appreciate that, in certain situations with certain evidentiary records, recognition of a particular problem might ultimately carry the day

on the question of nonobviousness, but that is not the case here. The Examiner articulates a reason, supported by rational underpinnings, as to why a person of ordinary skill would have found it obvious to modify the Gueret applicator to include a gradient foam underlayment, thereby allowing for precise, continuous delivery of a fluid from a dispensing reservoir, resulting in improving the performance of the Gueret applicator. Final Act. 3. Even if, as Appellant asserts, this proposed modification does not address the specific problem faced by Appellant, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Appellant. *In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006). Because there is no requirement that the prior art address the same problem as the claimed invention, the Examiner's reason to combine is appropriate and is not seen in any way as being founded on an "obvious to try" rationale.

Appellant's argument to the effect that the rejection amounts to selectively picking and choosing elements or concepts from the references so as to arrive at the claimed invention, using the claims on appeal as a guide, is not persuasive. The Examiner presents a cogent reason for making the proposed modification, and Appellant does not appear to take issue with that reason.

Appellant additionally argues that Guay teaches away from the proposed modification to Gueret, in that it specifically teaches away from using a flocked outer surface or any other kind of outer surface. Appeal Br. 9–10. Appellant relies on portions of Guay that discuss that an applicator surface area of the gradient foam of Guay be open to the environment. *Id.* at 9, citing Guay ¶¶ 16, 20, 57. Appellant posits that a person of ordinary skill

in the art, particularly in view of Roeder, would not have chosen a flocked covering for the Guay applicator. *Id.* at 10.

As to the latter point, the rejection proposed by the Examiner does not involve a proposal to modify the Guay applicator, but instead to use a gradient foam as disclosed by Guay as a reservoir in the Gueret applicator. The relative impact of the Roeder disclosure on the Gueret disclosure and the combination of Guay with Gueret is addressed above. The argument fails to apprise us of error in the rejection.

As to whether Guay teaches away from the proposed combination due to its disclosure that its preferred embodiment(s) are open or exposed to the environment, as contrasted with having a flocked applicator surface in the proposed combination, we note initially that the principle involved is that a reference may be said to teach away from a combination when it criticizes, discredits or otherwise discourages the proposed modification. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004); *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

The Examiner points out that Guay's teaching of using a gradient foam as an applicator does not constitute a teaching away from the alternative use as a reservoir, particularly in view of the disclosure in Guay that, indeed, the gradient foam could be used as a reservoir. *Ans.* 9, citing Guay ¶ 60. Appellant has thus not shown how Guay criticizes, discredits or otherwise discourages the use of its gradient foam in the manner proposed by the Examiner. *In re Fulton*, 391 F.3d at 1201; *In re Gurley*, 27 F.3d at 553.

Appellant's arguments do not apprise us of error in the Examiner's rejection of claim 1 as having been obvious over Gueret and Guay. The

rejection is therefore sustained. Appellant does not argue separately for the patentability of dependent claim 4, and the rejection is also sustained relative to claim 4.

*Claim 2--Unpatentability over Gueret, Guay, and Roeder*

Appellant argues that Roeder “teaches against flocking,” and therefore, “taken together, the purported combination of Gueret/Guay/Roeder actually teaches away from the present invention and cannot support a § 103 rejection.” Appeal Br. 10. Appellant acknowledges that Roeder discloses applicator softness levels cited by the Examiner as meeting the additional limitations of claim 2, but assigns error to a failure to consider all of the teachings of Roeder, including the identified problems with using flocks in an applicator. Reply Br. 6.

As noted in the analysis directed to the rejection of claim 1, both Roeder and Gueret identify problems or concerns with the use of flocking on cosmetic applicators. Appellant points out, in the above arguments, that Roeder’s solution is to effectively avoid the use of flocking. Gueret, however, provides improvements to the foam substrate underlying the flocking so as to obviate such problems in an applicator that employs flocking. These amount to two different approaches to dealing with known problems with the use of flocking, and, absent evidence that the Gueret approach does not overcome the problems, the two are appropriately viewed by persons of ordinary skill in the art as viable solutions.

Given that the rejection is based on the Gueret approach, and relies on Roeder only for its disclosure of specific Shore A values of hardness/softness for the applicator, we do not find error in the approach



taken by the Examiner in concluding that claim 2 would have been obvious over Gueret, Guay, and Roeder. The rejection of claim 2 is sustained.

*Claims 12 and 13--Unpatentability over Gueret, Guay, and Kligman*

The Examiner notes that Gueret and Guay do not specifically disclose the use of a skin smoothing composition comprising sodium silicate, polyvalent silicate, and water. Final Act. 5. The Examiner relies on Kligman as disclosing such a composition, and concludes that it would have been obvious to use that composition in the Gueret applicator, as modified by Guay, as a matter of merely using a known cosmetic liquid with a known cosmetic liquid applicator. *Id.*

Appellant argues that its “above remarks apply equally to this ground of rejection,” and objects to a purported piecemeal reconstruction of the invention. Appeal Br. 11. We understand the “above remarks” to be the arguments advanced with respect to claim 1, from which claims 12 and 13 depend.<sup>2</sup>

We have already addressed Appellant’s arguments in the analysis directed to claim 1, and again do not find that the arguments apprise us of error in the rejection. The rejection of claims 12 and 13 is therefore sustained.

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<sup>2</sup> Claim 12 recites “[a]n applicator according to Claim 1,” which ordinarily denotes that it is intended to depend from claim 1 and incorporate by reference each limitation of claim 1. However, the limitation appearing in claim 1 relative to the Denier of the flock fibers is present in claim 13, which depends from claim 12. Therefore, claim 12 may not truly depend from claim 1, notwithstanding its reference to claim 1. Because this issue does not affect the outcome in this appeal, we treat claim 12 as depending from claim 1, and including all of the limitations in claim 1 as well as in claim 12.

*Claim 15--Unpatentability over Gueret, Guay, Kligman, and Roeder*

Appellant repeats the arguments advanced with respect to claim 12 in contesting the rejection of claim 15. Appeal Br. 12. For the reasons noted above, the rejection is sustained.

DECISION

The rejections of claims 1, 2, 4, 12, 13, and 15 as being unpatentable are affirmed.

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, 4                   | 103                | Gueret, Guay                  | 1, 4                |                 |
| 2                      | 103                | Gueret, Guay, Roeder          | 2                   |                 |
| 12, 13                 | 103                | Gueret, Guay, Kligman         | 12, 13              |                 |
| 15                     | 103                | Gueret, Guay, Kligman, Roeder | 15                  |                 |
| <b>Overall Outcome</b> |                    |                               | 1, 2, 4, 12, 13, 15 |                 |

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED