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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STACY A. MUNDSCHAU, SANGHA PARK and  
COREY T. CUNNINGHAM<sup>1</sup>

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Appeal 2019-006565  
Application 15/533,777  
Technology Center 1600

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Before ERIC B. GRIMES, ULRIKE W. JENKS, and JOHN G. NEW,  
*Administrative Patent Judges.*

GRIMES, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to a cosmetic emulsion, which have been rejected as indefinite. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Appellant identifies the real party in interest as Kimberly-Clark Worldwide, Inc. Appeal Br. 1. We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a).

STATEMENT OF THE CASE

“The hydrophobic or occlusive properties of a particular formulation may be determined by measuring water vapor transport rate (wVTR) and contact angle. Substances with a low wVTR and a high contact angle are highly occlusive and protective against excessive hydration when the skin is exposed to water-based materials for an extended period.” Spec. 1:23–26.  
“The present disclosure relates to cosmetic oil-in-water emulsions that are breathable, have a relatively low wVTR, and have a low solids content.” *Id.* at 2:22–23.

Claims 1–20 are on appeal. Claims 1, 2, and 5, reproduced below, are illustrative (emphasis added):

1. A cosmetic oil-in-water emulsion comprising:  
water at a concentration of at least about 70% by total weight of the cosmetic oil-in-water emulsion;  
a plurality of water-in-oil emulsifiers;  
a base oil; the base oil having a *pre-immersion wVTR* of 1.0 to 30 g/m<sup>2</sup>/hr according to a *Pre-immersion Water Vapor Transport Rate Test Method* and being at a concentration of no more than 15% by total weight of the cosmetic oil-in-water emulsion;  
an oil-in-water emulsifier; and  
a film-forming polymer.
2. The cosmetic oil-in-water emulsion of claim 1, wherein the cosmetic oil-in-water emulsion has a *post-immersion wVTR* value of between 1.0 to 40 g/m<sup>2</sup>/hr according to a *Post-Immersion Water Vapor Transport Rate Test Method* and an oxygen permeability of at least 1.0 cc/100 in<sup>2</sup> per day according to an *Oxygen Permeability Test Method*.

5. The cosmetic oil-in-water emulsion of claim 1, wherein the cosmetic oil-in-water emulsion has a contact angle greater than 60° according to a *Contact Angle Test Method*.

#### OPINION

Claims 1–20 stand rejected under 35 U.S.C. § 112(b) as indefinite, for several reasons. Final Action 2–3. First, the Examiner finds that the claims are indefinite because they “recite a wVTR measurement without defining the terms of this measurement. Nowhere in the specification as filed is there a clearly set forth definition of this claim term.” *Id.* at 3.

Second, the Examiner finds that the claims are indefinite because “they recite a ‘base oil’ without definition of what is included or excluded by this term. As such, to interpret the claims, one must import limitations from the specification as filed into the claims.” *Id.* The Examiner finds that it is “unclear what components are required to meet the limitation ‘base oil.’” *Id.*

Third, the Examiner finds that

the oxygen permeability parameter . . . is unclear since this test is referenced without reciting the parameters of this term. These measurements may vary from one person or circumstance to another since the conditions such as temperature and humidity gradient under which the measurement is made influences the result.

*Id.*

Finally, the Examiner finds that “claim 5 is unclear since claim 5 recites a contact angle without defining the solid surface on which the measurement is taken, thereby leaving the claim open to variable results depending on the testing.” *Id.* at 3–4.

Appellant argues that the claim meaning “would be understood by one of ordinary skill in the art when reading the specification” because “each of the four specified test methods used in Appellant’s claims . . . are described on pages 25–28 in the section of Appellant’s specification entitled ‘Test Methods.’” Appeal Br. 4. Specifically, “claims 1, 4, 18, and 20 specify a Pre-immersion Water Vapor Transport Rate Test Method. This test method is fully defined and supported in Appellant’s original specification on page 25 under the sub-heading ‘Water Vapor Transport Rate (wVTR) – Pre-Immersion.’” *Id.*

“[C]laims 2 and 19 specify a Post-immersion Water Vapor Transport Rate Test Method. This test method is fully defined and supported in Appellant’s original specification on pages 25–26 under the sub-heading ‘Water Vapor Transport Rate (wVTR) – Post Immersion.’” *Id.* “[C]laims 2 and 19 . . . also specify an Oxygen Permeability Test Method. . . . The oxygen permeability parameters would be measured according to the specified Oxygen Permeability Test Method defined on page 26.” *Id.* at 5–6.

“[C]laim 5 also specifies a Contact Angle Test Method. . . . Appellant respectfully asserts that one of ordinary skill in the art, when reading the Contact Angle Test Method on pages 27 and 28 of Appellant’s original specification would understand the test parameters and equipment used in such test method.” *Id.* at 6.

Finally, Appellant argues that the “specification provides an express definition for the term ‘base oil.’ . . . [T]he term ‘base oil’ is defined on page 3 under the sub-heading ‘Base Oil’, which states, ‘[t]he base oil can be any oil with a wVTR less than 30.0 g/m<sup>2</sup>/hr.’” *Id.* at 4–5. As the Examiner has

pointed out, however, the “wVTR” used to define “base oil” is itself a term the Examiner finds to be indefinite. Ans. 5.

We agree with the Examiner that the claims as written are indefinite. “[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

“*Nautilus* emphasizes ‘the definiteness requirement’s public-notice function.’” *Dow Chem. Co. v. Nova Chems. Corp. (Canada)*, 803 F.3d 620, 630 (Fed. Cir. 2015). “Although the Court recognized that ‘[s]ome modicum of uncertainty’ may be tolerated, . . . the patent and prosecution history must disclose a single known approach or establish that, where multiple known approaches exist, a person having ordinary skill in the art would know which approach to select.” *Id.* (The *Dow* court’s reference to prosecution history was in the context of an infringement case; before a patent is issued, “[a]bsent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).)

*Dow* addressed an issue similar to the one on appeal here. In that case, “[t]he claim term at issue . . . provide[d] for ‘a slope of strain hardening coefficient greater than or equal to 1.3.’” *Dow*, 803 F.3d at 631. The record showed that at least four methods could be used to measure the relevant slope, and “each of these four methods may produce different results, i.e., a

different slope.” *Id.* at 633. “Because the methods do not always produce the same results, the method chosen for calculating the slope of strain hardening could affect whether or not a given product infringes the claims.” *Id.* at 634.

Similar to the multiple tests in *Dow*, here Appellant has not pointed to evidence, or even asserted, that those skilled in the art would have recognized, for example, “an Oxygen Permeability Test Method” or “a Contact Angle Test Method” as referring to a single, art-recognized test method carried out under specific, standardized conditions. Nor has Appellant pointed to evidence, or even asserted, that every method of measuring the parameters recited in the claims will provide the same result. Thus, the claim language, even read in light of the Specification, fails to apprise those skilled in the art of the scope of the claims, because it does not make clear which assays and assay conditions define whether or not a composition is encompassed by the claims.

Appellant correctly notes that “an Applicant has the ability to be their own lexicographer and can define aspects of their invention in the claims in whatever terms or language they choose.” Appeal Br. 3. To act as its own lexicographer, however, an applicant must “clearly set forth a definition of the disputed claim term.” *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

Here, as the Examiner has noted, “the specification as filed does not clearly present a special definition of the terms at hand.” Ans. 3. That is, the Specification does not define the parameters recited in the claims as being determined according to a specific test, under specific conditions, nor does the Specification define the “Test Method[s]” recited in the claims as those

described under “Testing Methods” in the Specification. *Cf.* Spec. 3:9–15 (expressly defining “water-in-oil emulsions,” “oil-in-water emulsions,” and a “stable” emulsion). Rather, the “Testing Methods” section of the Specification appears to describe the testing methods that were used in the Specification’s working examples, rather than prescribing those methods for use in defining the invention.

In addition, the claims themselves do not specify the steps and conditions of the testing methods used to determine the parameters defining the scope of the claims. Compare the instant claims, for example, to one of the claims on appeal in *In re Kao*, 639 F.3d 1057 (Fed. Cir. 2011), which recited:

a controlled release delivery system comprising at least one pharmaceutical excipient, *wherein upon placement of the composition in an in vitro dissolution test comprising USP Paddle Method at 50 rpm in 500 ml media having a pH of 1.2 to 6.8 at 37° C, about 15% to about 50%, by weight, of the oxymorphone or salt thereof is released from the tablet at about 1 hour in the test.*

*Id.* at 1061–62 (emphasis in original). Claim definiteness was not at issue in *Kao*; it is cited here only to show the lack of specificity in Appellant’s claims regarding the procedures and conditions for measuring the recited parameters.

In summary, the claims do not recite the test methods required to determine the scope of the claims, and the Specification does not define the claim terms with sufficient clarity to allow those skilled in the art to determine, with reasonable certainty, the test methods and conditions that define the scope of the claims. We therefore conclude that the claims, even read in light of the Specification, “fail to inform, with reasonable certainty,

those skilled in the art about the scope of the invention.” *Nautilus*, 572 U.S. at 901. The rejection of claims 1–20 under 35 U.S.C. § 112(b) is affirmed.

#### DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–20	112(b)	Indefiniteness	1–20	

#### TIME PERIOD FOR RESPONSE

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

AFFIRMED